

## **ADMINISTRATIVE PANEL DECISION**

### **Perrigo Pharma International DAC v. Qiu Xiaofeng Case No. D2022-4960**

#### **1. The Parties**

The Complainant is Perrigo Pharma International DAC, Ireland, represented by Omega Pharma Innovation & Development NV, Belgium.

The Respondent is Qiu Xiaofeng, China.

#### **2. The Domain Name and Registrar**

The disputed domain name <perrigoshop.com> is registered with Paknic (Private) Limited (the “Registrar”).

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 23, 2022. On December 23, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 24, 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 (Whois Agent, Web Domains By Proxy) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 27, 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 December 29, 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 January 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 2, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 6, 2023.

The Center appointed Luca Barbero as the sole panelist in this matter on February 10, 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 is a leading global self-care company, founded in 1887 by Luther Perrigo, the owner of a general store who had the idea to package and distribute patented medicines and household items for country stores.

Today, the Complainant is an international pharmaceutical group specialized in branded and private label self-care products, available at retailers, pharmacies, and e-commerce outlets in the United States of America (“United States”), across Europe, and in other major markets.

The Consumer Self-Care Americas (CSCA) segment of the Complainant’s group develops, manufactures, and markets over-the-counter (OTC) store brand products, primarily in the cough, cold, allergy, analgesics, gastrointestinal, smoking cessation, infant formula, and oral care categories.

The Consumer Self-Care International (CSCI) segment develops, manufactures, markets, and distributes well-known European self-care brands in the natural health and vitamins, cough, cold and allergy, oral care, smoking cessation, personal care, and derma-therapeutics and lifestyle categories (such as XLS MEDICAL, COLDREX, NIQUITIN, DERMALEX, LACTACYD, etc).

The Complainant is the owner of several trademark registrations for PERRIGO, including the following:

- United States trademark registration No. 1773993 for PERRIGO (word mark), filed on March 30, 1992, and registered on June 1, 1993, in International class 5;
- European Union Trade mark registration No. 000176883 for PERRIGO (word mark), filed on April 1, 1996, and registered on December 16, 1999, in International classes 3 and 5;
- United States trademark registration No. 4262523 for PERRIGO (figurative mark), filed on January 11, 2012, and registered on December 18, 2012, in International class 5;

The Complainant is also the owner of the domain name <perrigo.com>, registered on December 21, 1994, and used by the Complainant to promote its pharmaceutical products, and <perrigo.no>, registered on August 31, 2017, in the name of the Complainant’s Norwegian affiliate Perrigo Norge AS and used to promote the PERRIGO products on the Norwegian market.

The disputed domain name was registered on November 23, 2022, and is pointed to a website reproducing all the images and text published on the Perrigo’s official website at <perrigo.no> as well as the contact information of Perrigo Norge AS, replacing only the company email address with another one based on the disputed domain name (“[...]@perrigoshop.com”).

#### **5. Parties’ Contentions**

##### **A. Complainant**

The Complainant contends that the disputed domain name is confusingly similar to the trademark PERRIGO in which the Complainant has rights as it reproduces the trademark in its entirety with the mere addition of the descriptive term “shop” and the generic Top-Level Domain (gTLD) “.com”.

The Complainant contends that the use of the term “shop” does not prevent a finding of confusingly similarity and that, on the contrary, it could make the consumer believe that the website at the disputed domain name is an official PERRIGO online shop.

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant states that it never authorized the Respondent to register the disputed domain name.

The Complainant also submits that the Respondent is not commonly known by the disputed domain name and underlines that the Respondent registered the disputed domain name without any intention to use it in connection with a *bona fide* offering of goods or services, since the website points to a website identical to PERRIGO official website in Norway (“www.perrigo.no”) owned by the Complainant’s Norwegian affiliate Perrigo Norge AS and the Respondent used as contact details on the website “www.perrigoshop.com” the name and address of Perrigo Norge AS, changing only the contact email.

In view of the above, the Complainant submits the Respondent is obviously making an unfair use of the disputed domain name, with the intent to misleadingly divert consumers by a phishing attempt.

With reference to the circumstances evidencing bad faith, the Complainant indicates that, considering the PERRIGO group was created more than 130 years ago, is now well-established in its field in the United States and worldwide, and owns the PERRIGO trademarks all over the world, the Respondent was well aware of the Complainant when registering the disputed domain name.

