Decision for dispute CAC-UDRP-101174

Case number	CAC-UDRP-101174
Time of filing	2016-02-25 15:24:02
Domain names	provigilshop.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Cephalon, Inc.

Complainant representative

Organization	Matkowsky Law PC

Respondent

Organization	WhoisGuardService.com

IDENTIFICATION OF RIGHTS

The Complainant is the owner of US trademark registration No. 2000231 PROVIGIL, dated September 10, 1996, for pharmaceutical preparations for the treatment of human sleep disorders in International Class 5. The Complainant is also the owner of the CTM No. 003508843, dated March 25, 2008, for pharmaceutical preparations for the treatment of human sleep disorders in International Class 5.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

PRELIMINARY: LANGUAGE OF THE PROCEEDING

According to the Registrar's verification, the language of the registration agreement is Chinese. In that regard, the Complainant requests to proceed in English because the domain name itself is comprised of English words, not Chinese. Furthermore, the Complainant contends that the website hosted on the disputed domain name is in English. Therefore, it is clear that the Respondent who selected the domain name, and operates the Website, speaks English fluently, as that is the language they chose to operate the site in question and register the domain name in dispute comprised of English words. The registrant encountered the registration agreement in English although all Chinese registrars have to be governed by a Chinese registration agreement, so the registration agreement in English says that the Chinese version is the official one and controls. According to the Complainant the registrant probably does not even know how to read Chinese.

Under Paragraph 11(a) of the Rules, the Panel has the discretion to allow the proceeding to be conducted entirely in English, including an English-language complaint, notwithstanding that the Chinese registration agreement controls to the extent there is any inconsistent with the English version that was presented to the Respondent when he registered the domain name.

The main purpose of making the request is that the Complainant is not familiar with Chinese language and having to conduct the proceedings in Chinese would disadvantage the Complainant as it would have to incur added expense and inconvenience in having the Complaint translated into Chinese. The Complainant should not be compelled to incur translation costs to submit a Chinese language Complaint if the Panelist agrees that the proceedings may be conducted entirely in English. If the Panelist determines that the proceeding must be conducted in Chinese and does not make an exception as being requested by the Complainant, then Complainants would request an opportunity to provide a Chinese language complaint at that time.

For example, in Swarovski Aktiengesellschaft v. Zhang jie, WIPO Case No. D2012-0887, the Center verified that the language of the registration agreement was Chinese, and no agreement had been reached between the complainant and respondent that the language of the proceeding should be English. In that case, the complainant also filed its complaint in English, and requested that the proceedings be conducted in English because it was not familiar with Chinese, it would have added expense and inconvenience in having the complaint translated, and the respondent is able to communicate in English as the website hosted at the domain name was in English, as is the case here.

The Respondent, who chose to both register an English word in the disputed domain name consisting otherwise entirely of ASCII characters, and also host competing advertisements in English understands clearly the request being made herein to proceed in English, and has a fair opportunity to object to the use of English as the language of the proceeding. As the Panel found in the aforementioned case, "Using English as the language of the proceedings will not be prejudicial to the Respondent in its ability to articulate the arguments for the case, while if the proceedings are to be conducted in Chinese, the Complainant would be unfairly disadvantaged by being forced to translate the Complaint into Chinese."

The Panellist has also looked to the circumstances of the case to allow the proceeding to be conducted in English even though the Registration Agreement is in a foreign language. For example, in Case No. 100530, filed 11-19-2012 regarding <repettoshop.com>, the Panelist determined that the language of the proceeding would be in English even though the Registration Agreement was in Chinese. One of the determining factors was that the website corresponding to the disputed domain name was entirely in English, which is the case here. If Respondent uses English on his website hosted on the disputed domain, surely he can respond in English to an English language complaint regarding the same. Also in CAC Case No. 100614, the language of the registration agreement for eName Technology regarding multiple domain names was in Chinese, but the CAC Provider allowed the request not to translate the Complaint into Chinese to be presented to the Panelist, who found no reason why not to proceed in the English language without requiring the Complaint to be translated into Chinese.

For the reasons mentioned above, the Panel decides to comply with the Complainant’s request and orders the proceedings to be conducted in English.

BACKGROUND

Complainant Cephalon, Inc. (“Cephalon”), is an indirect, wholly-owned subsidiary of Teva Pharmaceutical Industries Ltd. Formed in 1976, through its predecessors-in-interest, Teva Pharmaceutical Industries Ltd., together with its subsidiaries (collectively, “Teva”), was first established in 1901 with its global headquarters in Israel. Operating in sixty countries worldwide, Teva (NYSE and TASE: TEVA) (www.tevapharm.com) is ranked among the top pharmaceutical companies in the world, and the world’s largest generic medicines producer. Teva’s net revenues in 2014 amounted to $20.3 billion.

In specialty medicines, Teva has a world-leading position in innovative treatments for disorders of the central nervous system, including pain, as well as a strong portfolio of respiratory products.

Cephalon's PROVIGIL® (modafinil) Tablets [C-IV] are part of Teva's CNS (Central Nervous System) line of specialty medicines. They contain modafinil, a Schedule IV federally controlled substances in the United States. Subject to important safety information, PROVIGIL® is indicated to improve wakefulness in adult patients with excessive sleepiness associated with narcolepsy, obstructive sleep apnea (but not as treatment for the underlying obstruction), or shift work disorder.

The PROVIGIL® mark is well known within its specialty area.

