

## **ADMINISTRATIVE PANEL DECISION**

### **Teva Pharmaceutical Industries Ltd. v. Frank Umbach and Henk Bergsma Case No. D2022-2733**

#### **1. The Parties**

The Complainant is Teva Pharmaceutical Industries Ltd., Israel, represented by SILKA AB, Sweden.

The Respondent is Frank Umbach, Germany, and Henk Bergsma, Germany.

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

The disputed domain names <tevapharm-cz.com> and <tevapiharm-cz.com> (“Domain Names”) are registered with Cronon AG Berlin, Niederlassung Regensburg (the “Registrar”).

#### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on July 26, 2022. On July 26, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On July 28, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on August 2, 2022, providing the registrant and contact information for multiple underlying registrants disclosed by the Registrar, and inviting the Complainant to either amend the Complaint adding the Registrar-disclosed registrants as the formal Respondents and provide relevant arguments or evidence demonstrating that all the named Respondents are, in fact, the same entity and/or that the Domain Names are under common control or indicate which Domain Names will no longer be included in the current Complaint. The Complainant filed an amendment on August 3, 2022, including its comments on the consolidation. Where it is necessary to make a distinction in this decision, the Panel will refer to the two Registrar-disclosed registrants respectively as the “First Respondent” and the “Second Respondent”. Where it serves no purpose, the Panel will in singular refer to just the “Respondent”.

On August 2, 2022, the Center transmitted an email in English and German to the Parties regarding the language of the proceeding. The Complainant confirmed its request that English be the language of the proceeding on August 3, 2022. The Respondent did not comment on the language of the proceeding.

On August 3 and 9, 2022, the Center received email communications in English sent from the listed email address of the First Respondent. On August 16, 2022, the Center suspended the proceedings on the

Complainant's request for suspension. On September 15, 2022, the Center reinstated the proceedings on the Complainant's request.

The Center verified that the Complaint and 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 in English and German of the Complaint, and the proceedings commenced on September 15, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 5, 2022. The Center did not receive a formal response.

The Center appointed Willem J. H. Leppink as the sole panelist in this matter on October 13, 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 following facts are undisputed.

The Complainant is a pharmaceutical company and one of the largest generic medicines producers in the world. It operates under the trademarks TEVA and TEVAPHARM and its roots date back to 1901.

The trademarks TEVA and TEVAPHARM were registered by the Complainant in numerous jurisdictions around the world, including the word mark TEVAPHARM in the European Union (registration number 018285645, registered on January 9, 2021), hereinafter also referred to as the "Trademark".

The Complainant is also the holder of the domain names <tevapharm.com>, registered on June 14, 1996, and <teva.cz>, registered on September 8, 1999.

The First Respondent registered the Domain Name <tevapharm-cz.com> on June 27, 2022, and the Second Respondent registered <tevapiharm-cz.com> on July 17, 2022. The Domain Names resolve to identical parked pages.

#### **5. Parties' Contentions**

##### **A. Complainant**

To the extent relevant for deciding this case, the Complainant makes the following contentions:

The Domain Names are identical or confusingly similar to a trademark in which the Complainant has rights. The Trademark is clearly recognizable in the Domain Names. The addition of the country identifier "cz" does not prevent a finding of confusing similarity between the Trademark and the Domain Names.

Furthermore, the Domain Name <tevapiharm-cz.com> includes the Trademark in full, with the addition of the letter "i", which can be considered as a typographical error when typing the Complainant's TEVAPHARM mark, but still the Trademark is sufficiently recognizable within this Domain Name.

The Respondent has no rights or legitimate interests in respect of the Domain Names. The Respondent is not a licensee of the Complainant, and it has not received any consent, permission or acquiescence from the Complainant to use the Trademark in association with the registration of the Domain Names. The

Complainant has found no evidence that the Respondent has been commonly known, prior to or after the registration of the Domain Names, under any name similar to the Domain Names or that it has any rights in trademarks similar to the Domain Names. The Respondent has not used the Domain Names in good faith or for a noncommercial activity. The Domain Names also do not resolve to an active website, but are pointing to a registrar's site. Besides, there is no evidence that the Domain Names have resolved to an active website in the past.

