Decision for dispute CAC-UDRP-103127

Case number	CAC-UDRP-103127
Time of filing	2020-06-24 10:41:43
Domain names	bannwehealth.com

Case administrator

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

Complainant

Organization	BIOFARMA
Organization	LES LABORATOIRES SERVIER

Complainant representative

Organization	IP TWINS

Respondent

Organization	Fundacion Privacy Services LTD

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant BIOFARMA SAS ("Biofarma") submitted evidence that it is the registered owner of the following trademark registrations:
(i) French trademark registration WEHEALTH No. 4280290, dated 15 June 2016, registered for goods and services in classes 5, 9, 10, 35, 36, 41, 42 and 44; and
(ii) International trademark registration WEHEALTH No. 1329611, dated 5 October 2016, registered for goods and services in classes 5, 9, 10 and 44, designating amongst other countries China, India and Russia.

The Complainant LES LABORATOIRES SERVIER SAS ("Servier") submitted evidence that it is the registered owner of the following trademark registrations:
(i) European Union trademark registration WEHEALTH BY SERVIER No. 015850548, dated 20 September 20 2016, registered for goods and services in classes 5, 9, 10, 35, 36, 41, 42 and 44;
(ii) French trademark registration WEHEALTH BY SERVIER No. 4300433, dated 19 September 2016, registered for goods and services in classes 5, 9, 10, 35, 36, 41, 42 and 44; and
(iii) International trademark registration WEHEALTH BY SERVIER No. 1361896, dated 11 November 2016, registered for

goods and services in classes 5, 9, 10 and 44, designating amongst other countries China, United States, India and Russia.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

Both Complainants are part of the Servier Group, the largest French pharmaceutical group on an independent level and the second largest pharmaceutical French group in the world. The group is active in 149 countries and employs more than 22,000 people throughout the world. 100 million patients are treated daily with Servier medicinal products and generics.

WEHEALTH is a department of the Servier Group that was launched in 2016 and is focused on establishing and developing partnerships between the Servier Group and promising startups in the domain of digital health. It has received publicity in the form of various online articles and press releases. On the web, WEHEALTH enjoys a dedicated website, accessible at the address <https://www.wehealth-digitalmedicine.com>.

The Complainant Biofarma is also the registrant of the domain names <wehealth.fr>, registered on 8 June 2016, and <wehealth.com>. Australian and Brazilian subsidiaries of the Complainants are also the registrants of the domain names <wehealthbyservier.com.au> and <wehealthbyservier.com.br>, both registered on 14 November 2016.

The disputed domain name was created on 30 April 2020.

On 18 June 2020, the Registrar of the disputed domain name confirmed that the Respondent is the current holder of the disputed domain name and that the language of the registration agreement is English.

The Respondent has not filed a Response.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Complainant made the following contentions:

With respect to identical or similar domain name, the Complainants assert that the disputed domain name is confusingly similar to the trademarks of the Complainants. The second level of the disputed domain name incorporates the whole of the Biofarma's registered trademark WEHEALTH with the addition of the term "bann". The Complainants believe that the average internet user will very likely identify "wehealth" within the disputed domain name. The Complainants refer to several WIPO panel decisions which have held that when a domain name wholly incorporates a complainant's registered mark, this is sufficient to establish identity or confusing similarity for the purposes of the Policy (eg. WIPO Case No. D2000-1525 Magnum Piering, Inc. v. The Mudjackers).

The Complainants contend that the distinctive component of the disputed domain name is "wehealth", which is Biofarma's trademark as well as an arbitrary term in itself. In the present case, the Complainants argue, the addition of the term "bann" does not lessen the inevitable confusion of the disputed domain name with Biofarma's WEHEALTH trademark. To the best of the Complainants' knowledge, the term "bann" could refer to (i) a river located in Ireland; (ii) a German city; or (iii) translation of "to forbid" in Icelandic (source: Google translate).

