Decision for dispute CAC-UDRP-101175

Case number	CAC-UDRP-101175
Time of filing	2016-02-25 15:26:23
Domain names	TRYNUVIGIL.COM

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Cephalon, Inc.

Complainant representative

Organization	Matkowsky Law PC

Respondent

Organization	Polina Griffin

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any pending or decided proceedings that relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is registered owner of the following trademarks:

- NUVIGIL (word), Community Trade Mark, filing date 15 November 2004, registration date 26 January 2006, trademark no. 004124831, registered for class 5 (including pharmaceutical preparations for the treatment and prevention of human neurological disorders, sleep and wakefulness disorders, narcolepsy, obstructive sleep apnea, shift work disorder, depression, attention deficit hyperactivity disorder, multiple sclerosis fatigue);

- NUVIGIL (standard character mark), US Trade Mark, filing date 27 May 2004, registration date 25 November 2008, trademark registration no. 3538564, US serial no. 78426061, registered for international class 5, US classes 006, 018, 044, 046, 051, 052;

- PROVIGIL (word), Community Trade Mark (now EU Trademark) , filing date 31 October 2003, registration date 25 March 2008, trademark no. 003508843, registered for class 5 (including pharmaceutical preparations for combatting excessive daytime sleepiness associated with narcolepsy, idiopathic hypersomnia, attention deficit, hyperactivity disorders, obstructive sleep apnea and other conditions related to excessive daytime sleepiness);

- PROVIGIL (typeset word(s)/letter(s)/number(s)), US Trade Mark, filing date 31 March 1994, registration date 10 September 1996, trademark registration no. 2000231, US serial no. 74507491, registered for international class 5, US classes 006, 018, 044, 046, 051, 052.

- According to the Panel research in the WHOIS database, the Complainant is also holder of the domain name <nuvigil.com> and <provigil.com>.

FACTUAL BACKGROUND

The Complainant is an indirect, wholly-owned subsidiary of Teva Pharmaceutical Industries Ltd. (collectively, "Teva"). Established in 1901 with its global headquarters in Israel, operating in sixty countries worldwide, with 2014 net revenues amounting to USD 20.3 billion, Teva is ranked among the top pharmaceutical companies in the world, and the world's largest generic medicines producer.

The Complainant's trademark "NUVIGIL" is used in connection with a pharmaceutical preparation indicated to improve wakefulness in adult patients with excessive sleepiness associated with narcolepsy, obstructive sleep apnea or shift work disorder, and is well known in this area. The preparation is part of Teva's CNS (Central Nervous System) line of specialty medicines, and contains armodafinil, a Schedule IV federally controlled substances in the United States.

The Complainant is the registered owner of "NUVIGIL" and "PROVIGIL" CTM and US trademarks.

The disputed domain name <trynuvigil.com> was registered on 5 May 2014 and is held by the Respondent.

The domain name website (i.e. website available under internet address containing the domain name) is used to (i) provide information on specialty medicines to improve wakefulness, including reviews and users' comments on Nuvigil, Provigil and purported generics such as Waklert and Modalert, and (ii) encourages the visitors to purchase such medicines without a prescription through third party's websites (e.g. available at http://modafinilorder.cc/); such websites offers worldwide delivery of the said medicines, including delivery to the United States where Nuvigil is a federally controlled substance. The domain name website also provides links to such third party's websites.

The Complainant seeks transfer of the disputed domain name to Complainant.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

The Parties' contentions are the following:

COMPLAINANT:

1) LANGUAGE OF THE PROCEEDINGS

The Complainant requests to proceed in English stating that the Panel has the discretion to apply paragraph 11(a) of the Rules For Uniform Domain Name Dispute Resolution Policy ("Rules"). The circumstances for such decision include the following:

- The disputed domain name consists of English words;
- The domain name website is in English;
- The Respondent's email account that was used to register the disputed domain name comprises of English words;
- The fact that the Respondent used a Chinese registrar, which has an obligation to have Chinese as the official language for Chinese registration agreements control, does not mean the Respondent speaks Chinese.

