

ADMINISTRATIVE PANEL DECISION

Gilead Sciences, Inc. v. Domain Administrator
Case No. D2023-1451

1. The Parties

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

The Respondent is Domain Administrator, Nigeria.

2. The Domain Name and Registrar

The disputed domain name <gileadadvanceaccess.com> is registered with Sav.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 4, 2023. On April 4, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 4, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Privacyprotection.Com, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 5, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on April 20, 2023.

The Center verified that the Complaint together with the amended 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 the Respondent of the Complaint, and the proceedings commenced on April 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 11, 2023. Apart from what seems to be “auto” messages received stating “Our office is closed for a short time while we are on holiday. We will get back to you as soon as we can but there could be a delay. Please be patient with us” no formal Response was filed with the Center. The Center appointed Zoltán Takács as the sole panelist in this matter on June 15, 2023. 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

The Complainant, founded in 1987 in Foster City, California is one of the largest biopharmaceutical companies in the world, employing approximately 20,000 people worldwide.

The Complainant is regularly listed in the Fortune 500 Companies rankings and is a member of the Standard and Poor's (S&P) 500 stock market index tracking.

Since 2004, the Complainant operates in the United States a free medication program called Gilead Advancing Access.

The Complainant is among others owner of the:

- United States Trademark Registration No. 3251595 for the word mark GILEAD, registered since June 12, 2007 for various pharmaceutical preparations and antivirals, antifungals and preparations for the treatment of infectious conditions in Class 5;
- United States Trademark Registration No. 3265504 for the word mark ADVANCING ACCESS, registered since July 17, 2007 for counseling and charitable services for patients in Class 44 .

The Complainant is among others owner of the domain name <gilead.com>, which was registered on May 27, 1995, and resolves to its corporate website.

The disputed domain name was registered on July 6, 2022, and was resolving to a website that contained various pharmaceutical related pay-per-click (PPC) links.

Currently the disputed domain name resolves to a blank webpage displaying a security message, warning that the connection with the website is not safe or that it is dangerous.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to its GILEAD trademark because it incorporates the entirety of its trademark with the addition of the terms "advance" and "access".

The Complainant alleges that the Respondent has no rights or legitimate interests in respect of the disputed domain name and is unable to rely on any of the circumstances set out in paragraphs 4(c)(i), (ii), or (iii) of the Policy.

The Complainant contends that the Respondent has registered and used the disputed domain name in bad faith. Due to the wellknown status of its GILEAD trademark it is implausible that the Respondent was not aware of its trademark at the time of registration of the disputed domain name, which than it afterwards used for its own commercial benefit with diverting Internet users to various pharmaceutical related PPC links.

The Complainant requests that the disputed domain name be transferred from the Respondent to the Complainant.

B. Respondent

The Respondent did not reply to the Complainant's contentions. Apart from what seems to be "auto" messages received by the Center stating "Our office is closed for a short time while we are on holiday. We will get back to you as soon as we can but there could be delay. Please be patient with us", no formal response was filed with the Center.

6. Discussion and Findings

Paragraph 15(a) of the Rules requires that the Panel's decision be made "on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

A complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the complaint, namely that;

- (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.

A. Identical or Confusingly Similar

Under paragraph 4(a)(i) of the Policy, there are two requirements which the Complainant must establish, first that it has rights in a trademark or service mark, and second that the disputed domain name is identical or confusingly similar to the trademark or service mark.

It has been a consensus view among UDRP panels that if the complainant owns a nationally or regionally registered trademark, then it generally satisfies the threshold requirement of having trademark rights.

The Complainant produced evidence of having registered rights in the GILEAD trademark by virtue of the United States Trademark Registration No. 3251595 listed above, which satisfies the requirement of having trademark rights for the purpose of the Policy.

Having determined the presence of the Complainant's trademark rights, the Panel next assesses whether the disputed domain name is identical or confusingly similar to the Complainant's trademark.

According to section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") the standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name.

The disputed domain name fully incorporates the Complainant's GILEAD trademark, which is evidently recognizable in the disputed domain name.

