

Teva Pharmaceutical Industries Ltd. v. Kobi Yosefian

IL-DRP Panel Decision

1. The Parties

The Complainant Teva Pharmaceutical Industries Ltd., Israeli based company, represented by Mr. Jonathan Matkowsky of Matkowsky Law PC.

The Respondent is Kobi Yosefian, of Holon, Israel.

2. The Domain Name and Registrar

The disputed domain names <tevadrgs.co.il> and <teva4me.co.il> are registered with LiveDns Ltd.

3. Procedural History

The Complaint was filed with ISOC-IL on February 23, 2016. The Complaint was transmitted to the Israeli Dispute Resolution Panel of ISOC-IL ("**IL-DRP**") under the IL-DRP Rules ("**Rules**").

On February 25, 2016 the IL-DRP appointed Jonathan Agmon as the sole panelist.

In accordance with the Rules, on February 28, 2016, the Panel transmitted to the Respondent by e-mail a copy of the Complaint and attached materials, providing the Respondent 15 days to respond to the Complaint.

The Respondent did not response to the complaint.

4. Factual Background

The disputed domain name <tevadrgs.co.il> was created on December 10, 2015.

The disputed domain name <teva4me.co.il> was created on April 24, 2015.

The Complainant is a multinational pharmaceutical company headquartered in Petah Tikva, Israel. The Complainant was founded in the year 1901, and it is the world's largest generic medicines producer, leveraging its portfolio of more than 1,000 molecules to produce a wide range of generic products in nearly every therapeutic area.

The Complainant is the owner of numerous trademark registrations for the mark TEVA worldwide. For example: Israeli trademark registration No. 41075 – TEVA טבע, with the registration date of July 5, 1977; U.S. trademark registration No. 1,567,918, with the registration date of November 28, 1989, and many others.

The Complainant also developed its presence on the Internet and is the owner of multiple domain names, consisting of the mark TEVA. For example: <teva.co.il>, <tevapharm.com> and others.

The disputed domain name <tevadrugs.co.il> currently resolves to a webpage offering the disputed domain name for sale.

The disputed domain name <teva4me.co.il> currently resolves to an inactive webpage.

5. Parties' Contentions

A. Complainant

The Complainant argues that both disputed domain names incorporate the entirety of the famous TEVA trademark, with the addition of the generic terms "drugs" and "4me" respectively which does nothing to distinguish the disputed domain name from the Complainant registered trademark.

The Complainant further argues that the Complainant's TEVA mark had been recognized with the Complainant by prior domain disputes resolution panels throughout the world.

The Complainant further argues that the Complainant's TEVA mark is a famous well-known mark globally in the Pharmaceutical & Life Science sector.

The Complainant further argues that the Respondent is not authorized or licensed to use the Complainant's TEVA mark in names, and he has no relationship with the Complainant.

The Complainant further argues that the Respondent is not commonly known by the names of the disputed domain names.

The Complainant further argues that the disputed domain name <teva4me.co.il> has been inactive since it was registered and this is evidence that the Respondent lacks rights and legitimate interest in the name.

The Complainant further argues that the disputed domain name <tevad rugs.co.il> is offered for sale and it is an indication of lack of rights and legitimate interest in the disputed domain name.

The Complainant further argues that the disputed domain name displays a pop-up window with a commercial click-through link and it is attributed to the Respondent and it is not a bona fide offering or a legitimate noncommercial or fair use.

The Complainant further argues that the Respondent has registered other domain name <gumigum.co.il> and offers it for sale, and that this domain name uses other's entity registered trademark. According to the Complainant, it is difficult to accept that his is merely a coincidence, especially when considering other well-known trademarks in the Respondent's portfolio.

The Complainant further argues that the Respondent is using the disputed domain name <tevad rugs.co.il> with a mail server and it is circumstantial evidence that it is being used for illegitimate activities related to Teva's business.

The Complainant argues that the disputed domain names were used in bad faith.

The Complainant further argues that it is inconceivable that Respondent was not familiar with Complainant TEVA trademark when it applied for the disputed domain names.

The Complainant further argues that the Respondent has intentionally chose the disputed domain name in an attempt to profit, as evidenced by offering for sale one of them.

or all of the above reasons, the Complainant requests the transfer of the disputed domain name.

B. Respondent

The Respondent did not respond.

6. Discussion and Findings

The IL-DRP is an alternative dispute resolution procedure intended to provide expedited resolution to disputes regarding the allocation of domain names under the .IL ccTLD in accordance with the Rules. The Respondent submitted to this process and Rules when he applied for and registered the disputed domain name with LiveDns Ltd. registration agreement provides that the applicant for the domain name accepts the ISOC-IL registration rules (see <https://domains.livedns.co.il/Terms.aspx>).

The ISOC-IL registration rules provide that "the [domain name] holder agrees to the jurisdiction of the IL-DRP." (See section 12.3). The Respondent, therefore, by applying for and registering the disputed domain name agreed to the IL-DRP and the Rules.

It is also noted that the Rules now adopted by ISOC-IL follow closely those of the Uniform Dispute Resolution Policy (UDRP) and therefore the WIPO Arbitration and Mediation Center case law (and others interpreting the UDRP) can be used as examples of how previous panels have adopted and interpreted provisions similar to the Rules and UDRP.

