

ADMINISTRATIVE PANEL DECISION

L. Perrigo Company, Perrigo Pharma International Dac v. Privacy Service
Provided By Withheld for Privacy ehf / The Carr
Case No. D2022-2470

1. The Parties

Complainants are L. Perrigo Company, United States of America (“United States” or “U.S.”) and Perrigo Pharma International Dac, Ireland, internally represented (hereafter collectively “Complainant”).

Respondent is Privacy Service Provided By Withheld for Privacy ehf, Iceland / The Carr, Australia.

2. The Domain Name and Registrar

The disputed domain name <perrigos-uk.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 7, 2022. On July 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 8, 2022, 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 and contact information in the Complaint. The Center sent an email communication to Complainant on July 18, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on July 19, 2022.

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 Respondent of the Complaint, and the proceedings commenced on July 19, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 8, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on August 9, 2022.

The Center appointed Scott R. Austin as the sole panelist in this matter on August 23, 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

Without contest by Respondent, Complainant asserts in its Complaint as amended, and its Annexes attached provide evidence sufficient to support that:

Started in 1887 by Luther Perrigo, the owner of a general store with the idea to package and distribute patented medicines and household items for country stores, Complainants L. Perrigo Company and Perrigo Pharma International DAC are sister companies and for purposes of this proceeding are collectively referred to as Complainant form a part of the Perrigo group of companies (the "Perrigo Group"). Complainant is therefore, part of an international pharmaceutical group specialized in providing branded and private label self-care products, available at retailers, pharmacies and e-commerce outlets in the United States, across Europe and in other major markets operating under the trademark PERRIGO (the "PERRIGO Mark").

Complainant L. Perrigo Company and Perrigo Pharma International DAC collectively own numerous registrations protecting the PERRIGO Mark all over the world, including:

United States Registration No. 1773993, PERRIGO, registered June 1, 1993, for a range of self-care products, including antihistamines, cough syrups, eye care preparations; dietary food supplements; and vitamin and mineral supplements in International Class 5, and claiming a first use date of July 1, 1975;

United States Registration No. 4262523, PERRIGO (stylized), registered December 18, 2012, for a range of products, including topical antibiotic creams and ointments, topical preparations for the treatment of alopecia, and medicated smoking cessation gums and lozenges in International Class 5, and claiming a first use in commerce date of March 12, 2012; and

European Union Registration No. 000176883, PERRIGO, registered on December 16, 1999, covering a range of goods including cough medications; throat sprays and gargles; lozenges; cold medications; nose sprays, flu medications; decongestants; respiratory stimulants; saccharin; salt petre; diet aids and supplements; vitamins and minerals; and food supplements in International Classes 3 and 5.

Australia Registration No. 752559, PERRIGO, registered on January 12, 2018, covering a range of goods in International Classes 3 and 5.

Complainant has also registered domain names that incorporate the PERRIGO Mark used to access and operate its official PERRIGO websites, including <perrigo.com> registered on December 21, 1994, used to access the official global website of the Perrigo Group at "www.perrigo.com", and <perrigouk.co.uk> registered on November 19, 2003, to access its local Perrigo website in the United Kingdom ("UK"), at "www.perrigouk.co.uk" providing information to the public about Complainant's products and services. Complainant Perrigo Pharma International DAC also owns the domain name <perrigo-uk.com> registered on September 5, 2018.

The disputed domain name was registered on February 17, 2022, and pointed to a pay-per-click ("PPC") parking page as of the date of its registration- with links referring to Complainant's field of activity such as "Online pharmacy", "Medicijnen kopen" (Buy medicines) or to competitors such as "Ezketamine Janssen", "Pfizer vacatures" (Pfizer job openings) or "Stelara Janssen", but since the Complaint was filed on July 6, 2022, the disputed domain name no longer points to an active web page.

5. Parties' Contentions

A. Complainant

Complainant contends that the disputed domain name is identical or confusingly similar to Complainant's well-known trademark, that Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered and is being used in bad faith.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

There are no exceptional circumstances within paragraph 5(e) of the Rules to prevent this Panel from determining the present dispute based upon the Complaint as amended, notwithstanding the failure of Respondent to lodge a substantive formal Response in compliance with the Rules. Under paragraph 14 of the Rules, where a party does not comply with any provision of the Rules, the Panel shall "draw such inferences therefrom as it considers appropriate".

