

ADMINISTRATIVE PANEL DECISION

Gilead Sciences, Inc. v. Domains By Proxy, LLC / Joel Sam
Case No. D2022-2625

1. The Parties

The Complainant is Gilead Sciences, Inc., United States of America (“United States” or “U.S”), represented internally.

The Respondent is Domains By Proxy, LLC. United States / Joel Sam, India.

2. The Domain Name and Registrar

The disputed domain name <gileadpharmaceutical.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 July 19, 2022. On July 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 20, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on July 25, 2022, 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 July 25, 2022.

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 July 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 17, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 22, 2022.

The Center appointed Manuel Moreno-Torres as the sole panelist in this matter on August 26, 2022. 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 an American biopharmaceutical company doing business worldwide. With current global revenues exceeding USD 27 billion and with over 14,000 individuals staff.

The Complainant owns exclusive rights to the GILEAD trademark worldwide, secured by over 120 trademark registrations around the world. By way of example:

GILEAD – U.S. Reg. No. 3,251,595, registered on June 12, 2007, covering “pharmaceutical preparations, namely, antivirals, antifungals and preparations for the treatment of infectious conditions” in Class 5.

GILEAD – India Reg. No. 2363685, registered on September 10, 2015, covering “pharmaceutical preparations” in Class 5.

The disputed domain name <gileadpharmaceutical.com> was registered May 12, 2022, and redirects to a landing page promoted by the Registrar with an offer to sell the disputed domain name and related searches with a button labeled “pharmaceutical”.

5. Parties’ Contentions

A. Complainant

The Complainant asserts that GILEAD is a well-known and famous mark and it is reproduced in the disputed domain name. The additional term “pharmaceutical” is a clear case of typosquatting.

The Top-Level Domain (“TLD”) “.com” is irrelevant in determining whether the disputed domain name is confusingly similar to the GILEAD mark.

The Complainant remarks to be the owner of domain name <gilead.com> since 1995 as well as the owner of a portfolio of over 340 domain names that incorporate the GILEAD trademark somehow.

The Respondent does not have rights or legitimate interests in respect to the disputed domain name. The Respondent is not associated or affiliated with the Complainant. Nor the Complainant has granted any rights to the Respondent to use GILEAD mark, whether a license to sell any products or offer any services, or any rights to registered the disputed domain name.

Further, the Complainant alleges that there is no indication that the Respondent is commonly known by “gilead”.

The Complainant also finds that the Respondent’s strategy for registering the disputed domain name focus on to capture and divert Internet search engine queries made by individuals seeking the Complainant’s genuine pharmaceutical products or medical information.

With regard to the third requirement, the Complainant supports a finding of bad faith registration and use on the following basis: The Respondent had constructive knowledge of GILEAD and was fully aware of the Complainant’s business based on the Complainant’s long standing worldwide trademark registrations covering GILEAD mark and business.

Moreover, the Complainant contends that the Respondent’s acts demonstrate bad faith use and registration. As such, by registering the entire GILEAD trademark and a misspelling of the term “pharmaceutical”.

Purposefully registering a domain with search terms to divert Internet users. The Complainant also notes that by using a privacy shield service the Respondent acted in bad faith. And finally, by offering the disputed domain name for sale there is a finding of bad faith registration.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed the Complainant must satisfy the Panel that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

There are no exceptional circumstances within paragraph 5(f) of the Rules to prevent the Panel from determining the dispute based upon the Complaint, notwithstanding the failure of the Respondent to file a Response. Under paragraph 14(a) of the Rules in the event of such a "default" the Panel is still required "to proceed with a decision on the complaint", whilst under paragraph 14(b) it "shall draw such inferences there from as it considers appropriate". This dispute resolution procedure is accepted by the domain name registrant as a condition of registration.

A. Identical or Confusingly Similar

As noted, the Complainant has established trademarks rights in GILEAD. Then, the test rests on the comparison between the mark and the disputed domain name. The disputed domain name incorporates the GILEAD trademark in its entirety together with the word "pharmatical" (a misspelling of the word "pharmaceutical"). The GILEAD trademark is clearly recognizable within the disputed domain name and the additional term does not prevent a finding of confusingly similarity. See sections 1.7 and 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Panel also notes that TLDs are generally irrelevant to the consideration of identity or confusing similarity between a trademark and a domain name

Accordingly, the first requirement is met under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

To demonstrate rights or legitimate interests in a domain name, non-exclusive respondent defenses under UDRP paragraph 4(c) include the following:

- (i) before any notice of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Complainant contends that the Respondent has not been authorized to use the GILEAD trademark as a domain name, that the Respondent is not commonly known by “gilead”, and that the Respondent is not affiliated with the Complainant. Under these circumstances it is well established that the burden of production shifts to the Respondent, but the Respondent did not object to the Complaint.

Moreover, the Panel notes the composition of the disputed domain name and its similarity with the Complainant’s trademark which carries an impermissible risk of implied affiliation (while the word “pharmaceutical” has been misspelled, there is a risk that Internet users will not notice such misspelling). This cannot be disregarded for the purposes of this second requirement.

Finally, and based on the case file, the Respondent is intending to sell the disputed domain name through a landing page offered by the Registrar. It is well accepted that resellers of domain names may have a legitimate interest in doing so in connections to dictionary words or common phrases. The Panel notes that the disputed domain name resolves to a landing page featuring a button labeled “pharmaceutical” that seemingly offers third party websites with competing pharmaceutical services. Therefore, the landing page is trading-off the Complainant’s trademarks rights. This finding is reinforced by the use of the word “pharmatical” (a misspelling of the word “pharmaceutical”).

The Panel finds that the Respondent lacks rights or legitimate interests under paragraph 4(a)(ii) of the Policy and therefore the second requirement is met.

C. Registered and Used in Bad Faith

The UDRP requires the complainant to prove that the respondent registered and used the disputed domain name in bad faith.

On balance, the Panel finds that the Respondent knew or should have known about the Complainant, its business, and its trademarks. For such finding the Panel takes into account the fame of the trademark. Indeed, previous UDRP decisions have recognized the fame and well-known character of the GILEAD trademark. See *Gilead Sciences, Inc. v. Super Privacy Service LTD c/o Dynadot / Kolawole Feyisitan*, WIPO Case No. [D2020-3517](#) or *Gilead Sciences, Inc. v. John Cuban, Gilead Online Pharmacy*, WIPO Case No. [D2020-1254](#).

Further, due to the composition of the disputed domain name and its use the circumstances described in 4(b)(iv) of the Policy are applicable: “By using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.”

The domain name resolves to a landing page with an offer to sell the disputed domain name and with pay-per-click links. While the offer is made by the Registrar, an entity seemingly unrelated with the Respondent, the use is to be considered as use in bad faith. Moreover, the Respondent cannot disclaim responsibility of the use implemented in the disputed domain developed by the Registrar. See *Telefonaktiebolaget LM Ericsson v. Domain Administrator, Fundacion Privacy Services LTD*, WIPO Case No. [D2022-0851](#) and section 3.5 of [WIPO Overview 3.0](#).

In accordance, the Panel finds that the Complainant has satisfied the requirements of 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 <gileadpharmaceutical.com> be transferred to the Complainant.

/Manuel Moreno-Torres/

Manuel Moreno-Torres

Sole Panelist

Date: September 9, 2022