

ADMINISTRATIVE PANEL DECISION

Actavis Group PTC ehf and Actavis Holdco U.S., Inc. v. Whois Privacy, Private by Design LLC / Paul Kemp, Mainline Information Systems, Inc.
Case No. D2022-0990

1. The Parties

The Complainants are Actavis Group PTC ehf, Iceland, and Actavis Holdco U.S., Inc., United States of America (“United States”), represented by SILKA AB, Sweden.

The Respondent is Whois Privacy, Private by Design LLC, United States / Paul Kemp, Mainline Information Systems, Inc., United States.

2. The Domain Names and Registrar

The disputed domain names <actaviis.com> and <actaviscompany.com> (the “Domain Names”) are registered with Porkbun LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 23, 2022. On March 23, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On March 24, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Names that differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on March 27, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to amend the Complaint. The Complainant filed an amendment to the Complaint on March 28, 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 the Respondent of the Complaint, and the proceedings commenced on April 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 1, 2022. The Respondent did not submit a response. Accordingly, the Center notified the Respondent’s default on May 3, 2022.

The Center appointed A. Justin Ourso III as the sole panelist in this matter on May 19, 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

The Complainants, an Iceland company and an American corporation that are subsidiaries of Teva Pharmaceutical Industries Ltd, a global pharmaceutical company, acquire, develop, manufacture, and market branded and generic pharmaceuticals, over-the-counter drugs, and other products, with a global commercial presence in approximately 100 countries.

The Complainants are joint owners of the trademark ACTAVIS. Among other registrations, the Iceland company owns a trademark registration issued in Iceland on November 28, 2003, No. 963/2003, for its mark ACTAVIS in Class 5 for pharmaceutical preparations and other goods, and the American corporation owns a United States trademark registration issued on September 7, 2010, No. 3,845,070, for its mark ACTAVIS (fig.) in Class 5 for generic pharmaceuticals. They have been co-complainants in at least four other UDRP cases.

The American Complainant owns the domain name <actavis.com>, created on September 3, 2002, and the Complainants or an affiliate own numerous other domain names incorporating their mark ACTAVIS. The Complainants have a substantial Internet presence through their domain names and web sites.

The Respondent registered both Domain Names on February 3, 2022, approximately an hour apart, using a privacy service, long after the Complainants had obtained numerous trademark registrations and numerous domain names incorporating their mark. At the filing of the Complaint, the Domain Names did not resolve to a functioning web site.

5. Parties' Contentions

A. Complainant

In addition to facts set forth in the Factual Background in Part 4 above, the Complainants contend the following. Regarding the element of confusing similarity with a mark in which they have rights, that they own trademark rights in the mark ACTAVIS; their trademark is recognizable within the Domain Names, which consist in one case of the mark with the addition of a single letter "i," an intentional misspelling, and, in the other case, of the mark with the addition of the word "company," which does not avoid confusing similarity; and the generic Top-Level Domain ("gTLD") does not differentiate the Domain Names from the mark.

Regarding the element of rights or legitimate interests in the Domain Names, the Complainants contend that their trademark was well known globally for many years (prior to the registrations of the Domain Names); the trademark ACTAVIS is distinctive and the Domain Names are not descriptive; the registration of the Domain Names is cyber-squatting; they have not licensed, or otherwise authorized the Respondent to use their mark; the only conceivable use of the Domain Names was to create an impression of an association with them; the Respondent is passively holding the Domain Names without using them; no evidence exists, including the Respondent's Whols information, that the Respondent is known by the Domain Names; and the sole purpose for registering the Domain Names was to take undue advantage of their trademark's reputation.

Regarding the element of bad faith registration and use of the Domain Names, the Complainants contend that their mark is distinctive, has been used exclusively by them since 2003, and is well-known worldwide; the Respondent registered the Domain Names with knowledge of the mark; the mere registration of domain names identical to or confusingly similar (particularly comprising a typo or incorporating the mark plus a term) to a well-known trademark creates a presumption of bad faith; even a preliminary search would have

disclosed their use of the ACTAVIS brand and the apparent failure to search was willful blindness; registration of the Domain Names with actual or constructive knowledge of the mark constitutes bad faith; the registration of both Domain Names an hour apart is evidence of a pattern of conduct; the Respondent concealed its identity and used false contact details, supporting an inference of bad faith; any good faith use seems implausible; the passive holding doctrine applies; and the circumstances dictate a finding of opportunistic bad faith.

