Decision for dispute CAC-UDRP-101610

Case number	CAC-UDRP-101610
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Domain names	tevasildenafil.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Teva Pharmaceutical Industries Ltd.

Complainant representative

Organization	RiskIQ, Inc

Respondent

Organization	SecureMedical

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings pending or decided related to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the registered owner of the following word trademarks “TEVA”:

• Israel (No. 41075, filed 5 August 1975, in Class 5, covering “pharmaceutical preparations and pharmaceutical products; chemical sanitary substances; cosmetics”);
• United States (No. 1,567,918, filed 17 February 1989, issued 28 November 1989, in Class 5: “house mark for a full line of pharmaceutical, veterinary and sanitary preparations”);
• Canada (No. TMA411063, filed 22 August 1990, issued 16 April 1993, in Classes 3, 5, and 6, covering inter alia “pharmaceutical preparations, pharmaceutical products and chemical sanitary substances (…)”);
• China (No. 644291 since 7 June 1993, in Class 5);
• EU (No. 001192830, filed 2 June 1999, issued 18 July 2000, in Classes 3, 5, and 10, whereby class 5 covers: “pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides”); and
• Israel (No. 188932, filed 27 March 2006, in Class 5, covering “vitamins, minerals, antioxidants”).

These trademarks are hereafter referred to as the "TEVA trademarks".

FACTUAL BACKGROUND

The Complainant is the owner of the TEVA trademarks. The disputed domain name <tevasildenafil.com> was registered on 8 March 2017. The Complainant's TEVA trademark registrations predate the registration of the disputed domain name.

The disputed domain name consists of the terms "teva" and "sildenafil". As referred to above, the Complainant owns certain registered word trademarks "TEVA" for pharmaceutical products and preparations. Sildenafil is a chemical compound used to treat erectile dysfunction in adult men.

The disputed domain name does not resolve to an active website.

The Complainant was formed in 1976 in Israel. The Complainant is a global pharmaceutical company, which develops, produces and markets generic medicines and a number of specialty medicines. The Complainant claims to be the leading generic drug company in the U.S, the leading generic pharmaceutical company in Europe, and the leading generic pharmaceutical company in Canada in terms of prescriptions and sales. The Complainant asserts that its revenues in 2016 amounted to $21.9 billion.

The Complainant claims that it manufactures and sells, inter alia, generic erectile dysfunction ("ED") medicines with the active ingredient sildenafil in various countries. The Complainant clams that it is on the verge of selling such medicines in the United States as well.

The Respondent is a medical technology company, established in 1998. The Respondent claims to offer healthcare services to patients, including services to increase the awareness of medicines, and telemedicine services. The Respondent claims that it has partnered with US licensed physicians and pharmacies since 1998, and that it has been a member of the American Telemedicine Association since 2004.

The Respondent also sells medicines for treating erectile dysfunction ("ED") through various websites including www.accessrx.com, www.viamedic.com, www.edrugstore.com, and www.edensrx.com. The Respondent claims to be the largest retailer of erectile dysfunction medicines in the United States, including Viagra, Cialis, Levitra, Stendra, and Staxyn.

The Respondent claims that it purchased the disputed domain name in March 2017 for the purpose of comparing the Complainant's generic version of erectile dysfunction medicines with other, brand-named, versions of ED medicines. The Respondent further claims that the reason why it has not yet published any information on the website available through the disputed domain name is that the Complainant's generic erectile dysfunction medicine has not yet been approved for use in the United States.

In an email of 8 May 2017, Mr. Matkowsky, the Complainant's attorney, gave notice to the Respondent of the Complainant's objections to the Respondent's registration of the disputed domain name, based on its earlier rights in the TEVA Trademarks. In this email, Mr. Matkowsky also asked whether the Respondent was willing to amicably transfer the disputed domain name to the Complainant. This email was resent on 7 June 2017. The Respondent replied: "We are the largest retailer of ED medication for the last 20 years in the US. We would like to talk to you about promoting your product when it is available in the US. Please call me at your convenience." (no date is mentioned in this email).

