

Domain Name Dispute Resolution Center (DNDRC)

Arbitration and Mediation Center

COMPLAINT PANEL DECISION

Case No. C2022-0008

Also in PDF C2022-0008

1. The Parties

The Complainant is Gilead Sciences Inc., having its office at 333 Lakeside Drive, Foster City, California 91404, U.S.A. through its authorized representative, Salim Hasan, having his office at Meer & Hassan, Attorneys at Law 306 Al-Faisal Plaza, 48 The Mall, Lahore, Pakistan.

The Respondent's name is Noman Shabbir with his address at Muhalla Al-Qadir Colony Daak, Hafiz Abad, Pakistan.

2. The Domain Names and Registrar

The domain name in dispute is <gilead.com.pk>, hereinafter referred to as the Disputed Domain Name [“the DDN”]. Vide email dated Tuesday 3 June 2022, PKNIC has informed DNDRC that the DDN was registered by Noman Shabbir, with his address at Muhalla Al-Qadir Colony Daak, Hafiz Abad, Pakistan.

3. Procedural History

DNDRC was informed of the Complaint against the Respondent as per PKNIC - Internet Domain Registration Policy, by notification from the Complainant on 13 January 2022.

The Respondent was issued a notification of the dispute along with a copy of the Complaint and a Response Form on 7 June 2022 informing the Respondent that if a Response was not received 10 days from the notification, the dispute would be proceeded ex parte. The Respondent was also issued a reminder notification on 11 June 2022.

The Respondent submitted a response via email on 16 June 2022. The Panel decided to give the Respondent another chance to provide the response by completing the Response Form along with additional time. The Respondent failed to provide a response in the Response Form within the

stipulated time period. The Panel, in interest of justice, has decided to consider the response given via email by the Respondent as the Response and process the Complaint accordingly.

Applying Paragraph 4(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules), DNDRRC appointed Mr. Sunain Qazi as the sole Arbitrator who has verified that the Complaint satisfies the formal requirements of the Policy and the Rules.

Factual Background

The domain name upon which the Complaint is based is <gilead.com.pk>.

PKNIC has confirmed via their email dated 3 June 2022 that the DDN was registered by the Respondent above-named and that the email address provided at the time of registration is mshehbaz629@gmail.com.

4. Parties Contentions

A. Complainant

The Complainant's brief contentions are reproduced below:

The Complainant has obtained registration for the trademark 'GILEAD' for Pharmaceutical, veterinary, and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressing; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides, being goods included in class 5 under registration no. I91092 in Pakistan.

The trademark referred to above is registered in Pakistan in the name of Gilead Sciences, Inc., a company organized and existing under the laws of the State of Delaware in the United States.

Gilead Sciences Inc., ("Gilead" or "the Complainant", for the purposes of the present proceeding the term " the Complainant " and / or "Gilead" shall mean and include the predecessors in title, sister concerns, wholly owned subsidiaries, associated companies, agents, affiliates, etc.), founded in 1987 in Foster City, California, is a biopharmaceutical company. Since commencement of operations, Gilead has grown into USD 24.7 billion company with over 12,000 employees around the world, including Canada, Brazil, Hong Kong, India, Korea, Japan, United Kingdom (International Headquarters), Australia, Austria, Belgium, Czech Republic, Denmark, France, Germany, Greece, Ireland, Italy, Netherlands, Norway, Poland, Portugal, Russia, Spain, Sweden, Switzerland, Turkey, and the United States of America. Gilead markets, distributes, and sells its biopharmaceutical products throughout the world. Copy of the Complainant's incorporation certificate is annexed as Exhibit-A.

Gilead appointed Ferozsons Laboratories Limited (Ferozsons) as its authorized partner in Pakistan in June 2014 under the Gilead Access Program, which aims to make cutting-edge drugs available to people suffering from life threatening diseases in developing and low-income countries. Printouts of the Complainant's Regional Business Partners List from Gilead's website are annexed as Exhibit-B.

