

## **ADMINISTRATIVE PANEL DECISION**

Gilead Sciences, Inc. v. Hilltop City Church  
Case No. D2022-2906

### **1. The Parties**

Complainant is Gilead Sciences, Inc., United States of America (“United States”), internally represented.

Respondent is Hilltop City Church<sup>1</sup>, United States.

### **2. The Domain Name and Registrar**

The disputed domain name <gileadhealth.org> (the “Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 5, 2022. On August 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On August 8, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email to Complainant on August 9, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on August 11, 2022.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on August 15, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 4, 2022. Respondent sent an email to the Center on August 11, 2022, but did not submit a formal response. On September 5, 2022, the Center informed the Parties that it will proceed to panel appointment.

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<sup>1</sup> The original Complaint identified a privacy service as Respondent. After Registrar verified the underlying customer data, the Complaint was amended to add the name of the underlying registrant, whom the Panel understands to be the proper Respondent.

The Center appointed Robert A. Badgley as the sole panelist in this matter on September 12, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### **4. Factual Background**

Complainant is a large pharmaceutical firm, and has manufactured and marketed numerous well-known pharmaceutical drugs. Complainant holds numerous trademark registrations in various jurisdictions for the mark GILEAD in connection with pharmaceutical preparations, including China Reg. No. 816124 (registered February 21, 1996), European Union Reg. No. 3913167 (registered November 7, 2005), and United States Reg. No. 3,251,595 (registered on June 12, 2007).

Annexed to the Complaint are numerous articles and other documents demonstrating Complainant's use of its GILEAD mark and the renown the mark enjoys. At least one prior panel in a UDRP case has recognized that GILEAD is a "famous registered trademark." *Gilead Sciences, Inc. v. Super Privacy Service LTD / Kolawole Feyisitan*, WIPO Case No. [D2020-3517](#) (transferring <gileadafrica.com>).

Complainant's main website is located via the domain name <gilead.com>, a domain name it has owned since 1995 and used since 1997 as its commercial website.

The Domain Name was registered on July 30, 2022. It currently does not resolve to an active website. As of August 5, 2022, the web page to which the Domain Name resolved stated in full:

"2022 Copyright. All Rights Reserved.

The Sponsored Listings displayed above are served automatically by a third party. Neither

Parkingcrew nor the domain owner maintain any relationship with the advertisers.

Privacy Policy"

The screenshot with the foregoing text, which was annexed to the Complaint, does not show the "sponsored listings" that may have displayed at Respondent's site.

On August 11, 2022, Respondent sent an email to the Center, which email states in full:

"We are not sure what this dispute is about, although we have secured a proper legal representation, but we are not still clear what this is about. We don't see any intellectual property here with the name."

"Gilead: is a location referenced in the Bible 92 times, first was Gen 31:21-22. Gilead is both a tribe of people as it is a land. Our idea specifically came from Jeremiah 8:22 'is there no Balm in Gilead', redirecting the people to seek Jesus who will heal them."

"Health: As far as we know, I am not aware the word "health" is a registered property of any individual or group. Finally, the domain was available when we purchased it and using names that is not personalized for anyone, we [are] still not sure how this is being contested. Kindly shed some light on this."

#### **5. Parties' Contentions**

##### **A. Complainant**

Complainant contends that it has established all three elements required under the Policy for a transfer of the Domain Name.

## B. Respondent

Apart from Respondent's email communication as described under section 4. above, Respondent did not formally reply to Complainant's contentions.

## 6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

### A. Identical or Confusingly Similar

The Panel concludes that Complainant has rights in the trademark GILEAD through registration and use demonstrated in the record. The Panel also concludes that the Domain Name is confusingly similar to that mark. The GILEAD mark is clearly recognizable within the Domain Name, and the additional word "health" does not prevent a finding of confusing similarity between the mark and the Domain Name.

Complainant has established Policy paragraph 4(a)(i).

### B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services; or
- (ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] are making a legitimate noncommercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel concludes that Respondent lacks rights or legitimate interests in connection with the Domain Name. The explanation – if that be the *mot juste* – offered by Respondent does nothing to elucidate Respondent's motives vis-à-vis the Domain Name. On the undisputed record here, there is a well-known and established trademark, GILEAD, added to the descriptive word "health" – a word closely associated with any pharmaceutical firm, and no viable assertion, much less evidence, of an actual legitimate motive. In these circumstances, the Panel concludes that Respondent has no rights or legitimate interests in respect of the Domain Name. Indeed, given the additional word "health," the Panel must conclude that Respondent more likely than not was targeting Complainant and its trademark when registering the Domain Name.

Complainant has established Policy paragraph 4(a)(ii).

### C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, “in particular but without limitation,” are evidence of the registration and use of the Domain Name in “bad faith”:

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or
- (ii) that Respondent has registered the Domain Name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location.

The Panel concludes that Respondent registered and used the Domain Name in bad faith under the Policy. The Panel incorporates its discussion above in the “Rights or Legitimate Interests” section. Again, the use of the word “health” in the Domain Name yields the finding, on a balance of probabilities and on the record here, that Respondent had Complainant’s well-known GILEAD mark in mind when registering the Domain Name.

With respect to bad faith use, the Panel finds that Complainant’s GILEAD mark is sufficiently well established and known, that Respondent’s non-use, or “passive holding,” of the Domain Name qualifies as bad faith use under the principle first set forth in *Telstra Corp. v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). In a word, the Panel cannot conceive of any realistic reason, other than a bad faith reason, why Respondent would have registered this Domain Name, which contains a well-known global trademark plus a descriptive word closely associated with that trademark.

Complainant has established Policy paragraph 4(a)(iii).

### 7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name <gileadhealth.org> be transferred to Complainant.

*/Robert A. Badgley/*

**Robert A. Badgley**

Sole Panelist

Date: September 23, 2022