In view of all these circumstances, it is highly unlikely that the Respondent intended to use the Domain Names for any legitimate or fair use. Likewise, the Complainant cannot conceive any possible situation in which the use of the Domain Names would not infringe its rights in TEVA or the Trademark.

The Domain Names were registered and are being used in bad faith. The Trademark and the Complainant's domain name <tevapharm.com> were registered and have been in use well before the registration of the Domain Names. The Complainant's Trademark, but also the other TEVA trademarks are well-known internationally.

Only someone who was familiar with the Complainant's TEVA trademark and the Trademark and the Complainant's activities would have registered two Domain Names including these marks, with a hyphen and the letters "cz", corresponding the Czech Republic, the country in which the Complainant operates. It is impossible to believe that the Respondent would have chosen the Domain Names if it did not have the Complainant and the Trademark in mind.

The Domain Names resolve to a parking website, which may amount to passive use by the Respondent. The non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding.

MX servers are configured for the Domain Names, which indicates a risk that the Respondent potentially uses the Domain Names to create email addresses, with the suffixes "@tevapharm-cz.com" and "@tevipiharm-cz.com" for deceiving purposes.

## **B. Respondent**

After the language submission by the Complainant, on August 3, 2022, an email communication was sent by a person using the email address registered in connection with the Domain Name <tevapharm-cz.com> with only the following contents: "Juast state what you want." (*sic*). Upon the request from the representative of the Complainant to inform if the First Respondent agrees to transfer the Domain Names to the Complainant, the same person on August 9, 2022, replied "OK". Attempts to have the First Respondent to countersign a settlement agreement failed, and the proceedings were reinstated on Complainant's request. No communications were received from the email address associated with the Second Respondent.

## **6. Discussion and Findings**

### **6.1 Language of the Proceedings**

The Complaint has been submitted in English.

Pursuant to Rules, paragraph 11, in the absence of an agreement between the parties, or specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement, subject to the authority of the Panel to determine otherwise. According to information the Center has received from the Registrar, the language of the registration agreement for the Domain Names is German. The Complainant has submitted a request that English be the language of the proceedings, to which point the Respondent has not replied at all. Given the provided submissions and circumstances of this case, the Center has decided to:

- 1) accept the Complaint as filed in English;
- 2) accept a Response in either English or German;
- 3) appoint a Panel familiar with both languages mentioned above, if available.

The Respondent did not respond to the Center's communication regarding the language of proceeding, but did submit informal communications on other topics in English.

Section 4.5.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") addresses the language of proceeding and notes that the aim is to conduct the proceedings with due expedition and thus paragraph 10 of the Rules vests a panel with authority to conduct the proceedings in a manner it considers appropriate while also ensuring both that the parties are treated with equality, and that each party is given a fair opportunity to present its case. It continues to give the scenarios warranting the proceeding in a language other than those of the registration agreement.

The Panel finds that several of such scenarios, which to a certain extent have also been brought forward in the Complaint, would apply: (i) at least the First Respondent has given the impression that he understood the language of the Complaint and also its contents, by submitting informal communications regarding the proceeding in English; (ii) the pages to which the Domain Names resolve included English language information; and, (iii) ordering the Complainant to translate the Complaint would likely result in unwarranted higher costs and delay.

In addition, a UDRP panel decided in *Zappos.com, Inc. v. Zufu aka Huahaotrade*, WIPO Case No. [D2008-1191](#), that a respondent's failure to respond to a preliminary determination by the Center as to the language of the proceeding "should, in general, be a strong factor to allow the Panel to decide to proceed in favour of the language of the Complaint".

