Decision for dispute CAC-UDRP-101155

Case number	CAC-UDRP-101155
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Domain names	xn--5dbchrbs4c6a.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Cephalon, Inc.

Complainant representative

Organization	Matkowsky Law PC

Respondent

Name	ABED AGBARIA

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings currently pending.

IDENTIFICATION OF RIGHTS

The Complainant relies on its following trademarks:

- The U.S. trademark PROVIGIL No. 2000231 registered on September 10, 1996, and duly renewed thereafter until the last renewal on November 8, 2006.

- The U.S. trademark PROVIGIL No. 2499937 registered on October 23, 2001, and duly renewed thereafter on October 25, 2011.

- The Community trademark PROVIGIL No. 003508843 registered on March 25, 2008.

- The Israeli trademark PROVIGIL No. 147877 registered on May 3, 2002 and duly renewed thereafter on February 20, 2008.

- The Israeli trademark פרוויג'יל, which is the Hebrew transliteration of PROVIGIL, No. 256564 registered on January 1, 2015.

The Respondent registered the domain name <xn—5dbchrbs4c6a.com> on October 25, 2014.

FACTUAL BACKGROUND

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

PRELIMINARY ISSUE: INTERNATIONALIZED DOMAIN NAME

The Complainant claims that the disputed domain name is an internationalized domain name ("IDN"). IDNs permit the global community to use a domain name in their preferred language or script. This is enabled by allowing domain names to have characters from different scripts, beyond the letters (a to z), digits (0 to 9) and hyphen (-), as encoded by the Unicode standard and as allowed by relevant IDN protocols. IDNs could contain characters with diacritical marks as required by many European languages, or characters from non-Latin scripts.

In relation to the instant proceeding, when a Hebrew domain name is typed in an IDN-aware browser (or another application), the Hebrew script is automatically translated into a "traditional" domain name comprised of Latin characters, digits and hyphens. The translated domain name is resolved in the Domain Name System (DNS). Most modern browsers have IDN support.

Punycode is a simple and efficient transfer encoding syntax designed for use with IDNs in Applications (IDNA) that was published in RFC 3492 through the Internet Engineering TaskForce (IETF)) in 2003. It uniquely and reversibly transforms a Unicode string into an ASCII string. ASCII characters in the Unicode string are represented literally, and non-ASCII characters are represented by ASCII characters that are allowed in host name labels (letters, digits, and hyphens).

According to the Complainant the domain name in dispute is <פרוביגיל.com>, an IDN with the Punycode translation of <xn--5dbchrbs4c6a.com>. (The domain was identified as <xn--5dbchrbs4c6a.com> in the online portal because the online portal won't accept identifying the domain in dispute as "<פרוביגיל.com>, an IDN with the Punycode translation of <xn--5dbchrbs4c6a.com>" for technical reasons.)

For the Complainant to display the <xn--5dbchrbs4c6a.com> properly in the <פרוביגיל.com> domain name, it first had to encode it into the <xn--5dbchrbs4c6a.com> domain name. The Respondent in this case did so through eNom, by requesting the domain name פרוביגיל.com, indicating to eNom that the second-level domain script is in Hebrew, and having eNom convert the Hebrew script into Punycode.

The Complainant contends it is universally accepted by Panels that IDNs and their Punycode translations are equivalent for purposes of applying the Policy. E.g., Dr. Ing, h.c. F. Porsche AG, v. Moniker Privacy Services / Sergey Korshunov, WIPO Case No. D2011-0100 (transferring <порше.com> <xn--e1arcf4b.com>) (Apr. 8, 2011); Saudi Arabian Oil Company v. Huloul Co., Claim No. FA1206001450578 (transferring <ارامكو-السعودية.com> [Punycode translation of <xn----ymcabk9akt8cvfni4bf5a.com>]) (July 28, 2 (internal citations omitted).

Therefore, the Complainant concludes that the <פרוביגיל.com> domain name shall be considered the same as its Punycode translation, <xn--5dbchrbs4c6a.com>, for purposes of this proceeding.

I. 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.

The Complainant claims and provides evidence that 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. Through Teva Pharmaceuticals USA, Inc. in the United States, where the domain name subject of dispute was registered with eNom and is being hosted in Texas, Cephalon’s PROVIGIL® (modafinil) Tablets [C-IV] is part of Teva’s CNS (Central Nervous System) line of specialty medicines. It first received approval in the United States in 1998. It contains modafinil, a Schedule IV controlled substance 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.

