Decision for dispute CAC-UDRP-101835

Case number	CAC-UDRP-101835
Time of filing	2018-01-11 09:00:23
Domain names	actavisgenerics.com

Case administrator

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

Complainant

Organization	Actavis Group PTC ehf

Complainant representative

Organization	RiskIQ, Inc. c/o Jonathan Matkowsky

Respondent

Name	Georgiy Kharchenko

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

Complainant is the owner of a trademark registration in the European Union as follows:

ACTAVIS: Community Trademark Reg. No. 003615721, registered on January 16, 2006.

FACTUAL BACKGROUND

The following facts have been asserted by the complainant and not contested by the respondent:

On August 2, 2016, Teva Pharmaceutical Industries Ltd. (NYSE and TASE: TEVA) and Allergan plc (NYSE: AGN) announced that Teva completed its acquisition of Allergan’s generics business (“Actavis Generics”). The Complainant is now an indirect, whollyowned subsidiary of Teva Pharmaceutical Industries Ltd. (NYSE and TASE: TEVA), a leading global pharmaceutical company headquartered in Israel, and the world's largest generic medicines producer. Adjusted EBITDA (non-GAAP operating income) for 2016 was $7.3 billion.

The Complainant has registered trademark rights in the ACTAVIS mark (EUIPO / CTM No. 003615721) in a variety of Classes, including Class 5 covering, among other items, pharmaceuticals preparations.

The Respondent was not authorized to use the ACTAVIS mark for any purpose by the Complainant, and has no affiliation whatsoever with it.

The Respondent initially resolved the disputed domain name to a registrar parking page with a number of commercial links to other websites.

Because the Whois record for the disputed domain name is masked with proxy services, the Complainant through its authorized representative requested the proxy provider to disclose the underlying registrant contact details pursuant to the proxy provider's terms of service. After the proxy provider notified its customer that the claim was received and processed, the Respondent initiated contact with Complainant's representative to express that he is open to selling the disputed domain name. The Respondent further stated that he originally was thinking of using the disputed domain name to sell shoes. The Complainant didn't respond to this message. The Respondent subsequently re-directed the disputed domain to a website belonging to the parent company of the Complainant – www.tevapharm.com.

The Respondent has also configured MX (Mail) records on the disputed domain name to the effect that it can receive and send e-mails using the disputed domain name.

Respondent has registered other domain names closely related to healthcare used for online marketing and sales, such as vitamins-private-label.com, which re-directs to phenterminedispensary.com to sell diet pills.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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

Trademark Rights and Confusing Similarity:

As reflected in a European Community Trademark Registration issued in 2006, the Complainant owns trademark rights in the term ACTAVIS for pharmaceutical preparations and related goods and services. The disputed domain name was acquired by the Respondent in 2016. As such, Complainant meets the threshold standing requirement of paragraph 4(a)(i) of the Policy in that it owns relevant trademark rights. In WIPO Case No. D2016-0205; Horten Advokatpartnerselskab v. Domain ID Shield Service CO., Limited / Krutikov Valeriy Nikolaevich, it has been stated: “It has been a consensus view among UDRP panels that if the complainant owns a registered trademark, then it generally satisfies the threshold requirement of having trademark rights.”)

Next, UDRP Panels have consistently held that where the asserted trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under paragraph 4(a)(i) of the Policy. See, e.g., LEGO Juris A/S v. DBA David Inc/ DomainsByProxy.com, Case No. D2011-1290 (WIPO, September 20, 2011). In fact, addition of a term that specifically relates to the Complainant's goods or services is particularly apt to increase the likelihood of confusion with the Complainant. Id.

Here, the disputed domain name consists of the ACTAVIS trademark followed by the descriptive word "generics" and the .com TLD. As one of the Complainant's primary functions is the sale of generic pharmaceuticals, it is quite clear that there is a confusing similarity between the disputed domain name and Complainant's trademark. H. Lundbeck A/S v. Domain Name Privacy Protection, Case No. 100544 (CAC, January 13, 2013) ("There can be no question but that the domain name <ordergenericlexapro.com> is confusingly similar to Complainant's <Lexapro> trademark.")

