Decision for dispute CAC-UDRP-101228

Case number	**CAC-UDRP-101228**
Time of filing	**2016-06-13 11:41:56**
Domain names	**provigilstore.com**

Case administrator

Name	**Lada Válková (Case admin)**

Complainant

Organization	**Cephalon, Inc.**

Complainant representative

Organization	**Matkowsky Law PC**

Respondent

Name	**Sandeep Ghume**

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant relies on rights in the PROVIGIL trademark registered in the United States under number 2000231 and in the European Union under number 003508843.

FACTUAL BACKGROUND

*** Excerpts from the Complaint
(references to annexes omitted)

BACKGROUND

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.

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.

Cephalon's PROVIGIL® (modafinil) Tablets [CIV] are part of Teva's CNS (Central Nervous System) line of specialty medicines. They contain modafinil, a Schedule IV federally controlled substances 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.

The PROVIGIL® mark is well known within its specialty area, and Complainant uses its mark online in domain names. (...)

CONFUSING SIMILARITY (ICANN Rule 3(b)(ix)(i); ICANN Policy ¶4(a)(i))

The test of confusing similarity under the Policy is confided to a comparison of the domain name and the trademark alone. E.g., WalMart Stores, Inc. v. Traffic Yoon, D2006 0812 (WIPO Sept. 20, 2006). Confusion in this context, in the sense of bewilderment or failing to distinguish between things, may be regarded as a state of wondering whether there is an association, rather than a state of erroneously believing that there is one. Forum Claim No. FA120001466844 (Dec. 22, 2012) (citing SANOFI-AVENTIS v. Jason Trevenio, WIPO Case No. D2007 0648 (July 11, 2007).

It has been ruled many times before that when a registered name is fully incorporated in a domain, it may be sufficient for demonstrating similarity. E.g., WIPO Case No. D20071365. The Domain incorporates the entirety of the registered mark, with the addition of a generic term. It is also universally accepted that generic top-level domains (gTLDs) such as ".com" or ".org" are not relevant to assessing this element of the Policy. E.g., Pomellato S.p.A v. Tonetti, D20000493 (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).

Therefore, the Domain is confusingly similar to the registered trademark in which Complainant has rights.

NO RIGHTS OR LEGITIMATE INTERESTS (ICANN Rule 3(b)(ix)(2); ICANN Policy ¶4(a)(ii))

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. Respondent has no connection or affiliation with Complainant whatsoever.

Moreover, 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 Policy ¶ 4(c)(ii). E.g., Reese v. Morgan, FA 917029 (Nat. Arb. Forum Apr. 5, 2007) (finding, under Policy ¶ 4(c)(ii), 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).

While the overall burden of proof rests with the complainant, panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is often primarily within the knowledge of the respondent. Therefore, a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests.

Once such prima facie case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. E.g., Hanna-Barbera Prods., Inc. v. Entm't Commentaries, FA 741828 (Nat. Arb. Forum Aug. 18, 2006).

The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc., FA 95095 (Nat. Arb. Forum July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); see also Talk City, Inc. v. Robertson, D20000009 (WIPO Feb. 29, 2000) ("In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.").

Respondent is luring consumers in search of the well-known PROVIGIL brand to a "Provigil Store" that promotes purchasing a variety of substitutes for Provigil, some of which purport to have the same active pharmaceutical ingredients. The site also specifically promotes "Provigil Without Prescription Available on Reliable Online Pharmacy," falsely advertising the generic name as "Provigil," and offering "Modawake" as a substitute under the Provigil brand with free shipping. The site delivers anywhere, including the USA without a prescription, which is illegal under the Controlled Substances Act. Such use does not demonstrate a legitimate right or interest. E.g., F. Hoffmann-La Roche AG v. Aleksandr Bannikov, WIPO Case No. D20150066; Eli Lilly and Company v. Igor Palchikov, FA 1105001388612; Lilly ICOS LLC v. Alexey Stoun, WIPO Case No. D20061170.

