

ADMINISTRATIVE PANEL DECISION

Gilead Sciences, Inc. v. Michael Schulz

Case No. D2022-4930

1. The Parties

The Complainant is Gilead Sciences, Inc., United States of America, represented internally.

The Respondent is Michael Schulz, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <gilead-sciences.org> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 21, 2022. On December 22, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 22, 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 (Privacy Service Provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 23, 2022, 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 December 23, 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 January 10, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 30, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 2, 2023.

The Center appointed Eva Fiammenghi as the sole panelist in this matter on February 27, 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 Gilead Sciences, Inc., a research-based biopharmaceutical company founded in 1987, with headquarters in Forster City, California, United States of America. The Complainant discovers, develops and commercializes innovative medicines in areas of unmet medical need.

The GILEAD trademark serves as a valuable identifier of Gilead, the company, as well as its various goods and services such as its pharmaceutical medications, health information and education services, and its pharmaceutical research and charitable services.

The Complainant owns exclusive rights to the GILEAD trademark worldwide secured by over 120 trademark registrations around the world and through ongoing use, including, but not limited to, the following:

- GILEAD – United States of America Reg. No. 3,251,595, registered on June 12, 2007, in cl. 5;
- GILEAD SCIENCES – United States of America Reg No. 1,611,838, registered on September 4, 1990, in cl. 5;
- GILEAD SCIENCES – Mexico Reg. No. 462911, registered on June 9, 1994, in cl. 5
- GILEAD SCIENCES – Japan Reg. No. 2352515, registered on November 29, 1991, in cl. 10
- GILEAD – Singapore Reg. No. T08/03446D, registered on July 24, 2008, in cl. 5;
- GILEAD – India Reg. No. 2363685, registered on July 13, 2012, in cl. 5;
- GILEAD – European Union Reg. No. 3913167, registered on November 7, 2005, in cl. 5;

The Complainant is the owner, among others, also of a domain name <gilead.com>, which registered on May 27, 1995, and has been used by the company since as early as 1997, in connection with its pharmaceutical products and related medical services.

The disputed domain name <gilead-service.org> was registered on December 18, 2022, and does not currently resolve to an active website. According to the Complaint, the disputed domain name was previously used to feature a German language copy of the Complainant's own website. The disputed domain name was allegedly registered with the intention of diverting search and web traffic for the Respondent's own commercial gain.

5. Parties' Contentions

A. Complainant

The Complainant argues that the disputed domain name is almost identical to the Complainant's trademark GILEAD SCIENCES which has become a distinctive identifier of its product and service offerings.

The Complainant argues that the disputed domain name is identical to its well-known GILEAD SCIENCES trademarks.

It is well established that the generic Top-Level Domain ("gTLD") ".org", being a necessary component of a domain name, may be disregarded for the purpose of comparison under this ground.

The Respondent is not affiliated with the Complainant and there is no evidence to suggest that the Respondent has registered the disputed domain name to advance legitimate interests.

The Complainant has never licensed or otherwise permitted the Respondent to use its trademarks or to register any domain name including its trademarks.

The Complainant requests that the disputed domain name be transferred to it.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed the Complainant must prove that:

- (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 was registered and is being used in bad faith.

These elements are discussed in turn below. In considering these elements, paragraph 15(a) of the Rules provides that the Panel shall decide the Complaint on the basis of statements and documents submitted and in accordance with the Policy, the Rules and any other rules or principles of law that the Panel deems applicable.

A. Identical or Confusingly Similar

In the present case, the disputed domain name <gilead-sciences.org> is confusingly similar to the Complainant's registered trademarks GILEAD SCIENCES and GILEAD.

The Complainant has shown its own trademark rights both in the GILEAD SCIENCES and GILEAD trademarks.

The disputed domain name incorporates in their entirety the GILEAD SCIENCES and GILEAD trademarks.

Moreover, it is well established that the generic Top-Level Domains ("gTLD") such as ".org", being a necessary component of a domain name, may be disregarded for the purpose of comparison under this ground.

The Panel finds that the first element of the Policy has been met.

B. Rights or Legitimate Interests

According to the Policy, paragraph 4(a)(ii), the Complainant has to demonstrate that the Respondent has no rights or legitimate interests in the disputed domain name.

There is nothing in the available case file to suggest that the Respondent is in any way affiliated with the Complainant, nor has the Complainant authorized or licensed the Respondent to use its trademarks, or to seek registration of any domain name incorporating its trademarks.

The Respondent has not made any submissions or any demonstrations that it has rights or legitimate interests in the disputed domain name.

In *Guerlain S.A. v. Peikang*, WIPO Case No. [D2000-0055](#), the panel stated that: "in the absence of any license or permission from the Complainant to use any of its trademarks or to apply for or use any domain name incorporating those trademarks, it is clear that no actual or contemplated *bona fide* or legitimate use of the domain name could be claimed by Respondent."

The Panel finds no evidence that the Respondent has used, or undertaken any demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services.

Likewise, no evidence has been adduced that the Respondent has been commonly known by the disputed domain name; nor, for the reasons mentioned above, is the Respondent making a legitimate noncommercial or fair use of the disputed domain name.

The Panel concludes, noting that the Respondent lacks any rights or legitimate interests in the disputed domain name, that the second element of the Policy has, therefore, been met.

C. Registered and Used in Bad Faith

The Respondent, by using the disputed domain name, is intentionally misleading the consumers and confusing them trying to attract them to other websites making them believe that the websites behind those links are associated or recommended by the Complainant.

A finding of bad faith may be made where the Respondent knew or should have known of the Complainant's rights in the GILEAD SCIENCES trademark prior to registering the disputed domain name.

Considering the notoriety of the Complainant and of the Complainant's Trademarks in the pharmaceutical field and given the distinctiveness acquired by the GILEAD SCIENCES trademark through over 30 years of use, the Panel considers it most unlikely that the Respondent did not know of the Complainant and the Complainant's Trademarks when registering the disputed domain name.

Moreover, in this case, the addition of ".org", as well as the fact that the Respondent mirror-translated the Complainant website "gilead.com" into German, make clear that the Respondent has intentionally mimicked the Complainant's web presence, likely in order to perpetuate a scam such as phishing.

The Panel concludes that the disputed domain name has been registered and is being used in bad faith, and that the Complainant has 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 disputed domain name, <gilead-sciences.org>, be transferred to the Complainant.

/Eva Fiammenghi/

Eva Fiammenghi

Sole Panelist

Date: March 13, 2023