II. Protected rights relied on by Complainant

The Complainant provides evidence it has trademark rights in Class 5 throughout the world in its PROVIGIL® mark. All of these

registrations were effective before the Domain was registered. Furthermore it claims to have trademark rights also in פרוויג'יל, in Class 5, which is a Hebrew transliteration of PROVIGIL.

According to the Complainant in Hebrew, there is no dictionary-meaning of פרוויג'יל other than as the transliteration and phonetic equivalent of PROVIGIL in Latin characters, which is also a coined term that has no dictionary meaning other than as mark known in its specialty field. A series of CAC Panels have already recognized Cephalon's rights in the PROVIGIL mark. CAC Case Nos. 100832-100835 (transferring, amongst others, <provigilmodafinilforsale.com>, <provigilonline.com>, <provigils.com>, <provigilmodafinil.net>, <provigil4bitcoins.com>, <genericprovigil.net>, <buy-provigil-generic.com>, <buyprovigilmed.com>).

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) (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 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).

III. The Domain is Substantially Identical or Confusingly Similar to the Complainant's Registered Marks.

The Complainant claims the disputed domain name <פרוביגיל.com> is nearly identical and confusingly similar to Complainant's registered PROVIGIL and פרוויג'יל marks. There is no dictionary-meaning of פרוביגיל other than as a Hebrew transliteration and phonetic equivalent of PROVIGIL in Latin characters, and a variant spelling of Complainant's registered פרוויג'יל mark that is pronounced the same and looks almost identical. The marks פרוביגיל and פרוויג'יל create the same commercial impression in Hebrew as equivalent to PROVIGIL in Latin characters. They are substantially identical phonetically, although there may be slightly different ways that both may be pronounced from PROVIGIL depending on the Hebrew speakers' dialect, as they are not generic Hebrew words, but transliterations, intended to be phonetically equivalent to the PROVIGIL trademark. Many UDRP panels have recognized that phonetic similarity is decisive for the finding of confusing similarity under the first element of the UDRP. E.g., WhatsApp Inc. v. Fancisco Costa, WIPO Case No. D2015-1708 (Dec. 9, 2015) (finding similar pronunciation between "wazzup" and WHATSAPP trademark) (internal citations omitted).

It is also universally accepted that the generic top-level domain (gTLD) ".com" is not relevant to assessing this element of the Policy. E.g., Pomellato S.p.A v. Tonetti, D2000-0493 (WIPO July 7, 2000) (finding <pomellato.com> identical to the complainant's mark because the generic top-level domain (gTLD) ".com" after the name POMELLATO is not relevant).

IV. The Respondent Does Not Have any Rights or Legitimate Interest in <פרוביגיל.com>.

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

Furthermore, the Complainant contends the 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.

According to the Complainant Respondent's web site gives the initial impression that it is an official site authorized by the Complainant due to use of the PROVIGIL logo on the top of the site and trademark in the title. The web site is misleading. The Respondent is passing itself off as connected with or authorized by the Complainant. Passing off is evidence that the Respondent lacks rights or legitimate interests in the Domain Name. E.g., Abbott Laboratories v. Elena Blinova / Galina Ehlmoxsen, FORUM Claim No. FA1512001651684 (use of the ABBOTT logo) (internal citations omitted).

The Complainant claims and provides evidence that it is clear that the Respondent is promoting Modup.net, a Rogue Internet Pharmacy as a place online to purchase a purported generic "alternative" to Complainant's PROVIGIL®. It is also clear that the Respondent is targeting an Israeli audience as the site explains that in Israel, it is presumably hard to get a prescription for PROVIGIL®, and the best option is to purchase online through Modup.net.

Furthermore, according to the Complainant the manner in which the Respondent is promoting Modup.net to Israelis by displaying Complainant's PROVIGIL® logo on the top of the homepage and throughout the site is not in compliance with the regulations concerning marketing prescription medicines in Israel. The Respondent has no legitimate interest in using a confusingly similar domain name to pass itself off as the Complainant by displaying Complainant's logo on the website, especially for a prescription medicine over the Internet in a manner that is not compliant with Israeli laws. The Respondent also has no legitimate interest in using the confusingly similar domain to promote to Israelis that they purchases a purported alternative generic from what is considered a Rogue Internet Pharmacy.