The Rules provide that disputes regarding the allocation of a domain name by a Holder may be brought by a Complainant on the following grounds:

- 3.1. the disputed domain name is the same or confusingly similar to a trademark, trade name, registered company name or legal entity registration ("Name") of the Complainant; and
- 3.2. the Complainant has rights in the Name; and
- 3.3. the holder has no rights in the Name; and
- 3.4. the application for allocation of the disputed domain name was made or the disputed domain name was used in bad faith.

A. Same or Confusingly Similar

It is up to the Complainant to show that the disputed domain names are the same or confusingly similar to a trademark, trade name, registered company name or legal entity registration of the complainant.

The Complainant is the owner of many trademark registrations, which consist of the mark TEVA, around the world. For example: Israeli trademark registration No. 41075 – TEVA טבע, with the registration date of July 5, 1977; U.S. trademark registration No. 1,567,918, with the registration date of November 28, 1989, and many others.

The disputed domain name <tevadrgs.co.il> comprises of the Complainant's TEVA trademark with the addition of the word "drugs" and the suffix ".co.il".

The suffix ".co.il" is ignored for the purpose of determination of the similarity between the disputed domain name since it is a common suffix showing that the domain name is part of the .il domain and associated with commercial activities (.co suffix).

The addition of the word "drugs" to the disputed domain name does not serve sufficiently to distinguish or differentiate the disputed domain name from the Complainant's TEVA trademark, as it is a descriptive element that refers to a main category of the Complainant's business.

The disputed domain name <teva4me.co.il> comprises of the Complainant's TEVA trademark with the addition of the numeral 4 and the word "me" which is pronounced "for me" and the suffix ".co.il".

The suffix ".co.il" is ignored for the purpose of determination of the similarity between the disputed domain name since it is a common suffix showing that the domain name is part of the .il domain and associated with commercial activities (.co suffix).

The addition of the term "4me" to the disputed domain name does not serve sufficiently to distinguish or differentiate the disputed domain name from the Complainant's TEVA trademark, as it is only a descriptive element that implies the pronouncement "teva for me".

Previous UDRP panels have ruled that the mere addition of a non-significant element does not sufficiently differentiate the domain name from the registered trademark: "The incorporation of a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to the Complainant's registered mark" (Britannia Building Society v. Britannia Fraud Prevention, WIPO Case No. D2001-0505).

Also, "[t]he Panel has compared the domain name at issue with the Complainant's trademarks INFOSPACE in their entirety, and concludes that the mere addition of the word "India" at the front of the Respondent's domain name is not sufficient to distinguish it from the trademarks of the Complainant. The Panel notes that such addition appears to be made most likely with a[n] intent to induce Internet users to believe that they are connecting their computers with a site pertaining to an Indian affiliate of the Complainant, or to some kind of "Indian operation" of the Complainant (InfoSpace.com, Inc. v. Hari Prakash, WIPO Case No. D2000-0076).

It is therefore, the finding of the Panel that the disputed domain names are confusingly similar to a trademark owned by the Complainant.

B. Rights in the Name

Next, it is up to the Complainant to show that the Complainant has rights in the TEVA trademark, and that the Respondent has no rights in the TEAV trademark.

The Complainant showed sufficient evidence showing it has rights in the TEVA trademark. Furthermore, the Complainant's well established rights in its trademark were asserted by many Administrative Panels, in different countries (See, inter alia: *Teva Pharmaceutical Industries Ltd. V. dh*, CAC Case No. 101041; *Teva Pharmaceutical Industries Ltd v. Kevin Wall*, Claim No. FA1302001483227; and more).

The evidence shows that the Complainant's TEVA trademark has gained significant goodwill, especially in Israel.

It is also up to the Complainant to show that the Respondent has no rights in the Name. The Complainant has provided that it has not approved or permitted for the Respondent to use its trademark or Name.

While the Complainant bears the "general burden of proof" under Rule 3.3, this burden shifts to the Respondent once the Complainant makes a prima facie showing that the Respondent lacks rights or legitimate interests. (See: *Neusiedler Aktiengesellschaft v. Kulkarni*, WIPO Case No. D2000-1769; see also *Dow Jones & Company and Dow Jones LP v. The Hephzibah Intro-Net Project Limited*, WIPO Case No. D2000-0704.)

In the present case, the Complainant alleged that the Respondent has no rights or legitimate interests in respect of the disputed domain names and the Respondent failed to assert any such rights, or legitimate interests.

The Panel finds that the Complainant established such a prima facie case inter alia due to the evidence provided to the Panel and due to the fact that the Complainant has not licensed or otherwise permitted the Respondent to use its TEVA trademark or a variation of it. The Respondent did not submit a response and did not provide any evidence to show any rights or legitimate interests in the disputed domain names. Thus, the Respondent did not rebut the Complainant's prima facie case.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

C. Application and Use in Bad Faith

Finally, it is up to the Complainant to show that the Respondent applied for allocation of the disputed domain names or the disputed domain names were used in bad faith.

