

ADMINISTRATIVE PANEL DECISION

Viatrix Specialty LLC v. xiaobing tang
Case No. D2023-4311

1. The Parties

The Complainant is Viatrix Specialty LLC, United States of America ("United States"), represented by The Webb Law Firm, United States.

The Respondent is xiaobing tang, China.

2. The Domain Name and Registrar

The disputed domain name <viagrahk.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 October 17, 2023. On October 18, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 18, 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 (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 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 October 19, 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 November 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 22, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on November 27, 2023.

The Center appointed Kateryna Oliynyk as the sole panelist in this matter on December 12, 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 global generics and specialty pharmaceuticals healthcare company. The Complainant states that it has acquired a controlling interest in a number of top-producing active pharmaceutical companies for generic drugs. It also develops and produces medicines for a wide range of medical disciplines.

The Complainant is the successor-in-title of the portfolio of the trademarks corresponding and/or including the VIAGRA trademark, which has been previously owned by Pfizer.

The Complainant is, *inter alia*, the owner of the following trademark registrations in many jurisdictions including in Hong Kong, China:

- United States Trademark Registration No. 2,162,548 for VIAGRA, registered on June 2, 1998, for compound for treating erectile dysfunction in International Class 5;
- European Union Trade Mark Registration No. 012547402 for VIAGRA, registered on July 7, 2015, for goods and services in International Classes 1, 3, 9, 10, 16, 25, 28, 31, 33, 35, 41, 42 and 44;
- Hong Kong, China Trademark Registration No. 199711657 for VIAGRA, registered on November 26, 1997, for pharmaceutical, veterinary and sanitary preparations in International Class 5.

The disputed domain name was created on August 22, 2022 and resolves to a commercial website mimicking the official website of the Complainant's predecessor-in-interest.

5. Parties' Contentions

A. Complainant

The Complainant contends 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 Complainant contends that the disputed domain name and the VIAGRA trademark are confusingly similar.

According to the Complainant's contentions, the disputed domain name incorporates the Complainant's VIAGRA trademark as the dominant portion of the disputed domain name, without any variations.

The Complainant contends that the addition of the term "hk", which is a two-letter international country code for Hong Kong, China, in the disputed domain name does not prevent a finding of confusing similarity between the disputed domain name and the VIAGRA trademark.

No Rights or Legitimate Interests

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant further submits that the Respondent is not using the disputed domain name in connection with *bona fide* offering of goods or services.

The Complainant asserts that the Respondent has not licensed or otherwise permitted the Respondent to register a domain name incorporating the VIAGRA trademark. The Respondent is also unable to receive any license or permission from Pfizer, as Pfizer does not have any rights to the VIAGRA trademark any longer.

The Complainant further indicates that the Respondent's website under the disputed domain name includes Pfizer's logo and creates the false commercial impression that the Respondent is authorized to use the VIAGRA trademark. As Pfizer is the previous owner of the VIAGRA trademark the rights to which have been assigned to the Complainant, the use of the disputed domain name will mislead the consumers as to the correct sources of the goods.

Registered and Used in Bad Faith

The Complainant submits that the Respondent registered and is using the disputed domain name in bad faith.

The Complainant submits that the Respondent has actual or constructive knowledge of the VIAGRA trademark when it registered the disputed domain name.

The Complainant contends 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 Complainant's trademark.

In this context the Complainant asserts that the Respondent is attempting to create a false association with the Complainant to mislead the consumers of Hong Kong, China. The Respondent's use of the logo of Pfizer, which was the Complainant's predecessor-in-interest with respect to the VIAGRA trademark, demonstrates that the Respondent is well aware that it does not own or have any right to the VIAGRA trademark, as used in the disputed domain name and on the website to which the disputed domain name resolves. Use of the Pfizer logo also demonstrates the Respondent's intent to lure consumers to its website. The Respondent's use of the Pfizer logo is an attempt to give an air of legitimacy to the Respondent's otherwise fraudulent website. Therefore, the Complainant asserts that this indicates that the Respondent has registered the disputed domain name in order to disrupt or damage the Complainant's business by misleading consumers in Hong Kong, China searching for information on the Complainant's products labelled with the VIAGRA trademark.

