Decision for dispute CAC-UDRP-101225

Case number	CAC-UDRP-101225
Time of filing	2016-06-13 11:37:45
Domain names	PROVIGILONLINE.ORG

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Cephalon, Inc.

Complainant representative

Organization	Matkowsky Law PC

Respondent

Name	Toby Bond

OTHER LEGAL PROCEEDINGS

None

IDENTIFICATION OF RIGHTS

For purposes of this proceeding, Complainant relies on an American and a European trademark (<PROVIGIL> U.S. Reg. Nos. 2000231 registered on 10 September 1996; OHIM CTM Reg. No. 003508843 registered on 25 March 2008).

FACTUAL BACKGROUND

Cephalon, Inc. (“Cephalon”), is an indirect, wholly-owned subsidiary of Teva Pharmaceutical Industries Ltd., and member of the Teva group of companies (“Teva”).

Teva is ranked among the top pharmaceutical companies in the world, and claims to be the world’s largest generic medicines producer.

Cephalon’s PROVIGIL® (modafinil) Tablets [C-IV] are part of Teva’s CNS (Central Nervous System) line of specialty medicines.

The website active at the Domain promotes purchasing a substitute for Provigil that purportedly has substantially the same active pharmaceutical ingredient (API). The site specifically promotes buying from anywhere in the world online API

Modafinil from vespharmacy.com. The site delivers anywhere, including the USA, without a prescription.

Based on Respondent's assertions, the website was different when it was launched. It was started out to spread awareness in the field of cyber-crimes and online threats. The site refers to the idea of pro-vigil-online (vigilance against online threats). However, the site was hacked and hackers replaced the original content with the controversial one. When receiving the Complaint, Respondent has put back the initial content.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

SIMILARITY. Complainant contends that:

• The test of confusing similarity under the Policy is confided to a comparison of the domain name and the trademark alone. E.g., Wal-Mart Stores, Inc. v. Traffic Yoon, D2006 0812 (WIPO Sept. 20, 2006).

• The Domain is composed of the Complainant’s trademark “PROVIGIL”, together with the word “ONLINE”.

• 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. D2007-1365. The Domain incorporates the entirety of the registered mark, with the addition of a generic term.

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

ABSENCE OF RIGHTS OR LEGITIMATE INTERESTS. Complainant contends that:

• 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.

• 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).

• Respondent is luring consumers in search of the well-known PROVIGIL brand to a website that promotes purchasing a substitute for Provigil that purportedly has substantially the same active pharmaceutical ingredient (API).

• The site specifically promotes buying from anywhere in the world online API Modafinil from vespharmacy.com. The site delivers anywhere, including the USA without a prescription, which is illegal under the Controlled Substances Act.

BAD FAITH REGISTRATION AND USE. Complainant contends that:

• 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.

RESPONDENT:

SIMILARITY. Respondent contends that Domain name is neither identical nor confusingly similar to the protected mark, but it gives no explanation in relation with the absence of confusion.

ABSENCE OF RIGHTS OR LEGITIMATE INTERESTS + BAD FAITH REGISTRATION AND USE. Because of the specificities of case, respondent's contention regarding the absence of right or legitimate interest, and bad faith, will be presented together. Respondent explains that :

• It is a novice website started out to spread awareness in the field of cyber-crimes and online threats. The site refers to the idea of #pro vigil online# (vigilance against online threats).

• The domain has been use for non-commercial purpose and there has been no monetary gain. Its purpose is to inform adults and teens of the potential dangers of the Internet and give them the knowledge to protect themselves.

• However the site was hacked. Apparently the hackers replaced the original content with the controversial content actually available.

• The Respondent does not monitor regularly its website and it is the reason why he was not aware of hacking before receiving the complaint.

As a result, the respondent claims that he has right and legitimate interest in registering and using the Domain, and that no bad faith can be proved against him.

ADDITIONAL INFORMATION PROVIDED BY THE COMPLAINANT:

In a non-standard communication, the Complainant asks to accept new evidence as an answer to the Respondent's response. Such evidence is made of :

• Mails exchanged between the complainant's attorney and the former hosting provider of the Domain. Those mails show that in February 2016, complainant's attorney asked the hosting provider to remove the infringing material, which was accepted. Obviously, controversial content was deliberately put back by Respondent between March 206 and July 2016 (filing of the complaint).

• Print-screen of the content of the website as shown by the way back machine (archive.org), showing that the controversial content was in line since ever.

