Decision for dispute CAC-UDRP-107384

Case number	CAC-UDRP-107384
Time of filing	2025-03-11 11:07:51
Domain names	actavis.online

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

Organization	Domain Name Privacy Inc.

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 Complainants each own registered trademarks for the word mark, ACTAVIS, in a variety of different jurisdictions around the world. Actavis Holdco U.S., Inc. holds trademarks registered in the United States and Actavis Group PTC ehf holds trademarks for ACTAVIS registered in other countries. Some of these trademarks include:

The word mark, ACTAVIS, Iceland national mark no. V0051143 registered on 28/11/2003;

The word mark, ACTAVIS, International mark no.827298 registered on 15/03/2004 in 27 countries.;

The word mark, ACTAVIS, an EUTM no. 003615721, registered on 16/01/2006 and renewed in 2023;

The word mark, ACTAVIS, a Mexican national mark no.1171632, registered on 30/07/2010;

The word mark, ACTAVIS, a Brazilian national mark no. 829692932, registered on 28/09/2010.

The figurative mark, ACTAVIS, a United States national mark no.5586410 registered on 16/10/2018.

The Second Complainant also has many domain names for the ACTAVIS mark. These registrations include <actavis.com> (registered in 2002), <actavis.net> (registered in 2003), <actavis.org> (registered in 2003), <actavispharma.com> (registered in

2003) and <actavispharmacompany.com> (registered in 2013).

The Complainants have been successful in numerous domain name dispute proceedings involving the ACTAVIS marks and many of these recognised that it is a mark with a reputation. These decisions include, for example:

(1) Actavis Group PTC ehf and Actavis Holdco U.S., INC. v. Kim Hasko, WIPO Case No. D2024-3469; (2) Actavis Group PTC ehf and Actavis Holdco U.S., INC. v. Masadepan 2toto, WIPO Case No. D2023-5252, (3) Actavis Group PTC ehf, Actavis Holdco U.S., Inc. v. Ostav Viktor Viktorovich, WIPO Case No. D2023-1244; (3) Actavis Group PTC ehf and Actavis Holdco U.S., Inc. v. Whois Privacy, Private by Design LLC / Paul Kemp, Mainline Information Systems, Inc., WIPO Case No. D2022-0990; (4) Actavis Group PTC ehf, Actavis Holdco US, INC. v. Withheld for Privacy Purposes, Privacy service provided by Withheld for Privacy ehf / Terry Tatang, bagp import and export pty ltd, WIPO Case No. D2021-2834; (5) Actavis Group PTC ehf and Actavis Holdco US, INC. v. Whois Agent (328792083), Whois Privacy Protection Services, Inc. / George Washere, WIPO Case No. D2021-1704; (6) Actavis Group PTC ehf, Actavis Holdco US, INC. v. Domain Admin, Privacy Protect, LLC (PrivacyProtect.org) / Vladimir Jonnas, WIPO Case No. D2021-1729; (7) Actavis Group PTC ehf, Actavis Holdco US, INC. v. Michael Nava, Domain Nerdz LLC, WIPO Case No. DCO2021-0045.

The well-known status and distinctiveness of the ACTAVIS mark has been the subject of comment in many WIPO UDRP decisions. See, for example, WIPO Case No. D2023-5252 ('the Complainants' ACTAVIS trademark is considered as being a well-known and reputable trademark'); WIPO Case No. D2023-1244 (noting the 'well-known nature of the Complainant's trademark'); WIPO Case No. D2021-2834 ('The Panel accepts the Complainant's submission that its trademark ACTAVIS constitutes an invented and distinctive term…'); WIPO Case No. D2021-1729 (noting 'the distinctive nature of the ACTAVIS mark'); and WIPO Case No. D2021-1704 ('In light of the evidence filed by the Complainant, the Panel finds that the Trademark and the Complainant's activities are well-known throughout the world.').