Where no substantive Response is filed, however, Complainant must still make out its case in all respects under paragraph 4(a) of the Policy. To succeed, Complainant must demonstrate that all the elements listed in paragraph 4(a) of the Policy have been satisfied. The Panel will address its findings on each of these requirements in more detail below.

The standard of proof under the Policy is often expressed as the "balance of the probabilities" or "preponderance of the evidence" standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true. See, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 4.2.

A. Identical or Confusingly Similar

Ownership of a trademark registration is generally sufficient evidence that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. [WIPO Overview 3.0](#), section 1.2.1. Complainant has demonstrated its rights because it has shown that it is the holder of multiple valid and subsisting trademark registrations for the PERRIGO Mark all over the world. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#).

With Complainant's rights in the PERRIGO Mark established, the remaining question under the first element of the Policy is whether the disputed domain name is identical or confusingly similar to Complainant's PERRIGO Mark. It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a "reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name". [WIPO Overview 3.0](#), section 1.7.

Prior UDRP panels have held the fact that a domain name which wholly incorporates a complainant's registered mark is sufficient to establish identity or confusing similarity for purposes of the Policy despite the addition of other words to such marks. [WIPO Overview 3.0](#), section 1.8 ("Where the relevant trademark is recognizable within the disputed 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"); see also *General Electric Company v. Recruiters*, WIPO Case No. [D2007-0584](#).

The disputed domain name <perrigos-uk.com> incorporates Complainant's PERRIGO Mark and adds a trailing letter "s" to the end of the Mark followed by a hyphen, the geographic abbreviation or country code "UK" and the Top-Level domain ("TLD") ".com". The disputed domain name, therefor, is confusingly similar

to Complainant's PERRIGO Mark, as it encompasses its registered PERRIGO Mark appending a single letter "s". which could be easily overlooked or considered as a "typo".

Prior UDRP panels have found registering a domain name that adds a single letter to a complainant's trademark to be within the conduct commonly referred to as "typosquatting", prohibited under the Policy, "the practice of misspelling an element of the mark, has consistently been regarded as creating domain names confusingly similar to the relevant mark." See, *Edmunds.com, Inc. v. Digi Real Estate Foundation*, WIPO Case No. [D2006-1043](#) (<edmundss.com>, transferred).

The letters "UK" is generally recognized as the two-letter country abbreviation for the United Kingdom as provided in ISO-3166 Alpha-2, as well as that country's country code top-level domain ("ccTLD"), but neither characterization would prevent the Panel from finding confusing similarity as noted in the UDRP precedents. Complainant also contends Respondent's selection of this UK geographic term for the disputed domain name is to enhance confusion of consumers because Complainant has a history of conducting business in the UK, but that issue is more appropriately considered under the second and third elements of the Policy. See *Natixis v. Domain eRegistration/ ID Shield Service, Domain ID Shield Service CO., Limited*, WIPO Case No. [D2016-2289](#).

Prior UDRP panels have found typographic differences, such as the inclusion or omission of hyphens and apostrophes are inadequate to avoid a finding of confusing similarity. See, e.g., *L'Oreal v. Tracey Johnson*, WIPO Case No. [D2008-1721](#). Finally, the addition of the Top-Level domain ("TLD") ".com" is irrelevant in determining whether the disputed domain name is confusingly similar. See, *Research in Motion Limited v. thamer Ahmed Alfarshooti*, WIPO Case No. [D2012-1146](#); [WIPO Overview 3.0](#), section 1.11.

Based on the above, this Panel finds that additional "s" and the UK country abbreviation appended by a hyphen to Complainant's mark to form the disputed domain name do not prevent a finding of confusing similarity between the disputed domain name and Complainant's PERRIGO Mark. Complainant's well-known PERRIGO Mark remains fully recognizable as incorporated in its entirety into the disputed domain name. Accordingly, the Panel finds the disputed domain name confusingly similar to the PERRIGO Mark in which Complainant has rights and Complainant has thus satisfied its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under the second element of the Policy, a complainant is first required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. If a complainant makes that showing, the burden of production on this element shifts to the respondent to come forward with relevant evidence of such rights or legitimate interests in the domain name. If the respondent fails to come forward with such evidence, a complainant is generally, deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1. See also, *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#). Respondent is in default and thus has not attempted to come forward to show any rights or legitimate interests in the disputed domain name under the Policy at paragraph 4(c).