Should "bann" refer to one of above-listed definitions or being devoid of any meaning, the Complainants contend that it does not allow the disputed domain name to escape being found confusingly similar to the WEHEALTH trademarks. The mere addition of the term "bann" fails to distinguish the disputed domain name from the Complainants trademarks, which remains recognizable within the disputed domain name. The Complainants refer to Section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0") which states that "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative,

meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element". The Complainants also point to WIPO decision D2019-1508 "Crédit industriel et commercial S.A. v. WhoisGuard Protected", and WIPO decision D2020-0603 "Tipico Co. Ltd. v. Nicholas Bacon". The Complainants contend that this is all the more true when the trademark in question is composed of an arbitrary word which in their view is the case with WEHEALTH.

The Complainants also contend that the disputed domain name should be considered as confusingly similar to the trademark registrations "WEHEALTH by Servier" held by Servier, WEHEALTH being a fanciful term placed in attack position of the concerned trademarks.

Moreover, it is common case law within UDRP proceedings that the addition of the gTLD ".com" is not significant in determining whether the domain name is identical or confusingly similar to the mark.

Therefore, the Complainants contend that the first condition under Paragraph 4(a) of the Rules is satisfied.

Regarding Respondent's rights or legitimate interests, the Complainants argue that the Respondent should be considered as having no rights or legitimate interests in respect of the disputed domain name for the following reasons:

Firstly, according to the Complainants verifications, the Respondent is not commonly known by the disputed domain name which redirects towards an error page (root) or a parking page inviting to purchase the disputed domain name.
The Complainants researches did not allow to find any element that would suggest that the Respondent could be known by "We health", "Bannwehealth" or "Bann Wehealth", the disputed domain name redirecting to the pages mentioned above as well as being listed for sale on Sedo, the Respondent accepting offers of 899 USD or more.

Secondly, the Complainants were not able to search for trademarks in the name of the Respondent at this stage of the procedure, due to the lack of information available on the WHOIS database. However, considering the current use of the disputed domain name, the Complainants strongly believe that the Respondent has acquired no trademark or service mark related to the WEHEALTH term.

Thirdly, the Complainants researches did not allow to find any clue of preparation to use the disputed domain name in connection with a bona fide offering of goods or services, the disputed domain name being merely parked and offered for sale.

Fourthly, the Respondent has never been granted authorization, license or any right whatsoever to use the trademarks of the Complainants. The Respondent is not commercially linked to the Complainants.

Fifthly, since the adoption and extensive use by the Complainants of the trademarks WEHEALTH and "WEHEALTH by Servier" predates the registration of the disputed domain name by the Respondent, the burden is on the Respondent to establish rights or legitimate interests it/he/she may have or have had in the domain names (in line with WIPO Case No. D2003-0174 "PepsiCo, Inc. v. Amilcar Perez Lista d/b/a Cybersor").

The Complainants strongly believe that none of the circumstances which set out how a respondent can prove his rights or legitimate interests are present in this case. In light of the above developments, given that the Complainants have made a prima facie case that the Respondent lacks legitimate rights or interest in the disputed domain name, the burden of proof shifts to the Respondent, who should come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name (as provided in WIPO Case No. D2003-0455, "Croatia Airlines d.d. v. Modern Empire Internet Ltd.").

Therefore, the Respondent should be considered as having no rights or legitimate interests in respect of the disputed domain name.

Turning to the bad faith argument, the Complainants assert that the Respondent has registered and is using the disputed domain name in bad faith, for the following reasons.

Firstly, the Complainants state that the Servier Group is so widely well-known that it is very unlikely that the Respondent ignored the rights of the Complainants on the term WEHEALTH. Several press releases, communiqué or news articles have been released on WEHEALTH and "WEHEALTH by Servier" prior to the disputed domain name registration, on an international level.

Secondly, WEHEALTH is a fanciful term consisting in a combination of English dictionary words. The combination of "we" and "health" makes no sense, grammatically speaking. As a result, "wehealth" stands out from the domain name "bannwehealth.com". The Complainant contends that the disputed domain name second level should be read "Bann Wehealth" and claim that the Respondent could not have registered the disputed domain name due to its dictionary meaning and/or its supposed value as a generic term.

