Decision for dispute CAC-UDRP-101172

Case number	CAC-UDRP-101172
Time of filing	2016-02-25 15:06:30
Domain names	GETNUVIGILSAFELY.COM

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Cephalon, Inc.

Complainant representative

Organization	Matkowsky Law PC

Respondent

Name	Fleurdeliz Jamero

OTHER LEGAL PROCEEDINGS

No other proceedings have been notified to the Panel.

IDENTIFICATION OF RIGHTS

The Respondent, Mr Jamero Fleurdeliz, a resident of Kidapawan City, the Philippines, became the registrant of the disputed domain name GETNUVIGILSAFELY.COM on 27 November 2014 through registration by the ICANN registrar Launchpad.com Inc. The Respondent did not enter a Response in this proceeding or make any submission during it.

The Complainant, Cephalon, Inc. of West Chester, Pennsylvania USA, is the holder of trademarks in the trade name Nuvigil. Evidence of two trademarks for Nuvigil was provided in the course of the proceeding by the Complainant, one an EU Community Trade Mark (CTM), registered on 26 January 2006 under No. 004124831, the other a US trademark, registered on 25 November 2008 under No. 3538564. Both these marks were registered under Class 5 of the Nice Classification scheme in relation to pharmaceutical preparations for the treatment and prevention of human neurological disorders, and notably among them sleep and wakefulness disorders, narcolepsy, obstructive sleep apnea, and shift work disorder.

Nuvigil corresponds to the pharmaceutical drug armodafinil produced and marketed by the Complainant.

The Complainant in addition submitted evidence for equivalent CTM and US registered trademarks for its Provigil product. This trade name corresponds to a similar pharmaceutical drug, modafinil, that is also protected under Class 5 of the Nice

Classification scheme. The Panel treated this evidence as additional information regarding the Complainant's presence in this specialty market.

The Complainant states that the registrant has no relationship with the Respondent whatsoever. It has therefore never authorized the Respondent's use of the Nuvigil trademark.

FACTUAL BACKGROUND

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

The Complainant, Cephalon, Inc., is an indirect, wholly-owned subsidiary of Teva Pharmaceutical Industries Ltd. Teva operates in sixty countries worldwide and is ranked among the top pharmaceutical companies in the world and as the world's largest generic medicines producer. Its well-known Nuvigil product, a mark well known within its specialty area, aims to improve wakefulness in adults. It belongs to a group of innovative treatments for disorders of the central nervous system that have won Teva a world-leading position. Users of Nuvigil can, as one example, include workers seeking to alleviate the effects of shift work.

Nuvigil is subject to important safety information.

PARTIES' CONTENTIONS

The Complainant contends that 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 2002, a finding that the complainant had established rights to the MILLER TIME mark through federal U.S. trademark registrations); Koninklijke KPN N.V. v. Telepathy Inc., D2001-0217 (WIPO 2001, a finding that the Policy only requires that a complainant demonstrate a mark in some jurisdiction); Thermo Electron Corp. v. Xu, FA 713851 (Nat. Arb. Forum 2006, a finding that the complainant had established rights in marks where the marks were registered with a trademark authority); Williams-Sonoma, Inc. v. Fees, FA 937704 (Nat. Arb. Forum 2007, a finding that it is irrelevant whether the complainant has registered its trademark in the country of the respondent's residence).

The Complainant further argues that previous panel decisions have generally held that trademark registrations are valid, 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, 2000; Poarch Band of Creek Indians dba PCI Gaming Authority v. Tech Admin, Virtual Point, NAF Claim No. FA1509001639763, 2015).

In addition, the Complainant points to a series of CAC Panels which have recognized Cephalon's rights in its PROVIGIL/NUVIGIL marks (CAC Case Nos. 100832-100835 (transferring, among others, NUVIGIL4BITCOINS.COM) and Case No. 100892 (transferring BUYNUVIGILQUICK.COM, NUVIGILQUICK.COM and NUVIGILRX.COM, among others).

CONFUSING SIMILARITY

The Complainant contends that the test of confusing similarity under the Policy is confined to a comparison of the domain name and the trademark alone (e.g., Wal-Mart Stores, Inc. v. Traffic Yoon, D2006 0812, WIPO 2006). Confusion in this context, in the sense of bewilderment or failing to distinguish between things, may be regarded as a state of wondering whether there is an association, rather than a state of erroneously believing that there is one (NAF Claim No. FA120001466844, 2012, citing SANOFI-AVENTIS v. Jason Trevenio, WIPO Case No. D2007 0648, 2007).

Furthermore, the Complainant submitted that it has been ruled many times before that, when a registered name is fully incorporated in a domain, this may be sufficient for demonstrating similarity (e.g., WIPO Case No. D2007-1365). This is because the domain name incorporates the entirety of the registered mark, with the addition of generic terms. It is also universally accepted that the generic top-level domain (gTLD) ".com" is not relevant to assessing this element of the Policy.

Therefore, the Complainant concludes that the disputed domain name is confusingly similar to the registered trademark in which Complainant has rights.

NO RIGHTS OR LEGITIMATE INTERESTS

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

Moreover, the pertinent WHOIS information identifies the registrant, whose name does not resemble the domain name. The Complainant argues that this is evidence that the Respondent has not been commonly known by the disputed domain, citing Reese v. Morgan, FA 917029, NAF 2007.

The Complainant observes that while the overall burden of proof rests with the Complainant, panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is often primarily within the knowledge of the Respondent. Therefore, a 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 proof shifts to the respondent (e.g., Hanna-Barbera Prods., Inc. v. Entm't Commentaries, FA 741828, NAF 2006).

