Decision for dispute CAC-UDRP-107264

Case number	CAC-UDRP-107264
Time of filing	2025-01-24 10:07:47
Domain names	actavislife.com

Case administrator

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

Complainant

Organization	Actavis Group PTC ehf
Organization	Actavis Holdco U.S., Inc.

Complainant representative

Organization	SILKA AB

Respondent

Name	MD AB JAKARIA

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

Two subsidiaries of Teva Pharmaceutical Industries Ltd, Actavis Holdco U.U., Inc., and Actavis Group PTC ehf, have jointly submitted the Complaint in the present proceeding and present themselves as one. Under Procedural Factors (below) the Panel rules in favour of such consolidation of Complainants.

Treating, therefore, the Complainants as one party in this proceeding, the Complainant has adduced evidence of owning the following trademarks in relation to the ACTAVIS brand name which also forms part of the two subsidiaries' company names:

- Icelandic trademark No. 993/2003, registered on 28 November 2003 in Nice Classification class 5;

- International trademark No. 8227298, registered on 15 March 2004 in Nice Classification classes 1, 3, 5, 10, 42 and 44;

- EU trademark No. 003615721, registered on 16 January 2006 in Nice Classification classes 1, 3, 5, 10, 42 and 44;

- Mexican trademark No. 1171632, registered on 30 July 2010 in Nice Classification class 1;

- Brazilian trademark No. 829692932, registered on 28 September 2010 in Nice Classification class 1; and

- United States trademark No. 5586410 (figurative), registered on 16 October 2018 in Nice Classification class 5.

The Complainant also claims that it owns other trademarks but without supplying evidence of them.

It provided evidence of pertinent domain names it holds: <activis.com>, registered on 3 September 2002, and four others, <activis.net> and <activis.org>, both registered in 2003, and <activispharma.com> and <activispharmacompany.com>, registered in 2003 and 2013 respectively.

The Respondent registered the disputed domain name <actavislife.com> on 24 October 2024 according to the Registrar Verification obtained by the CAC Case Administrator.

FACTUAL BACKGROUND

The two companies forming the Complainant in this proceeding (see Procedural Factors) are part of the Teva pharmaceuticals group, whose founding company was established in 1901. Teva's portfolio extends to around 3,600 medicines sold in 58 markets and is cited by third-party pharmaceutical industry observers (for which the Complainant adduced sources) as being among the world's leading generic drug manufacturers, with 50 manufacturing facilities and some 37,000 employees. After being acquired by Teva, the Complainant companies' products bearing the trademarked ACTAVIS brand continued to be offered.

Screenshots adduced by the Complainant show that the website to which the disputed domain name resolves features the company name "Actavis Life Science Ltd" accompanied by a large banner saying "Let's get in Touch", with copyright attributed to Actavis Life Science Ltd, while a comments page shows a welcome post generated, apparently automatically, by the web content management system employed for the web site's presentation.

Another set of screenshots show how the same website web content management program theme has been used with minimal alteration across a series of websites resolving to other domain names. One, in French, mentions recent posts about ink cartridges and IT supplies. Another contains the same generated welcome post as on the website that resolves to the disputed domain name, and they likewise all contain the same contact telephone number.

A further screenshot reveals the results of an SMTP test indicating that an active e-mail server is associated with the disputed domain name.

The Complainant performed a search for the ACTIVIS brand on a search engine which showed references only to the Complainant's products.

The Complainant and the CAC Administrator attempted to contact the Respondent but these attempts elicited no response.

The Panel's routine scrutiny of the Case File revealed that the Registrar Verification obtained by the CAC Administrator on its face discloses credible contact details.

PARTIES CONTENTIONS

COMPLAINANT:

1. The Complainant's rights

The Complainant refers, in addition to the evidence of its rights that it has adduced, to the renown and distinctiveness of its protected ACTAVIS brand, as has been recognized in several prior domain-name dispute resolution administrative proceedings.

Despite such renown and distinctiveness, the Respondent incorporated the Complainant's ACTAVIS trademark in full in the disputed domain name with the addition of the word <life>, which connotes life sciences, this being a field within which the Complainant's pharmacology business operates. Visually, the Complainant's brand is predominant while the <.com> TLD extension can be disregarded. The disputed domain name is confusingly similar to the Complainant's trademark in view of these factors.

2. The Respondent's lack of rights or legitimate interest

The Respondent lacks any right or legitimate interest in the disputed domain name. None of the factors indicated in the Policy that might substantiate a right or legitimate interest in favour of the Respondent is evident in the circumstances of this proceeding. Nor has the Respondent received any authorization from the Complainant to use its trademarked brand. Instead, the disputed domain name is put to illegitimate use, as evidenced by the screenshots of the website to which it resolves and other ones based upon the same content management theme and with the same telephone contact details. This use serves to misleadingly suggest an association with the Complainant that does not exist.

The above factors amount to a prima facie case.