WIPO Panels, relying on Rule 4.1 of the UDRP Rules, often rule that the bad faith clause provides a non-exclusive list of circumstances which can be helpful in showing that the Respondent acted in bad faith when he or she applied for or used the disputed domain name:

"For the purposes of [Paragraph 3.4 above], the following circumstances, in particular but without limitation, if found to be present, shall be evidence of the allocation or use of a domain name in bad faith:

- a. the Holder continues to hold the domain name during or after termination of employment or work for hire contract where the domain name allegedly should have been allocated to the employing/contracting party; or
- b. the Holder has requested allocation of the domain name primarily for the purpose of disrupting the business of a competitor; or circumstances indicating that the Holder has requested allocation or holds the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name allocation to the complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; or
- c. the Holder has requested allocation of the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that there is evidence of having engaged in a pattern of such conduct; or
- d. by using the domain name, the Holder has intentionally attempted to attract, for commercial gain, Internet users to its web site or other on-line location, by creating a likelihood of confusion with the Complainant's Name as to the source, sponsorship, affiliation, or endorsement of its web site or location or of a product or service on its web site or location".

Rule 4.1(b) provides that this Panel can find that the Respondent acted in bad faith if there are circumstances showing that the Respondent requested allocation of the disputed domain name primarily for the purpose of disrupting the business of a competitor; or circumstances indicating that the Respondent requested allocation or holds the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name allocation to the Complainant, who is the owner of the trademark or the service mark, or to a competitor of the Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name.

The disputed domain names are confusingly similar to the Complainant's TEVA trademark. Previous WIPO Panels ruled that "a likelihood of confusion is presumed, and such confusion will inevitably result in the diversion of Internet traffic from the Complainant's site to the Respondent's site" (see *Edmunds.com, Inc v. Triple E Holdings Limited*, WIPO Case No. D2006-1095). To this end, prior WIPO Panels have established that attracting Internet traffic by using a domain name that is identical or confusingly similar to a registered trademark is evidence of bad faith under paragraph 4(b)(iv) of the UDRP (see *Humana Inc., op. cit. supra*; *Edmunds.com v. Ultimate Search, Inc.*, WIPO Case No. D2001-1319).

Rule 4.1(d) provides that this Panel can find that the Respondent acted in bad faith if there are circumstances showing that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its web site or other on-line location, by creating a likelihood of confusion with the Complainant's Name as to the source,

sponsorship, affiliation, or endorsement of its web site or location or of a product or service on its web site or location.

The website under the disputed domain name <tevadrugs.co.il> incorporates the Complainant's TEVA trademarks and offers information (in Hebrew) offering the disputed domain name for sale.

The Panel finds, that the use of the disputed domain name <tevadrugs.co.il> offering it for sale is a clear indication of the Respondent knowledge of the Complainant and its registered trademark.

It is also suggestive of the Respondent's bad faith when the trademark of the Complainant was registered before the allocation of the disputed domain name (See: Sanofi-Aventis v. Abigail Wallace, WIPO Case No. D2009-0735). The Complainant's TEVA trademark is registered in Israel since the year 1977 and is well-known worldwide. The Respondent registered the disputed domain name after the Complainant registered its TEVA trademark.

The record also shows that the Respondent has not used the disputed domain name <teva4me.co.il>. The Respondent did not provide any explanation with respect to this disputed domain name. However, in view of the above stated with respect to the <tevadrugs.co.il> disputed domain name, it is suggestive that the Respondent's taking of a second disputed domain name comprising the Complainant trademark in full, even if it is unused, was made when the Respondent was aware of the Complainant's rights and therefore acted in bad faith when registering the <teva4me.co.il> disputed domain name.

The Respondent's passive use of the disputed domain name is also an indication, in this case, of bad faith registration and use of the disputed domain name. This Panel cites with approval that "[t]he concept of a domain name being used in bad faith is not limited to positive action: inaction is within the concept" See Cho Yong Pil v. Kee Dooseok, WIPO Case No. D2000-0754. See also: "[t]he significance of the distinction is that the concept of a domain name 'being used in bad faith' is not limited to positive action; inaction is within the concept. That is to say, it is possible, in certain circumstances, for inactivity by the Respondent to amount to the domain name being used in bad faith" (Telstra Corporation Limited v. Nuclear Marshmallow, WIPO Case No. D2000-0003).

Finally, the evidence shows that the Respondent has been engaged in systematic activity of registering domain names comprising trademarks of known brands and companies. Such systematic behavior is further evidence of bad faith registration and use of the disputed domain names.

These facts are sufficient to establish that the Respondent had registered the disputed domain name in bad faith, as provided in Rule 4.1(b) and 4.1(d). Thus, it is the finding of

the Panel that the Complainants met the burden of showing that the Respondent registered or used the disputed domain name in bad faith in accordance with Rule 3.4.

7. Decision

For all the foregoing reasons, in accordance with the Rules, the Panel orders that the domain name, <tevadrgs.co.il> be TRANSFERRED to the Complainant and the domain name, <teva4me.co.il> be REVOKED.

Jonathan Agmon

Sole Panelist

Date: March 27, 2016.