The Complainants requested transfer of the Domain Names to the “Complainant.”

B. Respondent

The Respondent did not submit a response.

6. Discussion and Findings

A. Multiple Complainants

Two Complainants filed the Complaint. In assessing the propriety of multiple complainants filing against a single respondent, panels examine whether the complainants have a common grievance or whether common conduct by the respondent affected the complainants similarly. Rules, paragraph 10(e); WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), sections 1.4.2 and 4.11.1. The Panel finds that the Complainants are related companies that jointly own the affected trademark. Accordingly, the Panel concludes that the consolidation of the two Complainants in this proceeding is proper.

B. Multiple Domain Names

The Complainants initiated this proceeding against the Respondent for the registration and use of two Domain Names and have requested the transfer of both Domain Names to the “Complainant.” A complaint may relate to more than one domain name, provided that the same person registered the domain names. Rules, paragraph 3(c); [WIPO Overview 3.0](#), section 4.11.1. The Panel finds that the Respondent registered both Domain Names that are the subject of the Complaint, and concludes that the inclusion of both Domain Names in this proceeding is proper.

C. The Effect of the Respondent’s Default

If a respondent does not submit a response to a complaint, a panel decides the dispute based upon the complaint. Rules, paragraphs 5(f) and 14(a). A complainant has the burden of proof, Policy, paragraph 4(a), and must still prove the elements of a claim to obtain the requested relief, notwithstanding a respondent’s default. [WIPO Overview 3.0](#), section 4.3. In the absence of exceptional circumstances, a respondent’s failure to respond to a complaint requires that a panel draw the inferences from this failure that it considers proper. Rules, paragraph 14(b).

The Panel finds that no exceptional circumstances exist for the failure of the Respondent to submit a response. Accordingly, the Panel infers that the Respondent does not deny the facts alleged and the contentions urged by the Complainants based upon these facts, and will draw all reasonable inferences that are proper from the evidence and the facts found by the Panel. *Id.*

Although the Panel may draw negative inferences from the Respondent’s default, the Complainants may not rely on conclusory allegations and must support their allegations with evidence to prove the three elements. [WIPO Overview 3.0](#), section 4.3.

D. Elements of a Claim

A complainant must prove three elements to obtain relief: (i) the domain name is identical or confusingly

similar to a trademark in which the complainant has rights; (ii) the respondent has no rights or legitimate interests in the domain name; and (iii) the respondent registered and is using the domain name in bad faith. Policy, paragraph 4(a).

(i) Identical or Confusingly Similar

On the first element, the Complainants must prove that (1) they have rights in a trademark and (2) the Domain Names are identical or confusingly similar to this trademark. Policy, paragraph 4(a)(i).

The Panel finds that the Complainants' Iceland and United States trademark registrations establish their trademark rights in their ACTAVIS mark. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds that the Domain Names are confusingly similar to the Complainants' ACTAVIS trademark. The trademark is easily recognizable within each of the Domain Names. One of the Domain Names incorporates the entire trademark, with the addition of a single letter "i" immediately after the existing letter "i." This additional letter is easily overlooked and likely to be a common typo when typing the mark in a search engine or browser. [WIPO Overview 3.0](#), section 1.9. The other of the Domain Names incorporates the entire trademark exactly and adds the word "company." The addition of the word "company" after the trademark does not prevent a finding of confusing similarity. [WIPO Overview 3.0](#), section 1.8. Lastly, unless it contributes to confusing similarity, panels disregard the gTLD in determining confusing similarity. [WIPO Overview 3.0](#), section 1.11.

Accordingly, the Panel concludes that the Complainants have proven the first element, namely, that the Domain Names are confusingly similar to a trademark in which they have rights.