Even if Respondent's promotional use of Complainant's PROVIGIL® online were in compliance with regulations concerning marketing of prescription medicines in Israel, the Respondent would still have no legitimate interest in using a domain name that is confusingly similar to Complainant's mark to drive traffic to a competitive product through click-through-links. It is presumed the Respondent realizes revenue from the operation of the carried links. In fact, the Respondent provides a coupon code to use when making a purchase at Modup.net, which presumably means the Respondent is part of its affiliate program through which it generates revenue. Using a confusingly similar domain name to promote and sell a competing product does not constitute a bona fide offering of goods or services or a legitimate noncommercial or fair use under paragraphs 4(c)(i) and 4(c)(iii) of the Policy.

V. Bad-faith Registration and Use

The Complainant contends Respondent’s manner of use of the disputed domain name to display the PROVIGIL logo across the top and promote purchasing a purported generic alternative for Respondent's own commercial gain is clear and convincing evidence that the Respondent had actual knowledge of Complainant's marks, and registered the disputed domain name in bad faith under paragraph 4(a)(iii) of the Policy.

Under paragraph 4(b)(iii) of the Policy, bad faith may be shown by evidence that the Respondent registered the disputed domain name "primarily for the purpose of disrupting the business of a competitor." Under paragraph 4(b)(iv), bad faith may be shown by evidence that "by using the domain name, [Respondent] intentionally attempted to attract, for commercial gain, Internet users to [Respondent's] web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [Respondent's] web site or location or of a product or service on [Respondent's] web site or location." The Respondent has done both by registering a substantially indistinguishable domain name equivalent to Complainant's registered marks, prominently featuring Complainant's trademark logo on top of the site, and then using the Domain Name for its own financial gain to sell a purported generic alternative aimed at users seeking Complainant's products. Such conduct is indicative of bad faith registration and use under paragraphs 4(b)(iii) and 4(b)(iv).

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLAINT 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.

PRINCIPAL REASONS FOR THE DECISION

According to paragraph 15(a) of the Rules, the Panel shall decide the Complaint in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

The Respondent did not reply to the Complainant's contentions. However, the consensus view of panelists is that a Respondent's default does not automatically result in a decision in favour of the Complainant. Although, the Panel may draw appropriate inferences from a Respondent's default, paragraph 4 of the UDRP requires the Complainant to support its assertions with actual evidence in order to succeed in a UDRP proceeding.

In order to obtain the transfer of the Disputed Domain Name and according to paragraph 4(a) of the Policy, the Complainant must prove each of the following:

"(i) The Disputed 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 Disputed Domain Name;

(iii) The Disputed Domain Name has been registered and is being used in bad faith".

At the same time, in accordance with paragraph 14(b) of the Rules:

"(a) In the event that a Party, in the absence of exceptional circumstances, does not comply with any of the time periods established by these Rules or the Panel, the Panel shall proceed to a decision on the complaint.

(b) If a Party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, these Rules or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate".

The Panel finds that in this case there are no such exceptional circumstances. Consequently, failure on the part of the Respondent to file a response to the Complaint permits an inference that the Complainant's reasonable allegations are true. It may also permit the Panel to infer that the Respondent does not deny the facts that the Complainant asserts.

First of all, there are two parts to the inquiry under the first element of the Policy. The Complainant must first demonstrate that it has rights in a trademark and secondly that the Disputed Domain Name is identical or confusingly similar to such trademark.

The Panel is satisfied that the Complainant is the owner of registered trademarks for the "PROVIGIL" sign. The Panel therefore turns to the second part of the inquiry.

Regarding the identity or confusing similarity between the Disputed Domain Name and the trademarks in which the Complainant has rights, it is to be noted that the Disputed Domain Name is an International Domain Name and is identified as <פרוביגיל.com> with the Punycode translation.

Indeed, for technical reasons, the Hebrew domain name <פרוביגיל.com> is identified as <xn--5dbchrbs4c6a.com> and it is universally accepted by Panels that International domain names and their Punycode translations are equivalent for purposes of applying the Policy.

Consequently, the Disputed Domain Name <xn--5dbchrbs4c6a.com> is considered equivalent as its Punycode translation <פרוביגיל.com> for the purposes of identity and confusing similarity test under the Policy.

