Decision for dispute CAC-UDRP-103360

Case number	CAC-UDRP-103360
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Domain names	wehealthbc.online, wehealthbeoo.online, wehealthbete.online, wehealthbey.online, wehealthbiop.online, wehealthbob.online, wehealthboss.online, wehealthbt.online, wehealthbuy.online, wehealthceks.online, wehealthcet.online, wehealthcop.online, wehealthcopl.online, wehealthct.online, wehealthctyu.online, wehealthdo.online, wehealthgoo.online, wehealthhype.online, wehealthio.online, wehealthiop.online, wehealthiota.online, wehealthle.online, wehealthnik.online, wehealthnono.online, wehealthpl.online, wehealthploik.online, wehealthqw.online, wehealthto.online, wehealthwe.online, wehealthxe.online

Case administrator

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

Complainant

Organization	BIOFARMA
Organization	LES LABORATOIRES SERVIER

Complainant representative

Organization	IP TWINS

Respondent

Name	Fedchik O Oleksandr

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

In this proceeding, the Complainants rely on the following trademarks.

For BIOFARMA SAS:

- French Trademark registration WEHEALTH No. 4280290, dated June 15, 2016, covering goods and services in international classes 5, 9, 10, 35, 36, 41, 42, and 44; and

- International Trademark Registration WEHEALTH No. 1329611, dated October 5, 2016, covers goods and services in international classes 5, 9, 10, and 44, notably designating China, India and Russia.

BIOFARMA SAS also relies on the US Trademark application WEHEALTH No. 88393510, filed in April 19, 2019, covering goods and services in international classes 5, 9, 10, 42 and 44.

For LES LABORATOIRES SERVIER SAS:

- European Union Trademark registration WEHEALTH BY SERVIER No. 015850548, dated September 20, 2016, covering goods and services in international classes 5, 9, 10, 35, 36, 41, 42 and 44;

- French Trademark Registration WEHEALTH BY SERVIER No. 4300433, dated September 19, 2016, covering goods and services in international classes 5, 9, 10, 35, 36, 41, 42 and 44; and

- International Trademark Registration WEHEALTH BY SERVIER No. 1361896, dated November 11, 2016, covering goods and services in international classes 5, 9, 10, and 44, notably designating China, United States, India, and Russia.

FACTUAL BACKGROUND

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

THE DISPUTED DOMAIN NAMES ARE IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANTS HAVE RIGHTS

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 has been launched in 2016 and is focused on establishing and developing partnerships between the Servier Group and promising Startups in the domain of digital health.

The Complainants refer to their trademarks cited above and the Complainant BIOFARMA is also the registrant of the domain names <wehealth.fr>, registered on June 8, 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 November 14, 2016.

The Complainants contend that the disputed domain names are confusingly similar to the Complainants registered trademarks.

The disputed domain names incorporate the whole of the Biofarma's registered trademark WEHEALTH with the addition of either generic English terms ("hype", "buy", "boss"...), or 2 to 5 characters terms devoid of any particular generic meaning at first glance ("nono", "iop", "copl"...). The Complainants note that the position of the "wehealth" term within the disputed domain names is important insofar as they are read from left to right and the average internet user will very likely identify "wehealth" within the disputed domain names.

It is well established 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.

The Complainants contend that the distinctive component of the disputed domain names, as well as their common denominator, is "wehealth", which is BIOFARMA's trademark. The mere addition of a descriptive term to a trademark within a domain name does not allow to escape the finding of confusing similarity.

The Complainants also contend that the disputed domain names should be considered as confusingly similar to the trademark registrations “WEHEALTH by Servierheld” by LES LABORATOIRES SERVIER, WEHEALTH being a fanciful term placed in attack position of the concerned trademarks.

The addition of a gTLD such as "online” is not significant in determining whether the disputed domain names are identical or confusingly similar to the mark.

Therefore, the disputed domain names are confusingly similar with the trademarks of the Complainants.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAMES

The Complainants’ arguments can be summarized as follows:

1) According to the Complainants verifications, the Respondent is not commonly known by the disputed domain names, which all redirect towards registrar error pages.

2) The Complainants also provide evidence that their research did not establish any preparation to use the disputed domain names in connection with a bona fide offering of goods or services, as the disputed domain names are currently not used on the web.

3) Even if the Respondent uses a WHOIS privacy service obfuscating its identity, 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.

4) Since the adoption and extensive use of the trademarks WEHEALTH and “WEHEALTH by Servier” by the Complainants predates the registration of the disputed domain names by the Respondent, the burden is on the Respondent to establish rights or legitimate interests it may have or have had in the domain names.

5) The Complainants performed a Trademark search using the Respondent name provided by the Registrar of the disputed domain names and did not find any trademark record that would indicate that the Respondent has rights on the term "wehealth".

The Complainants strongly believe that none of the circumstances that can prove Respondent’s rights or legitimate interests are present in this case and the Complainants have made a prima facie case.

