

## **ADMINISTRATIVE PANEL DECISION**

### **PROCAPS S.A. v. Thomas Guldager**

#### **Case No. D2022-4176**

#### **1. The Parties**

The Complainant is PROCAPS S.A., Colombia, represented by Muñoz Abogados S.A.S., Colombia.

The Respondent is Thomas Guldager, United States of America.

#### **2. The Domain Name and Registrar**

The disputed domain name <procapsgroup.org> registered with Hosting Concepts B.V. d/b/a Registrar.eu. (the "Registrar").

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 3, 2022. On November 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 7, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on November 7, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On the same day, the Center sent a Language of the Proceeding communication, as the Complaint was submitted in Spanish and the language of the registration agreement for the disputed domain name was English. The Respondent did not comment on the language of the proceedings. The Complainant filed an amended Complaint in English and confirmed the request that Spanish be the language of the proceeding on November 18, 2022.

The Center verified that the Complaint together with the amended 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 18, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 8, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 13, 2022.

The Center appointed Miguel B. O'Farrell as the sole panelist in this matter on December 28, 2022. 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.

### **Language of the Proceeding**

The Complainant filed a Complaint in Spanish with a request for Spanish to be the language of the proceeding.

After receiving the above-mentioned communications from the Center, the Complainant filed an amended Complaint in English, which is the language of the registration agreement.

Pursuant to paragraph 11 of the Rules, unless otherwise agreed by the Parties, the default language of the proceeding is the language of the registration agreement, subject to the authority of the panel to determine otherwise. In the circumstances, the Panel finds that there is no reason to depart from such principal in this case and resolves that the language of the proceeding is English.

### **4. Factual Background**

The Complainant is a Colombian company, which provides a broad range of pharmaceutical products, services and solutions, mainly under the trademark PROCAPS.

The Complainant owns several Colombian trademark registrations, including the following:

Registration No. 282314 for PROCAPS & Design, filed on November 12, 2003, with deadline of June 29, 2024, in class 44; and

Registration No. 282312 for PROCAPS & Design, filed on November 12, 2003, with deadline of June 29, 2024, in class 42.

In addition, the Complainant owns several domain names which include the trademark PROCAPS, such as <procapsgroup.com>; <procaps.com.co>; <procapslaboratorios.com>; and <grupoprocaps.com>.

The disputed domain name <procapsgroup.org> was registered on July 1, 2022, and at the time of writing this decision it does not resolve to an active webpage.

### **5. Parties' Contentions**

#### **A. Complainant**

The Complainant has a significant participation in the pharmaceutical market in Colombia, in which it offers and provides its customers with a broad portfolio of pharmaceutical products, services and solutions.

Under the domain name <procapsgroup.com> in the section "About Us", the Complainant claims the following:

"Procaps Group, S.A. ('Procaps Group') (NASDAQ: PROC) is a developer of pharmaceutical and nutraceutical solutions, medicines, and hospital supplies that reach more than 50 countries in all five continents. Procaps has a direct presence in 13 countries in the Americas and more than 5,300 collaborators working under a sustainable model. Procaps develops, manufactures, and markets over the counter (OTC) pharmaceutical products and prescription pharmaceutical drugs (Rx), nutritional supplements and high-potency clinical solutions."

The Complainant, in essence, claims that the disputed domain name is confusingly similar with the trademark PROCAPS in which the Complainant has rights and that the Respondent has no rights or legitimate interests in the disputed domain name, which was registered and is being used in bad faith.

More specifically, the Respondent has no rights in the trade trademark PROCAPS, nor has he been authorized by the Complainant to use the trademark PROCAPS in the disputed domain name.

The Respondent prevents the Complainant from viewing its trademarks and the services associated therewith in the disputed domain name.

The Respondent takes advantage from the Complainant's reputation and trademarks to defraud people through impersonation scams.

Considering that the Complainant's main domicile is Colombia, the use of the trademark PROCAPS in the disputed domain name creates a risk of confusion for Internet users, who may relate the site to which the disputed domain relates to the Complainant and its trademarks.

Finally, the Complainant requests the Panel to issue a decision ordering that the disputed domain name be transferred to the Complainant.

