

ADMINISTRATIVE PANEL DECISION

Actavis Group PTC ehf, Actavis Holdco U.S., Inc. v. Ostav Viktor Viktorovich
Case No. D2023-1244

1. The Parties

The Complainants are Actavis Group PTC ehf, Iceland (the “Complainant 1”) and Actavis Holdco U.S., Inc., United States of America (the “Complainant 2”), represented by SILKA AB, Sweden.

The Respondent is Ostav Viktor Viktorovich, Russian Federation.

2. The Domain Name and Registrar

The disputed domain name <actavisdoublecup.store> (the “Domain Name”) is registered with Beget LLC (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on March 22, 2023. On March 22, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On March 29, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Privacy Protect, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainants on March 29, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amendment to the Complaint on April 3, 2023.

On March 29, 2023, the Center sent an email to the Parties in both English and Russian regarding the language of the proceedings. On April 3, 2023, the Complainants reconfirmed its request that English be the language of the proceedings. The Respondent did not provide any comments regarding the language of the proceedings.

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 in English and Russian, and the proceedings commenced on April 4, 2023. In accordance with the

Rules, paragraph 5, the due date for Response was April 24, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 25, 2023.

The Center appointed Piotr Nowaczyk as the sole panelist in this matter on May 4, 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 Complainants are part of a global pharmaceutical group of companies focused on acquiring, developing, manufacturing and marketing the pharmaceuticals, generic and over-the-counter medicines and biologic products. The Complainants have a commercial presence in approximately 100 countries.

The Complainant 1 is the owner of numerous ACTAVIS trademark registrations, including:

- the International Trademark Registration ACTAVIS No. 827298 registered on March 15, 2004;
- the International Trademark Registration ACTAVIS No. 1161504 registered on November 2, 2012; and
- the European Union Trade Mark Registration ACTAVIS No. 003615721 registered on January 16, 2006.

The Complainant 2 is also the owner of ACTAVIS trademark registrations, in particular the United States of America Trademark Registration ACTAVIS No. 3845070 registered on September 7, 2010.

The Complainants are also the owners of numerous domain names incorporating the ACTAVIS trademark, including <actavis.com>.

The Domain Name was registered on January 9, 2023.

As of the date of this Decision, as well as at the time of submitting the Complaint, the Domain Name has resolved to an inactive website.

5. Parties' Contentions

A. Complainant

The Complainants request that the Domain Name be transferred to the Complainants. According to the Complainants, each of the three elements specified in paragraph 4(a) of the Policy are satisfied in the present case.

First, the Complainants submit that the Domain Name is identical or confusingly similar to the ACTAVIS trademark in which the Complainants have rights.

Second, the Complainants argue that the Respondent has neither rights nor legitimate interests in the Domain Name.

Third, the Complainants contend that the Domain Name was registered and is being used in bad faith.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

6.1. Preliminary Matters

A. Language of the Proceeding

The language of the Registration Agreement for the Domain Name is Russian. Paragraph 11(a) of the Rules provides that “unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding”. The Panel may also order that any documents submitted in a language other than that of the proceeding be translated.

As noted by previous UDRP panels, paragraph 11 of the Rules must be applied in accordance with the overriding requirements of paragraphs 10(b) and 10(c) of the Rules that the parties are treated equally, that each party is given a fair opportunity to present its case, and that the proceeding takes place with due expedition (see, e.g., *General Electric Company v. Edison Electric Corp. a/k/a Edison Electric Corp. General Energy, Edison GE, Edison-GE and EEEGE.COM*, WIPO Case No. [D2006-0334](#)).

The Complainants have submitted a request that the language of the proceeding be English. The Complainants note that the Domain Name is exclusively composed of the Latin characters. Moreover, the Domain Name includes the Complainants’ ACTAVIS trademark together with the English term “double cup”. Finally, the Complainants contend that in order to proceed in this case in Russian language, the Complainants would have to retain specialized translation services at a significant cost. This would impose a financial burden on the Complainants and would cause undue delay of the proceeding.

The Panel agrees that substantial additional expense and delay would likely be incurred if the Complaint had to be translated into Russian. Moreover, the Panel notes that the Respondent did not comment on the language of the proceeding, even though it was notified in English and Russian regarding the language of the proceeding.

Thus, taking these circumstances into account, the Panel finds that it is appropriate to exercise its discretion and allow the proceeding to be conducted in English.

B. Consolidation of Multiple Complainants

Neither the Policy nor the Rules expressly provide for the consolidation of multiple complainants, and generally read in singular terms of a “complainant” when referring to proceedings under the Policy. See *MLB Advanced Media, The Phillies, Padres LP v. OreNet, Inc.*, WIPO Case No. [D2009-0985](#). Nonetheless, 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. See section 4.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

Moreover, it is 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. See section 1.4.1, [WIPO Overview 3.0](#).

In the present case the Panel finds that as the Complainants are affiliated companies it is both equitable and procedurally efficient to allow the Complainants to proceed with the single consolidated Complaint.

