Decision for dispute CAC-UDRP-100833

Case number	CAC-UDRP-100833
Time of filing	2014-07-23 11:39:18
Domain names	buyprovigilshop.com, order-provigil.com, buyprovigilonlineshop.com, buynuvigil.com, provigilenergy.com , provigilpurchase.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Cephalon, Inc.

Complainant representative

Organization	Matkowsky Law PC

Respondent

Organization	Rx Revenue

OTHER LEGAL PROCEEDINGS

This case is a consolidation of domain names of case No. 100832 and case No. 100833, which consolidation was accepted by the CAC on 25 August 2014.

IDENTIFICATION OF RIGHTS

The Complainant owns numerous PROVIGIL trademark registrations throughout the world, including but not limited to the following federal trademark registrations in the United States:

- 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; and
- Reg. No. 2,499,937, first used in 1995, with a priority application-filing date of November 9, 1999, issued October 23, 2001, in International Class 5.

Further, the Complainant owns numerous NUVIGIL trademark registrations throughout the world, including but not limited to the following federal trademark registrations in the United States:

- Reg. No. 3,538,564, issued November 25, 2008 with a priority filing date of May 27, 2004, issued in 2006, in International Class 5; and

- Reg. No. 3,782,440, issued April 27, 2010 with a priority application filing date of February 11, 2009, In International Class 5.

FACTUAL BACKGROUND

The Complainant is a company with its legal seat in Frazer, Pennsylvania, United States. The Complainant is a global biopharmaceutical company that markets medicines in several therapeutic areas. This includes the Provigil and Nuvigil prescription medicines that are indicated to improve wakefulness in adults who experience excessive sleepiness due to obstructive sleep apnea, shift work disorder, or narcolepsy. In the United States, Provigil and Nuvigil are Schedule IV [C-IV] medications, as determined by the Drug Enforcement Agency (DEA), because they have the potential to be abused or lead to dependence.

The following domain names are subject of these proceedings:

1. buynuvigil.com
2. buyprovigilonlineshop.com
3. buyprovigilshop.com
4. order-provigil.com
5. onlineprovigil.org
6. provigilpurchase.com
7. Provigil-online.net
8. provigilmodafinil.net
9. provigilenergy.com
10. provigilonline.com
11. myprovigilonline.net
12. provigils.com

According to the relevant records the disputed domain names have been registered in the name of the following registrants. Respondent regarding domain names 1 up to and including 4 is RX Revenue from Russia. Respondent regarding domain name 5 and 6 is Luca Radu from the United States. Respondent regarding domain names 7 and 8 is John Horton from the United States. Respondent regarding domain name 9 is Lopas Kalto from - according to the register - “Oper, TJ”. Respondent regarding domain names 10 and 11 is Tomasevic T Robert from Lithuania. To conclude, Respondent regarding domain name 12 is Tomek Szekofski from Poland.

Domain names 1, 2, 3, 4, 6, 10 are being used for - in brief - websites that sell medicines without prescription being required, which medicines are pretended to be Nuvigil and Provigil. The other domain names are not being used.

The Complainant has requested to consolidate the multiple registrants as respondents in a single administrative proceeding pursuant to paragraph 3 (c) or 10 (e) of the Rules.

PARTIES CONTENTIONS

A RESPONSE HAS BEEN FILED REGARDING TWO DOMAIN NAMES. THIS RESPONSE SUPPORTS THE COMPLAINT

Of all Respondents, only John Horton has filed a response. Mr. Horton states that the Whois records regarding the domain names provigil-online.net and provigilmodafinil.net are falsified. He has never registered these domain names and therefore he fully supports the Complainant's filing and urges the Panel to transfer these domain names to the Complainant.

WIT RESPECT TO THE OTHER DISPUTED DOMAIN NAMES NO ADMINISTRATIVELY COMPLIANT RESPONSES HAVE BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are confusingly similar to the trademarks 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 Respondents to have no rights or legitimate interests in respect of the disputed domain names (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain names have been registered and were 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

I. Consolidation of Respondents

As also follows from previous UDRP decisions, cases against differing respondents can be consolidated under paragraphs 3(c) and 10(e) of the Rules, in circumstances that common control is being exercised over the disputed domain names or the websites to which the domain names resolve (e.g. Speedo Holdings B.V. v. Programmer, Miss Kathy Beckerson, John Smitt, Matthew Simmons, WIPO Case No. D2010-0281; Guccio Gucci S.p.A v. Andrea Hubner, Beijing Harmony Software Co.Ltd., jiang wang, et al, WIPO Case No. D2012-2212, Seiko Holdings Kabushiki Kaisha v. L. Collins Travis, C. Turner Jose, et al, WIPO Case No. D2013-0994).