THE DISPUTED DOMAIN NAMES WERE REGISTERED AND BEING USED IN BAD FAITH

The Complainants highlight the following:

- 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, communiqués or news articles have been released on WEHEALTH and “WEHEALTH by Servier” prior to the disputed domain names registration, on an international level;

- “WEHEALTH” is a fanciful term consisting of a combination of English dictionary words. Indeed, the combination of “we” and “health” makes no sense, grammatically speaking. The Complainants contend that the Respondent could not have registered the disputed domain names due to a dictionary meaning and/or a supposed value of “wehealth” as a generic term;

- The Complainants strongly believe that the Respondent have registered the disputed domain names primarily for the

purpose of selling them to the Complainants, owners of the trademarks “WEHEALTH”, for valuable consideration in excess of out-of-pocket costs directly related to the domain names;

- All the 30 disputed domain names share the common denominator “wehealth”. As a result, the presence of “wehealth” in the disputed domain names cannot be considered as a fortuitous occurrence. This shows the Respondent had the trademark of the Complainants in mind upon registering the disputed domain names. The registration of several dozens of domain names containing the highly distinctive trademark “wehealth” by the Respondent is another indication of bad faith in the registration of the disputed domain names;

- The disputed domain names are currently not used on the web, as they redirect towards error pages. The Complainants refer to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (WIPO Overview 3.0) stating that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. The totality of the circumstances should be looked at in each case;

- The Complainants contend that the high distinctiveness of WEHEALTH and “WEHEALTH by Servier” trademarks as well as their reputation and use on an international scale before the registration of the disputed domain names would qualify the Respondent as using the disputed domain names in bad faith according to the doctrine of passive holding;

- Considering all the elements above, the Complainants contend that the disputed domain names were registered, have been and are being used in bad faith by the Respondent. The combination of all the elements listed and detailed above shows that the Respondent has acted in bad faith when registering and using the disputed domain names.

The Complainants thus contend that the third element of the Policy is satisfied.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 names have been registered and are 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.

The Panel first needs to address the issue of consolidated complaint by two Complainants: BIOFARMA SAS and LES LABORATOIRES SERVIER SAS.

The Complainants request to transfer the disputed domain names to BIOFARMA SAS.

Both Complainants have rights in the “WEHEALTH” trademarks and are related.

As was noted by one of the previous panels in a similar case: “both Complainants share trademarks where the dominant term is “wehealth”. Additionally, both parties appear to be related, as both belong to the same corporate group, namely the Servier Group. Because of the above, the Panel does not believe that consolidating both Complainants under single Complaints upsets the careful equitable balance of this proceeding, while at the same time aiding in its procedural efficiency” (see CAC Case No. 103338).

Therefore, this Panel finds that consolidation in this proceeding is justified.

The second issue is the language of this proceeding.

The language of the registration agreement is Russian.

The Complainants asked to have English as the language of this proceeding, in particular, taking into account panel’s rights to determine the language of the proceeding, previous UDRP case law and provisions of WIPO Overview 3.0, in particular par.4.5.1. The Complainants also noted that some of the disputed domain names include English words. This suggests an operational understanding of English from the Respondent.

English language is not the native language of the Complainants or its representatives, therefore the Complainants contend that choosing English as the language for the current proceeding would not give them unfair advantage over the Respondent.

Normally the language of the administrative proceeding shall be the language of the Registration Agreement, however under par. 11 (a) of the Rules the Panel the authority to determine otherwise, having regard to the circumstances of the administrative proceeding.

The Panel in this dispute agrees with the request of the Complainants and finds that the language of the proceeding shall be English.

The Panel decided so taking into account that all the disputed domain names are in the .online zone that is international, the registrar – Beget LLC has an English language version of its website, the Respondent chose to register 30 domain names that include the Complainants’ trademarks in Latin characters (spelled in the English language) and some are combined with the words in English (i.e. “do”, “hype”) and the fact that the Respondent has been given a fair chance to respond and object but has not done so and considering previous UDRP decisions (e.g. CAC Case No.103140, Volkswagen AG v. Nowack Auto und Sport - Oliver Nowack, WIPO Case No. D2015-0070 and Yves Saint Laurent, SAS v. (Yin Sulan), WIPO Case No. D2018-0873) and with the view of par. 4.5.1. of WIPO Overview 3.0.

It is the Panel’s obligation to ensure that the administrative proceeding takes place with due expedition under paragraph 10 (c) of the UDRP Rules and in the Panel’s opinion it would be fair to have English as the language of this proceeding.

PRINCIPAL REASONS FOR THE DECISION

A. Identical or confusingly similar with Complainant’s trademark

The Complainants are the owners of numerous “WEHEALTH” trademark registrations.

As confirmed by WIPO Overview 3.0, paragraph 1.2.1: “Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case”.

The Panel notes though with reference to the US trademark application by BIOFARMA SAS that “a pending trademark application would not by itself establish trademark rights within the meaning of UDRP paragraph 4(a)(i)” (see par. 1.1.4 of WIPO Overview 3.0).

All the disputed domain names fully incorporate the “WEHEALTH” marks with the addition of either random letters or descriptive terms such as “buy”, “do”, “hype”.

The general test is whether the mark is recognizable within the disputed domain name (see par. 1.7 of WIPO Overview 3.0).

