Decision for dispute CAC-UDRP-106952

Case number	CAC-UDRP-106952
Time of filing	2024-10-16 09:02:56
Domain names	tevapharmacies.com

Case administrator

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

Complainant

Organization	Teva Pharmaceutical Industries Ltd

Complainant representative

Organization	SILKA AB

Respondent

Name	Blake Butikofer

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 name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner, among others, of the following trademark registrations:

- the national (Israel) trademark “TEVA” No. 41075, registered on 5 July 1977, protected for goods in class 5;
- the national (USA) trademark “TEVA” No. 1567918, registered on 28 September 1989, protected for goods in class 5;
- the EUTM “TEVA” No. 001192830, registered on 18 July 2000, protected for products in classes 3, 5, 10;
- the EUTM “TEVA” No. 015135908, registered on 28 July 2016, protected for goods and services in classes 1, 3, 5, 9, 10, 16, 35, 42, 44;
- the international trademark “TEVA” No. 1319184, registered on 15 June 2016, protected for goods and services in classes 5, 10, 42.

The Complainant proved Its ownership of the listed trademark registrations, except for the national US “TEVA” trademark No. 1567918, by the submitted extracts from the WIPO and EUIPO databases. The absence of an extract from the trademark register for the US “TEVA” trademark No. 1567918 does not change the overall finding of the Complainant’s rights in “TEVA” trademark.

FACTUAL BACKGROUND

The Complainant is a pharmaceutical company established in 1901. The Complainant is internationally active and maintains a

portfolio of approximately 3,600 medicines, reaching some 200 million people across 58 markets and six continents every day. The Complainant has over 50 manufacturing facilities and in the region of 37,000 employees. The Complainant owns several trademarks including the “TEVA” term (see above) and is also the owner of many domain names, which include the “TEVA” trademark, such as, <tevapharma.com>, registered since 2000.

The disputed domain name <tevapharmacies.com> (hereinafter “disputed domain name”) was registered on 4 October 2024. According to the Registrar, the Respondent is ‘Blake Butifoker’. The Respondent’s provided address as being at Illinois, United States.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant contends that the requirements of the UDRP have been met and that the disputed domain name should be transferred to it.

RESPONDENT:

No administratively compliant Response has been filed by the Respondent.

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 UDRP).

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 UDRP).

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 UDRP).

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

In the present case, the Respondent has not submitted any Response and consequently has not contested any of the contentions made by the Complainant. Therefore, the Panel proceeds to decide only on the basis of the Complainant’s factual statements and the documentary evidence provided in support of them [Paragraph 5(f) of The Rules].

1. CONFUSING SIMILARITY

The Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademarks.

The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (hereinafter “The WIPO Overview 3.0”) in Paragraph 1.2.1 states: “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 WIPO Overview 3.0 in Paragraph 1.7 states: “[…] 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.”

The WIPO Overview 3.0 in Paragraph 1.8 states: “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 nature of such additional term(s) may however bear on assessment of the second and third elements.”

In the WIPO Case No. D2006-0451, F. Hoffmann-La Roche AG v. Macalve e-dominios S.A., the panel stated that: “It is also well established that the specific top level of a domain name such as “.com”, “.org” or “.net” does not affect the domain name for the purpose of determining whether it is identical or confusingly similar”.

In the present case, the Complainant has established that it owns numerous national, international and EUTM trademark registrations consisting of the “TEVA” verbal element, protected for the classes in connection with pharmaceutical products (evidenced by the submitted extracts from the WIPO and EUIPO databases).

The disputed domain name <tevapharmacies.com> contains the Complainant’s trademark in its entirety. The general term “pharmacies” was added to the Complainant’s trademark. No further adjustments were made to distinguish the disputed domain name from the Complainant’s trademarks.

Past panels have declared that the addition of a general (descriptive) term cannot prevent the finding of confusing similarity. The added term “pharmacies” in the present case is a general term.

Therefore, the disputed domain name is considered to be confusingly similar to the relevant trademark.

The “.com” element of the disputed domain name does not affect the finding of confusing similarity.

As a result, the Panel finds that the Complainant has satisfied Paragraph 4(a)(i) of the UDRP.

2. THE RESPONDENT´S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAME

The Panel finds that the Respondent lacks rights or legitimate interests in the disputed domain name.

