

## **ADMINISTRATIVE PANEL DECISION**

**Astellas Pharma Inc. v. Sumit Biswas / Astellaz Pharmaceuticals**

**Case No. D2023-3327**

### **1. The Parties**

The Complainant is Astellas Pharma Inc., Japan, represented by Baker & McKenzie, United Kingdom.

The Respondent is Sumit Biswas, India and Astellaz Pharmaceuticals, India.

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

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

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 2, 2023. Also on August 2, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 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 (Astellaz Pharmaceuticals) and contact information in the Complaint.

The Center sent an email communication to the Complainant on August 9, 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 August 14, 2023.

The Center verified that the Complaint [together with the amendment to the Complaint/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 August 15, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 4, 2023. The Response was filed with the Center September 4, 2023.

The Center appointed Warwick A. Rothnie, Steven A. Maier, and Shwetasree Majumder as panelists in this matter on October 12, 2023. The Panel finds that it was properly constituted. Each member of 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 multinational pharmaceutical company originally formed in Japan on April 1, 2005 on the merger of two long established Japanese pharmaceutical companies.

Since its formation, the Complainant's business has expanded into the United States of America, Europe, the Middle East and Africa, South East Asia, and South Asia. According to the Complaint, the Complainant conducts business under its name and trademark, ASTELLAS, in more than 70 countries around the world; has 16 Research and Development bases, eight manufacturing bases, and a total workforce of over 14,000 personnel. The Complainant has also established subsidiaries in various jurisdictions including China, Taiwan, Republic of Korea, the Philippines, Thailand, Indonesia, India, Australia, and Singapore.

The Complainant uses the domain name <astellas.com>, which was registered on its behalf on May 14, 2004, for the purpose of hosting its main website. This website had over 179,000 visitors in June / July 2023 according to figures collated by "Similarweb".

For the financial year ending on March 31, 2022, the Complainant's group had total sales revenue of 1,296.2 billion Yen (or approximately USD 9.269 billion).

The Complainant has been recognized with a number of awards, including:

- (a) Perfect Equality Score on the Human Rights Campaign Foundation's annual Corporate Equality Index;
- (b) Silver Winner of "Company of the Year" in the Pharmaceutical and Biotech industries at the PM360 Trailblazer Awards ceremony;
- (c) 100 Best Companies in the US across all industries;
- (d) Top Companies for Working Parents; and
- (e) Forbes Best Midsize Employers List for four consecutive years.

The Complainant has registered ASTELLAS as a trademark in many countries around the world. For present purposes, it is sufficient to record that the Complainant is the owner of Indian Registered Trademark No 1319069 for the word mark ASTELLAS, which was filed on November 4, 2004, and formally entered on the Register in 2007, in respect of a wide range of pharmaceutical and medical products in International Class 5. The Complainant is also the owner of International Registration No. 1236280, ASTELLAS, (which has been granted in India) and which was registered on August 8, 2014 in respect of a range of goods and services in International Classes 1, 3, 5, 10, and 44.

The disputed domain name was registered on January 3, 2023.

The disputed domain name resolves to a website which appears to promote pharmaceutical products, as well as the business of Astellaz Pharmaceuticals which, according to the website, "aims to work towards human welfare by manufacturing and delivering innovative products for their health and wellness".

The website also identifies the first named Respondent as one of the three founding "team".

On May 5, 2022, the second named Respondent applied to register Indian Trademark Application No. 5436334, in respect of trading in medicine as included in International Class 35. On December 6, 2022, the Complainant filed a notice of opposition to the registration of this trademark. The second named Respondent has submitted a counter-opposition statement in answer.

## **5. Discussion and Findings**

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (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.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint 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. The Respondent**

The Complaint was filed naming the second named Respondent. The Registrar has confirmed, however, that the registrant at the date the Complaint was filed is the first named Respondent.

The Complainant has filed an Amended Complaint identifying the first named Respondent. However, the Complainant maintains that the true Respondent is the second named Respondent. As noted above, the disputed domain name resolves to a website which appears to promote the business of the second named Respondent. The website also identifies the first named Respondent as one of the founding “team”. The Response was filed in the name of Astellaz Pharmaceuticals.

The Panel notes that its search of public company registers in India did not disclose any company incorporated under the second named Respondent’s name. However, the second named Respondent appears to be a partnership and the first named Respondent one of its partners.

One possibility therefore is that the first named Respondent registered the disputed domain name in his capacity as a partner and on behalf of the partnership. While that seems the likely arrangement, it is not the only possibility.

In these circumstances, therefore, the Panel considers it appropriate to proceed on the basis that both are properly named as Respondents. Notice of the Complaint has been given to both and, as already noted, the Response has been received from the second named Respondent. Unless it becomes necessary to distinguish between them, this decision will refer simply to the Respondent for ease of reference.

### **B. Identical or Confusingly Similar**

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant’s trademark rights.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark at the date the Complaint was filed and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

The Complainant has proven ownership of the registered trademarks for ASTELLAS identified in section 4 above.

The second stage of this inquiry simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of “likelihood of confusion” under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties, the date they were acquired, and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this

stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See *e.g.*, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([WIPO Overview 3.0](#)), section 1.7.

In undertaking that comparison, it is permissible in the present circumstances to disregard the generic Top Level Domain (“gTLD”) component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

Disregarding the “.com” gTLD, the disputed domain name consists of the Complainant’s registered trademark with a “z” substituted for the “s”. The Respondent contends that “It’s totally different spelling” and “In our company ASTELLAZ, the ‘Z’ is the 26th alphabet in English language and in ASTELLAS, the ‘S’ is the 19th alphabet in English language, which is totally different. If anyone mistakes the typing, it will be the typing person’s mistake”).

