Decision for dispute CAC-UDRP-101304

Case number	CAC-UDRP-101304
Time of filing	2016-10-24 11:31:31
Domain names	ACTAVISSHOP.COM

Case administrator

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

Complainant

Organization	ACTAVIS, INC.

Complainant representative

Organization	Matkowsky Law PC

Respondent

Name	James Graham

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

Complainant is the owner of various "ACTAVIS" trademarks, including U.S. Reg. No. 4,694,086, issued March 3, 2015, covering various generic pharmaceuticals in International Class 5, and U.S. Reg. No. 3,214,449, issued March 6, 2007, covering amongst other classes, distributorship services in the field of pharmaceuticals in International Class 35, advisory and consultancy services in relation to healthcare for others, and counselling relating to pharmaceuticals for others, in International Class 44.

The disputed domain name was registered on September 15, 2016, i.e. the Complainant’s trademark predate the registration of the disputed domain name.

FACTUAL BACKGROUND

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

The Complainant is an indirect, wholly-owned 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.

The Complainant contends that the disputed domain name incorporates the entirety of its registered "ACTAVIS" trademark as the first and most prominent part of the disputed domain name; it adds only the generic word "shop" and the ".com" gTLD suffix, which does nothing to negate confusing similarity.

The Complainant further contends that the Respondent has no rights or legitimate interest in the disputed domain name. The Respondent is not known by the name "Actavisshop", nor is there any indication that the Respondent has any corresponding trademark rights, or that the Respondent has previously used the term "Actavis" in any legitimate manner. The Respondent has not been commonly known by the disputed domain name. The Complainant has not authorized the Respondent to use the distinctive trade mark "ACTAVIS" for any purpose. The Respondent uses the disputed domain name to purportedly offer a limited supply of Actavis Promethazine Cough Syrup with Codeine (alongside highly related products of third parties without any connection to the Complainant) for sale without a prescription. In the United States, the active ingredients in this product are regulated as a Schedule V Controlled Substance.

The Complainant has ceased all production and sales of its Promethazine Codeine product years ago because of unlawful and dangerous uses of the product contrary to its approved indication. The website for which the disputed domain name is used also commercializes other third-party products as a substitute for Actavis, making them available for purchase without a prescription. The Complainant therefore contends that the Respondent is engaged in a practice of relying on deception to take consumers to a website where products are for sale that are unsafe when purchased outside of a trusted supply chain.

The Complainant finally contends that the Respondent reproduces photographs of apparent "ACTAVIS" packaging and signage on his website, so that the Respondent was fully aware of the Complainant's business and the goodwill that vests in the "ACTAVIS" mark. The Respondent offers products for sale that are marked "Actavis" from the website to which the disputed domain name resolves. There is no knowing whether these are fake or genuine products, but according to the Complainant they are more likely the former, and are in any case offered for sale without prescription in an unregulated and unauthorized manner. The Respondent thereby uses the disputed domain name in bad faith, relying on consumer deception to gain a financial advantage from the misconception which the disputed domain name generates as to the connection between the goods offered and the Complainant.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that 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). Apart from the descriptive suffix "shop" the disputed domain name is identical to the Complainant’s protected brand name "ACTAVIS".

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown that the Respondent has no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii)of the Policy). The domain name is not being used to host any legitimate site, but merely to promote online sales of Complainant's prescription drug without the necessary prescription.

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown that 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). By using the domain name for the website described above the Respondent intentionally attempts to attract, for commercial gain, Internet users to an illegal online shop by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of this web site.

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

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks cited above. The only difference between the domain name and the "ACTAVIS" mark is the descriptive suffix "SHOP", which is insignificant to the overall impression.

The Panel finds that the Complainant successfully submitted prima facie evidence that the Respondent has made no use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, nor is the Respondent making a legitimate non-commercial or fair use of the disputed domain name, nor is the Respondent commonly known under the disputed domain name. This prima facie evidence was not challenged by the Respondent.

In the absence of a Response, the Panel infers that the Respondent had Complainant's trademark in mind when registering and using the disputed domain name as described above, which was therefore registered and is being 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. **ACTAVISSHOP.COM**: Transferred

PANELLISTS

Name	**Dr. Thomas Schafft**

DATE OF PANEL DECISION 2016-12-06

Publish the Decision