The Panel would have accepted a Response in German, but none was filed. Noting the Complainant's request and the above factors, the Panel finds sufficient factors supporting that the decision is rendered in English, the Panel will render its decision in English.

## 6.2 Consolidation

The Complainant, after it became clear that the Domain Names had different Registrar-disclosed registrants, requested consolidation. Section 4.11.2 of [WIPO Overview 3.0](#) addresses the issue of whether one proceeding can be brought against multiple respondents. It suggests that where a complaint is brought against more than one "respondent", the question is whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. To determine whether such consolidation is appropriate, Panels have considered a range of factors, such as the nature of the marks at issue, any naming patterns in the disputed domain names, and any (prior) pattern of similar respondent behaviour.

The Respondent, or at least the First Respondent, has in reply to the Complainant's request only stated "Just state what you want" (*sic*). Thus, there is no known rebuttal of the Complainant's request for consolidation.

On September 15, 2022, the Center informed the Parties that there would appear to be at least *prima facie* grounds sufficient to warrant accepting the Complaint for the Panel's final determination of the consolidation request on appointment.

The Domain Names were registered on similar dates (June 27 and July 17, 2022), the Domain Names resolve to the same parked website, the registrants of the Domain Names are according to the Whois information, located in the same country (Germany), the Domain Names are registered using the same Registrar, the Domain Names appears to be located on similar DNS servers, the Domain Names target the

Trademark, and the Domain Names have the same structure, the Trademark in full, together with a hyphen and the term “cz”. The only difference between them is the addition of the letter “i” in the Domain Name <tevapiharm-cz.com>.

Moreover, both named registrants are located in Germany, and when asked by the representative of the Complainant whether the First Respondent agreed to transfer the Domain Names (plural) to the Complainant, he only responded “ok”, without any mention that he would have only been the registrant of one of the two Domain Names.

On a balance of probabilities, the Panel finds it likely that the First Respondent and the Second Respondent are one and the same person or entity, or at minimum are under common control. Lacking substantive replies or objection, the consolidation is fair and equitable to all Parties, also taking into account that at the time of filing the Complaint the Complainant had good reasons to believe that there was in fact one and the same registrant and that both the First Respondent and the Second Respondent were provided proper notice and the ability to participate in this proceeding.

### **6.3 On the substance of the case**

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of a disputed domain name, a complainant shall prove the following three elements:

- (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.

#### **A. Identical or Confusingly Similar**

The Complainant must demonstrate that it has rights in a trademark or service mark and, if so, the domain name must be shown to be identical or confusingly similar to that mark.

The Complainant has shown that it has rights in the Trademark, that also predate the registration of the Domain Names. In addition, the Complainant has various trademark rights related to TEVA and TEVAPHARM valid in various jurisdictions, including the European Union, that also predate the registration of the Domain Names. The fact that these trademark rights predate the registration of the Domain Names is as such irrelevant for the Panel’s assessment of the first element, as the first element serves as a standing requirement, but is as such relevant for the assessment of the second and the third element.

The Panel finds the Domain Names confusingly similar to the Trademark. The Trademark is clearly recognizable in the Domain Names. The addition of the hyphen followed by the apparent country identifier “cz” does not prevent a finding of confusing similarity between the Trademark and the Domain Names. This also applies to the Domain Name <tevapiharm-cz.com>. The addition of the letter “i” in that Domain Name can be considered as a typographical error.

Previous UDRP decisions have found that the mere addition of geographical terms to a trademark in a domain name does not prevent a finding of confusing similarity. This has been held in many UDRP cases (see, e.g., *Inter-IKEA Systems B.V. v. Evezon Co. Ltd.*, WIPO Case No. [D2000-0437](#); *The British Broadcasting Corporation v. Jaime Renteria*, WIPO Case No. [D2000-0050](#); *Volvo Trademark Holding AB v. SC-RAD Inc.*, WIPO Case No. [D2003-0601](#); *Wal-Mart Stores, Inc. v. Lars Stork*, WIPO Case No. [D2000-0628](#); *America Online, Inc. v. Dolphin@Heart*, WIPO Case No. [D2000-0713](#); *AltaVista Company v. S. M. A., Inc.*, WIPO Case No. [D2000-0927](#)).

