Decision for dispute CAC-UDRP-101334

Case number	CAC-UDRP-101334
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Domain names	nuvigi.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Cephalon, Inc.

Complainant representative

Organization	RiskIQ, Inc.

Respondent

Name	Lambrev Aleksandr Svetoslavovich

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings pending or decided between the same parties and relating to the Disputed Domain Name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner, inter alia, of the registered NUVIGIL trademarks in the following jurisdictions:
- the US, trademark registration No. 3538564, filed on May 27th, 2004 and registered on November 25th, 2008;
- the EU, trademark registration No. 004124831, filed on November 15th, 2004 and registered on January 26th, 2006; and
- the Russian Federation, trademark registration No. 490281, filed on July 16th, 2012 and registered on June 24th, 2013.

FACTUAL BACKGROUND

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

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 (hereinafter collectively “Teva”), was first established in 1901 with its global headquarters in Israel. Operating in sixty countries worldwide, Teva (NYSE and TASE: TEVA) 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.

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 NUVIGIL® mark is well known within its specialty area, and the Complainant uses its mark in domain names (e.g. <http://nuvigil.com>).

PROTECTED RIGHTS RELIED UPON

The Complainant states that it has extensive trademark rights in Class 5 in its NUVIGIL® mark, including in the United States, the European Union, and the Russian Federation and claims 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.

CONFUSING SIMILARITY

The Complainant claims there is visual, aural and phonetic confusing similarity between the disputed domain name and trademark and that it may be presumed that by intentionally omitting the last letter of the trademark to cause confusion, the Respondent is actually causing such confusion.

NO RIGHTS OR LEGITIMATE INTERESTS

According to the Complainant, the Respondent does not have rights or legitimate interests in the domain name.

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

The Complainant states that the Respondent registered and uses the disputed domain name to host a rogue Internet pharmacy referring to itself as "Online Worldwide Drug Store" and offers third-party pharmaceuticals for sale.

The Respondent is not offering Nuvigil® through Online Worldwide Drug Store.

BAD-FAITH REGISTRATION AND USE

The Complainant asserts that the Respondent can be considered to be aware of the Complainant's trademark when registering the domain name, as also follows from the disruptive way the domain name is being used to market third-party pharmaceuticals on a rogue Internet pharmacy. The circumstances of this case indicate that the Respondent did in fact actually know of Complainant and the NUVIGIL mark and intended to register and use the disputed domain in bad faith.

According to the Complainant, the Respondent is attempting to attract, for commercial gain, Internet users to its web site, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement.

Additionally, the Respondent has engaged in typosquatting, which is evidence of bad faith registration and use.

Furthermore, according to the Complainant, the Respondent has registered both identical and confusingly similar domain names to other famous and well-known pharmaceutical trademarks to drive traffic to rogue Internet pharmacies, including the CIALIS mark owned by Eli Lilly, and XANAX and FELDENE marks owned by Pfizer (e.g., <fastshipcialisus.com>, <xaanex.com>, and <feldene.net>).

Therefore, the Complainant claims that the requirement of bad faith registration and use of the disputed domain name 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

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.

The language of the Registration Agreement is Russian.

However, the Panel agrees with the Complainant, taking into account the circumstances of the case, including the undisputed allegations of the Complainant that the website corresponding to the domain name is entirely in English and so are some other web sites of the Respondent, and the fact that Respondent has been given a fair chance to object but has not done so and considering previous UDRP decisions (e.g. Instagram, LLC v. lu xixi, PRIVATE, WIPO Case No. D2015-1168 and Sanofi and AVENTISUB II Inc. v. Nikolay Fedotov, WIPO Case No. D2013-2121), and determines in accordance with paragraph 11(a) of the UDRP Rules that the language of the proceeding shall be English.

PRINCIPAL REASONS FOR THE DECISION

In accordance with paragraph 4(a) of the Policy, to obtain transfer of the disputed domain name, the Complainant must prove the following three elements:

(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 Respondent has registered the domain name and is using it in bad faith.