BADFAITH REGISTRATION AND USE

The trademark registration rights predate the domain name registration, and the allegations that the trademark is well-known in its field has not been rebutted. Respondent can be considered to be 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 (...), 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. E.g., Cephalon, Inc. v Alen Mironassyan, Alen Mironassyan, CAC Case No. 100892. Therefore, the requirement of bad faith registration and use of the disputed domain name pursuant to article 4(a)(iii) of the Policy has been met.

PARTIES CONTENTIONS

Respondent filed a response reproduced here in its entirety:

"complainant's claiming that word "provigil" is patented by cephalon INC, But the domain name is provigilstore.com its not a single word provigil.

for e.g if your website name is udrp, and if i take domain name udrpinc.com that does not mean i am violating any rule.

Complainant has a bad intention behind this complaint as they do not want others to make business.
I will respect the judgement passed by judiciary."

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Name is identical or confusingly similar to a trademark in which the complainant has rights (within the meaning of paragraph 4(a)(i)of UDRP).

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 UDRP).

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 UDRP).

PROCEDURAL FACTORS

This 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

*** The domain name is confusingly similar to a trademark in which the complainant has rights

Pursuant to paragraph 4(a)(i) of UDRP the first question the Panel must answer to is whether or not the disputed domain name PROVIGILSTORE.COM is confusingly similar to the Complainant's trademark. The Respondent acknowledges the Complainant has trademark rights on the word PROVIGIL but replies that the domain name he registered is not just composed of this single word and that the addition of another word is "not violating any rule".

There are tons of UDRP decisions where Panels found there is confusing similarity where the Respondent merely added a generic word after a trademark in a .com domain name. The Complainant cites some classical decisions. Looking at the decisions of the past three years where the disputed .com domain name was combining a trademark and the word "store", the Panel observes that such a combination is consistently deemed confusingly similar: bicstore.com (WIPO 2016-0911: "The Panel notes that the disputed domain names incorporate the trademark BIC in its entirety with the addition of the term "store" and the generic Top-Level Domains ("gTLDs") ".com" and ".net", which can be disregarded being a generic term and a technical requirement of registration, respectively"); guess—store.com (NAF 1671008: "The top-level domain,".com", can be ignored for the purposes of comparing the domain name to the trademark. The domain name takes the trademark and merely adds (double) hyphenation plus the purely descriptive word, "store". The additions do not alter the identity of the trademark and only serve to heighten the likelihood of confusion"); norcold-store.com (NAF 1668815); zentriastore.com (WIPO D2015-2210); thulestore.com (WIPO D2015-1965); taser-store.com (WIPO D2015-2068: "The term "store", when combined with a trade mark, points to an online store at which goods bearing the Trade Mark can be purchased. This type of website is currently hosted at the Disputed Domain Name. Also, it is likely that an Internet user would interpret this additional term as subordinate to the Trade Mark, which is the dominant and distinctive part of the Disputed Domain Name (..). These factors serve to increase the confusing similarity"); isabellemarantstore.com (WIPO D2015-1817); lindtstore.com (WIPO D2015-1430); gianvitorossistore.com (NAF 1628059: "The word "store" is a generic term, and does nothing to adequately distinguish the domain name from the GIANVITO ROSSI mark"); spigenstore.com, (WIPO D2015-0889); lelostore.com (WIPO D2015-0966); kipling-store.com (NAF 1623460: "the Panel finds that Respondent's <kipling-store.com> domain name is confusingly similar to Complainant's KIPLING mark pursuant to Policy ¶ 4(a)(i)"); dixons-store.com (WIPO D2015-0652); scoobydoostore.com (NAF 1585358); hbostore.com (NAF 1585358); kindlestore.com (NAF 1576228); nobisstore.com (WIPO D2014-0066); sonystore.com (NAF 1522726: "Respondent's domain name consists of Complainant's SONY mark, the generic term "store," along the top level domain name ".com." Respondent's inclusion of a generic term does not distinguish the domain name from Complainant's trademark and thus the Panel concludes that Respondent's <sonystore.com> domain name is confusingly similar to Complainant's SONY mark pursuant to Policy ¶4(i)"); goyardstore.com (WIPO D2013-1520); lancel-store.com (WIPO D2013-1203); jcrewstore.com (WIPO D 2013-0688).