Recently, Gilead entered into a non-exclusive license agreement with BF Biosciences Limited (BFBL) a subsidiary of Ferozsons, for the manufacture and sale of remdesivir (which is used to treat SARS-COV2), under Gilead's Global Patient Solutions Program serving the developing world for distribution in 127 countries. Under the licensing agreements, the companies have a right to receive a technology transfer of the Gilead manufacturing process for remdesivir to enable them to scale up production more quickly to aid global efforts to fight the pandemic. Therefore, the general public in Pakistan are well aware of Gilead and associate the name/trademark/service mark Gilead and the domain name 'gilead.com' (hereinafter referred to as the "earlier domain name") exclusively with the Complainant alone. Printouts of relevant documents in support of the aforesaid from Gilead's website are annexed as Exhibit-C

'Gilead', which was adopted in June 1987, is the key part of the Complainant's trade name and its house mark. The Complainant is also the owner of trademark registrations for GILEAD in over 40 countries, including in Pakistan, in relation to "pharmaceutical preparations and substances...". A list of international trademark registrations for 'Gilead' is annexed herewith as Exhibit-D. Some randomly chosen copies of registration certificates for the trademark GILEAD registered world-wide are marked as Exhibit-E. Copy of 'Gilead', which was adopted in June 1987, is the key part of the Complainant's trade name and its house mark. The Complainant is also the owner of trademark registrations for GILEAD in over 40 countries, including in Pakistan, in relation to "pharmaceutical preparations and substances..." A list of international trademark registrations for 'Gilead' is annexed herewith as Exhibit-D. Some randomly chosen copies of registration certificates for the trademark GILEAD registered world-wide are marked as Exhibit-E. Copy of trademark registration numbers 191092 and 542880 for the trademark 'Gilead' in Pakistan is annexed as Exhibit-F. Renewal certificate is annexed as Exhibit-G.

Gilead is also the owner of the earlier domain name "gilead.com" since as early as May 27, 1995. Extract from WHOIS database in relation to the said domain is annexed as Exhibit-H.

Gilead also owns trademark registrations and applications for the trademark  GILEAD and uses such trademarks throughout the world. Gilead also owns numerous trademark registrations and applications for Gilead also owns trademark registrations and applications for brand names of products, namely; HEPSERA, TRUVADA, VIREAD, and AMBISOME in over 40 countries.

The Complainant came to know about the Disputed Domain Name through a global watch service, which was hired by the Complainant to protect its Intellectual Property rights. The

watch notice revealed that the Disputed Domain Name "gilead.com.pk" has been registered by an unknown person or entity (hereinafter referred to as "the Respondent"). Identity of the Respondent is not known as this information has not been made available in the WHOIS records. Extract from PKNIC's WHOIS database pertaining to the Disputed Domain Name is annexed as Exhibit-I.

Therefore, the Complainant seeks the following remedies:

In accordance with Paragraph 4(i) of the Policy, for the reasons described in Section 8 above, the Complainant requests the Administrative Panel appointed in this administrative proceeding that either the Disputed Domain Name be transferred to the Complainant or the Disputed Domain Name be cancelled.

B. Respondent

The Respondent's contentions are reproduced below:

As per addressing the complaint that my domain (www.gilead.com.pk) is being used in bad faith.

According to my knowledge and my experience as I am a Lawyer by profession and I have been doing this business for the past 5 years. if we are dealing with. This way we can write to any domain that they are using the domain in bad faith. I got the domains then sold them. I invested my money on them to earn money from it by selling them. I know my legal rights regarding this, My domain is here for sale, and if they want to purchase it contact my provider. If they challenge us legally they have to know that names are being patented under the ordinance 2000 and 2003. if they are the inventor or founder of their invention. My domains are only for sale, no business activity or services are being launched on them. And no business services or any kind of activity is running on this domain.

if they still want this dirty game for buying my domain on this free tag. So they are wrong. I know my rights. I know my business legality we can see others in Court.

5. Jurisdiction

The Panel's jurisdiction over this dispute between the Complainant and the Respondent is established by virtue of the Internet Domain Registration Policy version 4.4 (2019-08-19) and the Rules.

The Respondent applied for and was granted registration of the DDN based on these regulations, and has submitted to, the PKNIC - Internet Domain Registration Policy version 4.4 (2019-08-19)

and the Rules and correspondingly to the arbitral jurisdiction of the DNDRC and its arbitration decisions.