A. Identical or confusingly similar

The Panel finds that the Complainant has rights in the “NUVIGIL” trademark and the disputed domain is confusingly similar to Complainant’s trademark.

The Complainant is the owner of numerous “NUVIGIL” trademark registrations and refers to its US trademark registration No. 3538564, EU trademark registration No. 004124831 and its Russian trademark registration No. 490281, all protected for some goods in class 5 of the International Classification of Goods and Services.

The Panel holds that registration of a mark with a trademark office is generally sufficient evidence of having rights in a mark.

This is confirmed by extensive UDRP case law (see F. Hoffmann-La Roche AG v. Relish Enterprises, WIPO Case No. D2007-

1629 and Miller Brewing Co. v. Miller Family, FA 104177, National Arbitration Forum) and supported by WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0"), see paragraph 1.1: “If the complainant owns a trademark, then it generally satisfies the threshold requirement of having trademark rights.”

The Complainant clearly has trademark rights in “NUVIGIL” and this trademark is protected in various jurisdictions including Respondent’s own jurisdiction (Russia).

Previous UDRP decisions have also recognized Complainant’s rights in the “NUVIGIL” trademark, e.g. CAC Case No. 100833 (<buynuvigil.com>), CAC Case No. 100834 (<nuvigil4bitcoins.com>) and Cephalon, Inc. v. Kris McCann, WIPO Case No. DC02016-0009 (<nuvigil.co>).

The Panel finds the disputed domain name confusingly similar to Complainant’s trademark.

The disputed domain name is <nuvigi.com> and is almost identical to Complainant’s “NUVIGIL” mark. The only difference between Complainant’s mark and the disputed domain name is deletion of the last letter “L” from the domain name.

As stated in WIPO Overview 2.0 “the threshold test for confusing similarity under the UDRP involves a comparison between the trademark and the domain name itself to determine likelihood of Internet user confusion. In order to satisfy this test, the relevant trademark would generally need to be recognizable as such within the domain name”.

Here the mark is clearly recognizable within the domain name and the absence of the last letter does not change the overall impression and does not avoid the likelihood of confusion between the disputed domain name and the trademark. Making small changes such as adding or deleting a letter or a symbol does not usually change the perception of a mark within a domain name, see CAC Case No. 100911 (<schneider-electrica.com>).

The applicable top-level suffix in the domain name (.com) shall be disregarded since it does not itself form part of the relevant trademark.

Therefore, the Panel finds that the first requirement of the Policy has been satisfied.

B. Rights or Legitimate Interests

It is well accepted and confirmed by UDRP case law that while the overall burden of proof is on Complainant, the element of possible rights or legitimate interests of Respondent in the disputed domain name involves Complainant proving matters, which are peculiarly within the knowledge of Respondent. It involves the Complaint in the often impossible task of proving the negative.

Therefore, the rule is the following:

(i) a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests; and

(ii) once such prima facie case is made, the burden shifts to the respondent who has to demonstrate his rights or legitimate interests in respect of the domain name under paragraph 4 (c) of the Policy.

If the respondent fails to do so, the second element of the Policy is satisfied, see Julian Barnes v. Old Barn Studios, WIPO Case No. D2001-0121; Belupo d.d. v. WACHEM d.o.o., WIPO Case No. D2004-0110; CAC Case No. 101284 (<salomontw.com>) and CAC Case No. 101224 (<nuvigil-reviews.com>).

The Respondent did not respond.

While respondent’s failure to respond does not per se demonstrate that the respondent does not have rights or legitimate interests, it allows all reasonable inferences of fact in the allegations of the complaint to be deemed true (see paragraph

14(b) of the Rules and Vertical Solutions Management, Inc. v. webnet-marketing, inc., FA 95095, National Arbitration Forum).

The Complainant provided evidence that the Respondent was using the disputed domain name to market third-party pharmaceuticals unrelated to NUVIGIL®, such as CIALIS, LEVITRA, and PROPECIA through the web site called "Online Worldwide Drug Store".

