

## **ADMINISTRATIVE PANEL DECISION**

Haleon UK IP Limited v. MAURO TAGGIASCO

Case No. D2024-1199

### **1. The Parties**

The Complainant is Haleon UK IP Limited, United Kingdom, represented by SafeNames Ltd., United Kingdom.

The Respondent is MAURO TAGGIASCO, Italy.

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

The disputed domain name <haleon.site> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 20, 2024. On March 20, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 20, 2024, 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 (REDACTED FOR PRIVACY, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 22, 2024, 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 amended Complaint on March 25, 2024.

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 the Respondent of the Complaint, and the proceedings commenced on March 26, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 15, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 16, 2024.

The Center appointed Olga Zalomiy as the sole panelist in this matter on April 24, 2024. 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 British multinational consumer healthcare company established in July 2022 as a multibillion corporate spin-off from GlaxoSmithKline Consumer Healthcare (UK) IP Limited. Public media widely covered the launch of the HALEON brand worldwide. The Complainant owns <heleon.com> domain name that directs to its main website. The Complainant also holds a number of registrations in the HALEON mark:

- International registration No. 1674572 for the HALEON mark, registered on November 29, 2021;
- Mexican registration No. 2355199 for the HALEON mark, registered on February 10, 2022;
- United Kingdom registration No. UK00003726732 for the HALEON mark, registered on March 11, 2022.

The Complainant also uses its HALEON mark on various social media platforms.

The Respondent registered the disputed domain name on November 20, 2023. The disputed domain name does not direct to any active website.

On December 5, 2023, the Complainant sent a cease-and-desist letter to the Respondent notifying the Respondent about the Complainant's rights in the HALEON brand and requesting that the Respondent ceased its infringing activities and transferred the disputed domain name to the Complainant. On the same day, the Respondent sent an email stating the following:

"sure. i will sell this domain to you and i will guarantee not to register any other. Price is 2000 usd. i can receive it by wire or in crypto".

The Complainant rejected the Respondent's offer. On December 6, 2023, the Respondent sent another email reiterating his demand for USD 2,000 for the transfer of the disputed domain name and stating: "...I must emphasize that if this proposal is not agreeable, I am prepared to pursue alternative courses of action, including acquiring the desired domains independently. Given the current circumstances and my discovery of potential vulnerabilities, I am included to proceed with acquiring these domains at my discretion....

In the interest of transparency, I feel obligated to inform you that, should there be no engagement from your end to facilitate a company acquisition of my request, I will independently pursue the acquisition of these domains and may share our correspondence with relevant entities".

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

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

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is identical to its registered HALEON mark because the disputed domain name incorporates the HALEON mark in its entirety without any additions. The Complainant alleges that the generic Top-Level Domain ("gTLD") ".site" constitutes a technical registration requirement and, as such, is disregarded from the assessment of confusing similarity.

The Complainant argues that the Respondent lacks rights or legitimate interests in the disputed domain name because: (i) he does not possess any trademark rights for "HALEON"; (ii) he was not granted a license by the Complainant to use the term in domain names; (iii) he has not used the disputed domain

name for bona fide offering of goods or services and has merely held it passively; (iv) he is not commonly known by “HALEON”; (v) his non-use does not qualify as fair or noncommercial; and (vi) activating mail exchange for the disputed domain name suggests potential phishing activity.

The Complainant asserts that the Respondent registered the disputed domain name in bad faith, as he was aware or should have been aware of the Complainant’s trademark rights due to the Complainant trademark registration preceding the disputed domain name registration and extensive media coverage of the HALEON brand.

The Complainant contends that the Respondent’s previous involvement in a different domain name case, attempting to resell the domain name to the complainant, further demonstrates bad faith. Despite the Respondent’s non-use of the disputed domain name, the Complainant argues that bad faith is evident due to the strong reputation and distinctiveness of the HALEON mark. In the Complainant’s view, the Respondent’s activation of mail exchange records for the disputed domain name supports this assertion.

## **B. Respondent**

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

## **6. Discussion and Findings**

Pursuant to paragraph 4(a) of the Policy, to succeed in this proceeding, the Complainant must prove each of the following elements with respect to the disputed domain name:

- (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**

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.

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 entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. The inclusion of the gTLD “.site” is typically disregarded in the context of the confusing similarity assessment, being a technical requirement of registration. [WIPO Overview 3.0](#), section 1.11.1.

The Panel finds the first element of the Policy has been established.

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

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the

respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

The evidence on record shows that the Respondent is not commonly known by the disputed domain name. The Respondent is not making legitimate noncommercial or fair use of the disputed domain name or uses it for bona fide offering of goods or services, because the disputed domain name does not direct to an active website. The Respondent has not been authorized by the Complainant to use the Complainant's distinctive trademark in a domain name.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Panel finds the second element of the Policy has been established.

### **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.

In the present case, the Panel notes that the Respondent likely registered the disputed domain name for the bad faith purpose of selling it to the Complainant. While "registering a domain name for subsequent resale would not by itself support a claim that the respondent registered the domain name in bad faith with the primary purpose of selling it to a trademark owner", circumstances of this case indicate the disputed domain name was registered for the bad faith purpose of selling it to the Complainant because: (i) the Respondent's demand for USD 2,000 for transfer of the disputed domain name, which is identical to the Complainant's distinctive mark; (ii) the widespread media attention that the Complainant's brand received; (iii) the Respondent's threats to acquire other domain names and share them with third parties if the Complainant does not agree to the Respondent's asking price; and (iv) failure of the Respondent to submit any credible explanation for the disputed domain name registration.

In addition, the Respondent has been engaged in a pattern of bad faith conduct. The evidence shows that the Respondent was a respondent in a different domain name case, in which he was engaged in bad faith trademark registration and attempted to resell a domain name to a trademark owner.

Panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness of the Complainant's trademark, and the composition of the disputed domain name, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

The Panel finds that the Complainant has established 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 <haleon.site> be transferred to the Complainant.

*/Olga Zalomiy/*

**Olga Zalomiy**

Sole Panelist

Date: May 8, 2024