Decision for dispute CAC-UDRP-100832

Case number	**CAC-UDRP-100832**
Time of filing	**2014-07-23 11:57:59**
Domain names	**provigilmodafinilforsale.com**

Case administrator

Name	**Lada Válková (Case admin)**

Complainant

Organization	**Cephalon, Inc.**

Complainant representative

Organization	**Matkowsky Law PC**

Respondent

Organization	**Gracia Elmandero**

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant owns numerous registrations for the PROVIGIL® mark around the world, including but not limited to federal trademark registrations in the United States, such as: Reg. No. 2,000,231, first used in 1995, with a priority application-filing date of March 31, 1994, issued in 2006, in International Class 5.; Reg. No. 2,499,937, first used in 1995, with a foreign priority application-filing date of November 9, 1999, issued October 23, 2001, in International Class 5; and others.

FACTUAL BACKGROUND

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

The Complainant - Cephalon, Inc., an indirect wholly-owned subsidiary of Teva Pharmaceutical Industries Ltd. – claims it is a global biopharmaceutical company with a marketed portfolio and pipeline of specialty products dedicated to improving the quality of life of individuals around the world. Since its inception in 1987, Cephalon has brought first-in-class and best-in-class medicines to patients in several therapeutic areas.

The Complainant contends that 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.

The federally registered PROVIGIL® mark is well-known in its specialty field. The mark has been in continuous use is in commerce since 1995.

PARTIES' CONTENTIONS

The Complainant claims that the disputed domain is confusingly similar to its protected mark for the disputed domain name contains the entirety the Provigil mark with the addition of the descriptive phrase 'for sale' combined with a generic term for the active pharmaceutical ingredient (API) behind the trademarked medicine (i.e., "modafinil").

The Complainant states it has not authorized, licensed, or permitted the Respondent to register or use <provigilmodafinilforsale.com> or to use its trademark. Furthermore, according to the Complainant the Respondent is not known by the disputed domain name, nor has the Respondent acquired any trademark rights in respect of the domain name. The disputed domain name clearly alludes to the Complainant, and the Respondent uses it for commercial gain with the purpose of capitalizing on it to create a likelihood of confusion. Such use is not a legitimate noncommercial or fair use under the Policy.

According to the Complainant, the Respondent cannot satisfy the so-called requirements of Oki Data for the domain name does not make clear that it pertains to a website unconnected with the Complainant (there is no disclaimer on the site whatsoever—let alone a conspicuous one), and the Respondent is using the domain name to advertise two rogue online pharmacies that offer numerous other products across multiple pharmaceutical categories other than the genuine product of the Complainant. Furthermore, the Respondent does not disclose the nature of its relationship with either of the website owners, or its own identity; in fact, the Respondent masked its identity with proxy services. Medstore-online.cc is a "Rogue" Internet pharmacy by industry standards. MedStore-Online.cc falsely advertises Cephalon's Provigil as Provigil by "Consern Pharma." The picture used for the offering is not for Provigil, but for Modafinil Tablets even though it is being marketed with the Provigil mark, and a broad range of products are sold via this online pharmacy as well. Similarly, 24RxDirect.com re-directs automatically to online-drugs-24h.net, a rogue Internet pharmacy by industry standards (e.g., http://www.legitscript.com/), offering to ship worldwide Provigil, which is a controlled substance, without a prescription in a discreet unmarked parcel.

The Complainant claims that the Respondent was aware of the existence of Cephalon's marks. Only someone who was familiar with the Complainant's marks and its activity would have registered the domain name with the addition of a generic term or phrase describing the offering for sale of the trademarked-medicines over the Internet (i.e., "for sale"), and describing an active pharmaceutical ingredient (API) behind the trademarked medicines (i.e., "modafinil"). The Respondent is intending to attract the Internet users to its websites by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its websites, or by diverting confused users to the websites of third parties from which the Respondent presumably gains commercially, such as through collecting revenue on sales as part of an affiliate program.

