Decision for dispute CAC-UDRP-107120

Case number	CAC-UDRP-107120
Time of filing	2024-12-02 10:40:29
Domain names	tevamexicos.com

Case administrator

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

Complainant

Organization	Teva Pharmaceutical Industries Ltd

Complainant representative

Organization	SILKA AB

Respondent

Name	Guy Sensei

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 Teva Pharmaceutical Industries Ltd owns different trademarks consisting of the word TEVA. In particular the Complainant has fully proved to be the owner of the following signs:

- Israeli Trademark No. 41075 for TEVA registered on July 5, 1977, upon application made on August 5, 1975;

- U.S. Trademark No. 1567918 for TEVA registered on November 28, 1989, upon application made on February 17, 1989;

- EUTM No. 1192830 for TEVA registered on July 18, 2000, upon application made on June 6, 1999;

- International Trademark No. 1319184 for TEVA (design) registered on June 15, 2016;

- EUTM No. 15135908 for TEVA (design) registered on July 28, 2016, upon application made on February 23, 2016;

- Mexican Trademark No. 403326 for TEVA registered on January 10, 1992, upon application made on September 18, 1990; and

- Mexican Trademark No. 1657987 for TEVA (design) registered on July 21, 2016, upon application made on March 9, 2016.

FACTUAL BACKGROUND

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

The Complainant is Teva Pharmaceutical Industries Ltd. ("Complainant" or "Teva"), an international actively and widely known pharmaceutical company, established in 1901. According to the Complainant, Teva 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.

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 Complainant and its affiliated companies hold also many domain names including <tevamexico.com> and <tevamexico.com.mx>.

The disputed domain name <tevamexicos.com> was registered on November 6, 2024.

The Complainant states that the disputed domain name <tevamexicos.com> is confusingly similar to its trademark "TEVA". In particular, in the Complainant's view, the domain name comprises in full the "TEVA" trademark and the addition of the term "MEXICOS" is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark.

The Complainant states that the Respondent is not affiliated with him nor authorized by him in any way. The Complainant states that the Respondent has no rights nor legitimate interests in the disputed domain name and that it is not related in any way to its business. The Complainant does not carry out any activity for, nor has any business with the Respondent. The Respondent, according to the Whois database, is not commonly known by <tevamexicos> or by other names similar to the disputed domain name.

The Complainant also notes that the domain name <tevamexicos.com> resolves to a parking page and that, given the distinctiveness of the Complainant's trademark and reputation, it is reasonable to infer that the Respondent has registered the domain name with the full knowledge of the Complainant's trademarks. It is the Complainant's view that the Respondent has allowed the disputed domain name to be used with the intent to capitalise on its confusing similarity with the Complainant's "TEVA" brand and official online presence for Mexico-based internet users.

The Complainant has also demonstrated that the disputed domain name has been set up with MX records which suggests that it may be actively used for email purposes. This, according to the Complainant, is also indicative of bad faith registration and use.

PARTIES CONTENTIONS

The Complainant contentions are summarised above.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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 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 name (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 name has been registered and is 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.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 4(a) of the Policy provides that to obtain the transfer of the disputed domain name, the Complainant must prove that each of the following elements is present:

(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; and

(iii) the disputed domain name has been registered and is being used in bad faith.

1) The disputed domain name fully includes the Complainant's trademark. Also, it is added to the word "TEVA" the word "MEXICOS". In this respect the Panel notes that many previous panels under the Policy have found that a geographic identifier in a domain name (as in the disputed domain name <tevamexicos.com>) does not alter the finding of similarity between the domain name in dispute and the previous registered trademark (see, among others, Six Continents Hotels, Inc. v. Sdf fdgg, WIPO Case No. D2004-0384, Credit Agricole SA v. Frederik Hermansen, CAC Case No. 101249 and BOEHRINGER INGELHEIM ANIMAL HEALTH FRANCE v. João Carlos Linhares, CAC Case No. 106712). Finally, the generic Top-Level Domain ".com" is obviously a mere standard registration requirement and should be disregarded when assessing whether a disputed domain name is confusingly similar to the trademark in which the Complainant has rights. Accordingly, the Complainant has, to the satisfaction of the Panel, shown that the domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The Complainant therefore succeeds on the first element of the Policy.