It is also already well established that the addition of a generic Top-Level Domain such as “.com” is typically irrelevant when determining whether a domain name is confusingly similar to a complainant’s trademark.

As a result, the Panel finds that the Domain Names are confusingly similar to the Trademark, and that the Complainant has satisfied the first element of the Policy.

### **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides some examples without limitation of how a respondent can demonstrate a right or legitimate interest in a domain name:

- (i) before receiving any notice of the dispute, the respondent used or made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the domain name; or
- (iii) the 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 at issue.

Based on the Respondent not rebutting the Complaint and even more or less agreeing to a transfer of the Domain Names, as well as the *prima facie* evidence in the Complaint, the Panel finds that the above circumstances are not present in this particular case and that the Respondent has no rights or legitimate interests in the Domain Names.

The Complainant has not licensed or authorized the usage of the Trademark to the Respondent, and it does not appear from the present record that the Respondent is commonly known by the Domain Names.

The Panel also notes that the present record provides no evidence to demonstrate the Respondent’s intent to use or to make preparations to use the Domain Name in connection with a *bona fide* offering of goods or services. Indeed, there is no active website, other than a parked page, linked to the Domain Names and the Respondent has not provided any substantive reply to the Complaint, but more or less seemed to agree to the allegations. The Respondent has also not used the Domain Names in good faith or for a noncommercial activity. In addition, there is no evidence that the Domain Names have resolved to an active website in the past.

Consequently, the Panel is satisfied that the Respondent has no rights or legitimate interests in the Domain Names, and thus the Complainant has proven the second element of the Policy.

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

Paragraph 4(b) of the Policy states that the following circumstances in particular, but without limitation, shall be evidence of registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent has registered or 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 the complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent 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 the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 its website or location or of a product or service on its website or location.

When the Domain Names were registered by the Respondent (in June and July 2022), the Trademark was already directly connected to the Complainant's pharmaceutical products. The Trademark and the Complainant's domain name <tevapharm.com> were registered and have been in use well before the registration of the Domain Names. The Panel finds that the Complainant's Trademark, but also the other TEVA trademarks are well-known internationally. As the Domain Names reflect the Trademark (*i.e.* TEVAPHARM) in addition to the TEVA trademarks (without "pharm"), it is implausible that the Respondent would have registered the Domain Names without having the Complainant and its trademarks in mind.

The Panel finds that, lacking any substantive response from the Respondent and thus the unrebutted facts brought forward by the Complainant, that the Domain Names are also being used in bad faith. The Panel takes into account that MX servers are configured for the Domain Names. This is a clear indication that the Domain Names serve to create email addresses using the Domain Names. The Panel finds that it is inconceivable that use of such email addresses and the Domain Names would not infringe the Complainant's rights and would not potentially deceive recipients of emails coming from such addresses. As such the Panel finds that there is a high risk that the Domain Names will be used for phishing purposes. Furthermore, the behaviour of the Respondent in the proceeding and his lack of providing any substantive reply to the allegations in the Complaint, as well as the obvious situation of typosquatting in relation to one of the two Domain Names, add to the finding of use in bad faith. The passive holding of the Domain Names does not prevent a finding of bad faith under the doctrine of passive holding (see section 3.3 of the [WIPO Overview 3.0](#)).

Accordingly, the Panel finds that the Domain Names were registered and are being used in bad faith, and the Complainant has also satisfied the third element 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 Domain Names, <tevapharm-cz.com> and <tevapiharm-cz.com>, be transferred to the Complainant.

*/Willem J.H. Leppink/*

**Willem J. H. Leppink**

Sole Panelist

Date: October 19, 2022