Furthermore, according to the Complainant the Respondent has a pattern and practice of registering trademarks, including multiple Provigil marks. From a review of the Whois records, it is clear that the Respondent uses false aliases and contact information behind privacy and proxy services because the email account is exactly the same as disclosed in the registrar's verification, but the name of the person is completely different than the registrar's verification in this proceeding.

The Complainant concludes that for all of the foregoing reasons, the Respondent's registration of the domain name confusingly similar to the Complainant's trademark was done in bad faith.

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.

At the time of the commencement of this proceeding, the owner of the record of the disputed domain name was Wuxi Yilian LLC, Fujian China. Once notified of the Complaint, the Registrar disclosed another owner for the disputed domain name, Gracia Elmandero, Belize City, Belize. As it became apparent from the correspondence in the record, Wuxi Yilian LLC is the proxy service of the Registar, Bizn.com, Inc. Upon receiving the information from the Registrar, the Complainant amended the complaint and changed the Repondent's name to Wuxi Yilian LLC a/k/a Gracia Elmandero, GTR pt, a/k/a Paula Konrad, paula Konrad.

On 18 August 2014 the Complainant requested via nonstandard communication to consolidate the majority of the domains originally subject of Case No. 100832 into Case No. 100833. On 25 August 2014 the CAC allowed the consolidation as requested. The Complainant amended the Complaint accordingly on 31 August 2014. As a result only domain name “provigilmodafinilforsale.com” remained subject of Case No. 100832. The Panel has reviewed the procedural decision taken by the CAC and concurs with it. Accordingly, the Panel decision in this proceeding (Case No. 100832) will deal only with the disputed domain name provigilmodafinilforsale.com.

The decision was to be delivered on 15 October 2014 pursuant to Paragraph 15(b) of the Rules. However, due to the exceptional circumstances of the case and particular due to the complexity of the proceedings the Panel decided on its sole discretion on 16 October 2014 via nonstandard communication to prolong this deadline.

PRINCIPAL REASONS FOR THE DECISION

1. The Panel finds that the disputed domain name PROVIGILMODAFINILFORSALE.COM is confusingly similar to the Complainant’s earlier trade mark "PROVIGIL". Sufficient evidence has been submitted by the Complainant proving that it owns trademark rights to PROVIGIL at least in the USA. The disputed domain name is confusingly similar to the Complainant’s registered trademarks since it incorporates the Complainant’s mark “PROVIGIL”, merely (i) adding generic term “MODAFINIL” (which stands for a vigilance promoting drug), (ii) adding descriptive term “FOR SALE”, and (ii) adding the generic top level domain identifier “.com” at the end. Adding such generic and descriptive terms as “MODAFINIL” and “FOR SALE” does not distinguish the disputed domain name from the Complainant’s trademark.

2. 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). The Complainant has not authorized, licensed, or permitted the Respondent to register or use <provigilmodafinilforsale.com> or to use its trademark. The Respondent is not known by the disputed domain name, nor has the Respondent acquired any trademark rights in respect of the domain name. The Respondent has not submitted evidence of any use of the disputed domain name in connection with a bona fide offering of goods or services. There appears to be no other basis on which the Respondent could claim any rights or legitimate interests to the domain name.

In the absence of any Response from the Respondent, or any other information indicating the contrary, the Panel concludes

that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

3.The Respondent was aware of the existence of the PROVIGIL mark when registering the disputed domain name. As stated in the complaint, only someone who was familiar with the Complainant's marks and its activity would have registered the domain name with the addition of a generic term or phrase describing the offering for sale of the trademarked-medicines over the Internet (i.e., "for sale"), and describing an active pharmaceutical ingredient (API) behind the trademarked medicines (i.e., "modafinil"). Further, the Complainant has established that the Respondent has engaged in a pattern of conduct by registering multiple domain names incorporating the complainant's mark PROVIGIL. In accordance with Paragraph 4(b)(ii) and (iv) of the Policy, the Panel is satisfied that the disputed domain name was registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PROVIGILMODAFINILFORSALE.COM**: Transferred

PANELLISTS

Name	**Jose Checa**

DATE OF PANEL DECISION 2014-10-17

Publish the Decision