6. Discussion and Findings

In the landmark case of *Standard Chartered PLC v. Hosting Campus Domain* (case no. C2007-0001) available on the DNDRC website (http://www.dndrc.com/cases_resolved/pdf/c2007-0001.pdf), the Panel laid down the following four heads under which to analyze cases, under the Internet Domain Registration Policy version 4.4 (2019-08-19) and the UDRP:

1. *Illegality, unlawfulness or otherwise invalidity of the Application & Registration (a criteria in terms of the PKNIC - Internet Domain Registration Policy June 20, 2006, version 4.1 in addition to the criteria of the UDRP)*
2. *Identical or confusing similarity to a trademark or service mark in which the Complainant has rights (a UDRP criteria)*
3. *Legitimate interest in Domain Name (a UDRP criteria)*
4. *Registration and use in bad faith (a UDRP criteria)*

The decision of the dispute shall be addressed with respect to the following aspects:

- i. *Illegality, unlawfulness or otherwise invalidity with respect to the Application & Registration (a PKNIC - Internet Domain Registration Policy version 4.4 (2019-08-19) criteria).*
- ii. *Identical or confusing similarity with a trademark or service in which the Complainant has rights (a UDRP criteria).*
- iii. *Legitimate interest in the domain name (a UDRP criteria).*
- iv. *Registration and use of the domain name in bad faith (a UDRP criteria).*

I. Illegality, unlawfulness or otherwise invalidity of the Application & Registration

The PKNIC - Internet Domain Registration Policy version 4.4 (2019-08-19) states that it creates an exception for, and thus excludes the registration of a domain name that:

- a. *infringes upon a registered tradename,*
- b. *is not bona fide as recognized by international best practice,*
- c. *in the opinion of PKNIC, a contravention of the latest version of the Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/ Anti-Terrorism Act, 1997/any applicable criminal law,*

- d. has been declared by a Criminal Court of appropriate jurisdiction to have contravened the latest version of Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/Anti-Terrorism Act, 1997/any applicable criminal law), or*
- e. in the opinion of PKNIC is not appropriate for registration.*

As per the PKNIC - Internet Domain Registration Policy version 4.4 (2019-08-19),

If a party claims that a domain name already registered with PKNIC violates their registered tradename, an obvious derivation of their registered company name is not bona fide as recognized by international best practice, and is a contravention in the opinion of PKNIC to be a contravention of the latest version of the Pakistan Penal Code Act, 1860 (including offences of defamation & blasphemy)/ Anti-Terrorism Act, 1997/any applicable criminal law, PKNIC reserves the right to cancel, or transfer the domain to the claiming party as per the ICANN's Uniform Domain Name Dispute Resolution Policy [UDRP] (with PKNIC amendments) or as per the orders of a court judgment in Pakistan.

Therefore, for the purpose of assessing illegality, unlawfulness or otherwise invalidity of the Application & Registration of the DDN, the application and registration of the DDN shall be assessed in consideration of the following criteria:

- i. Whether the DDN infringes upon a registered trade name / trademark?
- ii. Whether the application and/or registration of the DDN is bona fide?
- iii. Whether the application and/or registration of the DDN contravenes the Pakistan Penal Code, 1860 (the “Penal Code”) or any applicable criminal law?

The Complainant and the Respondent have not submitted any contention with respect to this issue.

The Panel has conducted its own assessment and has concluded that the Complainant has provided copies of certificates of registration indicating that it has registered the word mark “GILEAD”. The Panel finds that the Complainant has submitted sufficient evidence that it has trademark rights in the word “GILEAD”. The DDN does prima facie incorporate in its entirety the registered trademark of the Complainant. In the view of the Panel, the DDN therefore infringes upon the trademark of the Complainant.

In the absence of any information provided by the Respondent, the Panel is unable to infer whether the Respondent also has rights to the term “GILEAD” that would indicate that the registration of the DDN by the Respondent was bona fide.

In view of the findings of the Panel that the DDN, which incorporates a registered trademark of the Complainant in its entirety, constitutes an infringement of the trademark of the Complainant in its entirety, the Panel, relying on the findings in *Standard Chartered PLC v. Hosting Campus*

Domain (case no. C2007-0001), also finds that the registration will contravene relevant provisions of the Pakistan Penal Code.

The Panel therefore finds that the registration of the DDN is unlawful. The Panel may decide this Complaint on this basis alone. However, for the sake of completeness and procedural fairness, but not to create a binding precedent, this Panel shall also assess the Complaint in terms of the ICANN UDRP as amended by the PKNIC - Internet Domain Registration Policy version 4.4 (2019-08-19).

