Decision for dispute CAC-UDRP-101170

Case number	CAC-UDRP-101170
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Domain names	BUYPROVIGILTODAY.COM, ONLINEPROVIGIL.COM

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Cephalon, Inc.

Complainant representative

Organization	Matkowsky Law PC

Respondent

Organization	Online Health Depot Limited

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of:

• US trade mark registration No. 2000231 for the mark PROVIGIL in class 5, dated 10 September 1996.
• CTM registration No. 003508843 for the mark PROVIGIL in class 5, dated 25 March 2008.

It should be mentioned that the disputed domain name <buyprovigiltoday.com> was registered on 19 January 2012 and the disputed domain name <provigilonline.com> was registered on 26 January 2012. Therefore, the registration of the Complainant's trademarks predates the registration of the disputed domain names.

FACTUAL BACKGROUND

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

PRELIMINARY: LANGUAGE OF THE PROCEEDING

The registration agreement is in Russian. The Complainant requests to proceed in English because the domain names are comprised of English words, not Russian, and the websites identified with the disputed domain names are in English. Therefore, it is clear that the Respondent who selected the domain names, and operates the Websites, speaks English fluently, as that is the language they chose to operate the sites in question, and to register the domain names in dispute comprised of English words. The Respondent submits that the Respondent is incorporated in the United Kingdom, where English is more predominant than Russian; moreover, the registrant's email address is comprised of English words, suggesting that Respondent uses English and not Russian as a dominant language for its business activities.

Under Paragraph 11(a) of the Rules, the Panel has the discretion to allow the proceeding to be conducted entirely in English, including an English-language complaint, notwithstanding the Russian registration agreement.

The main purpose of making the request is that 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. The Complainant should not be compelled to incur translation costs to submit a Russian language Complaint if the Panelist will agree that the proceedings may be conducted entirely in English. If the Panelist determines that the proceeding must be conducted in Russian and does not make an exception as being requested by the Complainant, then Complainants would request an opportunity to provide a Russian language complaint at that time.

The Complainant refers to Swarovski Aktiengesellschaft v. Zhang jie, WIPO Case No. D2012-0887, in which the Center verified that the language of the registration agreement was Chinese, and no agreement had been reached between the complainant and respondent that the language of the proceeding should be English. In that case, the complainant also filed its complaint in English, and requested that the proceedings be conducted in English because it was not familiar with Chinese, it would have added expense and inconvenience in having the complaint translated, and the respondent is able to communicate in English as the website identified with the domain name was in English, as is the case here.

The Respondent, who chose to both register an English word in the disputed domain name consisting otherwise entirely of ASCII characters, and also host competing advertisements in English understands clearly the request being made herein to proceed in English, and has a fair opportunity to object to the use of English as the language of the proceeding. As the Panel found in the aforementioned case, "Using English as the language of the proceedings will not be prejudicial to the Respondent in its ability to articulate the arguments for the case, while if the proceedings are to be conducted in [Russian], the Complainant would be unfairly disadvantaged by being forced to translate the Complaint into [Russian]."

Further, in CAC No. 100530, regarding <repettoshop.com>, the Panelist determined that the language of the proceeding would be in English even though the Registration Agreement was in Chinese. One of the determining factors was that the website corresponding to the disputed domain name was entirely in English, which is the case here. If the Respondent uses English on its websites identified with the disputed domains, the Respondent can respond in English to an English language complaint regarding the same. Also in CAC Case No. 100614, the language of the registration agreement for eName Technology regarding multiple domain names was in Chinese, but the CAC Provider allowed the request not to translate the Complaint into Chinese to be presented to the Panelist, who found no reason why not to proceed in the English language without requiring the Complaint to be translated into Chinese.

The Complainant requests the Panelist to allow the proceedings to be conducted in English, rather than require it to translate the Complaint into Russian.

BACKGROUND

The Complainant Cephalon, Inc. (“Cephalon”), is 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 PROVIGIL® (modafinil) Tablets [C-IV] are part of Teva's CNS (Central Nervous System) line of specialty medicines. They contain modafinil, a Schedule IV federally controlled substances in the United States. Subject to important safety information, PROVIGIL® 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 PROVIGIL® mark is well known within its specialty area.