B. Respondent

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

6. Discussion and Findings

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 Complainant 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 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.

Considering that the Respondent did not reply to the Complainant's contentions, in order to determine whether the Complainant has 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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

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.

The Panel finds the mark is recognizable within 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.

Although the addition of other terms here, "hk", may bear on assessment of the second and third elements, the Panel finds the addition of such term 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.

Finally, for the purpose of assessing under paragraph 4(a)(i) of the Policy, the Panel may ignore the generic Top-Level Domain ("gTLD"), see section 1.11.1 of the [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the VIAGRA trademark in which the Complainant has rights.

Based on the available record, 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 Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's *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 Complainant, and apparently, it has not been authorized by the Complainant to use its VIAGRA 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.

Rather, according to the unrebutted evidence of the Complainant, the website at the disputed domain name is mimicking the Complainant's predecessor-in-interest website and allegedly offering for sale the Complainant's products. It does not make it clear that there is no commercial connection with the Complainant. On the contrary, the use of the logo of the Complainant's predecessor-in-interest on the website misleads consumers regarding the origin of goods searching for information on the Complainant's products labelled with the VIAGRA trademark. In the Panel's view, such use demonstrates neither a *bona fide* offering of goods nor a legitimate interest of the Respondent within the meaning of paragraphs 4(c)(i) and (iii) of the Policy.

There is nothing in the case filing that might demonstrate that the Respondent is an affiliated entity or an authorized distributor or reseller of the Complainant and no agreement, express or otherwise, exists allowing the Respondent to use the Complainant's VIAGRA trademark or the Pfizer's logo on the website at the disputed domain name or to use the Complainant's VIAGRA trademark in the disputed domain name. Such use, noting in particular the failure of the Respondent to disclose the lack of relationship with the Complainant on the website at the disputed domain name, would not constitute a fair use (see [WIPO Overview 3.0](#), section 2.8).

Furthermore, the nature of the disputed domain name, that includes the Complainant's well-established trademark plus the geographic term "hk", carries a risk of implied affiliation and cannot constitute a fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

Panels have held that the use of a domain name for illegal activity here (sale of apparently counterfeit goods or illegal pharmaceuticals, impersonation/passing off) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Based on the available record, 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.

In the present case, the Panel considers the following factors: (i) the Complainant's registration and use of the relevant VIAGRA trademark predating the date at which the Respondent registered the disputed domain name, (ii) the reputation of the Complainant's mark, (iii) the failure of the Respondent to submit a response, (iv) the fact that the website to which the disputed domain name resolves displays the Complainant's trademark and product images, as well as the logo of the Complainant's predecessor-in-interest, thus misleading consumers as to the origin of goods, and (v) the fact that the disputed domain name leads to a website which gave the false impression that it was operated by the Complainant's predecessor-in-interest or its official retailer, thus misleading consumers searching for information on the Complainant's products labelled with the VIAGRA trademark and disrupting the Complainant's business.

Given the distinctiveness and renown of the Complainant's VIAGRA trademark, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's VIAGRA trademark, and to target the VIAGRA trademark. By registering and using the disputed domain name to resolve to a website mimicking the Complainant's predecessor-in-interest website, the Respondent has intentionally attempted to attract, for commercial gain, Internet users, by creating a likelihood of confusion with the Complainant's trademark. In the Panel's view, the circumstances of the case represent evidence of registration and use in bad faith of the disputed domain name. The Respondent failed to bring evidence as to the contrary. Consequently, the Panel concludes that the condition of paragraph 4(a)(iii) of the Policy is fulfilled.

Panels have held that the use of a domain name for illegal activity here (sale of apparently counterfeit goods or illegal pharmaceuticals, impersonation/passing off) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitute bad faith under the Policy.

Based on the available record, 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 <viagrahk.com> be transferred to the Complainant.

/Kateryna Oliinyk/

Kateryna Oliinyk

Sole Panelist

Date: January 11, 2024