Decision for dispute CAC-UDRP-101229

Case number	**CAC-UDRP-101229**
Time of filing	**2016-06-13 11:42:34**
Domain names	**PROVIGILWEB.ORG**

Case administrator

Name	**Lada Válková (Case admin)**

Complainant

Organization	**Cephalon, Inc.**

Complainant representative

Organization	**Matkowsky Law PC**

Respondent

Organization	**Sleepdex**

OTHER LEGAL PROCEEDINGS

Panel is not aware of any other legal proceedings.

IDENTIFICATION OF RIGHTS

The Complainant is proprietor of several registered trademarks for PROVIGIL, inter alia, proprietor of the US trademark registration No. 2000231 PROVIGIL registered on September 10, 1996 in class 5.

The disputed domain name was registered on July 29, 2004.

FACTUAL BACKGROUND

The Complainant is an indirect, wholly-owned subsidiary of Teva Pharmaceutical Industries Ltd, one of the world´s largest producers of generic medicines with net revenues in 2014 amounted to $20.3 billion. The Complainant’s PROVIGIL Tablets are for treatment of the central nervous system as a specialty medicine. The PROVIGIL trademark is well known within its specialty area.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that the disputed domain name was redirected to a website that promotes purchasing a substitute for Provigil by re-directing the domain to http://www.modafinilfacts.com/ where visitors are encouraged to "Visit our online store“ by clicking a button that lands on https://modapharma.com, an online pharmacy, offering purported generic substitutes.

With that, the Respondent is luring consumers in search of the well-known PROVIGIL brand to competitive products.

Whereas the trademark and the disputed domain name are similar and the use of the disputed domain name is not legitimate, the use also shows bad faith since the 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:

The Respondent did not dispute the claim or argued to be able to keep the disputed domain name, but declared his willingness to give up this domain name. He had contacted Complainant´s representative and offered to transfer the domain name free of charge. Furthermore, he declares that he had registered the domain name 12 years ago. So far the Complainant had not objected to it. The websites allegedly did not sell the PROVIGIL product but had only advertisements on them. In “About us” it was always said that there is no connection to Cephalon, Teva, or any other manufacturer of pharmaceuticals. The Respondent claims to have made an effort to make sure that website visitors were not confused.

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).

The Complainant has established the fact that it has valid trademark rights for “PROVIGIL”.

The disputed domain name is confusingly similar to the PROVIGIL mark of the Complainant since the addition of “web” as a generic indication for the internet in this context does not influence the overall character of the disputed domain name compared to the trademark of the Complainant.

The Panel therefore considers the disputed domain name to be confusingly similar to the trademark PROVIGIL in which the Complainant has rights in accordance with 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).

The Respondent has no rights or legitimate interests in the disputed domain name, since the Respondent is not a licensee of the Complainant nor has the Complainant granted any permission or consent to the Respondent to use its trademarks or designations confusingly similar to its trademarks. Furthermore, the Respondent has no rights or legitimate interests in the disputed domain name, since there is no indication that the Respondent is commonly known by the name PROVIGIL or that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services.

The Panel therefore finds that the Respondent does not have rights or legitimate interests in the disputed domain name.

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).

The Respondent does not dispute that he was aware of the PROVIGIL trademark when he registered and used the disputed domain name. His contention that he tried to avoid any confusion for customers about the circumstances of the site, do not hinder the consideration as having acted in bad faith in the meaning of the UDRP.
This Panel does not see any conceivable legitimate use that could be made by the Respondent of this particular domain name without the Complainant's authorization.

The circumstances of this case, in particular the advertising links to other sources where competitive products could be bought furthermore indicate that the Respondent registered and used the disputed domain name primarily with the intention of attempting to attract, for commercial gain, Internet users to its potential website or other online locations, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of such website or location, or of a product or service on such website or location. The Panel therefore considers the disputed domain name to have been registered and used in bad faith in accordance with 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.

This decision would have been not necessary if Respondent would have agreed to the formal offer of Complainant over the platform of the present ADR provider to settle the case. Since Respondent did not respond or only react to this offer, panel had to substantiate the decision in view of the not disputed facts and arguments.

PRINCIPAL REASONS FOR THE DECISION

The Complainant has established the fact that it has valid trademark rights for "PROVIGIL".

The disputed domain name is confusingly similar to the PROVIGIL mark of the Complainant since the addition of "web" as a generic indication for the internet in this context does not influence the overall character of the disputed domain name compared to the trademark of the Complainant.

The Respondent has no rights or legitimate interests in the disputed domain name, since the Respondent is not a licensee of the Complainant nor has the Complainant granted any permission or consent to the Respondent to use its trademarks or designations confusingly similar to its trademarks. Furthermore, the Respondent has no rights or legitimate interests in the disputed domain name, since there is no indication that the Respondent is commonly known by the name PROVIGIL or that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services.

The Respondent does not dispute that he was aware of the PROVIGIL trademark when he registered and used the disputed domain name. His contention that he tried to avoid any confusion for customers about the circumstances of the site, do not hinder the consideration as having acted in bad faith in the meaning of the UDRP.

This Panel does not see any conceivable legitimate use that could be made by the Respondent of this particular domain name without the Complainant's authorization.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PROVIGILWEB.ORG**: Transferred

PANELLISTS

Name	**Dietrich Beier**

DATE OF PANEL DECISION 2016-08-01

Publish the Decision