

ADMINISTRATIVE PANEL DECISION

Actavis Group PTC ehf and Actavis Holdco U.S., INC. v. Masadepan 2toto Case No. D2023-5252

1. The Parties

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

The Respondent is Masadepan 2toto, Cambodia.

2. The Domain Name and Registrar

The disputed domain name <actavisonlineshop.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 18, 2023. On December 19, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 19, 2023, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 19, 2023, 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 December 20, 2023.

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 January 5, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 25, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 26, 2024.

The Center appointed Kateryna Oliinyk as the sole panelist in this matter on January 31, 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 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.

After acquisition of the acquisition of Irish-based Allergan Inc back in 2015, Actavis PLC officially changed its name to Allergan plc, but the ACTAVIS name has been retained for the Complainants' U.S. and Canadian generics business.

On August 2, 2016, Teva Pharmaceutical Industries Ltd and Allergan plc announced that Teva had completed its acquisition of Allergan's generics business ("Actavis Generics"). The Complainants are now an indirect wholly-owned subsidiary of Teva Pharmaceutical Industries Ltd, a leading global pharmaceutical company headquartered in Israel, and the world's largest generic medicines producer.

One of the Complainants, Actavis Group PTC ehf, is the registered holder of numerous trademark registrations for the ACTAVIS trademark, including the following:

- International Trademark Registration No. 827298 for ACTAVIS, registered on March 15, 2004, for goods and services in International Classes 1, 3, 05, 10, 42, 44;
- European Union Trademark Registration No. 003615721 for ACTAVIS, registered on January 16, 2006, for goods and services in International Classes 1, 3, 5, 10, 42, 44;
- International Trademark Registration No. 1161504 for ACTAVIS & device, registered on November 2, 2012, for goods and services in International Classes 1, 3, 05, 41, 42.

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

The disputed domain name was created on November 13, 2023. The disputed domain name used to resolve to a website containing pay-per-click ("PPC") advertising links that redirected to websites competing with the Complainant's business. For the time of the administrative proceedings, the disputed domain name resolves to an inactive website. Mail eXchange ("MX") records, necessary for sending and receiving emails using the disputed domain name, have been activated for the disputed domain name on the hosting server.

5. Parties' Contentions

A. Complainants

The Complainants contend that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Identical or Confusingly Similar

The Complainants contend that the disputed domain name and the ACTAVIS trademark are confusingly similar.

According to the Complainants' contentions, the disputed domain name incorporates the Complainant's ACTAVIS trademark in full, followed by the generic terms "online" and "shop", and then by the generic top-level domain ("gTLD") ".com".

No Rights or Legitimate Interests

The Complainants contend that the Respondent has no rights or legitimate interests in the disputed domain name.

According to the Complainants' contentions, the use of the Complainants' ACTAVIS trademark significantly predates creation of the disputed domain name.

The Complainants further claim that the Complainants' registered ACTAVIS trademark is a distinctive term, exclusively associated with the Complainants. The disputed domain name is certainly 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 Complainants assert that the Respondent was seeking to create an impression of an association with the Complainants.

The Complainants further submit that the parking page to which the disputed domain name resolved is designed to lure consumers in search of its well-known brand to redirect to other pharma-related websites, through which the Respondent derives commercial benefit.

The Complainants also claim that, through the use of the disputed domain name, the Respondent is deliberately trying to portray a connection with the Complainants and thereby intends to "pass off" as the Complainants and have a free ride on their reputation and goodwill.

Registered and Used in Bad Faith

The Complainants submit that the Respondent registered and is using the disputed domain name in bad faith. The Respondent must have been aware of the Complainants' ACTAVIS trademark when it registered the disputed domain name. The Complainants contend that the disputed domain name is used with the view of attracting Internet users for commercial gain by creating a likelihood of confusion with the Complainants' trademark.

The Complainant asserts that the mere fact of registration of the disputed domain name that is confusingly similar or identical to a famous trademark by an entity that has no relationship to that mark is itself evidence of bad faith registration and use.

The Complainants contend that the availability of MX records to be indicative of bad faith use of the disputed domain name.

The Complainants claim that the Respondent is using Complainants' ACTAVIS trademark to divert Internet users to the Respondent's website for Respondent's commercial gain.

B. Respondent

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

6. Discussion and Findings

6.1. 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 Matter

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: “[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 Complainants must prove each of the following:

- i. that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainants 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.

Considering that the Respondent did not reply to the Complainants’ contentions, in order to determine whether the Complainants have met its burden as stated in paragraph 4(a) of the Policy, the Panel bases its decision on the statements and documents submitted and in accordance with the Policy and the Rules. Under paragraph 14(b) of the Rules, where a Party does not comply with any provision of the Rules, the Panel “shall draw such inferences therefrom as it considers appropriate”.

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 3.0](#), section 1.7.

Under the first element, the Complainants must establish that the disputed domain name is identical with, or confusingly similar to the Complainants’ trademark rights.

There are two parts to this inquiry: (i) the Complainants must demonstrate that it has rights in a trademark and, if so, (ii) the disputed domain name must be shown to be identical or confusingly similar to the trademark.

According to section 1.1.1 of the [WIPO Overview 3.0](#), the term “trademark or service mark” as used in UDRP paragraph 4(a)(i) encompasses both registered and unregistered (sometimes referred to as common law) marks.

Ownership of a nationally or regionally registered trademark serves as a prima facie evidence that the Complainants have trademark rights for the purposes of standing to file this Complaint. See section 1.2 of the [WIPO Overview 3.0](#). The Complainants submitted evidence that the ACTAVIS trademark enjoys protection under regional and international trademark registrations.