Moreover, in Hebrew, and after performing the necessary checks, it appears that there is no dictionary-meaning of the sign "פרוביגיל" other than the transliteration and phonetic equivalent of PROVIGIL in Latin characters. In these circumstances, the Disputed Domain Name <xn--5dbchrbs4c6a.com>, which equivalent is <פרוביגיל.com>, is confusingly similar to the trademarks in which the Complainant has rights.

Regarding the addition of the gTLD ".com" to the Disputed Domain Name, it is well-established that gTLDs may typically be disregarded in the assessment under paragraph 4(a)(i) of the Policy.

Indeed, “a principle which applies to all the domain names is that the addition of generic top level domains (gTLDs) or country code top level domains (ccTLDs) does not affect the confusing similarity or identity between the domain name and the trade mark(s) in issue. This has been clearly established from the beginning of the UDRP process, and now is no longer an issue. Thus, the addition of various types of gTLDs to the domain names (".com", ".net") does not change the assessment of confusing similarity” (see Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003).

In these circumstances, the Panel finds that the Disputed Domain Name is confusingly similar to the trademarks in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy have been satisfied.

Subsequently, paragraph 4(c) of the Policy lists several ways in which the Respondent may demonstrate rights or legitimate interests in the Disputed Domain Name:

“Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue”.

The consensus of previous decisions under the Policy is that the Complainant may establish this element by making out a prima facie case, not rebutted by the Respondent, that the Respondent has no rights or legitimate interests in the Disputed Domain Name. In the present case, the Panel finds that the Complainant has made out such a prima facie case.

The Respondent is not an authorized dealer, distributor or licensee of the Complainant and has been given no other permission from the Complainant to use the Complainant’s trademarks.

The Respondent’s name does not bear any resemblance to the Disputed Domain Name nor is there any basis to conclude that the Respondent is commonly known by the PROVIGIL trademarks or the Disputed Domain Name. Furthermore, there is no evidence that the Respondent has made demonstrable preparations to use or is using such terms in connection with a bona fide offering of goods and services.

The Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name and has not rebutted this by way of a formal Response.

In all of these circumstances, the Panel finds that the Complainant has proved that the Respondent has no rights or legitimate interests in the Disputed Domain Name and that the requirements of paragraph 4(a)(ii) of the Policy have been satisfied.

Finally, paragraph 4(b) of the Policy provides four, non-exclusive, circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

“(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location".

In the Panel's view, the Respondent necessarily had constructive knowledge of the Complainant's trademarks when registering the Disputed Domain Name since these trademarks have been used long before the Disputed Domain Name registration.

The Disputed Domain Name redirects to a website promoting what appears to be generic products of PROVIGIL products. Moreover, the website at the Disputed Domain Name gives the initial impression that it is an official website authorized by the Complainant due to the use of the PROVIGIL logo on it. By using the Disputed Domain Name, the Respondent has intentionally attempted to disrupt the Complainant's business.

"It is well-established in UDRP decisions that 'initial interest confusion' and the resultant misdirection of Internet traffic to respondent is independently sufficient to establish bad faith" (Pfizer Inc. v. jg a/k/a Josh Green, WIPO Case No. D2004-0784). In the present case, the Respondent is using the Disputed Domain Name as a forwarding address to a for-profit online pharmacy.

To a certain extent, the Respondent is encouraging consumers to enter into an irresponsible pattern of conduct in the purchase of medication. Considering that the Respondent is trading on the goodwill of the Complainant's trademarks, it should be also taken into account that the conditions under which the Respondent is promoting the sale of a purported generic alternative to PROVIGIL's products may lessen the reputation associated with the Complainant's trademarks.

Indeed, by the use of the website at the Disputed Domain Name, the Respondent is promoting another website as an online place to purchase the purported generic alternative of PROVIGIL's products. In the Panel's view, using a confusingly similar domain name in order to promote and sell a competing product does not constitute a fair use of this domain name.

Noting that the Disputed Domain Name is confusingly similar to the trademarks in which the Complainant has rights, together with the gTLD ".com"; that no Response has been filed; and that there appears to be no conceivable good faith use that could be made by the Respondent of the Disputed Domain Name, and considering all the facts and evidence submitted by the Complainant, the Panel finds that the requirements of paragraph 4(a)(iii) of the Policy are also fulfilled in this case.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **XN--5DBCHRBS4C6A.COM**: Transferred

PANELLISTS

Name	**Nathalie Dreyfus**

DATE OF PANEL DECISION 2016-02-29

Publish the Decision