The Panel therefore concludes that the disputed domain name is confusingly similar to the Complainant's trademark in accordance with paragraph 4(a)(i) of UDRP.

*** The Respondent has no rights or legitimate interests in the domain name

The Complainant contends the disputed domain name is used for a site "that promotes purchasing a variety of substitutes for Provigil, some of which purport to have the same active pharmaceutical ingredients" and observes this site "delivers anywhere, including the USA without a prescription, which is illegal under the Controlled Substances Act". Under UDRP the Panel only has the power to determine whether the Respondent has rights or a legitimate interest in the domain name from a trademark perspective; a Panel is not competent to assess whether the sale of a product on the Respondent's site is lawful under a local law (see CAC 100445: "The Panel rejects the Complainant's argument based upon the assertion that the goods on sale from the website are for sale without mandatory prescription. Although the Panel accepts that there are UDRP cases in which panelists have found in favor of a trade mark owner on that basis, the Panel respectfully suggests that such an approach is misconceived"; and see WIPO D2007-1773: "The UDRP procedure is not a procedure that is intended generally to

police alleged wrong doing on the internet. It is instead primarily directed at the misuse of a name or mark in which a complainant has developed or acquired rights. It is not designed for, or well equipped to deal with, broader disputes. There may perhaps be cases where the activity operating form a domain name is so obviously unlawful that this is a factor that may be taken into account when assessing bad faith. However, this Panel suspects that in most cases it will be possible to reach a finding of bad faith without the need to rely upon such reasoning. The issue of the sale of prescription medicines on the internet and the extent to which individuals should be allowed to directly purchase such products is one that raises a range of policy issues that include the imposition of suitable measures for the protection of public health, the protection of intellectual property rights, and drug company pricing practices. It is an area where national laws can vary. This Panel would suggest that this is a debate in which UDRP panels should be reluctant to become involved, even if that involvement is only peripheral.").

The Respondent is silent as to why he registered the domain name. In the absence of explanation or evidence this Panel is unable to assess whether Respondent has a right or a legitimate interest in the domain name. The Panel for example cannot establish if the Respondent is authorized to sell generic drugs comparable to PROVIGIL and uses this trademark to specify that these products are the generic drug of the original drug PROVIGIL (this Panel notes the Complainant does not allege the Provigil drug the Respondent sells counterfeit drugs).

Under paragraph 4(c) of UDRP the Respondent has not shown he uses the domain name in connection with a bona fide offering of goods or services. This Panel will follow past panels that found such a lack of evidence sufficient to show that a Respondent does not have rights or legitimated interest in the disputed domain name 4(a)(ii) of UDRP.

*** The domain name has been registered and is being used in bad faith

Since the Respondent registered the domain name to use the Complainant's trademark on his website, it is obvious that he knew the Complainant's trademark when he registered the disputed domain name. The Respondent does not challenge he had knowledge there was an intellectual property right on the word PROVIGIL (it was "patented by Cephalon INC", he writes), nor does he contest he has registered and has used the domain name to take unfair advantage of the Complainant's trademark.

The Panel therefore concludes that the disputed domain name was registered and is being used by the Respondent in bad faith in accordance with paragraph 4(a)(iii) of UDRP.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PROVIGILSTORE.COM**: Transferred

PANELLISTS

Name	**Dr. Cédric Manara**

DATE OF PANEL DECISION 2016-07-17

Publish the Decision