Decision for dispute CAC-UDRP-101169

Case number	CAC-UDRP-101169
Time of filing	2016-02-25 14:46:34
Domain names	BUY-NUVIGIL-ONLINE.NET

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Cephalon, Inc.

Complainant representative

Organization	Matkowsky Law PC

Respondent

Organization	Venture i. S.A

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided legal proceedings, which relate to the Domain Name.

IDENTIFICATION OF RIGHTS

For the purpose of these proceedings, the Complainant relies on its earlier NUVIGIL trademark in class 5, registered in the US (Reg. No. 3538564) and in the EU with the OHIM (reg. No. 4124831).

FACTUAL BACKGROUND

The Complainant is an indirect, wholly-owned subsidiary of Teva Pharmaceutical Industries Ltd. The Complainant, together with its subsidiaries, was first established in 1901, with its global Headquarters in Israel. Operating in six countries Worldwide, Teva is ranked among the top pharmaceutical companies in the world, and the world's largest generic medicines producer. The Complainant's revenues in 2014 amounted to $20.3 billion.

The trademark NUVIGIL is used in connection with a pharmaceutical preparation aimed at improving wakefulness in adult patients with excessive sleepiness associated with narcolepsy, obstructive sleep apnea, or shift work disorder.

The NUVIGIL mark is well-known within its speciality area.

The Domain Name BUY-NUVIGIL-ONLINE.NET was registered on July 1, 2015, i.e., well after the registration of the

Complainant's NUVIGIL trademarks cited as a basis for this Complaint.

PARTIES CONTENTIONS

The Parties' contentions are the following.

COMPLAINANT:

1. Confusing Similarity

The Complainant maintains that the Domain Name is confusingly similar to the Complainant's NUVIGIL trademark, because it fully incorporates its trademark with the addition of generic terms. Moreover, the gTLD ".com" is not relevant to assessing the confusing similarity requirement under the Policy.

2. Rights or Legitimate Interests

As far as the second element of the Policy is concerned, the Complainant states that providing prima facie evidence of the Respondent's lack of rights or legitimate interests in the Domain Name is sufficient to succeed on this point. 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 Complainant maintains that the pertinent Whois information identifying the registrant, does not resemble the Domain Name. On this record, the Respondent has not been commonly known by the Domain Name so as to have acquired rights or legitimate interests within the meaning of Para. 4(c)(ii)of the Policy.

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 the Complainant's NUVIGIL product. Such use does not demonstrate right or interest.

3. Bad Faith

According to the Complainant, there is bad faith in the registration of the Domain Name because the trademark registration predates the Domain Name registration and the Complainant's trademark is well-known in its field. Therefore the Respondent was aware of the Complainant's trademark when registering the Domain Name, as it also follows from the way the Domain Name is currently being used.

As far as use in bad faith is concerned, the Complainant states that the 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.

RESPONDENT:

The Respondent has filed a one sentence Response, stating as follows: "our client agrees to pass the ownership of the domain to the copyright holder".

RIGHTS

In the instant case, the Panel has not deemed necessary to verify whether 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), for the reasons explained below.

NO RIGHTS OR LEGITIMATE INTERESTS

In the instant case, the Panel has not deemed necessary to evaluate the Respondent's lack of rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy), for the reasons explained below.

BAD FAITH

In the instant case, the Panel has not deemed necessary to assess the registration and use of the Domain Name in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy), for the reasons explained below.

PROCEDURAL FACTORS

Before addressing the principal reasons for the decision, it is necessary to evaluate one procedural issue that the Complainant has raised.

The Complainant points out that the language of the Registration Agreement is Russian. The Registrar of the disputed domain name has confirmed.

The Complainant has requested to change the language of these proceedings to English because the Respondent appears to be fluent in English, while the Complainant would be jeopardised by having to conduct the procedure in Russian, which is a language that the Complainant does not know.

The main reasons to support the Complainant's request are the following. The Respondent is an anonymous and offshore hosting solution provider incorporated in Panama ad doing business worldwide. The Respondent offers anonymous solutions covering domain registrations. The Respondent's website is only in English and all press releases concerning their services are in English. Furthermore, the Domain Name itself includes English words and the website hosted on the Domain Name is also in English.

The Complainant is not familiar with Russian Language and having to conduct the proceedings in Russian would disadvantage the Complainant as it would have to incur added expense and inconvenience in having the Complaint translated into Russian.

According to Para. 11(a) of the Rules, "[u]nless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, 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 the instant case, it is clear that the Respondent is fluent in English, not only for the reasons mentioned in the Complaint, but also because the Response is written in English. Moreover, the Respondent did not object to the Complainant's request to change the language of the proceeding. On the other side, it is clear that the Complainant is not familiar with Russian.

As none of the parties would be affected by the change of the language of these proceedings from Russian to English, the Panel hereby determines to accept the Complainant's request to conduct these proceedings in English.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 4(a) of the Policy requires that, in order to obtain the transfer of the Domain Name the Complainant must prove that:

(i) The domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) The Respondent has no rights or legitimate interests with respect to the domain name; and

(iii) The domain name has been registered and is being used in bad faith.

However, the Panel notes that in the instant case, the Respondent has consented to the transfer of the Domain Name to the

Complainant. Therefore, the Respondent has agreed on the remedy requested by the Complainant. Under the circumstances, there is no longer a dispute as to the ownership of the Domain Name, as there are no longer contending claims.

In Williams-Sonoma, Inc. v. EZ-Port, WIPO Case No. D2000-0207, the panel decided to transfer the domain name to the complainant, without reviewing the facts supporting the claim even if the parties did not enter into a settlement agreement, because the Respondent had consented to the transfer.
In Infonxx.Inc v. Lou Kerner, WildSites.com, WIPO Case No. D2008-0434, the panel considered “that a genuine unilateral consent to transfer by the Respondent provides a basis for an order for transfer without consideration of the paragraph 4(a) elements.” For similar decisions, see also The Cartoon Network LP, LLLP v. Mike Morgan, WIPO Case No. D2005-1132; Pierre Balmain S.A. v. Domains By Proxy, LLC / Daniel Phillips, WIPO Case No. D2015-0189, and many others).

Para. 4.13 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0") provides that "[w]here the parties to a UDRP dispute have not succeeded in settling a case between themselves prior to the rendering of a panel decision, but the respondent has given its unilateral and unambiguous consent on the record to the remedy sought by the complainant, a panel may at its discretion order transfer (or cancellation) of the domain name on that basis alone."

Under Rule 10(a) the Panel may conduct the proceedings in such manner as it deems appropriate under the Policy and the Rules. Rule 10(c) requires the Panel to “ensure that the proceeding takes place with due expedition.” Rule 17 requires the Panel to terminate the proceeding when the parties have agreed to a settlement.

In view of the foregoing, considering that the Respondent has unequivocally agreed to the transfer of the Domain Name to the Complainant, the Panel finds that it is appropriate to enter an order granting the relief requested by the Complainant, without need to review the conditions set forth by Para. 4(a) of the Policy, so that the transfer may occur without delay.

In view of the aforementioned circumstances, in accordance with paragraph 15 of the Rules, the Panel orders that the disputed domain name <buy-nuvigil-online.net> be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BUY-NUVIGIL-ONLINE.NET**: Transferred

PANELLISTS

Name	**Angelica Lodigiani**

DATE OF PANEL DECISION 2016-03-19

Publish the Decision