

ADMINISTRATIVE PANEL DECISION

Viatrix Specialty LLC, Inc. v. lianjiao xie
Case No. D2023-4314

1. The Parties

The Complainant is Viatrix Specialty LLC, Inc., United States of America (“U.S.”), represented by The Webb Law Firm, U.S.

The Respondent is lianjiao xie, China.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 17, 2023. On October 18, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 18, 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 (PrivacyGuardian.org, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 20, 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 amendment to the Complaint on October 20, 2023.

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 the Respondent of the Complaint, and the proceedings commenced on October 23, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 12, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 16, 2023.

The Center appointed Francine Tan as the sole panelist in this matter on November 17, 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 is a global generics and specialty pharmaceuticals healthcare company. The Complainant states that it has acquired a controlling interest in a number of top-producing active pharmaceutical companies for generic drugs. It also develops and produces medicines for a wide range of medical disciplines.

The Complainant is the registered owner of the VIAGRA and VIAGRA-formative trade marks in many jurisdictions including in Taiwan (Province of China). Its trade mark registrations include the following:

- U.S. registration No. 2,162,548 for VIAGRA, registered on June 2, 1998;
- European Union registration No. 012547402 for VIAGRA, registered on July 7, 2015;
- Canadian registration No. TMA506911 for VIAGRA, registered on April 13, 1999; and
- Canadian registration No. TMA1087683 for VIAGRA CONNECT, registered on November 16, 2020; and

The disputed domain name was registered on July 8, 2023. At the time of the filing of the Complaint, the disputed domain name resolved to an inactive website.

5. Parties' Contentions

A. Complainant

The disputed domain name is identical or confusingly similar to the Complainant's VIAGRA trade mark in which it has rights. The disputed domain name incorporates the Complainant's VIAGRA trade mark. The word "viagra" is the dominant portion of the disputed domain name. The addition of the term "taiwan" does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's VIAGRA trade mark.

The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services. The disputed domain name resolves to an inactive page.

The disputed domain name was registered and is being used in bad faith. The disputed domain name resolves to an inactive webpage which shows that the Respondent is squatting on the disputed domain name to disrupt the Complainant's business. The Complainant's VIAGRA trade marks were registered long before the Respondent registered the disputed domain name. The Respondent had actual or constructive knowledge of the Complainant's VIAGRA marks when he registered the disputed domain name.

B. Respondent

The Respondent did not file a Response.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has established it has rights in the VIAGRA trade mark. The disputed domain name wholly incorporates the VIAGRA trade mark, with the addition of the word "taiwan". UDRP panels have held that where the relevant trade mark is recognizable within the domain name in dispute, the addition or omission of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), sections 1.7 and 1.8.)

The Panel finds in this case that the Complainant's VIAGRA trade mark is recognizable within the disputed domain name. The addition of the word "taiwan" does not serve to prevent a finding of confusing similarity with the Complainant's VIAGRA trade mark.

The Panel accordingly finds that the first element of paragraph 4(a) of the Policy has been satisfied.

B. Rights or Legitimate Interests

The Panel finds that the Complainant has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant's registrations of the VIAGRA trade marks predate the registration date of the disputed domain name by many years. The VIAGRA trade mark is well established and there is no evidence that the Respondent is commonly known by the disputed domain name.

The disputed domain name resolves to an inactive webpage. There is no evidence showing that the Respondent is using or has made demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services, or that he is making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain.

The Panel also finds that the disputed domain name which incorporates the Complainant's VIAGRA trade mark carries a risk that the disputed domain name would be perceived by Internet users to be affiliated with the legitimate holder of the trade mark, i.e. the Complainant. Where a domain name consists of a trade mark, such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the legitimate trade mark owner.

Having established a *prima facie* case, the burden of production shifts to the Respondent to show that he has rights or legitimate interests in the disputed domain name. The Respondent did not file any response to rebut the Complainant's assertions and evidence. The Panel therefore concludes that the Respondent has no rights or legitimate interests in the disputed domain name.

The Panel therefore finds that the second element of paragraph 4(a) of the Policy has been satisfied.

C. Registered and Used in Bad Faith

The Panel is persuaded that the Respondent targeted the Complainant and its well-known VIAGRA trade mark and finds this to be a straightforward case of cybersquatting. There is no other reason for the Respondent to have registered the disputed domain name except for the sole purpose of riding off the reputation and goodwill in the Complainant's VIAGRA trade mark and to create confusion with the Complainant's VIAGRA trade mark and business:

"If [...] circumstances indicate that the respondent's intent in registering the disputed domain name was in fact to profit in some fashion from or otherwise exploit the complainant's trademark, panels will find bad faith on the part of the respondent. While panel assessment remains fact-specific, generally speaking such circumstances, alone or together, include: (i) the respondent's likely knowledge of the complainant's rights, (ii) the distinctiveness of the complainant's mark, ... (vii) failure of a respondent to present a credible evidence-backed rationale for registering the domain name, [...]." (Section 3.1.1, [WIPO Overview 3.0.](#))

Additionally, UDRP panels have found that the mere registration of a domain name that is confusingly similar to a famous or widely known trade mark by an unaffiliated party can by itself create a presumption of bad faith. (Section 3.1.4, [WIPO Overview 3.0.](#))

The Respondent registered the disputed domain name long after the VIAGRA trade mark was registered. Given the fame and distinctiveness of the Complainant's VIAGRA trade mark, it is highly unlikely that the Respondent did not know of the Complainant and its trade mark prior to the registration of the disputed domain name.

“Noting the near instantaneous and global reach of the Internet and search engines, and particularly in circumstances where the complainant’s mark is widely known ... or highly specific and a respondent cannot credibly claim to have been unaware of the mark, ... panels have been prepared to infer that the respondent knew, or have found that the respondent should have known, that its registration would be identical or confusingly similar to a complainant’s mark”. (Section 3.2.2, [WIPO Overview 3.0](#).)

As to the fact that the disputed domain name has been passively held by the Respondent, UDRP panels have found that the non-use of a domain name, including a blank page, would not prevent a finding of bad faith. Considering the factors in this case, namely (i) the distinctiveness and reputation of the Complainant’s VIAGRA mark, (ii) the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good faith use, (iii) the Respondent concealing his identity, and (iv) the implausibility of any good faith use to which the disputed domain name may be put, the Panel does not find the non-use of the disputed domain name to prevent a finding of bad faith registration and use. (See [WIPO Overview 3.0](#), Section 3.3.)

The Panel therefore finds that the third element of paragraph 4(a) of the Policy has been satisfied.

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 <viagrataiwan.com> be transferred to the Complainant.

/Francine Tan/

Francine Tan

Sole Panelist

Date: December 1, 2023