This email conversation was followed by a telephone call between Mr. Matkowsky and Mr. Rao, the President of the Respondent. According to both parties, in this telephone call, Mr. Rao refused to transfer the domain name to the Complainant. According to the Respondent, "when pressed further by Mr. Matkowsky, Rao indicated a possibility that if a deal was worked out for having SMI be an authorized supplier, they may be able to work out a deal regarding the domain name". Further according to the Respondent, "Rao asked Mr. Matkowsky to convey its intention of becoming a supplier to Teva." The Respondent emphasizes that the Complainant's request for transferring the domain name and the Respondent's suggestion of becoming an authorized supplier of the Complainant's products were always separate in the Respondent's mind.

On 10 July 2017, Mr. Matkowsky sent a follow-up email to the Respondent, with the following content:

“John: This is to confirm our call that your daughter Angela is the company's legal counsel, and asked for you to intervene so I should not wait to hear back from her or that alias legal@. I understand from our call that you are not willing to transfer it unless your company becomes an authorized supplier for Teva, but that you want to sell the product throughout US and Canada, and promote it over and above the brand products that you have currently. I will convey this to Teva. Thanks for your time.” (emphasis added)

The Respondent replied the same day, stating:

“Yes Jonathan , we have been struggling with high prices for the brand products that we currently sell like Viagra , Cialis , Levitra , Stendra , and Staxyn.
We welcome a lower affordable generic ED product that we can sell and promote to our customers. We can market the product on all our websites and over 50 magazine publications. Our rankings in the major search engine are on page one most of the time for the brand products and we can help promote your clients product as well.
We are celebrating our 20th year in business and upon checking our corporate site you will get more of an understanding of Secure Medical.
Some of the websites; www.accessrx.com www.viamedic.com www.edrugstore.com www.edensrx.com and a few more that I will mention later.
www.securemedical.com
Thank you for your understanding”

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

I. The disputed domain name is identical or confusingly similar to Complainant's registered TEVA trademarks.

According to the Complainant, the disputed domain name reproduces the Complainant’s trademark TEVA in its entirety, adding only a generic name of a chemical compound sildenafil used to treat erectile dysfunction in adult men. Where the common noun added coincides with and in fact connotes if not precisely denotes Class 5 goods in respect of which the trademark incorporated in the domain name has been registered, confusing similarity is inevitable since the general public will necessarily associate it with the registered trademark (reference is made to WIPO Case No. D20040583, <buygeneric-viagrasildenafilcitrate.biz>). The generic top level suffix may be disregarded when considering whether the disputed domain name is identical or confusingly similar to the trade mark in which a complainant has rights.

II. The Respondent does not have any rights or legitimate interest in the disputed domain name.

According to the Complainant, the Respondent does not use the disputed domain name in connection with any legitimate use. The Respondent’s use and registration of the disputed domain name was not authorized by the Complainant. The Respondent is not commonly known by the disputed domain name. Also, the Respondent has not acquired rights in the disputed domain name. There is no legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers. According to the Complainant, a contemplated use cannot be considered “fair” if the domain name falsely suggests an affiliation or endorsement with the trademark owner, or is only being used as a bargaining chip to negotiate for such an affiliation or endorsement. The Complainant emphasizes that the additional term “sildenafil” combined with the TEVA trademark is well within the Complainant's field or at least indicates services related to the Complainant’s TEVA trademarks. The Complainant further emphasizes that the additional term “sildenafil” is not obviously critical, and there is no content hosted that could weigh in favour of potential rights or legitimate interests. The Complainant concludes that the disputed domain is being used as a pretext for commercial gain to the Respondent’s benefit.

III. The disputed domain name has been registered and is being used in bad faith.

Since the disputed domain name consists of a combination of the Complainant's TEVA trademark and the generic term "sildenafil", used to treat erectile dysfunction in adult men, it is inconceivable to the Complainant that the Respondent would have been unaware of the Complainant's TEVA trademark rights when registering the disputed domain name.

According to the Complainant, the email correspondence between the Complainant's authorized representative and the Respondent evidences that the Respondent was well aware of the Complainant's rights in the TEVA trademarks, particularly in relation to erectile dysfunction medication.

