

ADMINISTRATIVE PANEL DECISION

Actavis Group PTC ehf and Actavis Holdco U.S., INC. v. Kim Hasko
Case No. D2024-3469

1. The Parties

The Complainants are Actavis Group PTC ehf, Iceland, and Actavis Holdco U.S., INC., United States of America, represented by SILKA AB, Sweden.

The Respondent is Kim Hasko, United States of America.

2. The Domain Name and Registrar

The disputed domain name <actavispharm.com> is registered with Hostinger Operations, UAB (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on August 26, 2024. On August 26, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 27, 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 (Domain Admin, Privacy Protect, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 9, 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 September 13, 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 September 19, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 9, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 10, 2024.

The Center appointed Gary Saposnik as the sole panelist in this matter on October 15, 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 Companies are a global pharmaceutical company focused on acquiring, developing, manufacturing and marketing branded pharmaceuticals, generic and over-the-counter medicines, and biologic products. They have a commercial presence across approximately 100 countries.

Actavis Pharmaceuticals originated in Iceland in the early twenty-first century, and was acquired by Watson, an American pharmaceutical company, in 2012. In 2015, Actavis Plc changed its name to Allergan Plc, while retaining the Actavis name for selected geographic regions and products. Along with Actavis Generics, both companies were acquired by TEVA Pharmaceutical Industries Ltd, and the Complainant Companies (hereinafter the "Complainant") are now an indirect wholly owned subsidiary of Teva Pharmaceutical Industries Ltd.

The Complainant is the owner of the ACTAVIS mark in different jurisdictions, with ACTAVIS the predominant part of many of the trademarks owned by the Complainant. The Complainant also owns hundreds of trademark registrations for the mark ACTAVIS and ACTAVIS PHARMA globally, including the following marks:

- ACTAVIS, International Registration no. 827298, registered March 15, 2004, covering 30 jurisdictions;
- ACTAVIS PHARMA, International Registration no. 827299, registered March 15, 2004, covering 14 jurisdictions;
- ACTAVIS, United States Patent and Trademark Office Registration no. 3845070, registered September 7, 2010, in class 5, including generic pharmaceuticals;
- ACTAVIS PHARMA, European Union IPO Registration No. 3615713, registered August 24, 2005, in classes 1,3, 5, 10, 42, and 44.

The Complainant Companies have been previously co-complainants in the matters of <actavisonlineshop.com> (*Actavis Group PTC ehf and Actavis Holdco U.S., INC. v. Masadepan 2toto*, WIPO Case No. [D2023-5252](#)); <actaviscompany.com> (*Actavis Group PTC ehf, Actavis Holdco US, INC. v. Domain Admin, Privacy Protect, LLC (PrivacyProtect.org) / Vladimir Jonnas*, WIPO Case No. [D2021-1729](#)), and <actavis4saleonline.com> (*Actavis Group PTC ehf and Actavis Holdco US, INC. v. Whois Agent (328792083), Whois Privacy Protection Services, Inc. / George Washere*, WIPO Case No. [D2021-1704](#)), where consolidation of the Complainants was found to be proper.

The Complainant is the registrant of numerous domain names containing the ACTAVIS mark, including <actavis.com> (registered September 3, 2002), <actavispharma.com> (registered November 17, 2003), and <actavis.net> (registered December 3, 2003).

The disputed domain name was registered on July 23, 2024, and does not resolve to any content.

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 it has rights in the ACTAVIS marks since 2003, and ACTAVIS PHARMA marks since 2004 across various classes globally. The Complainant contends that the ACTAVIS mark is clearly identifiable in the disputed domain name, and the disputed domain name is also confusingly similar to the ACTAVIS PHARMA mark.

The Complainant submits that the Respondent lacks rights or legitimate interests in the disputed domain name, and that the burden of production should shift to the Respondent to put forward evidence to show that

it has rights or legitimate interests in the disputed domain name. The Complainant asserts that the Respondent is not affiliated with/authorized by the Complainant in any way to make use of the Complainant's trademark, while the Complainant has exclusive rights to the trademarks ACTAVIS and ACTAVIS PHARMA. The Complainant has invested a substantial amount of resources in promoting its product under the ACTAVIS mark worldwide. Given the mark's fame, any person or entity using the mark/name ACTAVIS in any manner is bound to lead customers and users to infer that its product or service has an association or nexus with the Complainant and would lead to confusion and deception.