However, on the date of the decision (January 3rd, 2017) the web site appears to be inactive.

To reach the right decision, a panel is allowed to undertake limited factual research into matters of public record if it deems this necessary including consulting a repository such as the Internet Archive (in order to obtain an indication of how a domain name may have been used in the relevant past).

Under paragraph 10(a) of the Rules the Panel shall conduct the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and the Rules and the Panel shall be able to independently visit the Internet in order to obtain additional light in a default proceeding (see Société des Produits Nestlé SA v. Telmex Management Services, WIPO Case No. D2002-0070; InfoSpace.com, Inc. v. Hari Prakash, WIPO Case No. D2000-0076).

The Panel by using the Wayback Machine at <www.archive.org> discovered five records for the web site under the disputed domain name, the first one dated March 2nd, 2016 and the last one - December 20th, 2016.
These findings confirm Complainant’s submissions that the web site under the disputed domain name was used as “on-line drug store” selling third-party pharmaceuticals.

The evidence submitted by the Complainant shows prima facie lack of rights or legitimate interests of the Respondent.

The Respondent has not been commonly known by the domain name, the Respondent is not making a legitimate noncommercial or fair use of the domain name and the domain name is not used in connection with a bona fide offering of goods or services.

It appears that the Respondent indeed used the domain name in connection with a sale of various pharmaceuticals. However, the Panel finds that such use cannot be considered “bona fide offering of goods”.

Circumstances of the case along with the proof that the Respondent also registered other domain names similar to third parties’ trademarks in the pharmaceutical industry, indicate Respondent’s intent to capitalize on the fame and reputation of the “NUVIGIL” mark to attract additional visitors to his web site.

Respondent’s use of Complainant’s trademark in the domain name appears to be a case of “typosquatting” and, as stated in CAC Case No. 100604 (<rcoketmail.com> and others) relying on some previous UDRP decisions, “there is also no legitimate interest to be found in typosquatting”.

The Panel, therefore, finds that the Complainant has shown a prima facie case that has not been rebutted by the Respondent and, therefore, satisfied the second requirement of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists non-exhaustive circumstances indicating registration and use in bad faith.
The Panel finds that the Complainant established, at least, one instance of bad faith registration and use, namely circumstances under paragraph 4 (b) (iv) of the Policy.

The Respondent clearly knew about the “NUVIGIL” mark (Complainant's NUVIGIL trademarks predate the registration of the disputed domain name (according to the Registrar's verification registered on February 2nd, 2016) and from the evidence submitted by the Complainant, including the way the domain name was used, it appears that the Respondent is quite active in the pharmaceutical industry, see CAC Case No. 100892 (<buynuvigilquick.com> and others).

As stated in CAC Case No. 101287 (<playspennies.com>):
“Typosquatting by reference to another's mark does not provide rights or legitimate interests and also involved registration and use in bad faith (see, for example, the cases identified in paragraph 1.10 of the WIPO Overview 2.0).”
A similar conclusion is confirmed by CAC Case No. 101344 (<borsorama.online>).

The Panel finds, from the evidence and information available, that the Respondent registered the domain name with the intention to benefit from the likelihood of confusion with the “NUVIGIL” trademark (see CAC Case No. 100881 (<essurveymonkey.com>, <frsurveymonkey.com>).

The Panel finds that the Respondent registered and used the disputed domain name for the purpose of intentionally attracting for commercial gain Internet users to Respondent's website, by creating confusion as to source, sponsorship, affiliation or endorsement by Complainant of Respondent's website and that the Respondent appears to have registered the disputed domain name with the clear intention of taking advantage of the goodwill established by the Complainant in its trademark, and for no other evident reason than to profit from that use of Complainant's mark (see AMPO, S. COOP v. Contactprivacy.com, Taeho Kim, Philippine, WIPO Case No. D2009-0177).

The Panel holds that the third requirement of the Policy has been satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NUVIGI.COM**: Transferred

PANELLISTS

Name	**Igor Motsnyi**

DATE OF PANEL DECISION 2017-01-03

Publish the Decision