

ADMINISTRATIVE PANEL DECISION

Otsuka Pharmaceutical Co., Ltd. v. Uriy Markov
Case No. D2024-1627

1. The Parties

The Complainant is Otsuka Pharmaceutical Co., Ltd., Japan, represented by Zacco Denmark A/S, Denmark.

The Respondent is Uriy Markov, Russian Federation.

2. The Domain Names and Registrar

The disputed domain names <abilifypack24.top>, <abilify365x.top>, and <abilify365x7.top> are registered with Hosting Concepts B.V. d/b/a Registrar.eu. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on April 18, 2024. On April 18, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 19, 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) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 19, 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 amendment to the Complaint on April 22, 2024.

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 April 26, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 16, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 17, 2024.

The Center appointed Alistair Payne as the sole panelist in this matter on May 23, 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, established in Japan in 1964 is an international company engaged in the research, development, production, marketing, and sale of pharmaceuticals as well as nutritional products and cosmetics across the world. In 2023, the Complainant's net sales exceeded JPY 716 billion with a profit exceeding JPY 220. The Complainant employs approximately 5,800 people worldwide. It markets a number of different pharmaceuticals including pharmaceuticals for the treatment of disorders in the central nervous system such as Abilify for schizophrenia. The Complainant's ABILIFY trade mark is registered both as a word mark and as a logo in more than 50 jurisdictions around the world including in the United States of America ("United States") under number 2772697, registered on October 7, 2003; and in the Russian Federation under registration number 256446, registered on March 10, 2003. The Complainant also holds a number of domain name registrations that contain the ABILIFY trade mark including, <abilify.com> and <abilifymaintena.com>.

The Respondent, based in the Russian Federation registered the disputed domain names <abilify365x.top> and <abilifypack24.top> on February 4, 2024 and February 13, 2024 respectively. Neither of these disputed domain names initially resolved to active websites. The Respondent registered the disputed domain name <abilify365x7.top> on February 21, 2024. It resolves to a website that purports to offer the ABILIFY product for sale online without prescription to United States residents and which contains detailed information on the product.

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 names.

Notably, the Complainant contends that the ABILIFY mark is wholly incorporated into and is recognisable in each of the disputed domain names and as a result each of the disputed domain names is confusingly similar to the Complainant's registered ABILIFY mark. It submits that the addition of the terms "365x7", "365x", and "pack24" does not prevent a finding of confusing similarity in each case.

The Complainant submits that the Respondent has not received any license or consent, express or implied, to use the Complainant's ABILIFY trade mark in domain names or in any other manner and neither has the Complainant acquiesced in any way to such use or application by the Respondent. It says that at no time was the Respondent authorised by the Complainant to register the disputed domain names. Further, the Complainant says that, to the best of its knowledge, the Respondent has no rights in the disputed domain names. It asserts that the Respondent has not used the disputed domain names as a trade mark, company name, business, or trade name and that the Respondent is not commonly known by any of the disputed domain names. In addition, says the Complainant, the Respondent has no legitimate interests in any of the disputed domain names.

The Complainant further notes that the disputed domain name <abilify365x7.top> is used for a website that purports to offer Abilify for sale without prescription and which contains detailed information on the product. This, says the Complainant, is not legitimate use because Abilify is a drug that requires prescription and to offer it for direct sale without prescription is not legal. It further suggests that the other two disputed domain names are currently not used for an active website but there is an immediate risk that they can be used for

“phishing”, which is not consistent with the Respondent having any rights or legitimate interests in these disputed domain names.

The Complainant asserts that its ABILIFY trade mark is a coined word and is therefore distinctive per se. It says that as the mark is registered in multiple jurisdictions around the world and has been used intensively since the Abilify product was launched, the Respondent must have had positive knowledge as to the existence of the Complainant’s ABILIFY trade mark at the time of registration of the disputed domain names.