It is also well accepted 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 (see par. 1.8 of WIPO Overview 3.0).

The “WEHEALTH” trademark is clearly recognizable in the disputed domain names.

The gTLD suffix “.online” is to be disregarded under the confusing similarity test.

Therefore, the Panel finds that the first requirement of the Policy has been satisfied.

B. Rights or Legitimate Interests

The general rule is the following:

(i) a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests; and

(ii) once such prima facie case is made, the burden shifts to the respondent who has to demonstrate his rights or legitimate interests in respect of the domain name under paragraph 4 (c) of the Policy.

If the respondent fails to do so, the second element of the Policy is satisfied, see Julian Barnes v. Old Barn Studios, WIPO Case No. D2001-0121; Belupo d.d. v. WACHEM d.o.o., WIPO Case No. D2004-0110 and CAC Case No. 101284.

The Complainants provided some arguments in support of their position in respect of lack of rights or legitimate interests of the Respondent summarized above.

The disputed domain names were registered on August 23, 2020.

The Respondent did not respond.

While failure to respond does not per se demonstrate that the Respondent does not have rights or legitimate interests, it allows all reasonable inferences of fact in the allegations of the complaint to be deemed true (see paragraph 14(b) of the Rules and Vertical Solutions Management, Inc. v. webnet-marketing, inc., FA 95095, National Arbitration Forum).

The disputed domain names are currently not used.

In the present dispute there is nothing to indicate Respondent’s rights or legitimate interests in respect of the disputed domain names.

The Complainants have made out a prima facie case.

The Panel, therefore, finds that the Complainants satisfied the second requirement of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists non-exhaustive circumstances indicating registration and use in bad faith.

These circumstances are non-exhaustive and other factors can also be considered in deciding whether the disputed domain name is registered and used in bad faith.

None of the disputed domain names is used for an active website.

There is a general agreement that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding (see par. 3.3 of WIPO Overview 3.0 and Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003).

One has to look at the circumstances of a case taking into account, in particular: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put (see e.g. Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003; "Dr. Martens" International Trading GmbH and "Dr. Maertens" Marketing GmbH v. Godaddy.com, Inc., WIPO Case No. D2017-0246; CAC Case No. 101435, CAC Case No. 101691, CAC Case No. 101640 and par. 3.3 of WIPO Overview 3.0).

The Panel notes that the fact that the Respondent registered 30 disputed domain names that all fully incorporate Complainants' "WEHEALTH" trademarks indicates that the Respondent was most likely targeting the Complainants as the combination of two dictionary words in the English language "We" and "Health" is indeed unusual in normal circumstances.

The Complainants provided evidence that their "WEHEALTH" marks have rather strong reputation. Even though the trademarks are relatively young (registered in 2016), the Complainants provided evidence of their extensive use in various regions of the world.

The Respondent failed to provide a response and address any of the issues raised by the Complainants.

The Panel is also of the opinion that under the circumstances of this case there can hardly be any good faith use of the disputed domain names by the Respondent.

Considering all the factors above, the Panel holds that the third requirement of the Policy has been satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **WEHEALTHBC.ONLINE**: Transferred
2. **WEHEALTHBEOO.ONLINE**: Transferred
3. **WEHEALTHBETE.ONLINE**: Transferred
4. **WEHEALTHBEY.ONLINE**: Transferred
5. **WEHEALTHBIOP.ONLINE**: Transferred
6. **WEHEALTHBOB.ONLINE**: Transferred
7. **WEHEALTHBOSS.ONLINE**: Transferred
8. **WEHEALTHBT.ONLINE**: Transferred
9. **WEHEALTHBUY.ONLINE**: Transferred
10. **WEHEALTHCEKS.ONLINE**: Transferred
11. **WEHEALTHCET.ONLINE**: Transferred
12. **WEHEALTHCOP.ONLINE**: Transferred
13. **WEHEALTHCOPL.ONLINE**: Transferred
14. **WEHEALTHCT.ONLINE**: Transferred

15. **WEHEALTHCTYU.ONLINE**: Transferred
16. **WEHEALTHDO.ONLINE**: Transferred
17. **WEHEALTHGOO.ONLINE**: Transferred
18. **WEHEALTHHYPE.ONLINE**: Transferred
19. **WEHEALTHIO.ONLINE**: Transferred
20. **WEHEALTHIOP.ONLINE**: Transferred
21. **WEHEALTHIOTA.ONLINE**: Transferred
22. **WEHEALTHLE.ONLINE**: Transferred
23. **WEHEALTHNIK.ONLINE**: Transferred
24. **WEHEALTHNONO.ONLINE**: Transferred
25. **WEHEALTHPL.ONLINE**: Transferred
26. **WEHEALTHPLOIK.ONLINE**: Transferred
27. **WEHEALTHQW.ONLINE**: Transferred
28. **WEHEALTHTO.ONLINE**: Transferred
29. **WEHEALTHWE.ONLINE**: Transferred
30. **WEHEALTHXE.ONLINE**: Transferred

PANELLISTS

Name	**Igor Motsnyi / Mocni Konsalting doo**

DATE OF PANEL DECISION 2020-11-30

Publish the Decision