

## **ADMINISTRATIVE PANEL DECISION**

### **Gilead Sciences, Inc. v. Olutoyin Adeoye**

### **Case No. D2023-0303**

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

The Complainant is Gilead Sciences, Inc., United States of America (“United States” or “U.S.”), represented internally.

The Respondent is Olutoyin Adeoye, Nigeria.

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

The disputed domain name <gileadscienceinc.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 January 23, 2023. On January 24, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 24, 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 (Privacy Service Provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 25, 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 amendment to the Complaint on January 25, 2023.

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 27, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 16, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 17, 2023.

The Center appointed Pablo A. Palazzi as the sole panelist in this matter on February 23, 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 a large pharmaceutical firm, and has manufactured and marketed numerous well-known pharmaceutical drugs.

Complainant holds numerous trademark registrations in various jurisdictions for the mark GILEAD in connection with pharmaceutical preparations, including China Reg. No. 816124 (registered February 21, 1996), European Union Reg. No. 3913167 (registered November 7, 2005), and United States Reg. No. 3,251,595 (registered on June 12, 2007).

Complainant is the owner of GILEAD SCIENCES mark registered in the United States, Mexico, and Japan as follows:

- GILEAD SCIENCES – U.S. Reg No. 1,611,838, registered on September 4, 1990.
- GILEAD SCIENCES – Mexico Reg No. 462911, registered on June 9, 1994.
- GILEAD SCIENCES – Japan Reg No. 2352515, registered on November 29, 1991.

Complainant's main website is located at the domain name <gilead.com>, a domain name it has owned since 1995 and used since 1997 as its commercial website.

The disputed domain name was registered on September 10, 2022. At the time of filing, and currently, the disputed domain name does not resolve to an active website.

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

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

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

According to the Complainant, each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case.

First, the Complainant submits that the disputed domain name is identical or confusingly similar to the GILEAD and GILEAD SCIENCES trademark registrations of the Complainant.

Second, the Complainant argues that the Respondent has neither rights nor legitimate interests in the disputed domain name.

Third, the Complainant submits that the disputed domain name was registered and is being used in bad faith.

##### **B. Respondent**

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

## 6. Discussion and Findings

Paragraph 4(a) of the Policy lists three elements, which a complainant must satisfy in order to succeed. The Complainant must satisfy that:

- (i) the 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 such domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

### A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the first element of the Policy has been established.

### B. Rights or Legitimate Interests

Under the Policy, a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name. Once such a *prima facie* case is made, the respondent carries the burden of production of demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. [WIPO Overview 3.0](#), section 2.1.

Paragraph 4(c) of the Policy lists the ways that a respondent may demonstrate rights or legitimate interests in the domain name:

- (i) before any notice of the dispute, the respondent's 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) the respondent (as an individual, business or other organization) has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; 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 or service mark at issue.

In this case, the Panel finds that the Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. In particular, the Respondent has not submitted any arguments or evidence to rebut the Complainant's contention that it has never authorized, licensed or permitted the Respondent to use the GILEAD mark in any way.

The Respondent is also not using the disputed domain name in connection with any *bona fide* offering of goods or services, nor is the Respondent making a legitimate noncommercial or fair use of the disputed domain name. Moreover, the composition of the disputed domain name, adding the corporate identifier “inc” to the Complainant’s trademark, carries a risk of implied affiliation, contrary to the fact, which cannot constitute fair use. [WIPO Overview 3.0](#), section 2.5.1.

Therefore, the Panel concludes that the Respondent does not have rights or a legitimate interests in the disputed domain name within the meaning of the Policy, paragraph 4(a)(ii).

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

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The Panel considers that the record of this case reflects that:

- The disputed domain name contains in its entirety the mark of the Complainant as well as the complete corporate name of the Complainant.
- Prior panels have recognized that GILEAD is a “famous registered trademark.” *Gilead Sciences, Inc. v. Super Privacy Service LTD / Kolawole Feyisitan*, WIPO Case No. [D2020-3517](#) and *Gilead Sciences, Inc. v. Hilltop City Church*, WIPO Case No. [D2022-2906](#).
- The Respondent has defaulted.

The use by the Respondent of the mark GILEAD with the words “science” and “inc” in the disputed domain name yields the finding, on a balance of probabilities and on the record here, that the Respondent had the Complainant’s well-known GILEAD mark and corporate name in mind when registering the disputed domain name. The Respondent was fully aware of the Complainant’s business, as well as its goodwill in the GILEAD and GILEAD SCIENCES marks.

With respect to bad faith use, the Panel finds that the Complainant’s GILEAD mark is sufficiently well established and known, that the Respondent’s current non-use, or “passive holding,” of the disputed domain name qualifies as bad faith use under the principle first set forth in *Telstra Corp. v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

In a word, the Panel cannot conceive of any realistic reason, other than a bad faith reason, why the Respondent would have registered this disputed domain name, which contains a well-known global trademark and the entire corporate name of the Complainant.

The Complainant has established Policy paragraph 4(a)(iii).

### **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 <gileadscienceinc.com> be transferred to the Complainant.

*/Pablo A. Palazzi/*

**Pablo A. Palazzi**

Sole Panelist

Date: March 14, 2023