For the abovementioned reasons, the Complainant contends that the Respondent is able to communicate in English and has

a fair opportunity to object to the use of English as the language of the proceeding.

Further, referring to previous WIPO and CAC cases, the Complainant claims not to be 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. It concludes that the Complainant should not be compelled to incur translation costs to submit a Chinese language Complaint if the Panel is inclined to agree that the proceedings may be conducted entirely in English, especially if the Respondent has no objection.

2) PROTECTED RIGHTS RELIED UPON

The Complainant has extensive "NUVIGIL" trademark rights for goods in class 5. For purposes of this proceeding, the Complainant relies on rights in the United States and Europe and refers to previous decisions where 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 such mark. The Complainant further states that 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.

The Complainant further points to a series of CAC Panels decisions that recognized Complainant's rights in its PROVIGIL/NUVIGIL marks, transferring, among others, <nuvigil4bitcoins.com>, <buynuvigilquick.com>, <nuvigilquick.com>, and <nuvigilrx.com>.

3) CONFUSING SIMILARITY

The Complainant refers to previous panel decisions and states that the test of confusing similarity under the Policy is confided to a comparison of the domain name and the trademark alone. Confusion in this context may be regarded as a state of wondering whether there is an association, rather than a state of erroneously believing that there is one. Similarity may be sufficiently demonstrated when a registered name is fully incorporated in a domain. The disputed domain name incorporates the entirety of the registered mark, with the addition of a generic term. The generic top-level domain (gTLD) ".com" is not relevant to assessing confusing similarity. Therefore, the disputed domain name is confusingly similar to the registered trademark in which the Complainant has rights.

4) NO RIGHTS OR LEGITIMATE INTERESTS

The Respondent has not been commonly known by the disputed domain name. Neither the Complainant has been authorized, permitted or licensed the Respondent to use its trademarks in any manner. The Respondent has no connection or affiliation with the Complainant whatsoever. The WHOIS information identifies the registrant, which does not resemble the domain name. On this record, 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 paragraph 4(c)(ii) of the Policy.

The Complainant refers to previous domain name decisions contending that the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests; once such prima facie case is made, the burden of production shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory.

The Respondent is luring consumers in search of the well-known Nuvigil brand to a rogue online pharmacy that promotes a "generic" purported substitute under the Modalert brand. The visitors of the site are encouraged to purchase through http://modafinilorder.cc/ where they purport to deliver worldwide, including to the United States without a prescription where Nuvigil is a federally controlled substance. Such use does not demonstrate a legitimate right or interest.

5) BAD-FAITH REGISTRATION AND USE

The trademark registration predates the domain name registration and is well known in its field. The Respondent can be considered to be aware of the Complainant's trademark when registering the domain name, as also follows from the content presented on the disputed domain website.

The Respondent attempts to attract, for commercial gain, Internet users to its website or to the websites linked thereto, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of their websites and of the products promoted therein. Therefore, the requirement of bad faith registration and use of the disputed domain name pursuant to paragraph 4(a)(iii) of the Policy has been met.

In addition, the Complainant points to the use of the copyright notice legend on the page to which the disputed domain website lures the visitors - "© 2011-2015 Modafinil - Provigil - Modalert." The PROVIGIL mark is owned by Complainant, and the copyright notice legend is designed to confuse visitors into believing that this rogue online pharmacy is approved by the Complainant. Further, the Complainant's product packaging is used in connection with the offer for sale of Modalert on the domain.

Apart from above mentioned domain disputes decisions, the Complainant presents the following evidence which has been assessed by the Panel:

- Registrar – Registrant Agreement by Todaynic.com,Inc. (English version);
- Excerpts from OHIM and US Patent and Trademark Office databases regarding Complainant's trademarks;
- Excerpts on the disputed domain name from WHOIS database;
- Screenshots of the disputed domain name website with the Respondent's content.

