

ADMINISTRATIVE PANEL DECISION

STADA Arzneimittel AG v. jordan gutarra
Case No. D2024-1870

1. The Parties

The Complainant is STADA Arzneimittel AG, Germany, represented by The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, United States of America.

The Respondent is jordan gutarra, Peru.

2. The Domain Name and Registrar

The disputed domain name <mystada.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 3, 2024. On May 3, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same date, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 8, 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 May 10, 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 May 16, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 5, 2024. The Respondent submitted a late response on June 8, 2024. On June 10 and June 11, 2024, the Complainant and the Respondent sent further email communications to the Center.

The Center appointed Luca Barbero as the sole panelist in this matter on June 12, 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 manufacturer of pharmaceutical products.

With its 125-year experience and currently 11,466 employees worldwide, the Complainant is present in approximately 115 countries and has achieved in 2023 group sales of EUR 3,734.8 million, reporting earnings before interest, taxes, depreciation and amortization of EUR 802 million.

The Complainant has provided evidence of ownership of several trademark registrations consisting of, or comprising STADA, including the following:

- Germany trademark registration No. 662147 for STADA (word mark), filed on June 26, 1953, and registered on September 3, 1954, in classes 1 and 5;
- European Union trademark registration No. 000569194 for STADA (word mark), filed on June 30, 1997, and registered on April 16, 1999, in classes 3 and 5;
- International trademark registration No. 562225 for STADA (word mark), registered on December 7, 1990, in class 5.

The Complainant is also the owner, amongst others, of the domain name <stada.com>, registered on December 13, 1999, and used by the Complainant to promote its products and activities under the trademark STADA.

The disputed domain name <mystada.com> was registered on April 8, 2024, and is currently pointed to a landing page indicating that the disputed domain name is not connected to an active website. Based on the screenshots submitted by the Complainant (Annex 8 to the Complaint), the disputed domain name resolved, prior to the start of the present proceeding, to a website featuring the STADA mark and the name of the Complainant and promoting the activity of the Complainant in the pharmaceutical sector.

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.

The Complainant contends that the disputed domain name is confusingly similar to the trademark STADA in which the Complainant has rights as it reproduces the trademark in its entirety with the mere addition of the word "my" and the generic Top-Level Domain ("TLD") ".com".

The Complainant states that the Respondent has no rights or legitimate interests in respect of the disputed domain name considering: i) it never assigned, granted, licensed, sold, transferred or in any way authorized the Respondent to register or use the STADA trademark in any manner; ii) the Respondent is not commonly known by the disputed domain name; and iii) the Respondent's use of the disputed domain name does not amount to a legitimate noncommercial or fair use nor to a bona fide offering of goods or services since, prior to the start of the present proceeding, the Respondent was using the disputed domain name in connection with a website that falsely appeared to be a website for, or otherwise associated with, the Complainant.

With reference to the circumstances evidencing bad faith, the Complainant indicates that, considering its trademark STADA is famous and/or widely known, the fact that its trademark registrations long predate the registration of the disputed domain name, and that the disputed domain name is similar to the Complainant's domain names <stada.com> and <stada.de>, it is inconceivable that the Respondent was unaware of the Complainant at the time of registering the disputed domain name.

The Complainant submits that the disputed domain name is so obviously connected to the Complainant that the Respondent's actions suggest opportunistic bad faith in violation of the Policy.

The Complainant further contends that, in view of the content of the Respondent's website, the Respondent has created a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of its website. The Complainant submits that particularly the use of the Complainant's logo on the website to which the disputed domain name initially resolved, giving appearance of false association with the Complainant, demonstrates that the Respondent has acted in bad faith.

B. Respondent

The Respondent submitted a late Response, in Spanish, on June 8, 2024, stating that, contrary to the Complainant's allegations, the disputed domain name in no way causes any risk of confusion with the Complainant's mark as the content of the website would not attempt to compete with or replicate the Complainant's products or services.

On the contrary, the Respondent contends that the website was created exclusively for educational purposes to share resources and study materials with a group of colleagues. However, the Respondent submits that it does not have screenshots of its website to demonstrate such assertions.

The Respondent also asserts that it never registered the disputed domain name with the intent of selling, or otherwise transferring it, to the Complainant or to any other third party, and that it did not intend to use the disputed domain name in bad faith, nor did it intend to interfere with the Complainant's business or divert traffic in an improper manner.