FACTUAL BACKGROUND

The Complainants are both subsidiaries of Teva Pharmaceutical Industries Ltd, a well-known pharmaceuticals company, established in 1901. Teva maintains a portfolio of approximately 3,600 medicines, used by some 200 million people across 58 markets and six continents every day. Teva has over 50 manufacturing facilities and approximately 37,000 employees. Teva is repeatedly featured in lists collating the world's top generic drug manufacturers. They have a commercial presence across approximately 100 countries. Both Complainants are now, as noted above, subsidiaries of Teva, supporting its position as a global leader in the pharmaceutical industry.

The disputed domain name was registered on 27 January 2025 and has resolved to a site which displays pay-per-click ('PPC') links to sites offering goods or services within the pharmaceutical industry). The Respondent is apparently the privacy service and no further details could be obtained about the identity of the registrant.

PARTIES CONTENTIONS

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

The Complainants request consolidation of the two Complainants and cite Paragraph 4.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ('WIPO Overview 3.0') lists factors panels typically consider when deciding whether multiple complainants in a dispute can be consolidated.

These factors include: 'whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation.'

The Panel finds that for the reasons submitted consolidation of the two Complainants into a single case is appropriate.

PRINCIPAL REASONS FOR THE DECISION

The Complainants have Rights in a name or mark similar or identical to the disputed domain name. The Panel accepts, that as other Panels have found, the Complainants' Mark is well-known or a mark with a reputation. The suffix has no bearing at the first factor of the Policy and/or the addition of the generic term ".online" adds nothing to the similarity analysis and it can be disregarded at this limb of the Policy. By use of the whole mark in the disputed domain name, the impression is given that the site is official and there is a risk of impersonation. The TLD .online also reinforces that impression.

As to the second limb of the Policy, a complainant is only required to make out a prima facie case that a respondent lacks rights or legitimate interests and then the burden shifts to the respondent to show it has rights or legitimate interests in the domain name. If it fails to do so, the complainant is deemed to have satisfied the limb in paragraph 4(a) (ii) of the Policy. See WIPO Case No. D2003-0455, Croatia Airlines d. d. v. Modern Empire Internet Ltd. Past panels have held that a Respondent was not commonly known by a disputed domain name if the Whois information was not similar to the disputed domain name. See the Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com>. Here we don't know how the Respondent is actually known as they are behind the privacy service. There is no legitimate or fair use on the face of it. Both passive holding and the use of PPC are neutral factors –and highly fact specific. There is no evidence of any genuine resales or distribution of the genuine item that might be nominative or other fair use. Often, where there is no website, the purpose will be for emails. Here the MX records are all configured. Such purposes include sending email, phishing, identity theft, or malware distribution. WIPO Overview 3.0, section 3.4. See, e.g., DeLaval Holding AB v. Registration Private, Domains By Proxy LLL / Craig Kennedy, WIPO Case No. D2015-2135. In such a case, the Panel is entitled to draw such inferences as are appropriate and they are that registration was not for a legitimate purpose or interest. The Respondent has therefore been granted an opportunity to come forward and answer or present compelling arguments that he has rights or legitimate interests in the disputed domain name but has failed to do so. There is no need to consider the offering for sale ground.

As to Bad Faith, the WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows is apposite. This is sometimes known as the passive Bad Faith test. Where a famous or well-known mark is incorporated into a domain name without any legitimate reason or explanation, Bad Faith can often be inferred. The Respondent did not come forward to explain the reasons for the selection of the disputed domain name and why there is no Bad Faith. Here it appears that the likely purpose of the Registrant/Respondent was for email purposes as the MX records are enabled. That purpose will very likely be for phishing and illegitimate and possibly criminal. That pushes passive holding and PPC over the line and the Panel finds there is Bad Faith.

The Complainants have discharged the burden of proof under the Policy and the Complaint is accepted.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **actavis.online**: Transferred

PANELLISTS

Name	**Victoria McEvedy**

DATE OF PANEL DECISION 2025-05-27