## **B. Respondent**

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

## **6. Discussion and Findings**

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the disputed domain name, the Complainant must prove each of the following, namely that:

- (i) the disputed domain name is identical or confusingly similar with a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

### **A. Identical or Confusingly Similar**

As set forth in section 1.7 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") the standing test for confusing similarity involves a reasoned but relatively straightforward comparison between the trademark and the disputed domain name to determine whether the disputed domain name is confusingly similar with the trademark. The test involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

The Panel considers that the disputed domain name is confusingly similar with the Complainant's PROCAPS trademark.

The disputed domain name incorporates the Complainant's trademark PROCAPS in its entirety with the addition of the term "group", which certainly does not prevent a finding of confusing similarity. Section 1.8 of [WIPO Overview 3.0](#) provides that when the relevant trademark is recognizable within the disputed domain name - as it occurs in this case- the addition of other terms would not prevent a finding of confusing similarity under the first element.

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

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the trademark PROCAPS in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy are fulfilled.

## **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy sets out the following several circumstances which, without limitation, if found by the panel, shall demonstrate that the respondent has rights to or legitimate interests in a disputed domain name, for the purposes of paragraph 4(a)(ii) of the Policy:

- before any notice to the respondent of the dispute, the respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or
- the respondent (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if the respondent has acquired no trademark or service mark rights; or
- the respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Complainant has proved that they are the owners of the PROCAPS mark. There is no indication that they have licensed or otherwise permitted the Respondent to use any of their trademarks, nor have they permitted the Respondent to apply for or use any domain name incorporating their mark.

There is no evidence in the present case that the Respondent has been commonly known by the disputed domain name, enabling it to establish rights or legitimate interests therein. The name of the Respondent does not resemble the disputed domain name in any manner.

Furthermore, there is no evidence in the file to prove any of the circumstances mentioned in paragraph 4(c) of the Policy, nor any other element to prove that the Respondent has legitimate interests or that it has established rights in the disputed domain name.

As established in section 2.5 of [WIPO Overview 3.0](#): “Fundamentally, a respondent's use of a domain name will not be considered ‘fair’ if it falsely suggests affiliation with the trademark owner; the correlation between a domain name and the complainant's mark is often central to this inquiry.” In this case, the Panel considers that the disputed domain name carries a high risk of implied affiliation with the Complainant and the Complainant's PROCAPS mark.

The Panel finds that the Complainant has made out a *prima facie* case, a case calling for an answer from the Respondent. The Respondent has not responded and the Panel is unable to conceive of any basis upon which the Respondent could sensibly be said to have any rights or legitimate interests in respect of the disputed domain name (*Telstra Corporation Ltd. v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

The Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name and that the requirements of paragraph 4(a)(ii) of the Policy have been fulfilled.

## **C. Registered and Used in Bad Faith**

The Panel is satisfied that the Respondent must have been aware of the Complainant's business and its trademark PROCAPS when it registered the disputed domain name on July 1, 2022. By that time, the

Complainant had registered and used the trademark PROCAPS for many years. Moreover, the disputed domain name contains the Complainant's mark in its entirety.

The Respondent when registering the disputed domain name was targeting the Complainant and its business by incorporating the trademark PROCAPS and the term "group", which lead Internet users to think that the website to which the disputed domain name resolves is the official website of the Complainant and thereby capitalize on the fame of the PROCAPS trademark for its own monetary benefit.

The fact that there is a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the disputed domain name is also a significant factor to consider that the disputed domain name was registered and is being used in bad faith, as stated in section 3.2.1 of [WIPO Overview 3.0](#).

Finally, the fact that the disputed domain name does not resolve to an active webpage does not avoid a finding of bad faith under the "passive holding" doctrine, particularly in view of the Respondent's failure to submit a response and to provide any evidence of actual or contemplated good-faith use of the disputed domain name, as indicated in section 3.3 of [WIPO Overview 3.0](#).

For the above reasons, the Panel finds that the requirements of paragraph 4(a)(iii) of the Policy have been fulfilled.

## **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 <procapsgroup.org> be transferred to the Complainant.

*/Miguel B. O'Farrell/*

**Miguel B. O'Farrell**

Sole Panelist

Date: January 11, 2023