II. Identical or confusing similarity to a trademark or service mark in which the Complainant has rights

The Complainant has contended the following:

- *Complainant, founded in 1987, discovers, develops and commercializes innovative medicines in areas of unmet medical need.*
- *In 2020, Gilead's total worldwide revenue was approximately USD \$24.6 billion. A copy of an excerpt from Gilead's 2020 Form 10-K is attached hereto as Exhibit-J.*
- *In 2020, Gilead was listed as #140 in the Fortune 500 Companies rankings. Gilead is regularly listed in the Fortune 500 Companies and Forbes' World's Best Employers rankings. Copies are appended hereto as Exhibit-K.*
- *Gilead develops, manufactures, and offers for sale over twenty-five pharmaceutical products, including BIKTARVY, EPCLUSA and TRUVADA. Gilead sells products which prevent and treat HIV infection and products which cure Hepatitis C. Gilead's recently approved pharmaceutical product, BIKTARVY, had sales exceeding US \$4.7 billion in 2019 in the United States alone.*
- *Gilead is a member of the S&P 500 and employs over 12,000 individuals worldwide. Unsolicited Internet sources and news articles demonstrate that the GILEAD brand is well known and famous for pharmaceutical products and medical information services (see, for example, Business wire press release from March 2019 regarding data on Biktarvy® and Wikipedia page for Gilead Sciences attached as Exhibit-L).*
- *The GILEAD mark serves as a valuable identifier of Gilead, the company, as well as its various goods and services such as its pharmaceutical medications, health information and education services, and its pharmaceutical research and*

charitable services. Through longstanding use and the tremendous success of its products, the GILEAD name has gained significant recognition in the United States and throughout the world, including Pakistan. Gilead has been the subject of hundreds of unsolicited news articles in such well-known publications as the New York Times, Wall Street Journal, Washington Post and national television and radio networks, thrusting Complainant and the GILEAD brand into the limelight. Copies of exemplar articles are appended hereto as Exhibit-M. The GILEAD mark is famous and well-known.

- Complainant's use of the GILEAD name for over 30 years is in itself evidence that the mark is well known. See *Celgene Corporation v. Diana Claire*, WIPO Case No. D2016-0922 (Jul. 7, 2016) (transferring celgenepharma.com) ("The Panel finds that Complainant has established that its CELGENE trademark is well known, as a result of its thirty years of extensive use of the mark.")
- Some of Gilead's medications have been placed on the World Health Organization's List of a Essential Medicines due to their nature as revolutionary treatments and cures of fatal diseases, including HARVONI (ledipasvir/sofosbuvir), a treatment for Hepatitis C infection, and TRUVADA (emtricitabine/tenofovir disoproxil), which is indicated for the prevention of infection by the HIV virus via pre-exposure prophylaxis. Copies of relevant documents are annexed as Exhibit-N.
- Gilead owns exclusive rights to the GILEAD trademark, including rights secured by over 120 trademark registrations around the world and through ongoing use, including, but not limited to, the following:

GILEAD -U.S. Reg. No.3,251,595, registered on June 12, 2007 covering "pharmaceutical preparations, namely, antivirals, antifungals and preparations for the treatment of infectious conditions" in Class 5;

GILEAD SCIENCES - U.S. Reg No. 1,611,837, registered on September 4, 1990 covering "pharmaceutical preparations for the treatment of viral diseases, such as AIDS and cancers, for professional medical use" in Class 5;

GILEAD - Singapore Reg. No. T08/03446D, registered on July 24, 2008 covering "pharmaceuticals" in Class 5;

GILEAD - India Reg. No. 2363685, registered on September 10, 2015 covering "pharmaceutical preparations" in Class 5;

GILEAD -EUTM Reg. No. 3913167, registered on November 7, 2005 covering "pharmaceutical and veterinary preparations; chemical, analytical and diagnostic reagents for in vivo use; chemicals for use in medical research, and medical or veterinary diagnosis," in Class 5 and "scientific, medical and industrial research and development services; clinical research; laboratory research; research and development of new drugs and clinical products; analysis of materials; chemical analysis; laboratory services; laboratory testing services; information and advisory services relating to the foregoing, including such services provided on-line from a computer network or the internet" in Class 42;

GILEAD - China Reg. No. 816124, registered on February 21,1996 covering "pharmaceuticals for the treatment and/or prevention of infectious diseases, cardiovascular and inflammatory conditions, degenerative disorders, and cancer" in Class 5;

GILEAD - Brazil Reg. No. 904960269, registered on July 7,2015 covering "pharmaceutical preparations" in Class 5; and