The Complainant emphasises that it had already publicly announced that it would launch a generic version of sildenafil-based erectile dysfunction medication in the United States. The Complainant further emphasises that it has in fact already launched such generic medication in other countries. According to the Complainant, it is a known fact that the Complainant will be able to launch its Abbreviated New Drug Application (ANDA) products pursuant to a royaltybearing license arrangement with Pfizer of 11 December 2017, or even earlier. The email correspondence between the Complainant's authorized representative and the Respondent evidences that Respondent intentionally registered the disputed domain name, to take advantage of the goodwill associated with the TEVA trademark in connection with sildenafil.

According to the Complainant, the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely known trademark by an unaffiliated entity can, by itself, create a presumption of bad faith (reference is made to WIPO Overview 3.0, Par 3.1.4). The strong connection between the term "sildenafil" and the TEVA trademarks also indicates that the Respondent registered the disputed domain name with the intention to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's TEVA trademarks as to the source, sponsorship, affiliation, or endorsement of its website or location or of a service on its website or location.

The correspondence between the Complainant's authorized representative and the Respondent evidences that the Respondent has no actual or contemplated good faith use, and that the Respondent merely intended to capitalize on the Complainant's TEVA trademark rights, specifically where the Respondent confirmed that it would transfer the disputed domain name only if the Complainant were to make the Respondent its authorized supplier.

The Complainant furthermore asserts that its TEVA trademarks are famous and well-known trademarks in the pharmaceutical space. The Complainant claims that the strong reputation of its TEVA trademarks and their wide use, combined with the absence of any evidence of actual or contemplated good faith use, are further evidence of bad faith registration and bad faith use, especially in the event of a passive use of a domain name.

RESPONDENT:

I. The disputed domain name is not identical or confusingly similar to Complainant's registered TEVA trademarks.

According to the Respondent, because of the addition of the term "sildenafil," the disputed domain name can not be considered identical to the Complainant's TEVA trademarks.

The Respondent further asserts that the disputed domain name is not confusingly similar to the Complainant's TEVA trademarks either, because consumers are not likely to be confused or to associate the disputed domain name only with "Teva".

The Respondent contests that the Complainant's TEVA trademarks are famous or well known, at least in the United States, in association with the Complainant or with the generic drug sildenafil. The Respondent argues that over 150 trademarks have been registered in the US containing the term "TEVA". The Respondent further argues that, even if the Complainant

might be known as a manufacturer of generic medications in general, it is not known as a major manufacturer or seller of sildenafil medication in the United States. The Respondent emphasizes that the Complainant's generic erectile dysfunction medication has not yet been approved in the US. According to the Respondent, this entails that a consumer based in the US would not associate "sildenafil" with "Teva" or be confused or link the source of the goods provided under the disputed domain name to "Teva".

The Respondent argues that the Complainant's reference to WIPO Case No. D20040583, <buygenericviagrasildenafil-citrate.biz>, is irrelevant since, contrary to WIPO Case No. D20040583, the Respondent in the current case is not using (nor intending to use) the disputed domain name to actively sell generic sildenafil products to the public. The Respondent reiterates that it intends to use the disputed domain name solely for comparing the Complainant's sildenafil medication to other ED medications, when the Complainant's product becomes available in the US. Also, in WIPO Case No. D20040583, the trademark "Viagra" was registered as a "compound for treating erectile dysfunction", whereas in the current case the TEVA trademark registrations do not contain the word "sildenafil" nor any other reference to erectile dysfunction medicines.

II. The Respondent has rights or legitimate interest in the disputed domain name.

The Respondent asserts that it makes or intends to make a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark at issue. The Respondent asserts that a use of a domain name is considered a fair use or protected free speech if this use is for comparison, comment, parody, or criticism (reference is made to Upwork Inc. v. Sunny Kumar, ADR case No. 101294, 2016-0916).

The Respondent argues that it bought the disputed domain name for the purpose of comparing the Complainant's generic ED medication with branded ED medications.

The Respondent adds: "In addition, as the largest retailer of ED medications in the U.S., Respondent has a legitimate interest in informing the drug facts regarding a generic version of ED medications. Much of Respondent's own websites are dedicated to providing comparisons of various products and informing the public of information about the respective drugs."

