Decision for dispute CAC-UDRP-101134

Case number	**CAC-UDRP-101134**
Time of filing	**2015-12-08 12:09:07**
Domain names	**tevaus.com**

Case administrator

Name	**Lada Válková (Case admin)**

Complainant

Organization	**Teva Pharmaceutical Industries Ltd.**

Complainant representative

Organization	**Matkowsky Law PC**

Respondent

Organization	**zhaoke**

OTHER LEGAL PROCEEDINGS

The Panel is unaware of any other pending or decided legal proceedings which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the registered holder of the following trademarks, among others:

- TEVA (figurative), Singapore national trademark, filing date 18 December 1991, registration date 18 December 1991, trademark no. T9111063A, registered for pharmaceutical, veterinary and sanitary preparations, all included in class 5;

- TEVA (figurative), Australian national trademark, filing date 13 November 1991, registration date 13 November 1991, trademark no. 567236, registered for pharmaceutical substances and compositions for human and veterinary purposes; air purifying medicated antiseptics and detergents; and all other goods in class 5;

- TEVA (word), Community Trade Mark, filing date 2 June 1999, registration date 18 July 2000, trademark no. 001192830, registered for classes 3, 5 (includes mainly pharmaceuticals and other preparations for medical purposes) and 10;

- TEVA (word), over 20 national trademarks registered by the Complainant for goods in class 5 (includes mainly pharmaceuticals and other preparations for medical purposes) before the date of registration of the disputed domain name; the jurisdictions include, for example, United States, United Kingdom, Canada, Iceland, Serbia, Slovakia, etc.

Moreover, the word "teva" constitutes a distinctive part of the Complainant's company name under which it operates worldwide.

FACTUAL BACKGROUND

The Complainant is Teva Pharmaceutical Industries Ltd. ("Complainant" or "Teva"), a top 10 pharmaceutical company worldwide, first established in 1901 with its global headquarters in Israel and currently active in 60 countries. In 2014 the Teva group generated USD 20.3 billion in net revenues and is traded on the Tel Aviv Stock Exchange, NASDAQ, and the New York Stock Exchange. The Teva group has a leading position in innovative treatments for disorders of the central nervous system, including pain, as well as a strong portfolio of respiratory products. Concerning the market share, in the United States, for example, one of every seven generic prescriptions is filled with a Teva product, and Teva's presence in the EU market is considerable.

Teva is the registered holder of numerous word and figurative "teva" trademarks in many jurisdictions (for more information see section Identification of Rights) as well as it operates worldwide under the company name including the distinctive "teva" word element.

The disputed domain name <tevaus.com> was registered on 23 November 2015 and is held by the Respondent. The Respondent, zhaoke, is based in China and no details on the Respondent were provided nor found on the internet.
A website available under the disputed domain has contained content related to pharmaceutical industry. In particular, it has been used to present links to lists of various websites, some relating to the pharmaceutical industry, including for example links to "Teva Pharmaceutical Jobs" website. In addition, a website available under the disputed domain name includes a note that the domain is for sale.

The Complainant seeks transfer of the disputed domain name from the Respondent.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

LANGUAGE OF THE PROCEEDINGS

The Complainant states that the Panel is allowed to apply paragraph 11(a) of the Rules For Uniform Domain Name Dispute Resolution Policy ("Rules") which confers authority to the Panel to conduct the proceeding in a language other than of the Registration Agreement, including the language of the Complaint. The circumstances for such decision include:

- The disputed domain name consists of English-based characters;

- The Respondent's email account used to register the disputed domain name comprises of English words;

- Depending on IP address of the internet user visiting the disputed domain name website, the website displays advertising in English;

- The Respondent entered into an English contract with a parking monetization supplier, Rook Media (DomainSponsor), a Swiss corporation with its office in New York, to display the English-based ads;

- The Respondent's email used with the domain name registrar has been used for the registration of several other domain names, including for example <hiltonhotels.biz>, which uses English generic or descriptive terms.
From the above the Complainant concludes that the Respondent is familiar with English language, as well as it targets English-speaking audience, and finds it to be in the spirit of fairness and justice to both parties to allow the case to proceed

in English.