GILEAD - Australia Reg. No. 1132718, registered on March 13, 2013 covering "pharmaceutical preparations, namely, pharmaceuticals for the treatment of viral infections; pharmaceuticals for the treatment of cardiovascular disorders and conditions; pharmaceuticals for the treatment of respiratory disorders and conditions; pharmaceuticals for the treatment of fungal diseases and disorders; pharmaceuticals for the treatment of liver disease; pharmaceuticals for the treatment of HIV/AIDS and hepatitis" in Class 5;

Copies of certificates of registration in the United States, India, European Union, China, Brazil, and Australia are attached hereto as Exhibit-O. Gilead owns a total of over 125 trademark Copies of certificates of registration in the United States, India, European Union, China, Brazil, and Australia are attached hereto as Exhibit-O. Gilead owns a total of over 125 trademark registrations and several pending applications to register the GILEAD trademark worldwide.

- *Gilead is also the owner of the earlier domain name gilead.com, which was registered on May 27, 1995 and has been used by the company since as early as 1997 in connection with its pharmaceutical products and related medical services. A copy of WHOIS information from the gilead.com website is attached hereto as Exhibit-P, while a printout from the website is attached hereto and included with Exhibit-Q. Gilead and others on its behalf have registered over 340 domain names*

that incorporate its GILEAD trademark. A list of these domain names is attached hereto as Exhibit-R.

- *The Domain contains Complainant's well-known and famous GILEAD trademark. This in itself is sufficient to support a finding that the Domain is confusingly similar to Complainant's mark. See PepsiCo, Inc. v. PEPSI, SRL (a/k/a P.E.P.S.I.) and EMS Computer Industry (a,1r/a EMS), VIIP0 case No. D2003-0696 (October 28, 2003) ("incorporating a trademark in its entirety can be sufficient to establish that a domain name is identical or confusingly similar to a registered trademark").*
- *Respondent willfully adopted the GILEAD name within the Domain in an attempt to unfairly capitalize on the valuable goodwill Gilead has built in its mark, with the intention of diverting search and web traffic for Respondent's own commercial gain.*
- *Respondent registered the Domain containing the GILEAD mark over thirty years after Complainant entered the biopharmaceutical industry.*
- *The addition of country indicator "PK" does not help distinguish the Domain from Complainant's trademark. PK stands for Pakistan. In fact, it only increases the likelihood of confusion due to the fact that Gilead's has an active presence through its authorized distributor and medicine access programs in Pakistan.*
- *WIPO has consistently held that the domain names consisting of a trademark and country name or indicator are confusingly similar. See, e.g., Swarovski Aktiengesellschaft v. wen Ben Zhou, WIPO Case. No. DCO2014-0587 (June 3,2014) ("the addition of a geographical name or indicator to a trademark, and in particular to the SWAROVSKI trademark, does not serve to differentiate the domain name from the trademark")(transferring swaroviskisg.com); F. Hoffmann-La Roche AG v. Rishmi Tyagi, Roche Pathology, D2016-t590 (Sept. 14, 2016) (transferring roche-india.com).*
- *In accordance with Rules, Paragraph 3(b)(viii), the complaint is based on the Complainant's registered trademark/service mark 'Gilead', the domain name "gilead.com" and its business name "Gilead Sciences, Inc.", in which the Complainant has the exclusive proprietary rights.*
- *In accordance with Rules, Paragraph 3(b)(ix)(1), the disputed domain "gilead.com.pk" incorporates the Complainant's registered trademark/service mark 'Gilead', the domain name "gilead.com" and business name "Gilead Sciences, Inc." in which the complainant has exclusive proprietary rights.*

- *The addition of the top-level domain ".com" is irrelevant in determining whether the Domain is confusingly similar to the GILEAD mark. See Blue Sky Software Corp. v. Digital Sierra, Inc., WIPO Case No. D2000-0165 (April 27, 2000) ("addition of .com is not a distinguishing difference"); Busy Body, Inc. v. Fitness Outlet Inc., WPO Case No. D2000-0 127 (April 22, 2000)*
- *Accordingly, the Panel must find that the Domain is identical and confusingly similar to Accordingly, the Panel must find that the Domain is identical and confusingly similar to Complainant's well-known GILEAD trademark. Complainant's well-known GILEAD trademark.*

It is an established principle that the incorporation of a Complainant's trademark in full within a disputed domain name may be sufficient to establish confusing similarity between the mark and the disputed domain name.