3. The Respondent's bad faith

As to the Respondent's bad-faith registration, the very construction of the disputed domain name as <actavislife.com> connotes an

understanding of the relationship of the Complainant's brand to the field of life sciences of which the Complainants' and parent company's business area of pharmacology forms part. As to the Respondent's bad faith use, it is clear from the details on the web site to which the disputed domain name resolves that the Respondent is in effect making an attempt to impersonate the Complainant. As to the Respondent activating the disputed domain name's e-mail facility, the Complainant contends that this may reflect an attempt to deceive internet users, such as by tricking them into providing sensitive health-related data under the false impression that they are engaging with the Complainant. Such behaviour defies any explanation based on good faith.

The Complainant invokes its search-engine results and its unanswered attempt to contact the Respondent as further indications of bad faith registration and use and claims that this is a case of passive holding of a domain name -- a further indication of bad faith in itself.

RESPONDENT:

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 trademarks 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 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).

PROCEDURAL FACTORS

The two Complainants which jointly submitted the Complaint in this proceeding requested that they be consolidated into one for the proceeding's purposes.

There being an identicality of interest, though of course distinct trademark rights, within the same corporate group to which each belongs, the Panel ACCEPTED this procedural request. It adds, however, the requirement that, if either of the consolidated Complainants were to seek to make a refiling on its own, it must demonstrate to the Panel that considers the new proceeding that it does so on the basis of its unique interest and fresh and compelling evidence. If any shared interest is by contrast concerned, the refiling request must be requested by both Complainants and on the same basis of fresh and compelling evidence.

The Panel is satisfied that all further procedural requirements under the UDRP were met and that there is no other reason why it would be inappropriate to provide a decision.

The Panel notes that its résumé of the Parties' contentions includes for the Complainant only its arguments pertinent to reaching a decision in this administrative proceeding; it omits in particular references made in the Complaint to many past ADR Panels' Decisions.

Lastly, the Panel notes the Complainant's invitation to the Panel to regard its submissions concerning the Respondent's lack of rights or of a legitimate interest as being adequate to constitute a prima facie case and thereby to shift the burden of proof to the Respondent. The Panel does not accept this argumentation with respect to the circumstances of this case, there being notably no clarity given by the Complainant as to what it actually means by a prima facie case relative to those circumstances. The Panel recommends instead close attention to the actual facts of the proceeding and their probative value.

PRINCIPAL REASONS FOR THE DECISION

The Panel FINDS that:

1. The Complainant has substantiated its rights in the ACTIVIS brand name; that this name is the predominant element in the disputed domain name; that the addition of the word “life” within the stem of <actavislife.com> produces a compound that reinforces cognitive association of the Complainant's brand with the life sciences sector of which the Complainant’s field of operation, pharmacology, forms part; and that, contrary to the Complainant’s contention, the <.com> extension should be taken into account in assessing confusing similarity since the TLD extension serves here to strengthen the connection between the disputed domain name and the commercial scope of the Complainant’s activities. It therefore CONCLUDES that the first part of the UDRP’s cumulative three-part test is met in this case on the ground of there being confusing similarity between the disputed domain name and the Complainant's brand in which it has rights.

2. Whilst the details of the Respondent provided in the Case File thanks to the Registrar Verification appear prima facie credible as to identity, the Complainant has shown that the Respondent’s design of the disputed domain name at registration and its use within a series of clearly spurious websites that rely also on other domain names, together with the activation of the disputed domain name’s e-mail facility, all points to a pattern of illegitimate use that, in this case amounts in effect to imitation of the Complainant's commercial operation based on its protected brand. The Panel therefore CONCLUDES that the second part of the UDRP’s test is also met.

3. The evidence adduced by the Complainant referred to under the preceding point is sufficiently egregious to allow a clear inference of bad faith registration and use, since, as the Complainant correctly reasons, some familiarity with the market for pharmaceutical products and of the Complainant’s brand presence within it was required on the Respondent’s part in order to form the – optically credible – compound of that brand and the word “life” in the commercially oriented <.com> name chosen. The screenshot evidence provided then unequivocally demonstrates active unauthorized use of the Complainant’s protected brand. Against this background, it is far from unreasonable to conclude that active use of the disputed domain name’s e-mail facility is then aimed at, or is perhaps actually being used, for unauthorized commercial gain in some manner by illegitimately exploiting the Complainant’s brand. Crucially, too, this is likely in addition to be to the detriment of unwitting internet users. In the Panel's estimation on the basis of previous similar cases, the probability indeed seems high in this case that the main purpose being pursued by the Respondent is some form of phishing scam. The Panel therefore has no hesitation in CONCLUDING that the third and final part of the UDRP’s test is met.

For these reasons, the Panel ORDERS transfer of the disputed domain name to the Complainant.

It notes, however, that it has not accepted some of the Complainant’s contentions, notably as concerns its search-engine results, which were not performed by an independent entity that had no prior dealings with the Complainant and whose results would hence not be compromised by the likely effect of those dealings on the operation of the search engine’s algorithms. Another contention which the Panel found to have little evidential value is the circumstance of the Complainant’s unanswered attempt to make contact the Respondent. Lastly, the Panel does not accept the notion that this case involves passive holding of a domain name. The disputed domain name is in active use, and probable phishing in particular falls within the kind of abuse that the UDPR serves to address.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **actavislife.com**: Transferred

PANELLISTS

Name	**Kevin Madders**

DATE OF PANEL DECISION 2025-03-10

Publish the Decision