According to the Respondent, the Complainant's representative, Mr. Matkowsky, restated the email conversation in a misleading manner to make it appear as if the Respondent was holding the disputed domain name at ransom to pressure the Complainant into agreeing to appoint the Respondent as its supplier. The Respondent argues that such was not its intention. According to the Respondent, it was in fact the Complainant who made the suggestion of the Respondent becoming an authorized Teva supplier, in exchange for the transfer of the disputed domain name. Further according to the Respondent, the Complainant made such suggestion "to try to make it look like [the Respondent] had ulterior motives for purchasing the domain name." The Respondent blames the Complainant for manipulating the UDRP in its favour.

The Respondent concludes: "Respondent has legitimate fair use and noncommercial interests in the domain and is free to reject Teva's request of transferring the domain to Teva. In the meantime, as a retailer of ED medications, Respondent is free to explore business opportunities of becoming an authorized dealer of Teva's generic version of ED medication, adding to Respondent's existing business of selling ED medications."

III. The disputed domain name has not been registered and is not being used in bad faith.

The Respondent argues that, to find a domain name is used in bad faith, the Complainant must provide evidence of the circumstances listed in paragraph 4 (b) of the Policy. The Respondent adds that the Complainant failed to provide evidence of any of these four circumstances.

The Respondent reiterates that it has acquired the disputed domain name for the legitimate purpose of providing drug facts, commenting on the Complainant's generic version of sildenafil, and comparing it with branded versions and other generic sildenafil products.

First, according to the Respondent, the Complainant failed to provide evidence demonstrating that the Respondent acquired the disputed domain name primarily for transferring it in exchange for consideration. The Respondent states that it never offered to transfer the disputed domain name in exchange for becoming a supplier of the Complainant. The Respondent contends that this suggestion came from the Complainant's representative, not from the Respondent. The Respondent reiterates that transferring the disputed domain name and becoming a supplier to the Complainant were always separate in the Respondent's mind.

Second, according to the Respondent, the Complainant fails to demonstrate that the Respondent has engaged in a pattern of conduct of registering domain names to prevent the mark holder from reflecting its mark in the domain(s).

Third, the Respondent states that the Complainant failed to substantiate that it registered the disputed domain name primarily to disrupt the Complainant's business as a competitor. The Respondent emphasizes that it is not to be considered a competitor of the Complainant, since it is a retailer of ED medications, whereas the Complainant is a manufacturer of generic medications.

Fourth, according to the Respondent, the Complainant failed to prove that the Respondent intentionally attempted to attract, for commercial gain, Internet users to the disputed domain by creating consumer confusion. The Respondent emphasises that no content has been posted on the website available through the disputed domain name, because the Complainant's sildenafil medicine has not yet been made available in the U.S. market. The Respondent underlines that the Complainant is not known in the U.S. as a manufacturer of sildenafil medication, and that the TEVA trademarks of the Complainant are not famous or wellknown in the U.S.

The Respondent adds: "SMI is the largest retailer in the U.S. of ED medications and ED medication is commonly known as sildenafil. When faced with a web site that includes a comparison of Teva's version of Sildenafil and other company's versions of Sildenafil, an ordinary consumer would not automatically assume the site is sponsored by or endorsed by Teva."

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

A. Identical or confusingly similar

The Panel notes that the disputed domain name consists of the terms "teva" and "sildenafil" together with the generic ".com" Top-Level Domain ("gTLD"). As referred to above, the Complainant is the owner of various registered word trademarks "TEVA" for pharmaceutical products and preparations. Sildenafil is a chemical compound used in medicines to treat erectile dysfunction in adult men. The disputed domain name thus incorporates the registered TEVA trademark(s) of the Complainant and the descriptive element sildenafil, a compound present in at least some of the products sold by the Complainant.

The Panel notes that previous panels have accepted that the incorporation of a trademark in its entirety into a domain name is sufficient to establish that the disputed domain name is identical or confusingly similar to a registered trademark. See Hürriyet Gazetecilik ve Matbaacılık Anonim Şirketi v. Moniker Privacy Services / Kemal Demircioglu, D2010-1941 (WIPO 28 January 2011) ("a domain name that reproduces the trademark in its entirety is confusingly similar to the mark" when the disputed domain names <hürriyet.com>, <hürriyetemlak.com>, and <hürriyetoto.com> fully incorporated the complainant's HURRIYET mark); See also Bayerische Motoren Werke AG, Sauber Motorsport AG v. Petaluma Auto Works, D2005-0941 (WIPO 20 October 2005) ("It has been stated in several decisions by prior UDRP administrative panels that incorporating a trademark in its entirety into a domain name can be sufficient to establish that the domain name is identical or confusingly similar to a registered trademark" when the <bmwsauberf1.com> domain name fully incorporated complainant's BMW and SAUBER marks).