The disputed domain name was registered more than two decades after the Complainant began using its registered and distinctive ACTAVIS marks. The disputed domain name is not a descriptive or dictionary term serving to indicate specific characteristics of any goods or services. It is extremely difficult to foresee any justifiable use that the Respondent may have with the disputed domain name.

The Respondent cannot be said to have legitimately chosen the disputed domain name unless it was seeking to create an impression of an association with the Complainant. Since there is no such authorized association, the Respondent's use of the disputed domain name cannot be said to be legitimate. Since the disputed domain name reproduces exactly the Complainant's distinctive and well-known trademark, therefore the domain name cannot qualify as a activity falling under the circumstances listed by paragraph 4(c) of the UDRP as demonstrating the Respondent's rights or legitimate interests in the disputed domain name.

The Respondent is not making any legitimate or fair use of the disputed domain name, and is instead, holding the disputed domain name passively. Therefore, the doctrine of passive holding from the case of *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) and [WIPO Overview 3.0](#), section 3.3, applies, since the website associated with the disputed domain name does not resolve. Additionally, the disputed domain name cannot be put to any good faith use, except in violation of the Complainant's rights.

Such a presumption is even stronger in the case of the combined use of the ACTAVIS mark and the typo "pharm", derived from the trademark ACTAVIS PHARMA. It is a clear case of cyber-squatting, with an intention to take advantage of the Complainant's substantial reputation and goodwill to confuse the public, divert business and tarnish the Complainant's reputation. The said usage is neither the demonstrable preparation to use nor a bona fide offering of goods or services, nor a legitimate non-commercial or fair use of the disputed domain name.

The Complainant submits that the disputed domain name was registered and is being used in bad faith. The Complainant's marks are distinctive in relation to pharmaceuticals and have been used by the Complainant exclusively since 2003, resulting in the marks transcending regional boundaries and acquiring a trans-border reputation. Citing [WIPO Overview 3.0](#), section 3.1.4, the Complainant argues that Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names composing typos or incorporating the mark plus a descriptive term) to a famous or widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith. The Complainant asserts that it is inconceivable that the registration of the disputed domain name was made without full knowledge of the existence of the Complainant and its well-known trademarks ACTAVIS and ACTAVIS PHARMA.

While the disputed domain name does not resolve to an active website, the non-use criteria would not prevent a finding of bad faith under the Telstra doctrine of passive holding. The Complainant asserts that it has a strong reputation and is widely known; the Respondent has provided no evidence of actual or contemplated good faith use by it of the disputed domain name; it is not possible to conceive of any plausible or contemplated active use of the disputed domain name containing its famous or well-known marks. Prior panels have held that passive holding of a domain name containing the ACTAVIS mark was considered bad faith registration and use. See *Actavis Group PTC ehf and Actavis Holdco U.S., Inc. v. Whois Privacy, Private by Design LLC/Paul Kemp, Mainline Information Systems, Inc.*, WIPO Case No. [D2022-0990](#); *Actavis Group PTC ehf and Actavis Holdco U.S., Inc. v. Masadepan 2toto*, WIPO Case No. [D2023-5252](#).

The Complainant further argues that the disputed domain name is a typo-squatting variation of the Complainant's trademark ACTAVIS PHARMA, as well as the domain name <actavispharma.com>. Therefore, anyone who encounters the disputed domain name might mistakenly believe it to be the Complainant's official website and quickly connect it with the Complainant. "Panels have consistently found that clear typosquatting may support an inference of bad faith registration...The Respondent has not explained the selection of this highly unusual Domain Name, which happens to be, visually, virtually identical to the Complainants' trademark. Panels have found typosquatting, coupled with an absence of rights or legitimate interests, to be a factor tending to show bad faith." [WIPO Overview 3.0](#), section 3.2.1. *Actavis Group PTC ehf and Actavis Holdco U.S., Inc. v. Whois Privacy, Private by Design LLC/ Paul Kemp, Mainline Information Systems, Inc.*, WIPO Case No. [D2022-0990](#).

The Complainant concludes by asserting that the use and registration of the disputed domain name is clearly intended to capitalize on consumer confusion for the Respondent's profit, a bad faith registration and use under the Policy.