In light of the above, this Panel concludes that the Complainant possesses rights to the ACTAVIS trademark and that the disputed domain name is confusingly similar to such mark.

Rights or Legitimate Interest

Paragraph 4(a)(ii) of the Policy directs an examination of the facts to determine whether the Respondent lacks rights or legitimate interest in the disputed domain name. Paragraph 4(c) lists a number of ways in which a respondent may demonstrate that it does have such rights or interest.

The first example, under Paragraph 4(c)(i), is where "before any notice to you of the dispute, your 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" Here, the disputed domain name initially resolved to a registrar parking page with pay-per-click links, and subsequently redirected users to Complainant's own website. Neither of these uses are bona fide under circumstances where the domain name clearly targets Complainant's ACTAVIS trademark. Health Level Seven International, Inc. v. McCarragher, Claim No. FA 1723981 (FORUM, April 28, 2017) ("Respondent's domain name resolves to a page hosting pay-per-click advertising for Respondent's commercial gain. The Panel therefore finds that the Respondent has failed to use <hl7community.org> for a bona fide offering of goods or services."); Choice Hotels International, Inc. v. EasyAnt Software Solutions / Anthony Ivins, Claim Number: FA 1477085 (FORUM, February 8, 2013) (Where respondent's domain merely redirected visitors to Complainant's own website "The Panel concludes that Respondent does not make a bona fide offering of goods or services under Policy 4(c)(i)).

Respondent asserts that it "was thinking about selling shoes under this domain name". However it has failed to submit any evidence to support this claim and has otherwise submitted no response to the present Complaint. Furthermore, as the Complainant points out, the Respondent also owns the domain name <vitamins-private-label.com> which redirects to a website at <www.phenterminedispensary.com>, a commercial site focussed on the sale of diet pills. Finally, the disputed domain name was registered a mere nine days after Complainant announced its acquisition of Allergan's generics business under the ACTIVIS trademark. This proximity in time undercuts any idea that registration of the domain name was somehow unrelated to the Complainant and its trademark. Upon a review of the evidence presented to this Panel, Respondent's claimed intention to sell shoes under the disputed domain name is simply not credible. DD IP Holder LLC v Manpreet Badhwar, Claim No. 1562029 (FORUM, July 14, 2014) (Respondent's claim that its <Dunkin.menu> domain would be used to promote its basketball classes – i.e., "dunkin" the ball – held not credible and provided it with no rights or legitimate interests in the domain). In view of the website activity undertaken by the Respondent under the disputed domain name, the Respondent has not used the disputed domain name in connection with a bona fide offering of goods or services under Paragraph 4(c)(i).

The second example, under Paragraph 4(c)(ii), is where a respondent is commonly known by the domain name. Complainant has made an unrebutted prima facie case showing that Respondent's name is Georgiy Kharchenko. There is no other evidence in the record to suggest that Respondent is commonly known by the disputed domain name or that has it acquired any trademark rights relevant thereto. As such, this sub-section of the Policy is of no help to the Respondent.

As to the third example, under Paragraph 4(c)(iii), there is no evidence that the Respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the ACTAVIS trademark. Respondent used the <actavisgenerics.com> domain name, first to resolve to a registrar parking page, and then to redirect users to a commercial pharmacy page. This is certainly not non-commercial. It also cannot be considered fair as it does not fit in to any accepted category of fair use such as news reporting, commentary, political speech, nominative or generic use, etc.

In light of the above analysis, this Panel finds that the facts of this case do not demonstrate that the Respondent has any rights or legitimate interest in the disputed domain name.

Bad Faith

Finally, the Complainant must prove, by a preponderance of the evidence, that the disputed domain has been registered and used in bad faith under paragraph 4(a)(iii) of the Policy. Hallmark Licensing, LLC v. EWebMall, Inc., Case No. D2015-2202 (WIPO, February 12, 2016) ("The standard of proof under the Policy is often expressed as the "balance of the probabilities" or "preponderance of the evidence" standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true.")

