Decision for dispute CAC-UDRP-101224

Case number	**CAC-UDRP-101224**
Time of filing	**2016-06-13 11:36:25**
Domain names	**nuvigil-reviews.com**

Case administrator

Name	**Lada Válková (Case admin)**

Complainant

Organization	**Cephalon, Inc.**

Complainant representative

Organization	**Matkowsky Law PC**

Respondent

Organization	**Victory Films Inc.**

OTHER LEGAL PROCEEDINGS

None of which the Panel is aware.

IDENTIFICATION OF RIGHTS

The Complainant has established that it has extensive trademark rights in the NUVIGIL mark.

In particular it on relies on its rights pursuant to trademark registrations in the United States of America and Europe, established by evidence submitted by the Complainant which the Panel accepts.

This evidence shows that the Complainant is registered as the owner of the United States trademark No. 3538564, registered on November 25, 2008, and the OHIM CTM trademark Reg. No. 004124831, registered on January 26, 2006.

FACTUAL BACKGROUND

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

GENERAL

The Complainant's case is that it is the owner of several trademarks for NUVIGIL, that it is the owner of the United States trademark No. 3538564 and also of the OHIM CTM trademark Reg. No. 004124831 that the disputed domain name <nuvigil -

reviews.com>, was registered on December 20, 2011 (i.e. several years after the Complainant's registration of its trademarks), and is registered in the name of the Respondent, that the domain name is confusingly similar to the NUVIGIL trademarks, that the Respondent has no rights or legitimate interests in the domain name and that the domain name was registered and used in bad faith.

BACKGROUND

The Complainant 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.

The Complainant's Cephalon’s NUVIGIL® (armodafinil) Tablets [C-IV] are part of Teva’s CNS (Central Nervous System) line of specialty medicines. They contain armodafinil, a Schedule IV federally controlled substances in the United States. Subject to important safety information, 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 Complainant claims its NUVIGIL® mark is well known within its specialty area, and Complainant uses its mark in its own domain names (e.g., see http://nuvigil.com).

COMPLAINANT'S CONTENTIONS

The Complainant has submitted 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 Apr. 15, 2002) (finding that the complainant had established rights to the MILLER TIME mark through its federal U.S. trademark registrations); Koninklijke KPN N.V. v. Telepathy Inc., D2001-0217 (WIPO May 7, 2001) ("The Policy does not require that the mark be registered in the country in which the Respondent operates. It is sufficient that a complainant can 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 trademark 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 trademark in the country of the respondent’s residence).

According to the Complainant previous panel decisions have generally held that trademark registrations are valid and constitute 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 February 20 2000); Poarch Band of Creek Indians dba PCI Gaming Authority v. Tech Admin, Virtual Point, NAF Claim No. FA1509001639763 (Nov. 13, 2015).

Moreover, the Complainant contends that several series of CAC Panels have recognized the Complainant's rights in its PROVIGIL/NUVIGIL marks. CAC Case Nos. 100832-100835 (transferring, among others, <nuvigil4bitcoins.com>); CAC Case No. 100892 (transferring
<buynuvigilquick.com>, <nuvigilquick.com>, <nuvigilrx.com>, among others); CAC Case No. 100175 (transferring <trynuvigil.com>); Case No. 100172 (transferring <getnuvigilsafely.com>); CAC Case No. 100169 (transferring <buy-nuvigil-online.net>).

In the light of the above and for the disputed domain name incorporates the Complainant's trademarks, the domain name is alleged by the Complainant to be confusingly similar to the registered trademark in which the Complainant has rights.

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

On top of that according to the Complainant, the pertinent WHOIS information identifies the registrant, which does not resemble the domain name. On this record, Respondent has not been commonly known by the disputed domain name so as to have acquired rights to or legitimate interests in it within the meaning of paragraph 4(c)(ii) of the Policy.