6.2. Substantive Matters – Three Elements

Paragraph 4(a) of the Policy places a burden on the Complainants to prove the presence of three separate elements, which can be summarized as follows:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainants have rights;
- (ii) the Respondent has no rights or legitimate interests in the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

The requested remedy may only be granted if the above criteria are met.

At the outset, the Panel notes that the applicable standard of proof in UDRP cases is the “balance of probabilities” or “preponderance of the evidence”. See section 4.2, [WIPO Overview 3.0](#).

A. Identical or Confusingly Similar

The first element that the Complainants must establish is that the Domain Name is identical or confusingly similar to the trademark in which the Complainants have rights.

The Complainants hold valid ACTAVIS trademark registrations which precede the registration of the Domain Name. The Domain Name incorporates this trademark in its entirety. As numerous UDRP panels have held, incorporating a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to a registered trademark (see *PepsiCo, Inc. v. PEPSI, SRL (a/k/a P.E.P.S.I.) and EMS COMPUTER INDUSTRY (a/k/a EMS)*, WIPO Case No. [D2003-0696](#)).

The addition of the term “doublecup” in the Domain Name does not prevent a finding of confusing similarity between the Domain Name and the Complainants’ ACTAVIS trademark. UDRP panels have consistently held that where the relevant trademark 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 section 1.8, [WIPO Overview 3.0](#).

The generic Top-Level Domain (“gTLD”) “.store” in the Domain Name is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. See section 1.11.1, [WIPO Overview 3.0](#).

Given the above, the Panel finds that the Domain Name is confusingly similar to the Complainants’ ACTAVIS trademark. Thus, the Complainants have proved the requirements under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under the second element, the Complainants must prove that the Respondent has no rights or legitimate interests in the Domain Name.

The respondent may establish a right or legitimate interest in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- (i) that it has used or made 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 prior to the dispute; or
- (ii) that it is commonly known by the domain name, even if it has not acquired any trademark rights; or

- (iii) that it 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.

Although given the opportunity, the Respondent has not submitted any evidence indicating that any of the circumstances foreseen in paragraph 4(c) of the Policy are present in this case.

On the contrary, it results from the evidence in the record that the Complainants' ACTAVIS trademark registrations predate the Respondent's registration of the Domain Name. There is no evidence in the case record that the Complainants have licensed or otherwise permitted the Respondent to use the ACTAVIS trademark or to register the Domain Name incorporating this trademark. There is also no evidence to suggest that the Respondent has been commonly known by the Domain Name.

Moreover, it results from the evidence on record that the Respondent does not make use of the Domain Name in connection with a *bona fide* offering of goods or services, nor does it make a legitimate noncommercial or fair use of the Domain Name. On the contrary, at the time of submitting the Complaint and as of the date of this Decision, the Domain Name has resolved to an inactive website. In fact, it does not result from the case evidence that the Domain Name has been used in any active way to date.

Given the above, the Respondent has failed to invoke any circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in respect of the Domain Name. Thus, there is no evidence in the case file that refutes the Complainants' *prima facie* case. The Panel concludes that the Complainants have also proved the requirement under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under the third element, the Complainants must prove that the Domain Name has been registered and is being used in bad faith.

Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark. See section 3.1, [WIPO Overview 3.0](#).

Under paragraph 4(b) of the Policy, evidence of bad faith registration and use includes without limitation:

- (i) circumstances indicating the domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the owner of a trademark or to a competitor of the trademark owner, for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name; or
- (ii) circumstances indicating that the domain name was registered in order to prevent the owner of a trademark from reflecting the mark in a corresponding domain name, provided it is a pattern of such conduct; or
- (iii) circumstances indicating that the domain name was registered primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the domain name has intentionally been used in an attempt to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with a trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on a website or location.

As indicated above, the Complainants' rights in the ACTAVIS trademark predate the registration of the Domain Name. This Panel finds that the Respondent was or should have been aware of the Complainants' trademark at the time of registration, as it has been proven to the Panel's satisfaction that the Complainants' ACTAVIS trademark is well known and unique to the Complainants. Thus, the Respondent could not likely reasonably ignore the reputation of products and services under this trademark. In sum, the Respondent in

all likelihood registered the Domain Name with the expectation of taking advantage of the reputation of the Complainants' ACTAVIS trademark.

Furthermore, as of the date of this Decision, as well as at the time of submitting the Complaint, the Domain Name has resolved to an inactive website. Considering the overall circumstances of this case, the Panel finds that the Respondent's passive holding of the Domain Name does not prevent a finding of bad faith. As numerous UDRP panels have held, passive holding, under the totality of circumstances of the case, would not prevent a finding of bad faith under the Policy. See section 3.3, [WIPO Overview 3.0](#). Here, given the well-known nature of the Complainants' trademark, the Respondent's failure to participate in the proceeding, and the implausible good faith use to which the Domain Name may be put, the Panel agrees with the above.

In addition, the Respondent's use of a privacy service that concealed the registrant information in this case is a further evidence of bad faith.

For the reasons discussed above, the Panel finds that the Complainants have proved the requirements 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 Domain Name <actavisdoublingcup.store> be transferred to the Complainants.

/Piotr Nowaczyk/

Piotr Nowaczyk

Sole Panelist

Date: May 18, 2023