Decision for dispute CAC-UDRP-101223

Case number	CAC-UDRP-101223
Time of filing	2016-06-13 11:32:10
Domain names	nuvigil-review-online.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Cephalon, Inc.

Complainant representative

Organization	Matkowsky Law PC

Respondent

Organization	CONTENT CREATORS INDIA

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided legal proceedings relating to the disputed domain name

IDENTIFICATION OF RIGHTS

The Complainant is the owner of different trademark registrations. In particular Cephalon, Inc owns:

- EUIPO Registration for "NUVIGIL" no. 4124831 registered on January 26, 2006 for class 5;

- U.S. Registration for "NUVIGIL" no. 3538564 registered on November 25, 2008 for class 5.

The Complainant also relies on NUVIGIL use online and in particular on the domain name <nuvigil.com> registered in 2004.

The disputed domain name was registered on January 25, 2012.

FACTUAL BACKGROUND

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

The Complainant is Cephalon, Inc. (“Cephalon”), 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 NUVIGIL (armodafinil) Tablets are part of Teva’s CNS (Central Nervous System) line of specialty medicines. NUVIGIL 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 NUVIGIL mark is well known within its specialty area, and Complainant uses its mark in the domain name <nuvigil.com>.

The Complainant assumes that the disputed domain name is confusingly similar to its registered trademark NUVIGIL as the disputed domain name contains the Complainant's trademark in its entirety. The mere addition of generic terms such as "review" and "online" does not alter the finding of similarity between the signs. In this perspective it should be considered that the Complainant also owns the domain name <nuvigil.com>. Moreover, the Complainant contends that it is well-settled that the addition of generic top-level domain suffix “.com” is non-distinctive because it is required for the registration of the domain name. Therefore, in the Complainant’s view, the disputed domain name is clearly confusingly similar to the NUVIGIL trademark and, as a result, the requirement of paragraph 4(a)(i) of the Policy is met.

The Complainant states that the Respondent has never been licensed, authorized or otherwise permitted to use the disputed domain name or any other domain name using the Complainant’s trademark. The Respondent is not known by the disputed domain name, nor has the Respondent acquired any trademark rights in respect of the domain name.

Furthermore, Respondent is luring consumers in search of the well-known NUVIGIL brand to a website that promotes allegedly competitive or highly related "brain vitamines" and "brain supplements" that have no affiliation with Complainant or its NUVIGIL brand, including specifically Excelerol from Accelerated Intelligence Inc, in California USA. Luring consumers in search on the well known NUVIGIL brand to a site promoting products purportedly competitive with Complainant's NUVIGIL product does not demonstrate a legitimate right or interest. In light of the foregoing, the Complainant claims that the requirement of paragraph 4(a)(ii) of the Policy is met.

The Complainant states that there is no doubt the Respondent was aware of the existence of Cephalon’s mark. In light of the use of the disputed domain name, Respondent is attempting 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. Considering the above, the Complainant claims that the requirement of paragraph 4(a)(iii) of the Policy is 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.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 4(a) of the Policy provides that to obtain the transfer of the domain name, the Complainant must prove that each of the following elements is present:

(i) the Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

(ii) the Respondent has no rights or legitimate interests in respect of the Domain Name; and

(iii) the Domain Name has been registered and is being used in bad faith.

A) The disputed domain name <nuvigil-review-online.com>, is comprised of the Complainant's trade mark NUVIGIL plus the generic wording "-review-online" to create the domain name <nuvigil-review-online.com>. The most distinctive part of the disputed domain name is Complainant's mark NUVIGIL. Adding generic words to this mark do not prevent the disputed domain name being confusingly similar to the Complainant's trade mark NUVIGIL. In addition, it must be considered that the relevant comparison to be made is with the first portion of the domain name only (i.e., "nuvigil-review-online"), as it is well-established that the top-level domain name ".com" should be disregarded for this purpose (see Playboy Enterprises International, Inc. v. John Taxiarchos, WIPO Case No. D2006-0561; Burberry Limited v. Carlos Lim, WIPO Case No. D2011-0344; Magnum Piercing, Inc. v. The Mudjackers and Garwood S. Wilson, Sr., WIPO Case No. D2000-1525).

The Panel finds that the disputed domain name is confusingly similar to the Complainant's mark NUVIGIL. Therefore, in the Panel's view the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B) The Complainant has long standing rights in the mark NUVIGIL. The Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain name as it is not commonly known under the disputed domain name and as the Respondent was never authorized or licensed or otherwise permitted by the Complainant to use the disputed domain name. The Respondent, in the absence of any response, has not shown any facts or elements to justify legitimate rights or interests in the disputed domain name. Therefore, on the basis of the evidences submitted and in the absence of a response the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name. Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C) Paragraph 4(b) of the Policy sets out a non-exhaustive list of circumstances that may indicate that the Domain Name was registered and used in bad faith, as follows:

(i) circumstances indicating that [the respondent has] registered or acquired a disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name to the complainant or to a competitor of the complainant, for valuable consideration in excess of [the respondent's] documented out-of-pocket costs directly related to the disputed domain name; or

(ii) [the respondent has] registered the disputed domain name in order to prevent the complainant from reflecting the complainant's trade mark or service mark in a corresponding domain name, provided that [the respondent has] engaged in a pattern of such conduct; or

(iii) the respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the disputed domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent's] website or other on-line location, 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.

The Panel is satisfied that the domain name in dispute was both registered and is being used in bad faith. As regards to bad faith registration, the evidence shows that Complainant's trademark NUVIGIL was registered long before the registration of the domain name in dispute. In addition, the Complainant has demonstrated to the satisfaction of this Panel that the Complainant's trademark NUVIGIL is well-known, as confirmed also by previous UDRP decisions mentioned by the Complainant (see in particular Cephalon, Inc. v. Alen Mironassyan CAC Case No. 100892). The Panel therefore finds that the domain name in dispute was registered in bad faith by the Respondent since there is no doubt the Respondent, at the time of the registration of <nuvigil-review-online.com>, was aware of the existence of Complainant's mark. The Respondent's use of the domain name in dispute is not "bona fide" because the Respondent uses said domain name also to promote brain vitamins unrelated to Complainant's product NUVIGIL. Therefore, as far as bad faith use of the domain name is concerned, the Panel accepts the Complainant's contention that by using the disputed domain name to promote products purportedly competitive with Complainant's product, the Respondent is intentionally attempting to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademark as to the source or sponsorship of the website, within the meaning of Paragraph 4(b)(iv) of the Policy (see Staples, Inc., Staples The Office Superstore, Inc., Staples Contract and & Commercial, Inc. v. John Morgan, WIPO Case No. D2004-0537 and Swarovski Aktiengesellschaft v. Domain Admin, PrivacyProtect.org / Robert S. Rayford WIPO Case No. D2012-2494).

The Complainant has therefore demonstrated, to the satisfaction of the Panel, that 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 ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NUVIGIL-REVIEW-ONLINE.COM**: Transferred

PANELLISTS

Name	**Avv. Guido Maffei**

DATE OF PANEL DECISION 2016-07-18

Publish the Decision