The Complainant's case is that the Respondent is luring consumers in search of the well-known NUVIGIL brand to a website that promotes allegedly competitive or highly related "brain vitamins" and "brain supplements" that have no affiliation with Complainant or its NUVIGIL brand, including specifically Excelerol from Accelerated Intelligence Inc., in California USA. The website specifically refers to Excelerol falsely as "Nuvigil Brain Supplement" with a link to the Excelerol website, unaffiliated with the Complainant. Luring consumers in search on the well-known NUVIGIL brand to a site promoting products purportedly competitive with Complainant's NUVIGIL product, such as Excelerol, does not demonstrate a legitimate right or interest. Labelling such products as "Nuvigil Brain Supplement" with a link to Excelerol.com constitutes false advertising as well.

BAD-FAITH REGISTRATION AND USE

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

In light of the use of the disputed domain name the Complainant claims, 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.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

RESPONDENT:

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

1. The Complainant has established trademark rights in the NUVIGIL mark. The Complainant has done so, by evidence which the Panel accepts, that it is the owner of the registered United States and European trademarks for NUVIGIL more particularly described above, namely U.S. Reg. 3538564 and OHIM CTM Reg. No. 004124831.

2. The Complainant has shown that the disputed domain name is confusingly similar to the NUVIGIL mark. That is so because the domain name includes the whole of the Complainant's NUVIGIL trademark and the generic word "reviews". It is now well established that a domain name incorporating a trademark together with a generic word or expression is confusingly similar to the trademark because an objective bystander would naturally assume that the domain name related to the activity encompassed by the trademark and the generic word. Thus, in the present case, the internet user would assume that the disputed domain name relates to the review of the Complainant's NUVIGIL products. That conclusion is consistent with many UDRP decisions.

3. The Complainant has also established that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant has shown a prima facie case that has not been rebutted by a formal Response or by any other means, that the Respondent has not been commonly known by the disputed domain name, that the Complainant has not authorized, permitted or licensed the Respondent to use its trademarks in a domain name or in any other manner and that the Respondent has no connection or affiliation with Complainant whatsoever ; see for example, Reese v. Morgan, FA 917029 (Nat. Arb. Forum Apr. 5, 2007) (finding under paragraph 4(c)(ii) of the Policy, holding 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).

4. Moreover, as the Complainant submits, the evidence shows that the Respondent has been using the domain name to resolve to a website that has the effect of luring consumers in search of the well-known NUVIGIL brand to a website that promotes products that compete with products of the Complainant and produced under a different brand name from that of the Complainant, i.e. Excelerol. Such use of a domain name without permission cannot give a registrant's right or legitimate interest in a domain name. In particular, using the domain name to promote products that are falsely alleged to be products of the Complainant such as the allegedly "Nuvigil Brain Supplement" cannot give rise to any such right or legitimate interest of the Respondent in the domain name.

5. The Complainant has also shown that the disputed domain name was registered and used in bad faith. That is so because, first, the registration of the Complainant's NUVIGIL trademark predates the registration of the disputed domain name, as it is the owner of the United States trademark No. 3538564, registered on November 25, 2008, and also of the OHIM CTM trademark Reg. No. 004124831, registered on January 26, 2006, and that the evidence is that the domain name was registered on December 20, 2011. Secondly, the Complainant has established that it and its NUVIGIL trademarks are well known in their field and that the Respondent must be inferred to have had knowledge of the trademark, in view of the use made of the domain name by causing it to resolve to a website where the Complainant's NUVIGIL products are extensively referred to.

6. In particular, the evidence shows that, within the meaning of paragraph 4 (b) (iv) of the Policy , 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 Respondent's web sites and of the products promoted therein; see Cephalon, Inc. v Alen Mironassyan, Alen Mironassyan, CAC Case No. 100892.

7. In addition to the foregoing, registering a domain name and using it without permission to promote competing products and products which the Respondent falsely claims are products of the Complainant, such as "Nuvigil Brain Supplement", as the Respondent has done, shows that the domain name has been registered and used in bad faith within the generally accepted meaning of that expression.

8. Accordingly, the Complainant has established all of the three elements it is required to prove and is entitled to the relief that it seeks.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NUVIGIL-REVIEWS.COM**: Transferred

PANELLISTS

Name	**The Hon. Neil Brown, QC**

DATE OF PANEL DECISION 2016-07-13

Publish the Decision