Bad faith registration and use has often been found where a respondent intentionally attempts to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of Respondent's website. Policy, paragraph 4(b)(iv). This applies, as well, to the use of links to third-party websites. Home Depot Product Authority, LLC v. richard garyson / vanillacc , Claim No. FA 1765644 (FORUM, February 5, 2018) (bad faith finding supported by the fact that, "when Internet users click on the link, they are redirected to third-party websites unrelated to Complainant.")

The disputed domain name initially resolved to a registrar parking page which contained monetized (pay-per-click) links to third-party websites that appear to be unrelated to either party in this case. The website is thus clearly of a commercial nature. AMUNDI S.A. v. Transure Enterprise Ltd, Case No. 101798 (CAC, January 22, 2018) ("The presence of pay per click advertising on the website is an indication of commercial gain.") Further, it is not critical that such commercial gain be sought directly by the Respondent. Bad faith may be found so long as commercial gain is sought by another person or entity who benefits from the function of the domain name. Focus Do It All Group v. Athanasios Sermbizis, Case No. D2000-0923 (WIPO, December 10, 2000) (finding that "[I]t is enough that commercial gain is being sought for someone" for a use to be commercial).

Of course, as the owner of the disputed domain name, Respondent is entirely and solely responsible for the content of its website and the functioning of its domain name regardless of whether the pay-per-click links on the site are selected by the Respondent or by another entity such as a registrar or hosting provider. See, e.g., Disney Enterprises, Inc. v. ll, Claim No. FA 1336979 (FORUM, August 31, 2010) (Respondent acted in bad faith, despite its claimed lack of control over the content on its parked, pay-per-click website); Transamerica Corporation v. Domain Administrator / Sandesa, Inc., Claim No. FA 1704763 (FORUM, January 4, 2017) (Respondent is responsible for the use made of the domain name. Knowingly registering a domain containing another's mark and parking it without limiting the ability of the parking service to improperly use it is sufficient evidence of bad faith registration and use.")

Next, the redirection of the disputed domain name to the Complainant's own website does not provide any shelter for the Respondent. Redirection to a Complainant's own website, by a domain name that contains its trademark, is typically not considered a good faith use of the domain name. Mandarin Oriental Services B.V. v. Domain Administrator, Matama, Case No. D2017-0615 (WIPO, May 10, 2017) ("Redirecting the disputed domain name to the Complainant's own website implies also bad faith: Such behaviour includes the risk that the Respondent may at any time cause Internet traffic to redirect to a website that is not that of, or associated with, the Complainant.") Furthermore, actions that were undertaken only after the Respondent was placed on notice of the present dispute can be of no help to the Respondent in countering an assertion of bad faith. DHL Operations B.V. and DHL International GmbH v. Eric White, WIPO Case No. D2010-0016 (WIPO, April 3, 2010)

(bad faith found despite the fact that the “Respondent changed the content of the webpage” after receiving the Complainants’ cease and desist letter.)

Finally, after the proxy provider for the disputed domain name notified its customer that a claim against the name was received and processed, the Respondent initiated contact with the Complainant's representative and stated “How about buying this domain? I am willing to sell... What's the offer?” Paragraph 4(b)(i) of the Policy states that bad faith may be found where a respondent offers to sell a disputed domain name to a complainant “for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name.” The Respondent’s suggestion that the Complainant purchase the disputed domain name clearly fits within the first part of the paragraph 4(b)(i) scenario. While there is no evidence in the record of what were the Respondent’s out-of-pocket costs, it may be presumed that the Respondent would have, in good faith, informed the Complainant of its asking price had it only been seeking reimbursement of such costs. Paragraph 14(b) of the UDRP Rules provides that panels may draw certain inferences in light of the particular facts and circumstances of the case e.g., where an explanation by the Respondent is called for but is not forthcoming, or where no other plausible conclusion is apparent. No response was submitted in this case and so the Respondent has not sought to explain itself or counter this presumption. As such, in addition to the basis set forth above, bad faith may also be found under paragraph 4(b)(i) of the Policy.

For the reasons stated above, it is the decision of this Panel that the Complainant has satisfied all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ACTAVISGENERICS.COM**: Transferred

PANELLISTS

Name	**Steven M. Levy, Esq.**

DATE OF PANEL DECISION 2018-02-08

Publish the Decision