PROTECTED RIGHTS RELIED UPON

Cephalon has trademark rights in Class 5 in its PROVIGIL® mark (see Identification of rights above).

The Complainant submits that Panels have found that registration of a mark with a trade mark authority, regardless of the location of the parties, is sufficient evidence of having rights in a mark. For example, Miller Brewing Co. v. Miller Family, FA 104177 (Nat. Arb. Forum Apr. 15, 2002) (finding that the complainant had established rights to the MILLER TIME mark through its federal U.S. trade mark registrations); Koninklijke KPN N.V. v. Telepathy Inc., D2001-0217 (WIPO May 7, 2001) (finding that the Policy only requires that complainant demonstrate a mark in some jurisdiction); Thermo Electron Corp. v. Xu, FA 713851 (Nat. Arb. Forum July 12, 2006) (finding that the complainants had established rights in marks where the marks were registered with a trade mark authority); Williams-Sonoma, Inc. v. Fees, FA 937704 (Nat. Arb. Forum Apr. 25, 2007) (finding that it is irrelevant whether the complainant has registered its trade mark in the country of the respondent's residence).

The Complainant submits that previous panel decisions have generally held that trade mark registrations are valid and constitute prima facie evidence of ownership, validity and the exclusive right to their use. For example, Microsoft Corporation v. J. Holiday Co. (WIPO case no. D2000-1493 February 20 2000); Poarch Band of Creek Indians dba PCI Gaming Authority v. Tech Admin, Virtual Point, NAF Claim No. FA1509001639763 (Nov. 13, 2015).

The Complainant further submits that a series of CAC Panels have recognized Cephalon's rights in its PROVIGIL and NUVIGIL marks, such as CAC Case Nos. 100832-100835 (transferring, amongst others, <provigilmodafinilforsale.com>, <provigilonline.com>, <provigil4bitcoins.com>, <genericprovigil.net>, <buy-provigil-generic.com>, etc.); see also CAC Case No. 100892 (transferring <buyprovigil-quick.com>, <buyprovigilextra.com>, <buyprovigilmeds.com>, <provigilforsale.com>, amongst others).

CONFUSING SIMILARITY (ICANN Rule 3(b)(ix)(1); ICANN Policy, paragraph 4(a)(i))

The Complainant submits that the disputed domains names are confusingly similar to the registered trade mark in which Complainant has rights.

NO RIGHTS OR LEGITIMATE INTERESTS (ICANN Rule 3(b)(ix)(2); ICANN Policy, paragraph 4(a)(ii))

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

Moreover, the pertinent WHOIS information identifies the registrant, which does not resemble the domain names. On this record, the Respondent has not been commonly known by the disputed domain names so as to have acquired rights to or legitimate interests in it within the meaning of Paragraph 4(c)(ii) of the Policy. For example, Reese v. Morgan, FA 917029 (Nat. Arb. Forum Apr. 5, 2007) (finding, under Paragraph 4(c)(ii) of the Policy, that a UDRP respondent was not commonly known by a contested domain name where there was no evidence in the record, including the relevant WHOIS information,

showing that that respondent was commonly known by that domain name, and where a complainant asserted that it did not authorize that respondent's use of its mark in the domain name).

The Complainant states 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 a 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 production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. E.g., Hanna-Barbera Prods., Inc. v. Entm't Commentaries, FA 741828 (Nat. Arb. Forum Aug. 18, 2006).

The Complainant asserts that the Respondent is luring consumers in search of the well-known PROVIGIL brand to a documented rogue online pharmacy that promotes a substitute arguably competitive product (MODALERT) to the PROVIGIL brand. Such use does not demonstrate a legitimate right or interest. See for example, F. Hoffmann-La Roche AG v. Aleksandr Bannikov, WIPO Case No. D2015-0066; Eli Lilly and Company v. Igor Palchikov, FA 1105001388612; Lilly ICOS LLC v. Alexey Stoun, WIPO Case No. D2006-1170.

BAD-FAITH REGISTRATION AND USE (ICANN Rule 3(b)(ix)(3); ICANN Policy, paragraph 4(a)(iii))

The Complainant asserts that the trade mark registration rights predate the domain name registration, and the allegations that the trade mark are well-known in its field has not been rebutted. The Respondent can be considered to be aware of the Complainant's trade mark when registering the domain names, as it obviously follows from the way the domain names are currently being used.