DOMAIN NAME IS IDENTICAL AND CONFUSINGLY SIMILAR TO THE PROTECTED MARK

The Complainant states that the disputed domain name <tevaus.com> is confusingly similar to the "teva" registered trademarks in which Complainant has rights. The disputed domain name includes "teva" with the addition of the geographically descriptive abbreviation (country code) "us" reserved for the United States. The Complainant refers to previous decisions in domain disputes, especially those with the pattern <trademark-us.com>, and quotes that the addition of descriptive wording to a trademark in a domain name is itself insufficient to avoid a finding of confusing similarity. The incorporated trademark "teva" constitutes the dominant or principal component of the disputed domain name. The ".com" top-level suffix in the domain name is disregarded under the confusing similarity test as it is a technical requirement of registration.

RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN THE DOMAIN NAME

The Complainant notes that panels in past disputes recognized that use of a domain name for purposes of parking and landing pages or PPC links itself does not establish rights or legitimate interests arising from a "bona fide offering of goods or services" or from "legitimate non-commercial or fair use" of the domain name, especially where resulting in a connection to goods or services competitive with those of the rights holder, which is the opposite of fair use, constituting illegitimate activities.

The Complainant states that:

- The Respondent uses the disputed domain name to earn parking revenue that specifically capitalizes on the trademark value, which is unfair use resulting in misleading diversion;

- The Respondent put the domain on DomainSponsor domain parking platform and presents commercial ads related to the pharmaceutical industry there; the Respondent lacks rights or legitimate interests in using the disputed domain name for domain revenue, specifically when it is linked to the "teva" trademark;

- The Respondent is responsible for the hosted content despite the fact that it hired DomainSponsor to handle the hosted content.

DOMAIN NAME HAS BEEN REGISTERED AND IS BEING USED IN BAD FAITH

The Complainant states that the following circumstances strongly indicate that the disputed domain name was registered and is used in bad faith:

- The Respondent incorporated the registered trademark "teva" in the disputed domain;

- The Respondent uses the disputed domain name to host multiple commercial links to goods and services, some of which are strongly related to the Complainant's trademark;

- The disputed domain name has attracted viewers for commercial gain, by creating a likelihood of confusion within the meaning of paragraph 4(b)(iv) of the Policy as a result of pay-per-click links;

- The Respondent presumably uses false contact information including multiple identities and physical addresses to register infringing domain names with his email account;

- The Respondent has pattern and practice of registering domain names including prominent third-party trademarks, such as <hiltonhotels.biz>, <barclaycard-us.com> or <continental-tire.com>, using the domains for parking revenue;

- The Respondent has not taken active steps to sell the disputed domain name to the Complainant, however, the domain is advertised for sale.

In support of its arguments, the Complainant refers to previous domain disputes before the Czech Arbitration Court, WIPO and the National Arbitration Forum (NAF) which recognized Complainant's rights in the TEVA registered mark.

The Complainant has presented to the Panel the following evidence, which has been assessed by the Panel:

1) Excerpt on the disputed domain name details from WHOIS database;
2) Excerpts on other domain names from whois database registered by the Respondent;
3) Excerpts from OHIM and other databases such as US Patent and Trademark Office regarding Complainant's trademarks;
4) Screenshots of the disputed domain name website;
5) Various documents to support additional arguments, including, for example, the decision of the National Arbitration Forum regarding <tevarx.com> disputed domain name.

RESPONDENT:
The Respondent has not provided any response to the complaint.

RIGHTS

The Panel concluded that the disputed domain name is confusingly similar to trademarks in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Uniform Domain Name Dispute Resolution Policy ("UDRP" or "Policy").