According to Paragraph 4(a)(ii) of the UDRP, the Complainant shall make a case that the Respondent lacks rights and legitimate interests in the disputed domain name. If the Complainant fulfils this demand the burden of proof shifts to the Respondent and so the Respondent shall demonstrate rights or legitimate interests in the disputed domain name. If the Respondent fails to prove its rights or legitimate interests, it is assumed that the Complainant satisfied the element of Paragraph 4(a)(ii) of the UDRP (see CAC Case No. 102430, Lesaffre et Compagnie v. Tims Dozman). Moreover, past panels were of the view that it is difficult or sometimes impossible to prove negative facts, i.e., absence of rights or legitimate interest on the part of the Respondent. In this respect, past panels referred to the WIPO Case No. D2000-1769, Neusiedler Aktiengesellschaft v. Vinayak Kulkarni. Within the meaning of Paragraph 4(a)(ii) of the Policy, once the complainant has made something credible (prima facie evidence), the burden of proof shifts to the Respondent to show that he has rights or legitimate interests in the domain name at issue by providing concrete evidence.

The WIPO Overview 3.0 in Paragraph 2.9 states: “Applying UDRP paragraph 4(c), panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant’s mark or otherwise mislead Internet users. Panels have additionally noted that respondent efforts to suppress PPC advertising related to the complainant’s trademark (e.g., through so-called “negative keywords”) can mitigate against an inference of targeting the complainant“.

In the CAC Case No. 102279, FileHippo s.r.o. v. whois agent, the panel stated that “[i]n the absence of a response, the Panel accepts the Complainant's allegations as true that the Respondent has no authorization to use the Complainant’s trademarks in the disputed domain name. Hence, as the Complainant has made out its prima facie case, and as the Respondent has not demonstrated any rights or legitimate interests as illustrated under Paragraph 4(c) of the Policy, nor has the Panel found any other basis for finding any rights or legitimate interests of the Respondent in the disputed domain name, the Panel concludes that the Complainant has satisfied the requirements of Paragraph 4(a)(ii) of the Policy.”

In the present case, the Complainant claims that the Respondent does not have trademark rights for, nor is it commonly known by, “tevapharmacies” or any similar term. The Respondent is not connected to nor affiliated with the Complainant and has not received a license or consent to use the “TEVA” trademark in any way.

Furthermore, the Complainant asserts that the Respondent has not used, nor prepared to use, the disputed domain name in connection with a bona fide offering of goods or services, nor a legitimate non-commercial or fair use. The disputed domain name currently resolves to a parked page which pay-per-click links to third-party sites that offer pharmacy-related goods/services (proved by the submitted screenshot of the website under the disputed domain name). By that, the links compete with/capitalize on the Complainant’s TEVA brand.

The Complainant adds that the disputed domain name carries a high risk of implied affiliation. The disputed domain name combines the Complainant’s internationally established “TEVA” trademark with the industry-related “pharmacies” term. Such a composition creates the misleading impression that the disputed domain name is operated by the Complainant or an authorized affiliate of such (to, for example, advertise the Complainant’s pharmaceutical goods or a list of locations where such items can be purchased). However, in the case at issue, the Respondent’s selection of the disputed domain name cannot constitute fair use.

The Complainant proved its ownership of numerous national, international and EUTM trademark registrations (see above). As was

already stated, the disputed domain name is confusingly similar to the Complainant's trademarks. By that, the Respondent is creating a likelihood of confusion and misleading the consumers. Such a finding is supported by the fact that the added "pharmacies" term is closely related to the Complainant's business activities worldwide. The use of pay-per-click links to third-party sites that offer pharmacy-related goods or services cannot constitute rights or legitimate interests in the disputed domain name.

There is no evidence that would lead to the conclusion that the Respondent is known by the disputed domain name. Identification of the Respondent is missing in the WHOIS information (evidenced by the WHOIS information related to the disputed domain name).

The Respondent did not reply to the Complaint and so failed to demonstrate his rights or legitimate interests in the disputed domain name.

Under such circumstances, the Panel cannot find any legitimate, non-commercial or fair use rights or interests of the Respondent in the disputed domain name.

Therefore, the Panel finds that the Complainant has satisfied the requirement under Paragraph 4(a)(ii) of the UDRP.