Complainant has established, *prima facie*, that Respondent lacks rights or legitimate interests in the disputed domain name. First, Complainant asserts it has no connection with Respondent, who is not now, nor has it ever been a representative, licensee, or employee of Complainant, nor has Complainant consented to or granted any authorization for Respondent to make use of Complainant's PERRIGO Mark in a domain name or otherwise. Complainant also shows Respondent is not commonly known by the disputed domain name because Respondent is listed in the Whois record submitted with the Complaint as Privacy Service Provided By Withheld for Privacy ehf, and the Registrar disclosed the registrant's name The Carr, neither of which bears any resemblance to the disputed domain name whatsoever. Complainant also states that to the best of its knowledge, Respondent has no genuine actual or legitimate business which uses the name or mark "perrigos", "perrigo", or any similar name and has not used the "perrigos", "perrigo" name or mark (or any similar name) in connection with the *bona fide* offering of goods or services such that it benefits from any goodwill in that as such terms are reflected in the disputed domain name.

It is generally regarded as *prima facie* evidence of no rights or legitimate interests if a complainant shows that the disputed domain name is identical or confusingly similar to a complainant's trademark, that the respondent is not commonly known by the disputed domain name, and that a complainant has not authorized the respondent to use its mark (or an expression which is confusingly similar to its mark), whether in the disputed domain name or otherwise. See, *Roust Trading Limited v. AMG LLC*, WIPO Case No. [D2007-1857](#).

In view of the above, the Panel finds that Complainant has made out a *prima facie* case that Respondent has no rights or legitimate interests in the disputed domain name. Respondent has not submitted any argument or evidence to rebut Complainant's *prima facie* case. The Panel determines, therefore, that Respondent does not have rights or legitimate interests in the disputed domain name and that Complainant has successfully met its burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Complainant contends that because Respondent has created a domain name that is confusingly similar to Complainant's PERRIGO Mark, as well as its <perrigo.com> domain name, it is implausible to believe that Respondent did not have actual knowledge of Complainant's mark when it registered its confusingly similar disputed domain name. 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 widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See, [WIPO Overview 3.0](#), section 3.1.4.

The Panel also notes here additional factors under section 3.1.4 and its cases from which the Panel may infer bad faith registration: (i) Respondent's addition of the letter "s" in the disputed domain as a "typo" inserted into both Complainant's PERRIGO Mark and Complainant's <perrigo-uk.com> domain name to confuse consumers, (ii) Complainant's official local UK website for Complainant's self-care products has for many years prior to filing the Complaint been accessed at "www.perrigouk.co.uk", also a strikingly similar string, which suggests Respondent targeted Complainant's mark when it picked the disputed domain name and inserted only a single trailing letter's difference in the disputed domain name <perrigos-uk.com>, (iii) Complainant's long and extensive use of the PERRIGO Mark worldwide, including registration in the United States and Europe many years prior to the registration of the disputed domain name in February 2022, and especially including the UK where Complainant operates, which Respondent has configured the disputed domain name to exploit by consumer confusion and false association, and (iv) the lack of Respondent's rights to or legitimate interests in the disputed domain name, having shifted from a PPC parking page with links to competitors of Complainant in its industry, and upon the filing of the Complaint, shifting to no active use. Given the circumstances of this case, such a showing is sufficient to establish bad faith registration. See, [WIPO Overview 3.0](#), section 3.2.1.

Even though the disputed domain name is currently inactive, (after previously resolving to a parking site with links to Complainant's competitors), prior UDRP panels have found the passive holding of a domain name still amounts to use in bad faith See, *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); see also, *Siemens AG v. yinsi baohu yi kai qi (Hidden by Whois Privacy Protection Service) / li zhe, zhe li*, WIPO Case No. [D2017-0375](#). The Panel finds that Respondent's registration and passive holding of the disputed domain name in the present proceeding amounts to registration and use of the disputed domain name in bad faith.

For the foregoing reasons, Complainant has met its burden under 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, <perrigos-uk.com> be transferred to Complainant.

/Scott R. Austin/

Scott R. Austin

Sole Panelist

Date: September 6, 2022