For details, see "Principal Reasons for the Decision".

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.

For details, see "Principal Reasons for the Decision".

BAD FAITH

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

For details, see "Principal Reasons for the Decision".

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.

Pursuant to paragraph 11 (a) of the Rules for Uniform Domain Name Dispute Resolution Policy, “the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding”. In this case according to the Registrar the language of the Registration Agreement is Chinese. However, the Complainant requested to change the language of the proceedings to English based on the reasons mentioned above.

The Provider sent the written notice to the Respondent in both English and Chinese. Therefore, the Respondent had an opportunity to respond but chose not to do so. Having considered the Complainant's submission regarding the language of the proceedings and the overall circumstances of this case, the Panel accepts the Complaint in English and shall render its decision in English.

PRINCIPAL REASONS FOR THE DECISION

RIGHTS

Since the domain name and the Complainant’s trademarks are not identical, the key element investigated and considered by the Panel is whether the disputed domain name consisting of a term “teva” accompanied by a suffix “us" is confusingly similar to the Complainant’s trademarks.

The threshold test for confusing similarity under the UDRP involves a comparison between the trademark and the domain name itself to determine likelihood of Internet user confusion. In order to satisfy this test, the relevant trademark would generally need to be recognizable as such within the domain name. An addition of common, dictionary, descriptive, or other descriptive terms is typically insufficient to prevent threshold Internet user confusion. Confusing similarity test under the UDRP typically involves a straightforward visual and aural comparison of the trademark with the domain name.

Applying the principles described above, the Panel contends that incorporation of the dominant “teva” element of Complainant’s trademarks (which standalone enjoys high level of distinctiveness) into the disputed domain name constitute confusing similarity between Complainant’s trademark and such domain name. Addition of non-distinctive element - suffix "us” cannot prevent the association in the eyes of internet consumers between the disputed domain name and the Complainant’s trademarks and thus the likelihood of confusion still exists. The generic term "us" may refer to the descriptive geographical abbreviation for the United States, which is one of the major markets in which the Complainant operates.

For sake of completeness, the Panel asserts that the top-level suffix in the domain name (i.e. the ".com") must be disregarded under the identity and confusing similarity tests as it is a necessary technical requirement of registration.

NO RIGHTS OR LEGITIMATE INTERESTS

Based on general Internet search, the Respondent is not commonly known by the disputed domain name. Given the fact, that the Respondent, in particular, decided to use a domain name which is identical with trademarks and signs of the Complainant, offering parking page for links to, inter alia, pharmaceutical industry related websites, as well as the Respondent advertised the disputed domain name for sale, in the absence of the Respondent's response the Panel concludes that the domain name was not intended to be used in connection with a bona fide offering of goods or services as required by the Policy.

The evidentiary burden therefore shifts to the Respondent to show by concrete evidence that it does have rights or legitimate interests in that name. However, the Respondent failed to provide any information and evidence that it has relevant 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 Panel finds it grounded that the Respondent registered and used the disputed domain name in bad faith, namely (i) for the purpose of selling the disputed domain name as it is advertised to be for sale; (ii) in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, given the fact that the Respondent engaged in a pattern of such conduct with other prominent trademarks of third parties (using the same email account for use of which the Respondent is responsible no matter if the email account is used by other persons acting with the Respondent in accordance); and (iii) by using the domain name the Respondent intentionally attempted to attract, for commercial gain, Internet users to the disputed domain name website by creating a likelihood of confusion with the Complainant's trademark.

For the reasons described above, the Panel contends, on the balance of probabilities, that the disputed domain name has been registered and is being used by the Respondent in bad faith.

Thus, the Panel has taken a view 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).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **TEVAUS.COM**: Transferred

PANELLISTS

Name	**JUDr. Jiří Čermák**

DATE OF PANEL DECISION 2016-01-15

Publish the Decision