(ii) Rights or Legitimate Interests

The Policy provides a non-exclusive list of circumstances that, if a panel finds proved, demonstrates that a respondent has rights to, or legitimate interests in, a domain name for the purposes of paragraph 4(a)(ii) of the Policy: (i) before any notice to a respondent of the dispute, its 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) a respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or (iii) a respondent is 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. Policy, paragraph 4(c).

The Complainants have alleged that they have not authorized the Respondent to use their mark. Because the Respondent has not contested this allegation and the Complainants have certified that the information in the Complaint is complete and accurate, the Panel accepts this allegation as proven. Rules, paragraph 14(b) and 10(d); [WIPO Overview 3.0](#), section 4.3.

Additionally, the Complainants have alleged that the Respondent (1) is not using, and has not made any preparations to use, the Domain Names in connection with a *bona fide* offering of goods or services; or (2) is not commonly known by the Domain Names; and (3) is not making a legitimate noncommercial or fair use of the Domain Names. For the reasons set forth in this paragraph and the preceding paragraph, the Panel finds that the Complainants have shown, *prima facie*, the second element – that the Respondent lacks rights or legitimate interests in the Domain Names.

Where a complainant shows *prima facie* that a respondent lacks rights or legitimate interests, the burden of production on this second element shifts to the respondent to come forward with relevant evidence proving rights or legitimate interests in the domain name. [WIPO Overview 3.0](#), section 2.1. The Respondent here has not submitted any evidence to rebut the *prima facie* showing. Accordingly, the Panel finds that the Complainants have proven that the Respondent has no rights or legitimate interests in the Domain Names, satisfying the second element. *Id.*

Additionally, the Domain Names do not resolve to a functioning web site, thereby providing no evidence of a

bona fide offering of goods or services, or a legitimate noncommercial or fair use of the Domain Name; the Registrar identified the Registrant as “Paul Kemp, Mainline Information Systems, Inc.,” a name that does not resemble the Domain Names; the Respondent used a privacy service; and the email address given for the registration details of the Domain Names has no apparent relation to the name of the Respondent, all of which corroborate that the Respondent is not commonly known by the Domain Names and is not using the Domain Names for a *bona fide* offering of goods or services, or a legitimate noncommercial or fair use.

Accordingly, the Panel concludes that the Complainants have proven the second element, namely, that the Respondent lacks rights or legitimate interests in the Domain Names.

(iii) Registered and Used in Bad Faith

Panels have consistently found that clear typosquatting may support an inference of bad faith registration. Here, one of the Domain Names has a suspicious spelling and the Complainants have alleged that this is an intentional misspelling of the Complainants’ trademark. The Respondent has not explained the selection of this highly unusual Domain Name, which happens to be, visually, virtually identical to the Complainants’ trademark. Panels have found typosquatting, coupled with an absence of rights or legitimate interests, to be a factor tending to show bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Similarly, the nature of the other Domain Name, which incorporates the Complainants’ trademark followed by the word “company,” coupled with an absence of rights or legitimate interests, tends to show bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Because (1) the Respondent has not offered an explanation for selecting either of the Domain Names, and the Panel cannot conceive of a legitimate one; (2) the Respondent registered the two Domain Names approximately one hour apart, tending to show a pattern of conduct; and (3) the trademark incorporated in the Domain Names was well-known, the Panel finds that the Respondent (1) was aware of the Complainants’ trademark when it registered the Domain Names; and (2) chose the Domain Names deliberately.

The Domain Names do not resolve to active web sites, however, UDRP panels have consistently found that non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Here, the Panel finds the following circumstances support a finding of bad faith: (1) the reputation of the Complainants’ trademark, (2) the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good faith use, and (3) the concealment of the Respondent’s identity behind a privacy service. Additionally, the implausibility of any good faith use for the Domain Name supports a finding of bad faith registration and use. [WIPO Overview 3.0](#), section 3.3.

Accordingly, the Panel concludes that the Complainants have proven the third element, namely, that the Respondent registered and has used the Domain Names in bad faith.

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 Names, <actaviis.com> and <actaviscompany.com>, be transferred to the Complainants.

/A. Justin Ourso III/
A. Justin Ourso III
Sole Panelist
Date: June 2, 2022