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 additional evidence provided by the Complainant in its non-communication sent after the response of the Respondent, needs some specific explanations.

Pursuant to Rule 10, the Panel conducts the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and these Rules, and it shall determine the admissibility, relevance, materiality and weight of the evidence. Pursuant to Rule 12, in addition to the complaint and the response, the Panel may request, in its sole discretion, further statements or documents from either of the Parties.

Of course, the Panel shall always make sure that its decisions and the way it conducts the administrative proceeding, are fair and treat equally both parties. This constraint derives not only from general principles of law and procedure, but also from Rule 10 (b) : “In all cases, the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case”.

These Rules are totally in accordance with the very basic spirit of ADR: providing to the parties a quick, cheap, efficient and flexible proceeding, however without compromise on the fundamental rights of both parties to be treated fairly and equally by an independent Panel, and subject to the control of a Court after the decision is published.
The Panel shall take into account the new evidence provided; notably:

• The non-standard communication and the additional evidence provided, are a direct and proportionate answer to the response filed by the Respondent;

• It is limited to what is needed to answer to facts and assertions of the Respondent, that the Complainant could not have known before reading the response of the Respondent;

• The Respondent was notified of the existence of a non-standard communication providing new evidence to the Panel; he had time to react before the Panel was designated. After such designation, Respondent could also have asked the Panel a further delay to answer;

• Both parties have been treated fairly and had all opportunities to present their case.

PRINCIPAL REASONS FOR THE DECISION

RIGHTS

The test of confusing similarity under the Policy is confided to a comparison of the domain name and the trademark alone.

The Domain is composed of two elements: the Complainant’s trademark “PROVIGIL”, together with the word “ONLINE”.

It has been ruled many times before that when a registered name is fully incorporated in a domain, it is often sufficient for demonstrating similarity. It is even more the case when the mere difference between the trademark and the Domain is a generic term such as "ONLINE".

NO RIGHT OR LEGITIMATE INTEREST

Complainant has demonstrated that its trademark is known worldwide. In the Panel's view, it is highly unlikely that

Complainant was not aware of the existence of this trademark when he registered the Domain.

Complainant has underlined - and Respondent didn't deny - that it has not authorized, permitted or licensed Respondent to use its trademarks in any manner. Respondent has no connection or affiliation with Complainant whatsoever.

The only remaining question is related to the history claimed by the Respondent related to the hacking of its website.

In that regard, the Panel is of the opinion that the history of the Domain (as concocted by Respondent) is made up for many reasons; notably:

- If this story were true, Respondent would have provided the Panel with more information. For example: the number of persons registered to the newsletter; the number of visits; copies of mails, questions or communications from the public; etc.

- Exchanges between complainant's attorney and the hosting provider in February 2016 show that, already at that time, the controversial content was available. It was removed by the hosting provider, but it came back soon after and this is the reason why, in June 2016, the Complainant has filed this complaint. It shows that the controversial content is online on purpose, and not as the result of the alleged hacking.

- Although print-screen from the way back machine are not legal evidences, the Panel may take them into account if they support, together with other elements, the assertions of a party. In this case, such print-screens show that the controversial content is available since a very long time. Even if the site was hacked - a story that the Panel does not believe in - Respondent should have been more proactive in monitoring his website. Respondent should have been even more proactive since he was aware (or should have been aware) of the fact that the Domain is similar to a well-known medicine with high impact on health, which create on him a higher duty of monitoring and vigilance.

BAD FAITH

In the Panel's view, the Complainant has demonstrated that the controversial content is available on the website since a long time, and that Respondent has put it online deliberately.

This website promotes purchasing a substitute for Provigil that purportedly has substantially the same active pharmaceutical ingredient (API). The site specifically promotes buying from anywhere in the world online API Modafinil from vespharmacy.com. The site delivers anywhere, including the USA, without a prescription.

It means that the Respondent has accepted to create a risk for public health by interfering with the distribution of a product that should normally be controlled by doctors and public authorities.

Furthermore, it should be noted that the Complainant's trademarks predate the registration of the Domain.

Therefore, according to the Panel's view, Respondent bad faith in both registering and using the Domain is blatant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PROVIGILONLINE.ORG**: Transferred

PANELLISTS

Name	**Mr. Etienne Wéry**

2016-07-19

DATE OF PANEL DECISION 2016-07-19

Publish the Decision