The Complainant has provided sufficient information, including annexing evidence of the same, that the Complainant has rights in the trademark "GILEAD". The addition of the ccTLD ".com.pk" would also not prevent the finding of confusing similarity.

The Respondent has not submitted any contention. In the absence of any valid explanation of how the DDN is not confusingly similar to the trademark of the Complainant, the Panel finds confusing similarity between the DDN and the Complainant's trademark under paragraph 4(a)(i) of the Policy.

III. Legitimate interests in a domain name

As per paragraph 4(c), the UDRP requires the Respondent's claim to be of legitimate interest and shall be:

"proved based on all evidence presented" that "shall demonstrate" the Respondent's "rights or legitimate interests to the domain name for purposes of [Paragraph 4\(a\)\(ii\)](#)."

Paragraph 4(a)(ii) states that:

"(i) before any notice to you of the dispute, your use of, or demonstrable 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; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are 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 or service mark at issue."

The Complainant has contended the following:

- *Respondent is not associated or affiliated with the Complainant. Complainant has not granted any rights to Respondent to use the GILEAD mark, whether a license to sell any products or offer any services, or any rights to register the Domain.*
- *There is no indication that Respondent is commonly known by the GILEAD name. The GILEAD name does not appear in the WHOIS record, which offers no way to contact the Respondent.*
- *Respondent's strategy for registering the Domain to capture and divert Internet search engine queries made by individuals seeking Gilead's genuine pharmaceutical products or medical information is clear on its face based on the registration of a domain name containing the entirety of the GILEAD trademark and country indicator PK.*
- *Complainant's mark is so well known and recognized, there can be no legitimate use by Respondent. Guerlain S.A. v. PeiKang, WIPO Case No. D2000-0055 (March 21, 2000). See also Veuve Clicquot Ponsardin v. The Polygenix Group Co., WIPO Case No. D2000-0163 (May 1, 2000) (bad faith is found where a domain name "is so obviously connected with such a well-known product that its very use by someone with no connection with the product suggests opportunistic bad faith").*
- *Respondent's cybersquatting on the Domain can be seen for no other purpose than wrongfully diverting traffic for its own commercial gain and/or phishing efforts, which is bad faith, not a legitimate use of the Domain. See Actelion Pharmaceuticals Ltd. v Fils James / Litemills, WIPO Case No. D2015-2115 (Jan. 12, 2016) (transferring actelionpharma.com).*
- *By adopting and registering a domain name which is identical to the Complainant's earlier trade name / trademark / service mark 'GILEAD' and/or which incorporates the earlier trade name / trademark / service mark 'GILEAD' in its entirety as well as the domain name 'gilead.com', the Respondent will not only be making wrongful gains for itself but is intending to cause wrongful loss to the Complainant.*

- *The registration of the disputed domain name by the Respondent appears to be motivated for no other reason than to create a false impression among the general public that the Respondent's products or services emanate from the Complainant. This is also apparent from the fact that upon assessing the website of the Respondent at the Uniform Resource Locator (URL) www.gilead.com.pk, the users are automatically redirected to the Complainant's website consisting of the earlier domain name www.gilead.com which is a different URL from the one they originally requested by the users, thus reinforcing the (false) connection.*
- *Without prejudice to any of the foregoing, it is submitted that the Complainant has prior rights in the earlier domain name www.gilead.com, and the Disputed Domain Name www.gilead.com.pk was registered with full knowledge of the Complainant's prior rights in the earlier domain name, trade name and trade mark.*

The Respondent has contended the following:

As per addressing the complaint that my domain (www.gilead.com.pk) is being used in bad faith.

According to my knowledge and my experience as I am a Lawyer by profession and I have been doing this business for the past 5 years. if we are dealing with. This way we can write to any domain that they are using the domain in bad faith. I got the domains then sold them. I invested my money on them to earn money from it by selling them. I know my legal rights regarding this, My domain is here for sale, and if they want to purchase it contact my provider. If they challenge us legally they have to know that names are being patented under the ordinance 2000 and 2003. if they are the inventor or founder of their invention. My domains are only for sale, no business activity or services are being launched on them. And no business services or any kind of activity is running on this domain.

if they still want this dirty game for buying my domain on this free tag. So they are wrong. I know my rights. I know my business legality we can see others in Court.