The Complainant claims that due to the distinctive nature and intensive use of the Complainant’s trade mark ABILIFY it is immediately inconceivable that the Respondent could use any of the disputed domain names for any plausible purpose that would not infringe the Complainant’s rights. It says that two of the disputed domain names resolve to parked pages featuring pay-per-click (“PPC”) links to third party websites, which is recognised by panelists as a basis for finding bad faith use. However, this claim is not supported by any supporting evidence. It also says, as noted above, that the disputed domain name <abilify365x7.top> is used for a website that purports illegally to offer the Abilify product for sale without prescription which is further evidence of use in bad faith.

B. Respondent

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

6. Discussion and Findings

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 trade mark and the disputed domain names. 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 trade mark 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 each of the disputed domain names. Accordingly, each disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms such as “365x”, “pack24”, and “365x7” in the respective disputed domain names may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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 Complainant has submitted that the Respondent has not received any license or consent, express or implied, to use the Complainant's ABILIFY trade mark in domain names or in any other manner and neither has the Complainant acquiesced in any way to such use or application by the Respondent. The Complainant has also asserted that the Respondent was never authorised by it to register any of the disputed domain names and that to the best of its knowledge, the Respondent has no rights in the disputed domain names. It has submitted that the Respondent has not used the disputed domain names as a trade mark, company name, business, or trade name and that the Respondent is not commonly known by any of the disputed domain names and that it has no rights or legitimate interests in any of them.

On reviewing each of the websites to which the respective disputed domain names resolve, the Panel finds that they all now redirect to websites that purport to offer the Abilify product for sale without prescription and which contains detailed information on the product and prominently displaying the Complainant's ABILIFY trade mark. The Complainant has asserted that this is not a legitimate use because Abilify is a drug that requires prescription and to offer it for direct online sale without prescription is not legal.

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 names such as those enumerated in the Policy or otherwise.

Panels have held that the use of a domain name for illegal activity here, claimed as being the illegal online offer for sale of pharmaceuticals without prescription or impersonation can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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.

The ABILIFY trade mark is a coined word and is highly distinctive for pharmaceutical products. The Complainant has registered it in numerous jurisdictions and has used the ABILIFY mark internationally in connection with its schizophrenia products. The fact that its mark and a description of the product's characteristics are displayed at the website to which each of the disputed domain names resolve indicates that it is more than likely that the Respondent was well aware of the Complainant's mark and product at the time of registration of each of the disputed domain names.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Under paragraph 4(b)(iv) of the Policy there is evidence of registration and use of the disputed domain name in bad faith where a respondent has used the disputed domain name to intentionally attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's trade marks as to the source, sponsorship, affiliation or endorsement of the website.

The Respondent in this case has used each disputed domain name to confuse and redirect Internet users to the same website which features the ABILIFY mark and which describes it and purportedly offers it for sale online without any prescription and prominently displaying the Complainant's ABILIFY trade mark. Internet users may be confused into thinking that there is some connection or affiliation with the Complainant when they see each of the disputed domain names and enter them and are redirected to the Respondent's website at which the ABILIFY product is advertised for sale. The Respondent is clearly using each of the disputed domain names for its own commercial purposes and without the Complainant's authority and the Panel therefore finds that the requirements of paragraph 4(b)(iv) are satisfied and that this amounts to evidence of registration and use of the disputed domain names in bad faith.

As noted under section 6.B above when the Panel reviewed the website to which each disputed domain name resolved, as per the record, they all redirect to the same website that purports to offer the Abilify product for sale online without prescription and which contains detailed information on the product. Whether the product offered is genuine or not, it is a category of pharmaceutical, as submitted by the Complainant, that is generally restricted and distributed only by medical prescription. As such its offer for sale online amounts to an illegal activity and the Panel notes that the Respondent has not attempted to rebut this assertion.

Panels have held that the use of a domain name for illegal activity such as, in the present case, the alleged distribution of pharmaceuticals or impersonation constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain names in this manner also constitute 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 names <abilifypack24.top>, <abilify365x.top>, and <abilify365x7.top> be transferred to the Complainant.

/Alistair Payne/

Alistair Payne

Sole Panelist

Date: June 4, 2024