RESPONDENT:

The Respondent has not provided any response to the complaint.

RIGHTS

The Panel concluded that the disputed domain name is confusingly similar to trademarks in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Uniform Domain Name Dispute Resolution Policy ("UDRP" or "Policy").

For details, see "Principal Reasons for the Decision".

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 disputed domain name within the meaning of paragraph 4(a)(ii) of the Policy.

For details, see "Principal Reasons for the Decision"

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.

For details, see "Principal Reasons for the Decision".

PROCEDURAL FACTORS

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.

Pursuant to paragraph 11 (a) of the Rules for Uniform Domain Name Dispute Resolution Policy, "the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to

determine otherwise, having regard to the circumstances of the administrative proceeding". In this case according to the Registrar the language of the Registration Agreement is Chinese. However, the Complainant requested to change the language of the proceedings to English based on the reasons mentioned above.

The Provider sent the written notice to the Respondent in both English and Chinese. Therefore, the Respondent had an opportunity to respond but chose not to do so. Having considered the Complainant's submission regarding the language of the proceedings and the overall circumstances of this case (in particular, that the domain name website is in English), the Panel accepts the Complaint in English and shall render its decision in English.

PRINCIPAL REASONS FOR THE DECISION

RIGHTS

Since the domain name and the Complainant’s trademarks are not identical, the key element investigated and considered by the Panel is whether the disputed domain name <trynuvigil.com> consisting of a term "nuvigil" accompanied by a generic term "try" is confusingly similar to the Complainant’s trademarks.

The threshold test for confusing similarity under the UDRP involves a comparison between the trademark and the domain name itself to determine likelihood of Internet user confusion. In order to satisfy this test, the relevant trademark would generally need to be recognizable as such within the domain name. An addition of common, dictionary, descriptive, or other descriptive terms is typically insufficient to prevent threshold Internet user confusion. Confusing similarity test under the UDRP typically involves a straightforward visual and aural comparison of the trademark with the domain name.

Applying the principles described above, the Panel contends that incorporation of the dominant "nuvigil" element of Complainant’s trademarks (which standalone enjoys high level of distinctiveness) into the disputed domain name constitute confusing similarity between Complainant’s trademark and such domain name. Addition of non-distinctive element – common and generic term "try"- cannot prevent the association in the eyes of internet consumers between the disputed domain name and Complainant’s trademarks and thus the likelihood of confusion still exists. On the contrary, the generic term "try" may encourage consumers to visit the site to "try" the prescription medicine marketed under the Complainant’s trademarks.

For sake of completeness, the Panel asserts that the top-level suffix in the domain name (i.e. the ".com") must be disregarded under the identity and confusing similarity tests as it is a necessary technical requirement of registration.

NO RIGHTS OR LEGITIMATE INTERESTS

Based on general Internet search, the Respondent is not commonly known by the disputed domain name. Given the fact, that (i) the Respondent, in particular, decided to use a domain name which includes trademarks of the Complainant, to present information and comments on Complainant’s products and alternative generic products, and displays link to other websites offering prescription products for online sale with worldwide delivery (including the United States), etc. and (ii) in the absence of the Respondent's response, the Panel concludes that there is no indication that the domain name was intended to be used in connection with a bona fide offering of goods or services as required by the Policy.

Consequently, the evidentiary burden shifts to the Respondent to show by concrete evidence that it does have rights or legitimate interests in that name. However, the Respondent failed to provide any information and evidence that it has relevant rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Panel finds it grounded that the Respondent registered and used the disputed domain name in bad faith, namely, by using the domain name the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the disputed domain name website or other on-line locations, by creating a likelihood of confusion with the Complainant's mark

as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location.

For the reasons described above, the Panel contends, on the balance of probabilities, that the disputed domain name has been registered and is being used by the Respondent in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **TRYNUVIGIL.COM**: Transferred

PANELLISTS

Name	**JUDr. Jiří Čermák**

DATE OF PANEL DECISION 2016-04-08

Publish the Decision