As has been previously adopted by the discussions and findings in WIPO authorities, it is for the Respondent to rebut the allegations put forth by the Complainant after the Complainant establishes a prima facie case about the lack of legitimate interest in a disputed domain name. Also, with respect to proving rights or legitimate interests in the disputed domain name(s), it is for the Respondent to submit evidence pertaining to the same as it would be extremely difficult, if not impossible, for the Complainant to prove a negative assertion. As such, to satisfy the Panel that it has rights or legitimate interests to the DDN, the Respondent was obliged to respond and submit evidence with respect to the same.

The Complainant has indicated that it is in use of the name “GILEAD” and has registered trademarks, demonstrating a prima facie case of legitimate interest in the DDN whereas the Respondent has not provided any document to support he has a legitimate interest in the DDN. The Panel notes that the DDN does not resolve to a website that uses the name “GILEAD”. The Respondent has also stated in his response that he is not conducting any business activity or services on the DDN, and it was just bought for the purpose of selling it hence the Respondent may not have a legitimate interest in the DDN.

In the light of the information provided by the Complainant and the Respondent in support of their legitimate interest in the DDN, the Panel finds that the Respondent does not have rights to or a legitimate interest in the DDN pursuant to paragraph 4(a)(ii) of the Policy.

IV. Registration and use in bad faith

The Complainant has contended the following:

- *When viewing the totality of the circumstances, Respondent's acts overwhelmingly demonstrate bad faith use and registration: 1) the intentional registration of a domain name consisting solely only of the GILEAD trademark and country indicator "pk"; 2) purposefully registering a domain and redirecting users to the Complainant's website to divert Internet users and to show false association with the Complainant herein, when no such connection exists; 3) all in the context of Gilead's presence in Pakistan and ownership of gilead.com.pk.*
- *At the very least, Respondent had constructive knowledge of Gilead's trademarks and its rights due to Gilead's longstanding worldwide trademark registrations covering the GILEAD mark. "Registration of a domain name that is confusingly similar to a mark, despite knowledge of the mark holder's rights, is evidence of bad faith registration pursuant to policy 4(a)(iii)]." Hugh At the very least, Respondent had constructive knowledge of Gilead's trademarks and its rights due to Gilead's longstanding worldwide trademark registrations covering the GILEAD mark. "Registration of a domain name that is confusingly similar to a mark, despite knowledge of the mark holder's rights, is evidence of bad faith registration pursuant to Policy 4(a)(iii)." Hugh Jackman v. Peter Sun, FA 248716 (Nat. Arb. Forum May 10, 2004).*
- *Indeed, WIPO has recognized that domain names containing the combination of a well-known pharmaceutical trademark used around the world together with a country name implies bad faith. Amgen, Inc. v. Amgen India, Inc., WIPO case No. D2019-1217 (July*

30, 2019) (transferring amgenindia.com) see also *F. Hofmann-La Roche AG v. Rishmi Tyagi, Roche Pathology*, D2016-1590 (Sept. 14, 2016) (transferring roche-india.com).

- Respondent is fully aware of the Complainant's business, as well as its goodwill in the GILEAD mark, and registered the Disputed Domain Name in bad faith See *Celgene Corporation v. Diana Claire*, WIPO case No. D2016-0922 (Jul. 7, 2016) (transferring celgenepharma.com) („The Panel finds that Complainant has established that its CELGENE trademark is well known, as a result of its thirty years of extensive use of the mark. Respondent's inclusion of a term, 'pharma,' which refers to Complainant's filed of activity, puts beyond doubt whether Respondent has targeted Complainant.”)
- The Disputed Domain Name "gilead.com.pk", is identical to the Complainant's earlier domain name "gilead.com" with the addition of the .PK ccTLD. The likelihood of confusion is to be determined from the perspective of an ordinary prudent person on the basis of a fleeting glance. There is a serious likelihood that an ordinary person, upon encountering the Disputed Domain Name, would cast a fleeting glance and the impression that will be communicated would be that the domain belongs to or is associated with, the Complainant, owing to use of the identical mark/name 'Gilead'.
- The Disputed Domain Name is identical to the Complainant's earlier domain name, of which the Complainant is the original creator, adopter and prior bona fide user and registered proprietor globally, including in Pakistan. In these circumstances, the Disputed Domain Name is neither capable of distinguishing, nor adapted to distinguish, the Respondent's products is neither capable of distinguishing, nor adapted to distinguish, the Respondent's products and/or services or establishment from that of the Complainant. It can, thus, be seen that the Disputed Domain Name does not satisfy any of the conditions laid down in Rules, Paragraph 3(b); Supplemental Rules, Paragraphs 4(a), 12(a).
- The Complainant's business name / earlier domain name / trademark /service mark 'GILEAD' is distinctive to the Complainant herein by virtue of extensive and continuous use in the form of the earlier trade name / domain name and trade mark worldwide since as early as 1987. The Respondent had, thus, no bona fide reason to adopt the Disputed Domain Name "gilead.com.pk".
- For all of the foregoing reasons, Respondent registered and is using the Disputed Domain Name in bad faith and Complainant has satisfied Section 4(a)(iii) of the Policy, requiring Respondent to transfer the Disputed Domain Name to Complainant.