6. Discussion and Findings

6.1. Preliminary Procedural Issue: Late Response

Paragraph 14(a) of the Rules provides that, in the event of a late response, absent exceptional circumstances, panels shall proceed to a decision based solely on the complaint. On the other hand, paragraph 10(b) of the Rules requires panels to ensure that parties are treated with equality and that each party is given a fair opportunity to present its case.

The Response was filed three days after the deadline for the filing of a Response. Based on the overall circumstances of the case, considering the Response was filed before the appointment of the Panel, that the delay in the filing has not caused significant delay in the proceeding, and that the Respondent's submissions will not influence the outcome of the proceeding, bearing in mind the Panel's obligations under paragraph 10(b) of the Rules, the Panel deems appropriate in this case to consider the Response despite its late filing. Given the circumstances, the Panel does not deem appropriate to request a Supplemental Filing for the Complainant to submit its comments on the Response and will proceed to Decision to ensure that the proceeding takes place with due expedition.

6.2. Substantive Issues

According to paragraph 15(a) of the Rules: "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law

that it deems applicable.” Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

- (i) that the disputed domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that 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. Indeed, the Complainant has provided evidence of ownership of valid trademark registrations for STADA in several jurisdictions.

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

The Panel finds the addition of the term “my” to the trademark STADA does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The TLD “.com” is viewed as a standard registration requirement and as such can be disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

Therefore, 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.

In the case at hand, the Complainant has made a prima facie case, and the Respondent has failed to raise any convincing circumstance that could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain name.

According to the evidence on record, there is no relationship between the Complainant and the Respondent, and the Complainant has not authorized the Respondent to register or use its trademark or the disputed domain name. Moreover, there is no element from which the Panel could infer a Respondent’s right over the

disputed domain name, or that the Respondent might be commonly known by the disputed domain name.

The Respondent asserted to have registered the disputed domain name for use in connection with a website exclusively set up for educational purposes, to share resources and study materials with a group of colleagues.

However, the Panel notes that the Respondent has not submitted any documents demonstrating the use of the disputed domain name in connection with the contents described in the Response. Moreover, the screenshots submitted by the Complainant and the ones available in the Internet Archive at “www.archive.org”¹ show that the disputed domain name resolved prior to the start of this proceeding to a website featuring the Complainant’s name and marks, and a copyright notice “©2024 por Stada [...]” (English translation: “©2024 by Stada [...]”), and promoting the Complainant’s activities in the pharmaceutical sector. The Panel finds that such use of the disputed domain name does not amount to a bona fide offering of goods or services or a legitimate noncommercial or fair use without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant’s trademark.

Furthermore, the Panel notes that the disputed domain name is inherently misleading, as it suggests an affiliation with the Complainant and its STADA mark. Even where a domain name consists of a trademark plus an additional term, UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. [WIPO Overview 3.0](#), section 2.5.1.

Therefore, 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.

As to the bad faith at the time of the registration, the Panel notes that, in light of the prior registration and use of the trademark STADA in connection with the Complainant’s pharmaceutical products and the promotion of the Complainant’s activities online through the website “www.stada.com”, the Respondent should have been aware of the Complainant and its trademark at the time of registration.

Indeed, considering the disputed domain name resolved to a website displaying the Complainant’s marks and a copyright notice, and promoting the Complainant’s activities in the pharmaceutical sector, explicitly mentioning the Complainant’s name, the Panel finds that the Respondent clearly intended to target the Complainant and its trademark at the time of registration of the disputed domain name.

In view of the Respondent’s prior use of the disputed domain name in connection with the website described above, featuring the Complainant’s marks and a copyright notice and promoting the Complainant’s activities in the pharmaceutical sector, without providing any disclaimer as to the lack of affiliation with the Complainant and expressly mentioning the Complainant’s company name, the Panel finds that the Respondent has intentionally attempted to attract Internet users to its website, likely for commercial gain, by creating a likelihood of confusion with the Complainant’s trademark as to the source, sponsorship, affiliation or endorsement of its website according to paragraph 4(b)(iv) of the Policy.

¹ Noting the general powers of a panel articulated in paragraphs 10 and 12 of the UDRP Rules, it has been accepted that a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision. [WIPO Overview 3.0](#), section 4.8.

The disputed domain name is currently not pointed to an active website. Panels have found that the non-use of a domain name 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 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. Considering the reputation of the Complainant in the pharmaceutical sector and the prior use of the disputed domain name described above, the Panel 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.

Therefore, the Panel finds that the Complainant has also 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 <mystada.com> be transferred to the Complainant.

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: June 26, 2024