

Decision for dispute CAC-UDRP-100834

Case number	CAC-UDRP-100834
Time of filing	2014-07-23 11:37:07
Domain names	nuvigil4bitcoins.com, provigil4bitcoins.com

Case administrator

Name	Lada Válková (Case admin)
------	---------------------------

Complainant

Organization	Cephalon, Inc.
--------------	----------------

Complainant representative

Organization	Matkowsky Law PC
--------------	------------------

Respondent

Organization	Domain Administrator c/o PrivacyGuardian.org
--------------	--

OTHER LEGAL PROCEEDINGS

The panel is not aware of other proceedings.

IDENTIFICATION OF RIGHTS

The Complainant relies on its US registered marks: (a) Provigil; Reg. No. 2,000,231, (a typed drawing mark) first used in 1995, issued in 2006, in class 5. and Reg. No. 2,499,937 (a figurative mark with words and design elements), first used in 1995, issued October 23, 2001, in class 5 and others; and (b) Nuvigil; Reg. No. 3,538,564 (a word mark), issued November 25, 2008 in class 5 and Reg. No. 3,782,440 (a figurative mark with words and design elements), issued April 27, 2010, in class 5 and others. It also relies on its use in international commerce and rights arising from the same. It claims protection also on the basis that its marks are well known.

FACTUAL BACKGROUND

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

The Complainant contends that Cephalon, Inc. ("Cephalon"), an indirect wholly-owned subsidiary of Teva Pharmaceutical Industries Ltd., is a global biopharmaceutical company. Since its inception in 1987, Cephalon has brought medicines to patients in several therapeutic areas.

Cephalon's Provigil and Nuvigil are prescription medicines indicated to improve wakefulness in adults who experience

excessive sleepiness due to obstructive sleep apnea, shift work disorder, or narcolepsy. In the United States, the schedules of controlled drugs are determined by the Drug Enforcement Agency (DEA) and are based on a drug's potential for abuse. Both Provigil and Nuvigil are Schedule IV [C-IV] medications, because they have the potential to be abused or lead to dependence. In other words, these are prescription only medicines.

According to the Complainant, the Provigil mark is well-known and has been in continuous use is in commerce since 1995. Cephalon also owns numerous other registrations for the mark around the world, including but not limited to federal trademark registrations in the United States (cited above). It claims these registrations are incontestable pursuant to the Lanham Act, 15 U.S.C. § 1065(b), and constitute evidence of Complainant's exclusive right to use the mark for the products and services specified in those registrations pursuant to 15 U.S.C. § 1065 and 1115(b). It claims Provigil is a famous mark.

The Complainant also claims that since at least as early as 2009, the Nuvigil mark has been in continuous use in commerce and it owns numerous registrations for it around the world, including the US federal trademark registrations (cited above), and exclusive rights to use the mark for the goods specified in these registrations.

The Complainant contends that it acquired its rights in its marks significantly prior to when the disputed domains were created in January 2014.

The Complainant claims that the disputed domain names incorporate its trademarks in their entirety. The combination of the word "Nuvigil" or "Provigil" with the figure "4" and the term "bitcoins" does not affect the overall impression of the dominant part of the disputed domain name. It relies on previous UDRP decisions holding that the addition of a common word does not distinguish a domain name from Complainant's trademark or preclude a finding of confusing similarity. The addition of generic top-level domain suffix ".com" is non distinctive because it is required for the registration of the domain name. Therefore, the Complainant contends the disputed domain names are clearly confusingly similar to the trademarks and, as a result, the requirement of paragraph 4(a)(i) of the Policy is met.

The Complainant claims that the Respondent has never been licensed, authorized or otherwise permitted to use the disputed domain names or any other domain name using Complainant's trademark. The Respondent is not known by the disputed domain names, nor has the Respondent acquired any trademark rights in respect of the domain names. Furthermore, the Respondent's use of the disputed domain names do not satisfy the test for bona fide use established in prior UDRP panel decisions as the disputed domain names are being used to host a website offering competitive or generic products identical to Complainant's products, which are being sold under Complainant's trademark, and such websites do not accurately and prominently disclose the Registrant's relationship with the trademark owner.

According to the Complainant, the Respondent has used the disputed domain names to intentionally attempt to attract, for commercial gain, Internet users to websites by creating a likelihood of confusion with the Complainant's trademarks as to source, sponsorship, affiliation, or endorsement of the websites or of products available at the websites or through the sites. This is not a legitimate noncommercial or fair use under the Policy. E.g., *Aventisub II Inc. Sanofi v. Nikolay Fedotov*, WIPO Case No. D2013-2121 (Feb. 9, 2014) (transferring <allegra-store.com>). It says there is no reason why the Respondent should have any right or interest in any of the disputed domain names. E.g., *F. Hoffman-La Roche AG v. Duggins Frank*, Case No. D2014-0508 (Nat. Arb. Forum June 5, 2014) (transferring <buyvaliumbuy.com>); *F. Hoffman-La Roche AG v. Whois Agent, Whois Privacy Protection Service*, WIPO Case No. D2014-0496 (May 27, 2014) (transferring <purchasevaliumonline.com> and noting that even if original Valium products were being sold, this would not automatically give rights to use the trademark in the disputed domain). The Complainant claims that in light of the foregoing, the requirement of paragraph 4(a)(ii) of the Policy is met.