There are some panels that have considered the position to be somewhat more nuanced and that this may not be so in all cases, although it has been recognised that in most cases where a domain name incorporates the entirety of a trademark, then the domain name will for the purposes of the Policy be confusingly similar to the mark (see for example, the detailed discussion of this topic in Research in Motion Limited v. One Star Global LLC WIPO Case No. D2009-0227).

Given this, the Panel has no difficulty in concluding in this case that the registered domain name incorporates the entirety of the Complainant's TEVA trademark(s) and that the addition of the descriptive term sildenafil and the ".com" gTLD does not prevent a finding of confusing similarity under the first element of paragraph 4(a) of the Policy. Rather, the addition of a product manufactured by TEVA, the compound generically known as Sildenafil, to the TEVA trademark serves to induce the very association that consumers can be expected to make, remembering in particular that the .com gTLD does not refer only to one market but is of potentially global scope for this kind of product.

Therefore, the Panel concludes that the disputed domain name is confusingly similar to the registered TEVA trademarks of the Complainant.

B. Rights or legitimate interests

As regards paragraph 4(a)(ii) of the Policy, while the overall burden of proof rests with the Complainant, it is commonly accepted that this should not result in an often-impossible task of proving a negative. Therefore, numerous previous Panels have found that the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the Respondent fails to come forward with such appropriate allegations or evidence, the Complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy. If the Respondent does come forward with some allegations or evidence of relevant rights or legitimate interests, the panel then has to weigh all the evidence, with the burden of proof always remaining on the Complainant.

The Complainant has made a prima facie case that the Respondent does not use the disputed domain name in connection with any legitimate use; that the Respondent's registration of the disputed domain name was not authorized by the Complainant; that the Respondent is not commonly known by the disputed domain name; that the Respondent has not acquired rights in the disputed domain name; and that there is no legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers. The Complainant has also made a prima facie case that the Respondent uses the disputed domain name as a bargaining tool to negotiate to become an authorized supplier of the Complainant's products.

Under paragraph 4 (c) of the Policy, a respondent can use the following elements, among others (this is not an exhaustive list), to prove rights or legitimate interests in a domain name for the purposes of Paragraph 4(a)(ii) of the Policy:
(i) before any notice of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
(ii) the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if

the respondent has acquired no trademark or service mark rights; or
(iii) the respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel notes that the Respondent claims that it intends to use the disputed domain name for comparing the sildenafil-based generic medication of the Complainant with other (branded) sildenafil-based medication. However, the Panel also notes that the Respondent fails to provide any evidence of such intended use.

In the email conversation of 10 July 2017, the Panel notes that no reference can be found of the Respondent's intention to use the domain name for comparing the Complainant's generic sildenafil medicine with other brand-name sildenafil medicines. On the contrary, in these emails, the Respondent chose to mention that it is the largest retailer of erectile dysfunction medication in the US and explicitly offered to promote the Complainant's sildenafil-based medicine. The Respondent furthermore referred to high sale prices for the branded sildenafil products it was already selling, such as Viagra, Cialis, Levitra, Stendra, and Staxyn. The Respondent explicitly voiced its interest in selling a generic sildenafil product, which it could market "on all our websites". The Respondent finally invited the Complainant to check its corporate website and referred to other domain names used by the Respondent. The Respondent did not submit screenshots of its corporate website or its other websites, but from the email conversation of 10 July 2017, it can be understood that these websites are mainly used for the sale of sildenafil-based erectile dysfunction medication, rather than for informing the public of the characteristics of sildenafil-based medicines by comparing various products with one another.