Thirdly, and in light of the two above paragraphs as well as the current use of the disputed domain name, the Complainants strongly believe that the Respondent have registered the disputed domain name primarily for the purpose of selling it to the Complainants, owners of the trademarks WEHEALTH, for valuable consideration in excess of out-of-pocket costs directly related to the domain name.

Fourthly, to succeed in a UDRP proceeding, the Complainants must not only show that the domain name was registered in bad faith. The WEHEALTH trademark being arbitrary and intensively used worldwide, the Complainants see no possible way whatsoever in which the Respondent would use the disputed domain name in connection with a bona fide offer of products or services in the first place. The Respondent offers the disputed domain name for sale on the parking page it redirects to and indicates that only offers of 899 USD or more will be considered for the disputed domain name.

In light of the above, the Complainants contend that such use of the disputed domain name qualifies as bad faith use by the Respondent, who is attempting to sell the disputed domain name to the corresponding trademark owner. Consequently, the Complainants believe that the third condition under Paragraph 4(a) of the Policy is deemed satisfied.

RIGHTS

The Complainants have, 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 Complainants have rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainants have, 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 Complainants have, 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

It has been established that the Rules for Uniform Domain Name Dispute Resolution Policy allow consolidation of multiple domain name disputes and that it is generally possible for multiple complainants to bring a complaint against a single respondent. Circumstances that typically allow for such consolidation are (i) that the multiple complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) that it would be equitable and procedurally efficient to permit the consolidation (see 4.11.1 of WIPO Overview 3.0). The Panel finds that both the Complainant Biofarma and the Complainant Servier have common grievance against the Respondent, that the Respondent engaged in common conduct that has affected both Complainants in a similar fashion, and that it would be equitable and procedurally efficient to permit the consolidation.

The Panel further notes that due to the COVID-19 pandemic the written notice of the Complaint was not sent by the CAC because the destination country of the Respondent does not provide delivery services at the moment. According to the CAC,

such procedure was preapproved by ICANN. The Rules for Uniform Domain Name Dispute Resolution Policy require that the Provider employs "reasonably available means calculated to achieve actual notice to Respondent". The Panel believes that if the CAC sent the Complaint only by all means anticipated by Paragraph 2(a)(ii) of the Rules, particularly to the email address identified by the Respondent when registering the disputed domain names, because physical delivery anticipated by Paragraph 2(a)(i) of the Rules is objectively not available at the moment, then the CAC employed "reasonably available means" and satisfied the requirement of the Rules relating to the forwarding of the Complaint to the Respondent.

Therefore, 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

This is a proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy ("Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy ("Rules") and the CAC Supplemental Rules.

Paragraph 15 of the Rules provides that the Panel shall decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

According to Paragraph 4(a) of the Policy, the complainant must prove each of the following: (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; (ii) the respondent has no rights or legitimate interests in respect of the disputed domain name; (iii) the disputed domain name has been registered and is being used in bad faith.

A. Identical or confusingly similar domain name

The Complainants demonstrated that they own trademark registrations for the marks "WEHEALTH" and "WEHEALTH BY SERVIER" in various countries around the world. There is no doubt that such trademark registrations confer on its owners sufficient rights to satisfy the requirement of having trademark rights for the purposes of standing to file a UDRP case. Therefore, the Panel finds that the Complainants have established such registered rights.

It is well established that the generic top-level suffix .com may be disregarded when considering whether a disputed domain name is confusingly similar to a trademark in which a complainant has rights.

It is therefore necessary to analyse whether "bannwehealth" is identical or confusingly similar to the trademark WEHEALTH (respectively WEHEALTH BY SERVIER which contains an addition element "by Servier" which is however merely descriptive and does not affect this analysis). The Panel notes that it has been well established in UDRP proceedings that the domain name is deemed to be confusingly similar to the relevant trademark if it incorporates the trademark in its entirety. The WIPO Overview 3.0 in particular provides that "while each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing" (section 1.7). In the present case, the disputed domain name clearly incorporates the entirety of the trademark WEHEALTH and it can therefore be safely presumed that the disputed domain name is confusingly similar to such trademark.