According to section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the 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 addition of the terms "advance" and "access" to the Complainant's trademark in the disputed domain name does not prevent a finding of confusing similarity.

According to section 1.11.1 of the [WIPO Overview 3.0](#), the applicable Top-Level Domain ("TLD") in a domain name (in this case ".com") is viewed as a standard registration requirement and as such is generally disregarded under the first element confusingly similar test.

The Panel finds that the disputed domain name is therefore confusingly similar to the Complainant's trademark and that the first ground of the Policy is established

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, a respondent may demonstrate its rights or legitimate interests in a domain name by showing any of the following circumstances, in particular but without limitation:

- (i) before any notice of the dispute, its use of, or demonstrable preparation to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods and services;
- (ii) it has been commonly known by the domain name;
- (iii) it is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue.

According to section 2.1 of the [WIPO Overview 3.0](#), while the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent.

As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with the relevant evidence demonstrating its rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

In the present case, the Complainant has submitted sufficient and uncontested evidence that it holds well-established prior rights in the GILEAD trademark.

The Complainant has not authorized the Respondent to use its trademark, in a domain name, or otherwise.

There is no evidence that the Respondent is commonly known by the disputed domain name.

The website to which the disputed domain name resolved featured PPC links of contents in competition with the Complainant’s business. According to section 2.9 of the [WIPO Overview 3.0](#), “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”.

In addition, the inherently misleading nature of the disputed domain name, consisting of the Complainant’s GILEAD trademark and the terms almost identical to the Complainant’s ADVANCING ACCESS trademark and its program under that name carries a risk of implied affiliation (see section 2.5.1 of the [WIPO Overview 3.0](#)).

The Respondent failed to respond, and by doing so failed to offer the Panel any type of evidence set forth in paragraph 4(c) of the Policy, or otherwise counter to the Complainant’s *prima facie* case and the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name in accordance with paragraph 4(a)(ii) of the Policy

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists a number of factors which, if found by the panel to be present, shall be evidence of registration and use of a domain name in bad faith. This non-exclusive list includes:

- (i) circumstances indicating that you have registered or you have acquired the domain name 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 your documented out-of-pocket costs directly related to the domain name; or

- (ii) you have 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 you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.

It has been well-established in prior decisions under the UDRP, with which the Panel agrees, that the Complainant's GILEAD trademark is well-known (see *Gilead Sciences, Inc. v. WhoisGuard Protected, WhoisGuard, Inc./Krug Jr Robert John*, WIPO Case No. [D2020-2662](#)).

According to section 3.1.4 of the [WIPO Overview 3.0](#), UDRP 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".

The Respondent's replication of the Complainant's well-known trademark in the disputed domain name and the addition of the terms "advance" and "access" that almost match the name of the Complainant's "Advancing Access" program in view of the Panel demonstrate that the Respondent registered the disputed domain name in order to target the Complainant and its trademark.

The Respondent's previous use of the disputed domain name for a parking web page showing sponsored third party listings of goods and services in competition with the Complainant is in view of the Panel evidence of the Respondent's intent to unlawfully capitalize on the Complainant's trademark and business.

Further to the Respondent's lack of any rights to or legitimate interests in the disputed domain name, the above discussed facts convince the Panel that the Respondent has intentionally attempted to attract, for commercial gain Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of such site or the services advertised on such site, within the meaning of paragraph 4(b)(iv) of the Policy.

As mentioned above, at the time of rendering of this administrative decision the disputed domain name was resolving to a blank webpage displaying a security message, warning that the connection with the website is not safe or that it is dangerous.

According to section 3.3 of the [WIPO Overview 3.0](#), from inception of the UDRP, panels have found that non-use of a domain name does not prevent a finding of bad faith under the doctrine of passive holding.

The Respondent chose not to respond to the Complaint and rebut the Complainant's credible assertions and evidence, which the Panel accepts and finds that the disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(a)(iii) of the Policy.

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 disputed domain name <gileadadvanceaccess.com> be transferred to the Complainant.

/Zoltán Takács/

Zoltán Takács

Sole Panelist

Date: June 22, 2023