2) The Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain name as it is not commonly known under the disputed domain name and was never authorized to use the Complainant´s "TEVA" trademark. The Respondent, in the absence of any Response, has not shown any facts or element to justify prior rights or legitimate interests in the disputed domain name. The Complainant therefore succeeds on the second element of the Policy.

3) Paragraph 4(b) of the Policy sets out the following examples of circumstances that will be considered by an Administrative Panel to be evidence of the bad faith registration and use of a domain name:

(i) circumstances indicating that the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the domain name registrant's out-of-pocket costs directly related to the domain name; or

(ii) the domain name was registered in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the domain name registrant has engaged in a pattern of such conduct; or

(iii) the domain name was registered primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the domain name registrant intentionally attempted to attract for financial gain, Internet users to the registrant's website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the registrant's website or location or of a product or service on the registrant's website or location.

The above examples are not exclusive and other circumstances may exist that demonstrate the registration and use of a domain name in bad faith.

As to the registration of the disputed domain name in bad faith, the reputation of the Complainant's trademark is such that, in the Panel's view, the Respondent could not ignore the trademark "TEVA" at the time of the registration of <tevamexicos.com>. It is therefore obvious that the Respondent selected the disputed domain name to create confusion with the Complainant´s affairs. It is the Panel's view that the Respondent was in bad faith when it decided to register the domain name in dispute since said registration was done having perfectly in mind the Complainant's trademark and the Complainant's business activity.

Furthermore, there is no evidence that the disputed domain name has been actively used by the Respondent for a website containing a concrete offer of goods and/or services. Instead, it only directs to a parking page. Although there is no evidence that the disputed domain name is being actively used or resolved to a website with substantive content, Panels have found that the non-use of a domain name (including a blank or "coming soon" or "parking" page) would not prevent a finding of bad faith under the doctrine of passive holding (see, among others, Sanofi v. Blingorf Steven, WIPO Case No. DCO2024-0020).

Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad

faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include the degree of distinctiveness or reputation of the complainant's mark and the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good faith use.

The distinctiveness and reputation of the Complainant's trademark, and the composition of the disputed domain name (Complainant's mark plus geographic identifier) support the finding that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy. Furthermore, the Panel's view is that there is no conceivable plausible reason for good faith use with regard to the disputed domain name.

Finally, the Panel has verified that the Respondent has set up "MX-records" for the disputed domain name. This entails that the Respondent can send e-mails through the e-mail address "@tevamexicos.com". The Respondent can therefore use the disputed domain name to send fraudulent e-mails such as messages containing spam and/or phishing attempts that Internet users could well assume were sent by the Complainant. (See Confédération Nationale du Crédit Mutuel, Crédit Industriel et Commercial v. Khodor Dimassi, WIPO Case No. D2016-1980 and Paris Saint-Germain Football v. MHP Private, WIPO Case No. D2019-0036). Albeit that there are no concrete examples of such use, it seems 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. The Panel finds that the mere conduct of making preparation for sending e-mails which are very likely to confuse the recipient of such e-mails as to their origin, is without justification and is inconsistent with the Complainant's exclusive rights in the "TEVA" trademark (see Accenture Global Services Limited v. Registration Private, Domains by Proxy, LLC / Richa Sharma, Name Redacted, WIPO Case No. D2019-2453). In consideration of the above, the Panel deems that the domain name in dispute was registered and used in bad faith and accordingly that the Complainant has satisfied also the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **tevamexicos.com**: Transferred

PANELLISTS

Name	**Guido Maffei**

DATE OF PANEL DECISION 2025-01-14

Publish the Decision