The Respondent has contended the following:

As per addressing the complaint that my domain (www.gilead.com.pk) is being used in bad faith.

According to my knowledge and my experience as I am a Lawyer by profession and I have been doing this business for the past 5 years. if we are dealing with. This way we can write to any domain that they are using the domain in bad faith. I got the domains then sold them. I invested my money on them to earn money from it by selling them. I know my legal rights regarding this, My domain is here for sale, and if they want to purchase it contact my provider. If they challenge us legally they have to know that names are being patented under the ordinance 2000 and 2003. if they are the inventor or founder of their invention. My domains are only for sale, no business activity or services are being launched on them. And no business services or any kind of activity is running on this domain.

if they still want this dirty game for buying my domain on this free tag. So they are wrong. I know my rights. I know my business legality we can see others in Court.

To establish that the DDN has been registered in bad faith, Complainant must show that the Respondent was aware or should have been aware of Complainant and the mark at the time of registration. Some WIPO panels have found that it is enough if a Respondent ought to have known of a complainant's mark when the disputed domain name is registered. (For example, in *Maori Television Service v. Damien Sampat, WIPO Case No. D2005-0524*, the panel stated that a finding of bad faith can be made when the Respondent "knew or should have known of the registration and use of the trademark prior to registering the domain" and cited other panel decisions to similar effect.)

The Panel finds that the "GILEAD" mark of the Complainant had considerable popularity worldwide and in Pakistan, the jurisdiction of the Respondent, at the time of registration of the DDN and the Complainant has even cited WIPO case laws in its contentions to support this claim as well as annexures of trademarks. However, the Respondent did not provide any submission that he was not aware about the Complainant or its business at the time of registration of the DDN. Furthermore, the Respondent has submitted in his response that he deals in buying and selling domain names and has claimed that the Complainant may contact his provider if they wish to buy the DDN.

The Panel, therefore, in view of the contentions of both the Complainant and the Respondent, finds that it is likely that the Respondent knew about, or ought to have known about, the well-known "GILEAD" mark owned by the Complainant and its business. The Panel also infers, based on the information provided by the Complainant and the Respondent, and based on the lack of legitimate interest on part of the Respondent, that the Respondent registered and was using the DDN in bad faith, with the primary intent to sell the DDN for costs exceeding the out-of-pocket expenses. The

Panel therefore concludes that the DDN was registered and is being used in bad faith by the Respondent.

7. Decision

Analyzing the details provided by the Complainant, the Panel perceives that the “GILEAD” mark has been registered by the Complainant, hence the Complainant reserves crucial interest in such mark. Usage of these marks by the Respondent could endanger the reputation that the Complainant has worked hard at building and maintaining and result in confusion as to the registrant of the DDN.

Taking all the discussion above into consideration, the Panel concludes and decides that:

1. The Respondent’s registration of the DDN is contrary to the PKNIC - Internet Domain Registration Policy version 4.4 (2019-08-19)
2. The Respondent has no legitimate interest in the DDN.
3. The DDN is identical to the Complainant’s trademark/names and registered domain names.
4. The DDN was registered and is being used in bad faith.

Pursuant to Section 4 of the Policy, the Panel, therefore, recommends that PKNIC transfer the registration of the domain name in dispute <gilead.com.pk> to the Complainant, as prayed, within 48 hours of receipt of this decision either by email or through the website where it will be uploaded, www.dndrc.com/cases_resolved/, whichever is earlier. The Complainant shall also be at liberty to contact PKNIC for implementation of this decision.

Arbitrator: Sunain Qazi

Sole Panelist

Date: 15 July 2022