Also, in its email of 10 July 2017, the Complainant unambiguously mentioned its understanding that the Respondent was not willing to transfer the domain name unless the Respondent could become an authorized supplier for the Complainant's (sildenafil) medicines. The Panel notes that the Respondent replied by confirming its intention to sell the Complainant's sildenafil-based medicines. The Respondent did not contest the Complainant's unambiguous understanding that the transfer of the domain name was linked to the Respondent becoming an authorized supplier of the Complainant's (sildenafil) medicines. The Panel finds it improbable that the Respondent would not have appreciated that the Complainant's statement could have legal implications. The Panel further finds the assertion of the Respondent that it was the Complainant and not the Respondent who first suggested that the Respondent could become an authorized supplier as a compensation for the transfer of the domain name as unsupported by the evidence available to it. The evidence at hand, i.e. the email conversation of 10 July 2017, instead suggests that it was the Respondent, and not the Complainant, who linked the transfer of the disputed domain name to becoming an authorized supplier. Had the understanding of the Respondent been any different, the Panel would have expected the Respondent to contest the explicit understanding of the Complainant in the Respondent's email of 10 July 2017. However, the Respondent did not contest this understanding and on the contrary confirmed its desire of becoming a supplier of the Complainant's medicines.

In terms of its other arguments, the Respondent stated in its response: "Respondent has legitimate fair use and non-commercial interests in the domain and is free to reject Teva's request of transferring the domain to Teva. In the meantime, as a retailer of ED medications, Respondent is free to explore business opportunities of becoming an authorized dealer of Teva's generic version of ED medication, adding to Respondent's existing business of selling ED medications." However, the Panel points out that the Respondent is not free to register and use a domain name in conflict with the Policy. The Panel further finds that the demonstrated use by the Respondent of the disputed domain name in a negotiation to become an authorised supplier or retailer of the Complainant, does not correspond to a legitimate or fair use.

The Panel therefore finds that the use of the disputed domain name by the Respondent does not amount to a legitimate non-commercial or fair use, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. The Panel furthermore finds no evidence of the Respondent's use of (or demonstrable preparations to use) the disputed domain name in connection with a bona fide offering of goods or services or indeed evidence of preparations to establish a separate comparison website. In this last respect, the Panel does acknowledge that there can be some legitimate scope for such sites, particularly where public interest concerns apply. Commercially, too, the Panel recognises that traders offering similar products might wish to offer means to display, for example, comments by experts and/or users. But it would, all the same, expect some form of differentiation in registering a domain name for this purpose with respect to the brand/product name in question. Setting up an entire specific website for this purpose, rather than, for

instance, integrating comparison in an existing site catering for multiple products would, furthermore, suggest that there would be some special reason to do so. Yet no differentiation was made or specific justification indicated by the Respondent.

The Panel finally finds no evidence that the Respondent is commonly known by the disputed domain name.

The Panel therefore decides that the Respondent has no rights or legitimate interests in the disputed domain name.

C. Bad faith registration and use

The Panel notes that Complainant's TEVA trademark registrations predate the registration of the disputed domain name. The oldest registered TEVA trademark of the Complainant dates from 5 August 1975. This trademark covers the Complainant's home market, Israel, and predates the disputed domain name with 41 years. The US TEVA trademark of the Complainant dates from 1989 (application filed on 17 February 1989, and issued on 28 November 1989). This trademark covers the Respondent's home market, the US, and predates the disputed domain name by 27 years.

The Complainant's registered TEVA trademarks are all valid for Class 5, covering pharmaceutical preparations and pharmaceutical products.

The Panel notes that both parties involved in the dispute conduct a business of, inter alia, the sale of pharmaceutical preparations and pharmaceutical products.

The Respondent claims at various points to be the largest retailer of erectile dysfunction medicines in the United States. The Panel finds that the Complainant has provided sufficient evidence that it is a major manufacturer and seller of generic medicines in various countries, including in the United States. Given the scale of the activities of the Respondent as the largest retailer of ED medicines in the US, and given the scale of the sales of generic medicines by the Complainant, the Panel finds it inconceivable that the Respondent would not have been aware of the prior trademark rights of the Complainant.

As discussed above, there is no evidence supporting the claim of the Respondent that it registered the disputed domain name for the purpose of comparing the sildenafil-based generic medication of the Complainant with other (branded) sildenafil-based medication.

From the email correspondence of 10 July 2017, submitted by the Complainant, it follows that the Respondent has used or attempted to use the disputed domain name as a bargaining tool to become appointed as an authorized supplier of the Complainant's products.

