Decision for dispute CAC-UDRP-101441

Case number	CAC-UDRP-101441
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Domain names	provigilnews.com, provigil.online, provigil.shop

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Cephalon, Inc.

Complainant representative

Organization	RiskIQ, Inc

Respondent

Organization	Privacy protection service - whoisproxy.ru a/ka/ Veaceslav Ciuntu

OTHER LEGAL PROCEEDINGS

The Complainant has submitted that there are no other legal proceedings, pending or decided, which related to the disputed Domain Name. No such proceedings are known to the Panel.

IDENTIFICATION OF RIGHTS

The Complainant is the holder of rights under trade mark law; see for instance registration 2000231 in the United States (originally issued 10 September 1996 and renewed) and Community Trade Mark 003508843 in the European Union (issued 31 March 2008). Both registrations relate to the string PROVIGIL.

FACTUAL BACKGROUND

The Complainant Cephalon, Inc., a subsidiary of global pharmaceutical company Teva Pharmaceutical Industries Ltd., manufactures and promotes the drug Provigil. It holds a number of trademark registrations as set out above. Moreover, it registered the domain name <PROVIGIL.COM> and continues to publish a website at that address. Provigil is a drug containing modafinil, a controlled substance under US law, and prescribed for patients suffering from (for instance) excessive sleepiness associated with narcolepsy.

PARTIES CONTENTIONS

The Complainant contends that the disputed Domain Names <PROVIGILNEWS.COM>, <PROVIGIL.ONLINE>, and <PROVIGIL.SHOP> are confusingly similar to the trademark PROVIGIL. The Complaint includes a number of Annexes, which

set out the use of the disputed Domain Names, through websites (<PROVIGIL.ONLINE> and <PROVIGIL.SHOP>) and email (<PROVIGILNEWS.COM>).

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed Domain Names are 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).

Disregarding the relevant TLDs, both <PROVIGIL.ONLINE> and <PROVIGIL.SHOP> easily meet this test as the text is identical to the trademark in which the Complainant has rights.

However, in respect of the disputed Domain Name <PROVIGILNEWS.COM>, such a finding requires more caution. The Complainant cites the earlier decision in Case 101229 <PROVIGILWEB.ORG>, where the Panel found that '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'. Indeed, the addition of descriptive or generic wording to a mark is generally not determinative across a wide range of UDRP Cases.

In the present Case, while 'web' may indeed be a generic indication for the Internet, 'news' could be a more precise identifier of, for instance, news concerning the subject matter identified in the remaining part of a Domain Name. Moreover, the Policy notes that, in the context of paragraph 4(a)(ii), it is possible for a Respondent to argue that a legitimate noncommercial or fair use is being made of the Domain Name, where there is not an intent for commercial gain to misleadingly divert consumers or to tarnish the mark at issue. Examples in the case law include criticism sites and fan sites. Nonetheless, it is by now an established practice to recognise that in cases of this nature, it is more appropriate to accept a submission that the disputed Domain Name is identical or confusingly similar, and to address the question of legitimate use under subsequent headings (see e.g. WIPO AMC decisions D2008-0430 <METROLINKSUCKS.COM> and D2009-1105 <WIZZAIRSUCKS.COM>. As such, while taking due care not to equate the clear confusion in respect of <PROVIGIL.ONLINE> and <PROVIGIL.SHOP> with the more ambiguous position of <PROVIGILNEWS.COM>, this first element can be deemed to have been satisfied.

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 disputed Domain Names (within the meaning of paragraph 4(a)(ii)of the Policy).

The Complainant has declared that it has not authorised, permitted, or licensed the Respondent to use its trademarks, and that the Respondent has no connection or affiliation with it. It also asserts that the Respondent has not been commonly known by the disputed Domain Names.

The Respondent has not provided any evidence to the contrary, and the Panel has not been able to identify any relevant rights or legitimate interests. As such, this second element has been satisfied.

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed Domain Names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

The particular aspect of paragraph 4(a)(iii) of the Policy that arises in this Case is that set out in paragraph 4(b)(iv) of the Policy: that the Respondent has 'intentionally attempted to attract, for commercial gain, Internet users to [the] 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 [the] web site or location or of a product or service on [the] web site or location'.

In this regard, the earlier Decision in Case 100892 (<BUYNUVIGILQUICK.COM> and other names in a consolidated Decision) is similar. In that case, the Panel identified four linked factors in determining bad faith: (1) the trademarks being well-known; (2) the registration of the disputed Domain Names falling well after the trademark registration; (3) the reasonable assumption, based on the use of the disputed Domain Names, that the Respondent was aware of the first two points, and (4) the intentional attempt to attract users, for commercial gain, through this likelihood of confusion. These four factors are again present in this Case. Relevant evidence in respect of the third and fourth point has been submitted by the Complainant.

The Panel places due weight on the Respondent's attempts, as set out in the Complainant's submissions, to rely upon user awareness of the mark PROVIGIL in order to offer products through an online pharmacy. As summarised in the recent WIPO AMC decision D2017-0080 <VALIUM-KAUFEN.NET>, this model of using a Domain Name formed out of the mark associated with a prescription pharmaceutical product to attract users to such a commercial service raises issues both in respect of legitimate interests and bad faith, and has been the subject of numerous decisions under the Policy.

There is, again, a need for caution regarding one of the disputed Domain Names (<PROVIGILNEWS.COM>) as the evidence of bad faith appears confined to the use of a mail server. Limited evidence of actual use has been provided and so the Panel accepts, with caution, the common purpose of the Respondent across the three disputed Domain Names and the wider activities as identified in the documentary evidence provided by the Complainant along with the Complaint (read alongside the mail information set out the documentary evidence). The Panel notes that the Respondent has not chosen to provide information in its defence, but that cases where bad faith turns on email addresses are often accompanied by evidence of the use of the email address or mail server in question. Such evidence where it is exists is welcome, not least because it provides a more robust basis for a finding, in the context of the repeated reference to the 'use' of a Domain Name in the Policy.

For completeness, it should be noted that the Panel does not accept the contention of the Complainant that the use of a proxy registration service is evidence of bad-faith registration and use. There are a number of reasons why a proxy registration service would be used and the caselaw does not provide authority for a presumption of this nature. The Panel also finds that the Complainant's contention that the service ultimately accessed through the disputed Domain Names is 'identified as a rogue Internet pharmacy according to reviews online' is not supported by appropriate evidence contained in the Complaint.

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 Panel notes that the Amended Complaint appropriately identifies the Respondent.

PRINCIPAL REASONS FOR THE DECISION

In the absence of any Response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed Domain Names <PROVIGILNEWS.COM>, <PROVIGIL.ONLINE>, and <PROVIGIL.SHOP>. On the other hand, it is clear that the Complainant has rights in respect of the trademark PROVIGIL, which is similar in many respects to the disputed Domain Names. In light of the evidence presented regarding the use of the disputed Domain Names by the Respondent, and the legal findings as set out above, the Panel can find that the disputed Domain Names in question are being operated in bad faith. The requirements for the acceptance of a Complaint under paragraph 4 of the UDRP have therefore been met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PROVIGILNEWS.COM**: Transferred
2. **PROVIGIL.ONLINE**: Transferred
3. **PROVIGIL.SHOP**: Transferred

PANELLISTS

Name	Dr Daithi Mac Sithigh

DATE OF PANEL DECISION 2017-04-24

Publish the Decision