

ADMINISTRATIVE PANEL DECISION

Perrigo Pharma International Dac v. Domain Administrator,
Fundacion Privacy Services LTD
Case No. D2022-4939

1. The Parties

The Complainant is Perrigo Pharma International DAC, Ireland, represented internally.

The Respondent is Domain Administrator, Fundacion Privacy Services LTD, Panama.

2. The Domain Name and Registrar

The disputed domain name <smilesocietyperrigo.com> is registered with Media Elite Holdings Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 22, 2022. On December 22, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 30, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 9, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 29, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 21, 2023.

The Center appointed Francine Tan as the sole panelist in this matter on March 1, 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 states that the Perrigo Group is a leading global self-care company which was started in 1887. It is now an international pharmaceutical group which specializes in self-care products, which are available through retailers, pharmacies, and e-commerce outlets in the United States of America (“U.S.”), across Europe and in other major markets. Its Consumer Self-Care Americas segment is involved in the development, manufacturing, and marketing of over-the-counter branded products, including products to treat colds, coughs, and allergies, as well as infant formula and oral care, among many other types of products. Its Consumer Self-Care International segment develops, manufactures, markets, and distributes well-known European self-care brands in natural health and vitamins as well as oral care products and products to treat colds, coughs, and allergies, among many other types of products.

The Perrigo Group owns the PERRIGO trade mark all over the world. The Complainant is the registered owner of the following trade marks:

- U.S. Trade Mark Registration No. 1773993 for PERRIGO, registered on June 1, 1993;
- U.S. Trade Mark Registration No. 4262523 for , registered on December 18, 2012; and
- European Union Trade Mark No. 000176883 for PERRIGO, registered on December 16, 1999.

The Perrigo Group owns, through its affiliate, Ranir, LLC, the domain name <smile-society.com>, which was registered on July 17, 2017.

The disputed domain name was registered on August 8, 2022. It resolves to an active website which displays Pay-Per-Click (“PPC”) links to third-party websites. The links are titled “Pharmaceutical Company”, “Biopharmaceutical Company”, “Pharmaceutical Data”, or “Pharma Company”, which refer to the Complainant’s field of activity.

The Complainant sent a cease-and-desist communication by email on August 24, 2022, and requested immediate cancellation or transfer of the disputed domain name. The Respondent did not reply.

5. Parties’ Contentions

A. Complainant

The disputed domain name is confusingly similar to its PERRIGO mark as the disputed domain name wholly reproduces the PERRIGO mark in its entirety with the addition of the words “smile” and “society”. The addition of the expression “smile society” does not prevent a finding of confusing similarity. Moreover, the expression “smile society” corresponds to the Complainant’s domain name <smile-society.com>.

The Respondent has no rights or legitimate interests in respect of the disputed domain name as it has not permitted the Respondent to register the disputed domain name. There is no evidence that the Respondent has trade mark rights in the sign “Perrigo” or is commonly known by the name “Perrigo”. Apart from the PPC links, on December 21, 2022, the domain name pointed to the website “www.adrastos-eli.com” which was identified by the Complainant as a security threat.

The disputed domain name was registered and is being used in bad faith. The Perrigo Group was created more than 130 years ago and is well established in its field in the U.S. and worldwide. It has trademark registrations around the world. The Respondent did not choose the disputed domain name by chance but with the knowledge of the Complainant’s and/or the Perrigo Group’s activities, reputation, and PERRIGO trade marks, hoping to mislead Internet users. This is confirmed by the fact that: (i) the Respondent associated the PERRIGO trade mark with the expression “smile society” which is used by the Perrigo Group

in its domain name <smile-society.com>; and (ii) the parked page had links to “Pharmaceutical Company” or “Pharma Company”, which correspond to the Complainant’s field of activity.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights.

A registered trade mark provides a clear indication that the rights in the mark shown on the trade mark certificate belong to its respective owner. The Complainant provided evidence that it owns the PERRIGO mark. The disputed domain name comprises the Complainant’s PERRIGO mark in its entirety with the addition of the words “smile” and “society”. It is a well-established principle that where the trade mark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. (See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.8.) The Complainant’s PERRIGO mark is clearly recognizable in the disputed domain name.

Further, it is well established that the adding of the generic Top-Level Domain “.com”, as a standard registration requirement, is disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#), section 1.11.1).

Therefore, the Panel finds that the disputed domain name is confusingly similar to a trade mark in which the Complainant has rights and paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Once a complainant establishes a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name, the burden of production shifts to the respondent to show that it has rights or legitimate interests in respect of the disputed domain name (see [WIPO Overview 3.0](#), section 2.1).

In the present case, the Complainant has demonstrated a *prima facie* case that the Respondent lacks rights or legitimate interests in respect of the disputed domain name. The Respondent has failed to assert any such rights or legitimate interests exist. The Complainant provided evidence that it owned trade mark registrations of the PERRIGO mark many years before the date that the disputed domain name was registered. The Complainant is not affiliated with, nor has it licensed or otherwise permitted the Respondent to use the Complainant’s trade mark. There is no evidence that the Respondent is commonly known by the disputed domain name.

Further, the Respondent did not respond to the Complainant’s email of August 24, 2022 nor did it submit a Response. Accordingly, the Respondent failed to invoke any circumstance that might demonstrate that it has rights or legitimate interests in the disputed domain name. Given the use of the disputed domain name to feature PPC links related to and competing with the Complainant’s services, the Panel finds such use does not represent a *bona fide* offering, pursuant to section 2.9 of the [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Paragraph 4(a)(ii) of the Policy has been satisfied.

C. Registered and Used in Bad Faith

The Complainant must also show that the Respondent registered and is using the disputed domain name in bad faith (per paragraph 4(a)(iii)) of the Policy). Paragraph 4(b) of the Policy lists circumstances that may constitute evidence of bad faith under paragraph 4(a)(iii) of the Policy.

The disputed domain name incorporates both the Complainant's PERRIGO mark and the words "smile" and "society" which correspond to the Perrigo Group's domain name <smile-society.com> in their entirety, which the Panel finds is a clear attempt by the Respondent to confuse and/or mislead Internet users seeking or expecting the Complainant. Further, the Complainant has submitted evidence which shows that the Respondent registered the disputed domain name long after the Complainant registered the PERRIGO trade mark. The Complainant has also submitted evidence showing that PERRIGO is a well-established trade mark. Given the evidence presented to the Panel, the Panel finds that it is highly likely that the Respondent was aware of the Complainant at the time of registering the disputed domain name and specifically targeted the Complainant and its goodwill in the business associated with the PERRIGO trade mark.

Given the particular circumstances of this case, namely the reputation of the Complainant's trade mark, the registration of the disputed domain name having taken place long after the registration of the Complainant's PERRIGO trade mark, the nature of the PPC links, the similarity between the disputed domain name and the Perrigo Group's domain name <smile-society.com>, the failure of the Respondent to submit a response or to reply to the Complainant's cease-and-desist communication, the Panel concludes that the disputed domain name was registered and is being used in bad faith with the intention of misleading unsuspecting Internet users for commercial gain by creating a likelihood of confusion with the Complainant's PERRIGO trade mark.

Accordingly, having regard to the circumstances of this particular case, the Panel finds that the Complainant has met its burden under paragraph 4(a)(iii) 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 <smilesocietyperrigo.com> be transferred to the Complainant.

/Francine Tan/

Francine Tan

Sole Panelist

Date: March 15, 2023