3. THE REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME IN BAD FAITH

The Panel finds that the Respondent registered and used the disputed domain name in bad faith.

The WIPO Overview 3.0 in Paragraph 3.1.1 states: "If on the other hand circumstances indicate that the respondent's intent in registering the disputed domain name was in fact to profit in some fashion from or otherwise exploit the complainant's trademark, panels will find bad faith on the part of the respondent. While panel assessment remains fact-specific, generally speaking such circumstances, alone or together, include: (i) the respondent's likely knowledge of the complainant's rights, (ii) the distinctiveness of the complainant's mark, […], (vii) failure of a respondent to present a credible evidence-backed rationale for registering the domain name, […].

The WIPO Overview 3.0 in Paragraph 3.1.4 states: "Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith."

In the WIPO Case No. D2006-1440, National Football League v. Thomas Trainer, the panel stated: "when a registrant, such as the Respondent here, obtains a domain name that is confusingly similar to a famous mark, with no apparent rights or legitimate interests in the name, and then fails to respond to infringement claims and a UDRP Complaint, an inference of bad faith is warranted."

In the WIPO Case No. D2018-0497, StudioCanal v. Registration Private, Domains By Proxy, LLC / Sudjam Admin, Sudjam LLC, panel stated: "In that circumstance, whether the commercial gain from misled Internet users is gained by the Respondent or by the Registrar (or by another third party), it remains that the Respondent controls and cannot (absent some special circumstance) disclaim responsibility for, the content appearing on the website to which the disputed domain name resolve […] so the Panel presumes that the Respondent has allowed the disputed domain name to be used with the intent to attract Internet users for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, affiliation, or endorsement of the Respondent's website to which the disputed domain name resolves. Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith."

In the CAC Case No. 102827, JCDECAUX SA v. Handi Hariyono, the panel stated: "There is no present use of the disputed domain name but there are several active MX records connected to the disputed domain name. It is concluded that it is inconceivable that the Respondent will be able to make any good faith use of the disputed domain name as part of an e-mail address."

In the present case, the Complainant has established that it owns numerous national, international and EUTM trademark registrations consisting of the "TEVA" verbal element, protected for classes in connection with pharmaceutical products, with the priority right since 1977 (proved by the submitted extracts from the WIPO and EUIPO databases).

The disputed domain name <tevapharmacies.com> contains the Complainant's trademark in its entirety. The addition of the general term "pharmacies" does not prevent the finding of confusing similarity.

Past panels have declared that the Complainant's trademarks are well-known (see, e.g., WIPO Case No. D2022-0955, Teva Pharmaceutical Industries Limited v. Joseph Waweru, Joseph Waweru). Therefore, the disputed domain name is confusingly similar to the highly distinctive and well-known earlier trademark of the Complainant.

A simple Google search for "tevapharmacies" leads Internet users mostly to the Complainant's websites (evidenced by the submitted screenshot of a Google search for 'tevapharmacies' keyword).

Therefore, this Panel states that the Respondent must have been aware of the Complainant's trademarks and Its reputation before the registration of the disputed domain name on 4 October 2024.

As was evidenced by the submitted screenshot of the website under the disputed domain name, the disputed domain name is leading Internet users to a parking website providing commercial pay-per-click links to other websites, offering pharmacy-related goods or services. By that, the disputed domain name might confuse and attract Internet users to the Respondent's confusingly similar website for the Respondent's own commercial gain.

Moreover, the disputed domain name has been set up with MX records (evidenced by the DNS query). Such a finding leads to the conclusion that the disputed domain name might be actively used for email purposes. In the present situation, when the Respondent is trying to divert Internet users to the confusingly similar website for his commercial gain through the commercial links, this Panel assumes, that MX records for the disputed domain name cannot be used for any good faith purposes.

The bad faith of the Respondent might also be supported by the fact that the Respondent used the name of an actual employee of the Complainant for the purpose of registering the disputed domain name (proved by the screenshot of the employee's LinkedIn profile).

Thus, it might be concluded that the Respondent is not using the disputed domain name in good faith.

Following the above-mentioned, the Panel finds that the Complainant has satisfied conditions pursuant to Paragraph 4(a)(iii) of the UDRP.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **tevapharmacies.com**: Transferred

PANELLISTS

Name	**Radim Charvát**

DATE OF PANEL DECISION 2024-11-19

Publish the Decision