From this email conversation, the Panel notes the following facts, in chronological order:

• First, the Complainant contacted the Respondent, informing the Respondent that its registration of the domain name is disputed, based on the earlier trademark rights of the Complainant, and asking whether the Respondent was willing to voluntarily transfer the domain name to the Complainant.
• Second, the Respondent replied, informing the Complainant of its status as largest retailer of erectile dysfunction medication in the US, and mentioning that it would like to talk with the Complainant about promoting the Complainant's product "when it is available in the US" (it is thus clear to the Panel that the Respondent referred to the Complainant's sildenafil-based generic ED medicine, which was at that time close to being launched in the US, and whose active component "sildenafil" is reflected in the disputed domain name). In other words, in answer to the Complainant's claim of dispute of the domain name, the Respondent offered to discuss promoting the Complainant's products, while not making the effort to contest the domain name claim of the Complainant.
• Third, on the invitation of the Respondent, the Complainant's representative held a telephone conversation with the Respondent.
• Fourth, subsequent to the telephone conversation, the Complainant's representative sent an email to the Respondent with a

confirmation of what had been discussed during the telephone conversation, whereby the Complainant unambiguously mentioned its understanding of the Respondent's position in the sense that the Respondent was not willing to transfer the domain name unless the Respondent could become an authorized supplier for the Complainant's (sildenafil) medicines.
• Fifth, the Respondent replied to this email by confirming its willingness to sell the Complainant's sildenafil-based medicines. In its reply, the Respondent did not contest the Complainant's understanding of the Respondent's position, namely that the transfer of the domain name is linked to the Respondent becoming an authorized supplier of the Complainant's (sildenafil) medicines. The Panel can only read this response as a confirmation that the Respondent indeed considered a commercial relationship, whereby the Respondent would be granted the right to sell the Complainant's sildenafil ED medicines as the price to be paid for the transfer of the disputed domain name.

In its response, the Respondent even admitted: "when pressed further by Mr. Matkowsky, Rao indicated a possibility that if a deal was worked out for having SMI be an authorized supplier, they may be able to work out a deal regarding the domain name". As mentioned above under the second prong of paragraph 4(a) of the Policy, the Panel finds it unlikely that the suggestion of becoming an authorized supplier originated with the Complainant, and this quotation in fact confirms such view.

In sum, the Panel considers this email correspondence as sufficient proof of bad faith use of the disputed domain name by the Respondent.

The Panel also notes that the disputed domain name is comprised of a combination of the Complainant's TEVA trademark and the generic term "sildenafil", used to treat erectile dysfunction in adult men. The Panel notes that the Respondent apparently was well aware of the fact that the Complainant was on the verge of bringing its generic sildenafil-based ED medicines to the US market at the time of registration of the domain name. This circumstance is furthermore congruent with the Respondent registering the disputed domain name and then offering a commercial partnership upon being notified by the Complainant of its rights. Given the combination of words in the disputed domain name, and given the familiarity of the Respondent with the market of medicines in general and of ED medicines in particular, the Panel finds it unlikely that the Respondent would not have been aware of the Complainant's TEVA trademark rights when registering the disputed domain name, while, as seen above, evidence to support the assertion that a separate comparison site was to be launched was not provided. The Panel therefore concludes that the Respondent has registered the disputed domain name in bad faith in the sense of the UDRP.

The Respondent argues that the Complainant failed to provide evidence of any of the circumstances listed in paragraph 4 (b) of the Policy, and that, therefore, bad faith is absent. However, the Panel emphasises that the circumstances listed in paragraph 4 (b) of the Policy are mere examples of bad faith, and that the Complainant is not required to prove all circumstances listed in this paragraph 4 (b). The Panel adds that a Complainant may in fact be able to prove other elements of bad faith than those listed in paragraph 4 (b) of the Policy. In any case, from the combination of facts listed above, the Panel concludes that the Complainant has sufficiently proved that the disputed domain name was registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **TEVASILDENAFIL.COM**: Transferred

PANELLISTS

Name	**Bart Van Besien, Kevin J. Madders, Matthew Harris**

DATE OF PANEL DECISION 2017-09-25

Publish the Decision