This kind of misspelling of the Complainant’s trademark, however, is insufficient to avoid a finding of confusing similarity as the test is based on the placement of letters on the QWERTY keyboard and not on the sequence in which the letters appear in the alphabet. (See *e.g.*, [WIPO Overview 3.0](#), section 1.9, particularly bearing in mind that the letter “s” and the letter “z” are diagonally adjacent on the standard QWERTY keyboard). In any event and apart from anything else, the Complainant’s trademark and the Respondent’s name sound the same and the Complainant’s trademark remains visually and aurally recognisable within the disputed domain name.

Accordingly, the Panel finds that the Complainant has established that the disputed domain name is confusingly similar to the Complainant’s trademark, and the requirement under the first limb of the Policy is satisfied.

### **C. Rights or Legitimate Interests**

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

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

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

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 relevant evidence demonstrating 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. [WIPO Overview 3.0](#), section 2.1.

The Respondent registered the disputed domain name well after the Complainant began using its trademark, and also after the Complainant had registered its trademark.

The Complainant states that it has not authorised the Respondent to use the disputed domain name. Nor is the Respondent affiliated with it.

The Respondent relies on its filing of the Indian Trademark Application and its name. The Respondent points out it has filed a counter-opposition statement to the Complainant's opposition. It further contends that the substitution of the "z" for the "s" means the two signs are totally different.

As already noted in section 5B above, the Panel does not agree the disputed domain name, or the Respondent's trademark, are not confusingly similar to the Complainant's trademark. "Astellaz" is plainly the dominant, or at least an important, distinctive feature of the Respondent's trademark application. Aurally, the term "Astellaz" is likely to sound exactly the same as the Complainant's trademark. The two are also visually very similar.

Under the Policy, panels have recognized that even a registered trademark corresponding to a disputed domain name does not automatically confer rights or legitimate interests under the Policy. See *e.g.*, [WIPO Overview 3.0](#), section 2.12 and cases cited therein. In the present case, the Respondent has a pending, opposed application only. While the application designates a class not directly covered by the Complainant's registrations, nor does it cover the manufacturing and research services the Respondent's website claims is the Respondent's business, and which directly conflict with the Complainant's registered rights.

Next, the second named Respondent's name has been adopted many years after the Complainant began using its name and trademark. The term "Astellas" is a coined or invented term and is not directly descriptive of the goods or services in issue. ASTELLAS appears to have significance and meaning in relation to such products by reason only of its adoption and use by the Complainant.

Further, it appears that the Complainant has been using its trademark on a very substantial scale. The Panel considers it is very likely that someone proposing to enter the field of pharmaceutical and medical products and services in 2022 or 2024, particularly the manufacture and sale of such products, would be aware of the Complainant's adoption, and use of the Complainant's name and trademark.

Further still, and while the Panel is cognizant that in some cases where there is a pending/opposed trademark application the case may be considered better resolved in another forum, the Respondent has not sought to explain how its name came to be adopted in the face of the Complainant's trademark.

The inherent distinctiveness of the term ASTELLAS and its long and extensive use by the Complainant, therefore, leads to a strong inference that the Respondent adopted its name and the disputed domain name to take advantage of their confusing resemblance to the Complainant's trademark. In such circumstances, the Panel finds that the Respondent cannot rely on paragraph 4(c)(ii) of the Policy.

Furthermore, it is well established that using a disputed domain name confusingly similar to a Complainant's trademark in connection with unauthorised goods and services does not qualify as a good faith offering of goods and services for the purposes of paragraph 4(c)(i) of the Policy. That is particularly so where the goods and services appear to be those for which the Complainant's trademark is registered.

Accordingly, the Panel finds that the Complainant has established a *prima facie* case under the Policy that the Respondent has no rights or legitimate interests in the disputed domain name and the Respondent has not rebutted that *prima facie* case. Therefore, the Panel finds the Complainant has established the second requirement under the Policy also.

#### **D. Registered and Used in Bad Faith**

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent. These are conjunctive requirements; both must be satisfied for a successful complaint: see *e.g.*, *Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd*, WIPO Case No. [D2010-0470](#).

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by (usually) the complainant.

For the reasons discussed in section 5C above, the Panel considers it very likely the Respondent knew of the Complainant's name and trademark when the Respondent (a) adopted its name and (b) registered the disputed domain name.

In short, the Complainant's trademark is an invented or coined term and not descriptive. The disputed domain name is confusingly similar to the Complainant's trademark and, further, the Respondent uses its name and the disputed domain name in connection with pharmaceutical products and services like the Complainant.

In the absence of a convincing explanation from the Respondent about how its confusingly similar name came to be adopted in connection with pharmaceutical goods and services, therefore, the Panel infers that the Respondent adopted its name and the disputed domain name to take advantage of their resemblance to the Complainant's trademark. Accordingly, the Panel finds that the Respondent registered the disputed domain name in bad faith.

Further, the manner of use – apparently in connection with the pharmaceutical goods and services falling within the scope of the Complainant's trademark – constitutes use in bad faith under the Policy.

Accordingly, the Complainant has established all three requirements under the Policy.

#### **6. 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, <astellaz.com>, be transferred to the Complainant.

*/Warwick A. Rothnie/*

**Warwick A. Rothnie**

Presiding Panelist

*/Steven A. Maier/*

**Steven A. Maier**

Panelist

*/Shwetasree Majumder/*

**Shwetasree Majumder**

Panelist

Date: October 26, 2023