In the current case the Complainant has argued extensively and convincingly, and has submitted various relating supporting documents, that there is an interconnection between all the Respondents. For example, there is a close similarity between the disputed domain names, each of which incorporates the Complainant’s trademarks concerned in its entirety in conjunction with non-distinctive, generic terms. Further, the interconnection can - in brief - be inferred from the common registration information, use of similar websites, and/or use of similar domain name servers as identified by the Complainant. Moreover, there is a pattern of use of obviously fake registration details as follows from the many delivery failures experienced by the Case Administrator of the CAC when sending case documents to the Respondents, and as follows from the apparent spoofed identity of Mr. John Horton.

In this context, the Panel is prepared to assume that it is most likely that the disputed domain names are controlled by the same person or entity and that as a result and considering the aims and objectives of the Policy, it is in this case procedurally efficient and appropriate under the Rules to consolidate the cases into this single proceeding.

II. The material requirements of the Uniform Domain Name Dispute Resolution Policy

A. Identical or Confusingly Similar

The Complainant’s trademarks are reproduced in the disputed domain names in their entirety, while merely descriptive, generic elements have been added in the disputed domain names. In this context, the disputed domain names are confusingly similar to the Complainant's trademarks. The Panel therefore finds that the first requirement of paragraph 4(a) of the Policy has been satisfied.

B. Rights or Legitimate Interests

The Complainant has not authorized, licensed, or permitted the Respondents to register or use the disputed domain names or to use the Complainant's trademarks. Further, the Respondents are not known under the disputed domain names, nor do they have any trademark rights in respect of the disputed domain names. Some of the disputed domain names are not being used, and the ones that are used cannot be considered to be used for the bona fide offering (of the Complainant's) products. The websites accessible through the disputed Domain Names do not make clear that there is no connection with the

Complainant, do not or not only offer the trademarked products of the Complainant, do not disclose the identity or disclose a false identity of the supplier, offer the medicines without prescription while prescription is required for such medicines, falsely pretend to be licensed pharmacy and/or use counterfeit marks of the Respondent.

In this context, the Panel finds that the Respondents do not have rights or legitimate interest in the disputed domain names.

C. Registered and Used in Bad Faith

It is established as undisputed that the Complainant's trademarks are well-known throughout the world. Further, the trademarks predate the registrations of all disputed domain names. The Respondents can be considered to be aware of the Complainant and the Complainant's trademarks when registering the domain names, as obviously also follows from the way most of the domain names are currently being used, which use moreover has a malicious character. Accordingly, the Panel assumes that by registering and using the domain names, the Respondents have intentionally attempted to attract, for commercial gain, Internet users to their web sites, by creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation, or endorsement of their web sites and/or of products on their web site.

To conclude, the requirement of bad faith registration and use of the disputed domain names pursuant to article 4(a)(iii) of the Regulations has also been met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BUYPROVIGILSHOP.COM**: Transferred
2. **ONLINEPROVIGIL.ORG**: Transferred
3. **PROVIGILONLINE.COM**: Transferred
4. **MYPROVIGILONLINE.NET**: Transferred
5. **ORDER-PROVIGIL.COM**: Transferred
6. **BUYPROVIGILONLINESHOP.COM**: Transferred
7. **BUYNUVIGIL.COM**: Transferred
8. **PROVIGILENERGY.COM** : Transferred
9. **PROVIGILPURCHASE.COM**: Transferred
10. **PROVIGIL-ONLINE.NET**: Transferred
11. **PROVIGILS.COM**: Transferred
12. **PROVIGILMODAFINIL.NET**: Transferred

PANELLISTS

Name	**Alfred Meijboom**

DATE OF PANEL DECISION 2014-10-30

Publish the Decision