The Complainant claims that the Respondent was aware of the existence of Complainant's trademarks when the Respondent registered the disputed domain names and there is no other plausible explanation for Respondent's adoption of the term "provigil" or "nuvigil" in conjunction with the figure "4" and term "bitcoins" in the disputed domain name other than to attract for commercial gain Internet users by creating a likelihood of confusion with Complainant's trademarks.

It argues the disputed domain names resolve to websites offering purportedly, the same types of products as those offered

under Complainant's respective marks, sold under Complainant's respective trademarks but referring to different brands. That is, <nuvigil4bitcoins.com> referring to "Waklert" brand of Nuvigil, and <provigil4bitcoins.com> referring to "Modalert" brand. It relies on Paragraph 4(c)(iv) of the Policy and claims the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its web site or other on-line location, by creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation, or endorsement and this is evidence of the use of a domain name in bad faith.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The disputed domain names commence with the Complainant's respective trade marks (the words 'Nuvigil' and 'Provigil') with the addition of '4bitcoins' and the suffix .com. The generic top level suffix .com may be disregarded. The Complainant relies on the authority of F. Hoffman-La Roche AG v. William Tell, WIPO Case No. D2014-0463 (June 2, 2014) (transferring <valium4bitcoins.com>) (when a domain name wholly incorporates a complainant's registered trademark that may be sufficient to establish confusing similarity for purposes of the Policy).

While the disputed domain names incorporate the Complainant's trade marks, the additional words are not generic in this Panel's view and contain a distinguishing informational and promotional message about the currency and/or payment method of the offered commercial transaction. However, the Panel finds the disputed domain names to be similar to the Complainant's trade marks, based on the inclusion of the marks. Therefore, 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 relies on the authority of Aventisub II Inc. Sanofi v. Nikolay Fedotov, WIPO Case No. D2013-2121 (Feb. 9, 2014) (transferring <allegria-store.com>)(no legitimate noncommercial or fair use of proprietary name for site selling generics). This case was not defended and this greatly limits its value as precedent.

The Panel accepts the Complainant's assertions that the Respondent is not commonly known by the disputed domain names and is not affiliated with nor authorised by the Complainant. However, this is not the end of the inquiry. Other legitimate and fair uses even on the face of it would include bona fide offering with descriptive and nominative fair use.

It must be noted that in this case, the disputed domain names resolved to sites with what this Panel considers are very clear immediate disclaimers that a generic (or non-proprietary) medicine was offered, as an alternative to the proprietary medicines named in the disputed domain names. It is also relevant that the sites also contained legal notices advising that the sales were legal in and from their country of origin (India) but that ordering consumers would be responsible for local law compliance. Such imports for limited amounts for personal use appear (from online public resources viewed by the Panel) to be legal (in the UK at least) provided a prescription can be produced to customs on request, if any. This Panel considered this to be honest and bona fide. The UDRP might protect the Respondent if selling only the Complainant's own medicines under the authority of Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No.D2001-0903.

However, the Panel is compelled to note again that EU trade mark law may protect the Respondent if it was selling the Complainant's own medicines and alternatives. However, trade mark law in the EU in relation to permitted comparative advertising of alternative products alone by keywords and domain names is in flux. The fact that the public must click through to see the disclaimers in a case where only alternatives are offered, means the outcome would currently be uncertain even at law.

The UDRP is not the law however and under the UDRP the Complainant need only make a prima facie showing of absence of rights or legitimate interest in the disputed domain names on the part of the Respondent and the evidentiary burden then shifts to the Respondent to show it has rights or legitimate interests in that name. The Respondent has made no attempt to do so here.

It would not therefore be right to explore the fair and legitimate use issues further here where there is no response.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name. Therefore, this panel finds the Complainant has 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 Respondent was obviously aware of the existence of the Complainant's trade marks when it registered the disputed domain names. Moreover, the disputed domain names resolve to websites offering competing alternative products to those of the Complainant. In light of the failure of the Respondent to come forward and defend its use as fair and legitimate and rebut 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

The Complainant made a prima facie case and the Respondent failed to defend and show potentially applicable defences.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NUVIGIL4BITCOINS.COM**: Transferred
2. **PROVIGIL4BITCOINS.COM**: Transferred

PANELLISTS

Name	Victoria McEvedy
------	-------------------------

DATE OF PANEL DECISION	2014-09-12
------------------------	------------

Publish the Decision