B. Respondent

The Respondent did not reply to the Complainant's contentions

6. Discussion and Findings

6.1. Consolidation of Multiple Complainants

Previous UDRP panels have concluded that consolidation of multiple complainants in a single complaint is permissible. In assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation. [WIPO Overview 3.0](#), section 4.11.1; *Actavis Group PTC ehf and Actavis Holdco U.S. INC. v. Masadepan 2toto*, WIPO Case No. [D2023-5252](#).

It is also well accepted that a trademark owner's affiliate such as a subsidiary of a parent or of a holding company, or an exclusive trademark licensee, is considered to have rights in a trademark under the UDRP for purposes of standing to file a complaint. [WIPO Overview 3.0](#), section 1.4.1. As in the cases cited above, this Panel finds that the Complainants are affiliated companies, and that it is both equitable and procedurally effective to allow the Complainants to proceed with the single consolidated Complaint.

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 confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel finds the mark is recognizable 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 disputed domain name is a misspelling of the ACTAVIS PHARMA mark, merely leaving off the "a" at the end of the mark. A domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element. [WIPO Overview 3.0](#), section 1.9.

Even if just based on the ACTAVIS mark, the addition of the term “pharm” may bear on assessment of the second and third elements, but this Panel finds that the addition of such term 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 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.

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.

Based on the evidence submitted, the Panel finds that there is no evidence that the Respondent is a licensee of, or otherwise affiliated with, the Complainant, and has not been authorized by the Complainant to use the ACTAVIS or ACTAVIS PHARMA marks. There is no evidence that the Respondent has been commonly known by the disputed domain name, and there is no similarity or association between the name of the Respondent and the disputed domain name, which could demonstrate rights or legitimate interests of the Respondent.

Additionally, there is no evidence that the Respondent has used or made demonstrable preparations to use the disputed domain name in connection with a legitimate noncommercial fair use or a bona fide offering of goods or services. Moreover, given the composition of the disputed domain name, which is a one-letter variation of both the Complainant’s trademark and domain name, the disputed domain name is inherently misleading and such composition cannot constitute fair use given it effectively suggests ownership by, or affiliation to, the Complainant contrary to the fact. [WIPO Overview 3.0](#), sections 1.9 and 2.5.

The disputed domain name does not resolve to any content. Panelists 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.

While 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, (iii) the respondent’s concealing its identity or use of false contact details..., and (iv) the implausibility of any good faith use to which the domain name may be put.

[WIPO Overview 3.0](#), section 3.3; *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

Based on a totality of the evidence presented, this Panel finds that the Complainant's ACTAVIS and ACTAVIS PHARMA marks are distinctive and have become well-known in the pharmaceutical industry. The Respondent did not respond to the Complaint nor have they provided any evidence of actual or contemplated good-faith use. Based on the distinctiveness of the ACTAVIS mark, and the inclusion of a typo of a term related to the Complainant's product, it is implausible that the Respondent would have any good faith use to which the domain name may be put.

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 registered the disputed domain name more than 20 years after the Complainant acquired trademark rights in the ACTAVIS and ACTAVIS PHARMA marks, as well as the <actavis.com> domain name. The disputed domain name is an obvious typo of the Complainant's ACTAVIS PHARMA mark and shows a clear indication of knowledge and targeting of the Complainant and its well-known pharmaceutical marks.

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. In the instant case, the disputed domain name is a typo of a widely known mark, including the Complainant's ACTAVIS mark plus the addition of "pharm", a descriptive term referring to the Complainant's pharmaceutical business and product. Panels have consistently found that clear typosquatting may support an inference of bad faith registration.

[WIPO Overview 3.0](#), section 3.2.1; *Actavis Group PTC ehf and Actavis Holdco U.S., Inc. v. Whois Privacy, Private by Design LLC/ Paul Kemp, Mainline Information Systems, Inc.*, WIPO Case No. [D2022-0990](#).

Additionally, 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. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's trademark, and the composition of the disputed domain name containing a typo of the Complainant's ACTAVIS PHARMA mark, 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 use 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 <actavispharm.com> be transferred to the Complainant.

/Gary Saposnik/

Gary Saposnik

Sole Panelist

Date: October 29, 2024