Therefore, the Complainants have 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 Panel has established that the disputed domain name contains the ACTAVIS trademark followed by the terms “online” and “shop”, and finally followed by the gTLD “.com”.

Although the addition of other terms (here, “online” and “shop”) may bear on assessment of the second and third elements, the Panel finds the addition of such terms 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.

Under section 1.7 of the [WIPO Overview 3.0](#), while each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.

It is the view of the Panel that it is readily apparent that the Complainants’ ACTAVIS trademark remains recognizable in 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 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 Complainants have established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainants’ 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 case filing, the Panel establishes that there is no evidence that the Respondent is a licensee of, or otherwise affiliated with, the Complainants, and apparently, it has not been authorized by the Complainants to use its ACTAVIS trademark.

Based on the present case records, the Panel finds that 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. See, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones TheDotCafe*, WIPO Case No. [D2008-0642](#).

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.

Simply holding the disputed domain name does not, in the absence of other evidence, amount to use for a bona fide offering of goods or services. Nor does the previous use of the disputed domain name for a parking page with PPC links.

Non-use of the disputed domain name constitutes passive holding and so the disputed domain name is not used in connection with a bona fide offering of goods or services. The Panel finds that the passive holding of the disputed domain name does not constitute legitimate noncommercial or fair use of the disputed domain name. See, by way of example, *Skyscanner Limited v. WhoisGuard Protected, WhoisGuard, Inc. / petrov petya*, WIPO Case No. [DCC2020-0003](#); *Instagram, LLC v. Zafer Demir, Yok*, WIPO Case No. [D2019-1072](#) “The passive holding of the disputed domain name does not amount to use or preparations to use it in connection with a bona fide offering of goods and services. Nor is there any evidence which indicates that the Respondent is commonly known by the disputed domain name. Nor does a passive holding of the disputed domain name comprise a legitimate noncommercial or fair use of it.”

The Panel noted that the disputed domain name used to resolve to the parked page comprising PPC links that redirected to websites competing with the Complainants’ business.

The Panel notes the statements in the [WIPO Overview 3.0](#) on the question of whether “parked” pages comprising PPC links support the Respondent’s rights or legitimate interests. Section 2.9 of the [WIPO Overview 3.0](#) stated that:

“[a]pplying UDRP paragraph 4(c), panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant’s mark or otherwise mislead Internet users.

Panels have recognized that the use of a domain name to host a page comprising PPC links would be permissible – and therefore consistent with respondent rights or legitimate interests under the UDRP – where the domain name consists of an actual dictionary word(s) or phrase and is used to host PPC links genuinely related to the dictionary meaning of the word(s) or phrase comprising the domain name, and not to trade off the complainant’s (or its competitor’s) trademark.”

In the present case, the Respondent’s use of the confusingly similar disputed domain name to host a parking page with PPC links referring to the services competing with the Complainants’ and offered by third parties does not, absent any further explanation, provide the Respondent with rights or legitimate interests in the disputed domain name as the services advertised on the website to which the disputed domain name resolve do not correspond to any obvious meaning of the phrase comprising the disputed domain name. The Respondent’s use of the disputed domain name is not bona fide, but rather evidence of bad faith, seeing as the Respondent presumably receives click-through-revenue by virtue of the misled Internet users drawn to the PPC site because of the confusingly similar disputed domain name.

Hence the Respondent’s use of the confusingly similar disputed domain name to host a parking page with PPC links does not, absent any further explanation, provide the Respondent with rights or legitimate interests in the disputed domain name.

Having reviewed the available record, the Panel finds the Complainants have established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainants' 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.

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.

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. [WIPO Overview 3.0](#), section 3.2.1.

Panels have found that the non-use of a domain would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the current non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although 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, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3.

The Panel notes that at the point of issuance of this Decision the website associated with the disputed domain name is "passively held".

The particular circumstances of this case that the Panel has considered are:

- i. the Complainants' ACTAVIS trademark is considered as being a well-known and reputable trademark;
- ii. the disputed domain name consists of the Complainants' registered ACTAVIS trademark, with the additional of the generic terms, that consumers would associate with sales by the Complainants of their merchandise as sold under the Complainants' trademark;
- iii. the Respondent has not submitted any response and has not provided any evidence of actual or contemplated good-faith use;
- iv. the Respondent concealed its identity;
- v. the implausibility of any good faith use to which the disputed domain name may be put.

The Complainants also note that the disputed domain name used to resolve to a parking page with PPC links and the including hyperlinks competing with and/or relating to the Complainants' business. Furthermore, MX records, necessary for sending and receiving email using the disputed domain name, have been activated for the disputed domain name on the hosting server.

In these circumstances, where the Respondent has offered no plausible explanation for the registration of the disputed domain name, the Panel finds that the Respondent has been using the disputed domain name to intentionally attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the ACTAVIS trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent. See [WIPO Overview 3.0](#), section 3.1.4.

Respectively, the Panel finds that the use of a domain name that is identical or confusingly similar to a trademark to obtain click-through-revenue can amount to bad faith use (see, among others, *Ifscience Limited v. Domains By Proxy LLC / Dr Chauncey Siemens*, WIPO Case No. [D2016-0909](#); and *AMADEUS IT GROUP, S.A. v. Contact Privacy Inc. Customer 0151133672, Contact Privacy Inc. Customer 0151133672 / Milen Radumilo*, WIPO Case No. [D2018-2192](#)).

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 <actavisonlineshop.com> be transferred to the Complainants.

/Kateryna Oliinyk/

Kateryna Oliinyk

Sole Panelist

Date: February 14, 2024