In light of the use of the disputed domain names, as evidenced by the documents submitted by the Complaint, 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 their web sites and of the products promoted therein. (See Cephalon, Inc. v Alen Mironassyan, Alen Mironassyan, CAC Case No. 100892). Therefore, according to the Complainant the requirement of bad faith registration and use of the disputed domain names 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

LANGUAGE

Under Paragraph 11(a) of the Rules, the language of the administrative proceeding shall be the language of the Registration Agreement, but the Panel may allow the proceeding to be conducted in another language, having regard to the circumstances of the case.

Although the registration agreement is in Russian, the Complainant has requested the proceedings to be in English. It says it is not familiar with the Russian language and it would disadvantage the Complainant if it had to conduct the proceedings in Russian, as it would have to incur added expense and inconvenience in having the Complaint translated into Russian.

It appears from the evidence submitted by the Complaint that the language of the websites that use the disputed domain names is English; the disputed domain names incorporate English words and the registrant's email address is comprised of English words. Further, the Respondent's address is in England.

It appears that Respondent is familiar with the English language and uses English for its business activities connected to the disputed domain names. Under these circumstances the Respondent will not be disadvantaged if the proceedings are conducted in English. By contrast, the Complainant would be disadvantaged if the proceedings were conducted in Russian and if it had to incur the expense and inconvenience of having to translate the Complaint into Russian.

Having regard to the circumstances of the case, the Panel agrees that the proceedings should be conducted in English.

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 requires the Complainant to prove each of the following three elements

(i) The disputed domain names are identical or confusingly similar to a trade mark or service mark in which the Complaint has rights.
(ii) The Respondent has no rights or legitimate interests in the domain names.
(iii) The domain names have been registered and used in bad faith

The Panel is satisfied that the Complainant is the owner of trade mark registrations for the mark PROVIGIL.

When considering whether a disputed domain name is confusingly similar to a trade mark in which the Complainant has rights, it is well established that the generic top level suffix .com may be disregarded.

The disputed domain names <buyprovigiltoday.com> and < onlineprovigil.com>, are comprised of the Complainant's trade mark PROVIGIL plus the generic words "buy" and "today" to create the domain name <buyprovigiltoday.com>, and the word "online" to create the domain name < onlineprovigil.com>. The most distinctive part of the disputed domain names is Complainant's mark PROVIGIL. Adding generic words to this mark do not prevent the disputed domain names being confusingly similar to the Complainant's trade mark PROVIGIL.

The Panel finds that each of the disputed domain names <buyprovigiltoday.com> and < onlineprovigil.com>, are confusingly similar to the Complainant's mark PROVIGIL.

B. Lack of rights or legitimate interests.

The Complainant says that the Respondent has not been commonly known by the disputed domain names. Further, the Complainant says that the Respondent has not been authorised or licensed to use the Complainant's mark PROVIGIL, and that the Respondent is not connected or affiliated with the Complainant in any way.

The Respondent has not filed a Response and has provided no evidence that it has any rights or legitimate interests in the disputes domain names.

The Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain names.

C. Registered and used in bad faith.

Paragraph 2 of the Policy provides that it is the Respondent's responsibility, when registering a domain name, to determine whether it would infringe or violate someone else's rights.

The Complaint has long-standing trade mark registrations for PROVIGIL. The Respondent's use of the disputed domain names, indicate that it is aware of the Complainant's rights. It also appears from the evidence submitted with the Complaint that the Respondent is attempting to attract for commercial gain, Internet users to its websites linked to the disputed domain names, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the websites and the products they promote.

The Respondent has not filed a Response and has provided no evidence of any actual or contemplated good faith use of the domain names. There appears to be no reason why the Respondent would register the disputed domain names other than to create a likelihood of confusion with the Complainant's mark PROVIGIL.

Taking all these factors into consideration the Panel finds that the disputed domain names were registered and used by the Respondent in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BUYPROVIGILTODAY.COM**: Transferred
2. **ONLINEPROVIGIL.COM**: Transferred

PANELLISTS

Name	**Mrs Veronica Bailey**

DATE OF PANEL DECISION 2016-04-06

Publish the Decision