The Panel is of the view that such finding could be escaped only if the other part of the disputed domain name, in this case the word "bann", would be sufficiently distinctive and would confer an overall different impression or meaning that would clearly distinguish the disputed domain name from the asserted trademarks. The Complainants provided various possibilities of interpretation of the word element "bann", but none of them indeed allows for any plausible finding of sufficient distinctiveness and the trademark WEHEALTH is clearly recognizable within the disputed domain name.

Therefore, the Panel concurs with the Complainants' allegations as to similarity/confusing similarity set out above and finds that the disputed domain name is confusingly similar to the trademarks in which the Complainants have rights.

B. Lack of rights or legitimate interests

The Complainants provided various arguments that support the conclusion that the Respondent lacks rights or legitimate interests in the disputed domain name. In particular, the Complainants argue that the Respondent is not commonly known by the disputed domain name, has apparently no registered trademarks, there is no clue of preparation to use the disputed domain name in connection with any bona fide offering of goods or services, and that the Complainants have not authorised, licensed, or otherwise permitted the Respondent to use any of their marks. The Complainants therefore contend that the burden is on the Respondent to establish rights or legitimate interests it may have or have had in the disputed domain name.

The Respondent has not filed a Response and the Panel notes that indeed there is no evidence that the Respondent has used or has been preparing to use the disputed domain name in connection with a bona fide offering of goods or services, that the Respondent would be commonly known by the disputed domain name, nor that the Respondent has made any legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain.

Therefore, the Panel is satisfied that the Complainant has made out a prima facie case and finds that the Respondent has no rights or legitimate interest in the disputed domain name.

C. Registration and use of the disputed domain name in bad faith

With respect to the bad faith argument, the Complainants infer that the Respondent likely had knowledge of their rights because of the widely well-known status of the Servier Group and press coverage of activities made under the "WEHEALTH" and the "WEHEALTH by Servier" marks. The Complainants also argue that the disputed domain name has no dictionary meaning and/or is not a generic term and that the Respondent could not have had attempted to register it as such. Finally, the Complainants believe that the Respondent have registered the disputed domain name primarily for the purpose of selling it to the Complainants, mainly because the domain name redirects to a parking page with commercial links and with a link redirecting to a domain marketplace at <sedo.com> where the disputed domain name is advertised as being for sale for a minimum offer of USD 899. The Complainants support these allegations by evidence.

While the Panel is not at all convinced that the well-known status of the Servier Group would extend specifically to the WEHEALTH mark or to activities performed under this mark, it seems clear that there several circumstances in this case that demonstrate the Respondent's bad faith. The Panel has already established that the Respondent lacks own rights to or legitimate interests in the disputed domain name, which itself can be in indication of bad faith. The same applies to the fact that the disputed domain name incorporates the entirety of the WEHEALTH mark. The Complainants have also presented evidence that the disputed domain name redirects to a parking page not only with various commercial links but also with a link that explicitly invites internet users to buy the domain name. Such link takes the internet user to a marketplace where the minimum offer price is USD 899 which seems disproportionate to the usual costs of obtaining a .com domain name. It is plausible to believe that the Complainants would be among the very few to be interested in acquiring the disputed domain name and thus the primary targets of such offer. Furthermore, the use of the disputed domain name does not create an impression on the Panel that it could be considered a "good faith use".

Finally, the Panel notes that the Respondent has not filed a Response and therefore failed to present any credible evidence-backed rationale for registering the disputed domain name.

Having carefully balanced the arguments laid out by the Complainants and given the lack of the Respondent's response, the Panel has come to the conclusion that the disputed domain name has been registered and has been used by the Respondent in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BANNWEHEALTH.COM**: Transferred

PANELLISTS

Name	**Mgr. Vojtěch Chloupek**

DATE OF PANEL DECISION 2020-08-12

Publish the Decision