The Complainant underlines that this is further emphasized by the fact that the disputed domain name is pointed to a website identical to that of Perrigo Norge AS (“www.perrigo.no”) and that in a phishing attempt, the Respondent changed the email address displayed on the website from Complainant’s company email address to [...]@perrigoshop.com.

The Complainant also submits that the use of a Whois privacy service upon registration of the disputed domain name is further proof of the Respondent’s bad faith registration.

## **B. Respondent**

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

## **6. Discussion and Findings**

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**

The Panel finds that the Complainant has established rights over the trademark PERRIGO based on the trademark registrations cited under section 4 above and the related trademark registration details submitted as annexes 6, 7, and 8 to the Complaint.

As highlighted in section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), the first element functions primarily as a standing requirement, and the threshold test for confusing similarity typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the

disputed domain name. Moreover, as found in a number of prior cases decided under the Policy, where a trademark is recognizable within a domain name, the addition of descriptive terms does not prevent a finding of confusing similarity under the first element. See section 1.8 of the [WIPO Overview 3.0](#).

In the case at hand, the Complainant's trademark PERRIGO is entirely reproduced in the disputed domain name, with the mere addition of the dictionary term "shop" and the gTLD ".com", which is commonly disregarded under the first element confusing similarity test (section 1.11 of the [WIPO Overview 3.0](#)).

Therefore, the Panel finds that the Complainant has proven that the disputed domain name is confusingly similar to a trademark in which the Complainant has established rights according to paragraph 4(a)(i) of the Policy.

## **B. Rights or Legitimate Interests**

It is well established that the burden of proof lies on the complainant. However, satisfying the burden of proving a lack of the respondent's rights or legitimate interests in respect of the domain name according to paragraph 4(a)(ii) of the Policy is potentially onerous, since proving a negative can be difficult considering such information is often primarily within the knowledge or control of the respondent.

Accordingly, in line with previous UDRP decisions, it is sufficient that the complainant shows a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name in order to shift the burden of production on the respondent. If the respondent fails to demonstrate rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy or on any other basis, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

In the case at hand, the Panel finds that the Complainant has made a *prima facie* case and that the Respondent, by not having submitted a Response, has failed to demonstrate rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy.

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.

As mentioned above, the disputed domain name has been pointed to a website identical to that of the Complainant's Norwegian affiliate Perrigo Norge AS ("www.perrigo.no"), reproducing all the related images and text, with the only difference that the Respondent changed the contact email address.

The Panel finds that the Respondent's use of the disputed domain name clearly amounts to an attempt to pass off as the Complainant's Norwegian-affiliated company and, therefore, does not constitute a *bona fide* offering of goods or services or a legitimate non-commercial or fair use without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark.

Indeed, as stated in section 2.13.1 of the [WIPO Overview 3.0](#), panels have categorically held that the use of a domain name for impersonation/passing off can never confer rights or legitimate interests on a respondent.

Therefore, the Panel finds that the Complainant has proven that the Respondent has no rights or legitimate interests in the disputed domain name according to paragraph 4(a)(ii) of the Policy.

## **C. Registered and Used in Bad Faith**

Paragraph 4(a)(iii) of the Policy requires that the Complainant proves that the disputed domain name was registered and is being used by the Respondent in bad faith.

As to the bad faith at the time of the registration, the Panel notes that, in light of the Complainant's long and extensive use of the trademark PERRIGO worldwide, including online via the Complainant's website "www.perrigo.com", the Respondent was more likely than not aware of the Complainant's trademark at the time of registration of the disputed domain name, with which it is confusingly similar.

Furthermore, the circumstance that the disputed domain name has been pointed to a website reproducing the Complainant's trademark and contents taken from the Complainant's Norwegian affiliate demonstrates that the Respondent was indeed well aware of the Complainant's trademark and group of companies.

Moreover, the Panel notes that, in view of the use of the disputed domain name to divert users to the website described above, identically reproducing the official website of the Complainant's Norwegian affiliate at <perrego.no>, with the sole substitution of the contact email address with an email address based on the disputed domain name, the Respondent clearly intentionally attempted to attract Internet users to its website, very 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.

Therefore, the Panel finds that the Complainant has also proven that the Respondent registered and is using the disputed domain name in bad faith according to 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 <perrigoshop.com> be transferred to the Complainant.

*/Luca Barbero/*

**Luca Barbero**

Sole Panelist

Date: February 24, 2023