According to the Complainant, Panels have found that registration of a mark with a trademark authority, regardless of the location of the parties, is sufficient evidence of having rights in a mark. E.g., Miller Brewing Co. v. Miller Family, FA 104177 (Nat. Arb. Forum Apr. 15, 2002) (finding that the complainant had established rights to the MILLER TIME mark through its federal U.S. trademark registrations); Koninklijke KPN N.V. v. Telepathy Inc., D2001-0217 (WIPO May 7, 2001) (finding that the Policy only requires that complainant demonstrate a mark in some jurisdiction); Thermo Electron Corp. v. Xu, FA 713851 (Nat. Arb. Forum July 12, 2006) (finding that the complainants had established rights in marks where the marks were registered with a trademark authority); Williams-Sonoma, Inc. v. Fees, FA 937704 (Nat. Arb. Forum Apr. 25, 2007) (finding that it is irrelevant whether the complainant has registered its trademark in the country of the respondent's residence).

Previous panel decisions have generally held that trademark registrations are valid and constitute prima facie evidence of ownership, validity and the exclusive right to their use. E.g., Microsoft Corporation v. J. Holiday Co. (WIPO case no. D2000-1493 February 20 2000); Poarch Band of Creek Indians dba PCI Gaming Authority v. Tech Admin, Virtual Point, NAF Claim No. FA1509001639763 (Nov. 13, 2015).

The Complainant contends, that series of CAC Panels have recognized Cephalon's rights in its PROVIGIL/NUVIGIL marks. CAC Case Nos. 100832-100835 (transferring, amongst others, <provigilmodafinilforsale.com>, <provigilonline.com>, <provigil4bitcoins.com>, <genericprovigil.net>, <buy-provigil-generic.com>, etc.); see also CAC Case No. 100892 (transferring <buyprovigil-quick.com>, <buyprovigilextra.com>, <buyprovigilmeds.com>, <provigilforsale.com>, among others).

CONFUSING SIMILARITY (ICANN Rule 3(b)(ix)(i); ICANN Policy ¶4(a)(i))

The Complainant claims that the disputed domain name is confusingly similar to the registered trademark in which the Complainant has rights.

NO RIGHTS OR LEGITIMATE INTERESTS (ICANN Rule 3(b)(ix)(2); ICANN Policy ¶4(a)(ii))

The Complainant claims the Respondent has not been commonly known by the disputed domain name, and, further, the Complainant has not authorized, permitted or licensed the Respondent to use its trademarks in any manner. Respondent has no connection or affiliation with the Complainant whatsoever.

Moreover, the pertinent WHOIS information identifies the registrant, which does not resemble the domain name. On this record, the Respondent has not been commonly known by the disputed domain name so as to have acquired rights to or legitimate interests in it within the meaning of Policy ¶ 4(c)(ii). E.g., Reese v. Morgan, FA 917029 (Nat. Arb. Forum Apr. 5, 2007) (finding, under Policy ¶ 4(c)(ii), that a UDRP respondent was not commonly known by a contested domain name where there was no evidence in the record, including the relevant WHOIS information, showing that that respondent was commonly known by that domain name, and where a complainant asserted that it did not authorize that respondent's use of its mark in the domain name).

Furthermore, according to the Complainant the Respondent is luring consumers in search of the well-known PROVIGIL brand to a website that promotes purchasing a substitute for Provigil that has the same active pharmaceutical ingredients. The site specifically promotes buying with bitcoins online SUN PHARMA brand API Modafinil. The site delivers to the USA without a prescription, which is illegal under the Controlled Substances Act. Such use does not demonstrate a legitimate right or interest. E.g., F. Hoffmann-La Roche AG v. Aleksandr Bannikov, WIPO Case No. D2015-0066; Eli Lilly and Company v. Igor Palchikov, FA 1105001388612; Lilly ICOS LLC v. Alexey Stoun, WIPO Case No. D2006-1170.

BAD-FAITH REGISTRATION AND USE

The trademark registration rights predate the domain name registration, and the allegations that the trademark is well-known in its field has not been rebutted. The Respondent can be considered to be aware of the Complainant's trademark when registering the domain name, as obviously also follows from the way the domain name is currently being used.

In light of the use of the disputed domain name as evidenced by documents submitted by the Complainant, the Respondent is attempting to attract, for commercial gain, Internet users to its web site or to the web sites linked thereto, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of their web sites and of the products promoted therein. E.g., Cephalon, Inc. v Alen Mironassyan, Alen Mironassyan, CAC Case No. 100892. Therefore, according to the Complainant the requirement of bad faith registration and use of the disputed domain name pursuant to article 4(a)(iii) of the Policy has been met.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Name is identical or confusingly similar to a trademark or service mark in which the complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Domain Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

The Panel accedes to the Complainant's request that the language of the proceeding be English because, although the Registration Agreement is in Chinese, the domain name is in English, as is the website to which the domain name resolves.

Although some attempts to notify the Respondent of the Complaint failed, others were delivered to contacts for the Respondent in the Whois information.

Accordingly the Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

The domain name, which was registered on August 7, 2014, many years after the Complainant registered its PROVIGIL trademark, is confusingly similar to that mark because it comprises that mark together with the descriptive word "shop" and the inconsequential gTLD ".com".

The Complainant's assertions that the Respondent lacks rights or legitimate interests in the domain name suffice to establish a prima face case. In the absence of any Response, the Complainant has established that element.

The domain name resolves to a website offering "Provigil online cheap modafinil", indicating that the Respondent was well aware of the Complainant's mark when registering the domain name and is using the domain name to confuse Internet

users as to the sponsorship of the website and the genuineness of the goods offered. Accordingly the domain name was registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **PROVIGILSHOP.COM**: Transferred

PANELLISTS

Name	**Alan Limbury**

DATE OF PANEL DECISION 2016-04-01

Publish the Decision