The Complainant furthermore argues that the Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory, citing Vertical Solutions Mgmt., Inc. v. webnet-marketing, Inc., FA 95095, NAF 2000, a finding that the Respondent's failure to respond allows all reasonable inferences of fact in the allegations of the Complaint to be deemed true. The Complainant also cites Talk City, Inc. v. Robertson, D2000-0009, WIPO 2000, in the same connection.

Finally, the Complainant alleges, and substantiates with screenshots, that the Respondent is luring consumers in search of the well-known NUVIGIL brand to a documented rogue online pharmacy that promotes "generic" and brand name pharmaceutical products, including products arguably competitive with Complainant's NUVIGIL product, such as Modalert. Such use does not demonstrate a legitimate right or interest.

BAD-FAITH REGISTRATION AND USE

The Complainant submits that its trademark registration predates the domain name registration and that the Respondent can be considered to have been aware of the Complainant's trademark when registering the domain name, as also follows from the way the domain name is currently being used.

It further maintains that the use of the disputed domain name demonstrated in the evidence the Complainant has submitted shows 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 the web site(s) 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.

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 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.

In this regard, the Panel, however, makes the following observations on procedural factors in this case:

(1) By providing evidence of the registrar Launchpad.com Inc's registration agreement, the Complainant satisfied any requirement to show that the language of the proceeding should be in English. The limited nature of the evidence provided does not allow any further reliance to be made on the agreement itself.

(2) During the course of the Panel's examination of the evidence it received in the Case File, the Panel discovered that, on its face, the Complainant had only submitted trademark evidence (in relation to its obligations under Paragraph 3 (b)(viii) and (xiv) of the Uniform Domain Name Dispute Resolution Policy) in respect of its Provigil trademarks and not in respect of the Nuvigil trade name upon whose basis the proceeding had been introduced.

(3) To clarify how a Complaint containing such a manifest deficiency was submitted to the Panel for decision, the Panel addressed a Non Standard Communication (NSC) to the Czech Arbitration Court's Case Administrator.

(4) Both the Case Administrator and the Complainant's representative responded by NSC to the Panel's NSC stating that a technical problem must have intervened that made the parts of the relevant annex to the Complaint (Annex 3) not visible to the Panel, whereas those parts were visible in the documentation on their respective sides.

(5) The Complainant furthermore suggested that in (any) future cases, copies of each document would be provided in separate files (i.e. annexes). The Panel strongly endorses this approach in light of the difficulties that occurred in this case and the prejudice that might have been done to the Complainant's case.

(6) Finally, the projected decision date was extended to afford the opportunity to the Respondent and the Case Administrator to respond to the material new evidence that the Complainant had submitted.

PRINCIPAL REASONS FOR THE DECISION

The Complainant having satisfactorily shown:

(i) that the Respondent has been trading, through its website, on the basis of the Nuvigil trade name by having combined it with a .com domain name registration formed of the sales phrase GETNUVIGILSAFELY;

(ii) that the disputed domain name bears no other possible association than to the Nuvigil pharmaceutical product for wakefulness disorders, particularly in light of content shown on the website and of there being no likelihood of a connection with the Respondent’s own identity;

(iii) that the Respondent and the Complainant have no connection whatsoever; and

(iv) that the Respondent’s registration and use of the disputed domain name can, without any circumstance to the contrary having been shown by the Respondent or being self-evident, only have been to attract web traffic for commercial gain in a manner clearly falling within circumstances highlighted as constituting bad faith under the UDRP.

The sole significant issue to be decided upon is whether the Complainant itself has a right or legitimate interest in the trade name Nuvigil.

The Panel emphasizes here that it is for Complainant to prove its case, as is indicated in Paragraph 3 (b)(viii) and (xiv) of the Uniform Domain Name Dispute Resolution Policy Rules. It is not the Panel's function simply to accept the word of the Complainant, to search for evidence on its behalf or to make significant assumptions for its benefit, as a substitute for what can and should be provided by that party to the dispute. This would be at odds with the requirement that rests on the Panelist under Paragraph 7 of the UDRP Rules to treat the parties impartially and independently and could expose not only a single Panel but the Provider and even the dispute resolution process to suspicion, to the detriment of the process' essential role in the domain name arena.

In the present proceeding, the apparent failure to provide proper substantiation of rights relating to the alleged Nuvigil trademarks, combined with a selective and, in this Panel's view, somewhat over-simplified analysis of past panel decisions (notably the KPN v. Telepathy WIPO decision) tending to favour a Complainant as such, tended to undermine the Complainant's claim even in this uncontested case.

In weighing the elements before it, the Panel remarks that it may certainly take note of the panel decisions to which a Complainant refers but, so far as legal inferences are concerned, it remains equally entitled to consider countervailing positions adopted elsewhere and must above all always be mindful of its duty fairly to administer the Policy in the instant case. The Panel in addition noted that, faced with apparently poor evidence regarding trademarks, no evidence was adduced of the Complainant's own use of the Nuvigil trade name in domain names for which it is registrant.

It is therefore fortunate that the query to the Case Administrator made in the course of this proceeding brought conclusive evidence to the Panel's attention of the Complainant's trade marks in respect of the trade name Nuvigil. In effect, the Complainant's representative did not know of, and – the Panel wishes to make quite clear – could not have reasonably have foreseen, the technical difficulty that led the Panel to be unable to view the Complainant's most important evidence concerning its rights and interests.

The recommendation to separate documents into different annexes that is provided in the Procedural Factors section of this Decision will, if followed in other proceedings, serve to avoid a similar difficulty occurring in other cases.

In conclusion, the Panel has no hesitation on the basis of the above outcomes to order transfer of the disputed domain name to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **GETNUVIGILSAFELY.COM**: Transferred

PANELLISTS

Name	**Kevin J. Madders**

DATE OF PANEL DECISION 2016-04-13

Publish the Decision