Decision for dispute CAC-UDRP-101858

Case number	CAC-UDRP-101858
Time of filing	2018-01-26 09:12:10
Domain names	buyprovigilmz.com, provigil1st.com, provigilb3.com, provigilvuc.com, provigilbtc.com, provigilinb.com, provigildcr.com, provigillsk.com, provigilxmr.com, provigilnem.com, provigilcht.com, provigilpod.com, provigilkr.com, provigilks.com, provigil17.com, provigilbit.com

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Cephalon, Inc.

Complainant representative

Organization	RiskIQ, Inc c/o Jonathan Matkowsky

Respondent

Name	Ilgam Nurtdinov

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is owner of the following trademarks:

International (word) trademark no. 438439 "PROVIGIL" registered on June 28, 1978, duly renewed, in Class 5 for Pharmaceutical products, namely prescription drugs, with designation under the Madrid Protocol in Austria, Benelux, Switzerland, Germany, France, Hungary, Italy, Kenya, Liechtenstein, Lesotho, Morocco, Monaco, Mozambique, Portugal, Romania, Serbia, Russia, Swaziland.

US (word) trademark no. 74507491 "PROVIGIL" filed on March 31, 1994, registered on September 10, 1996, duly renewed, in Class 5 for pharmaceutical preparations for the treatment of human sleep disorders.

US (device) trademark no. 76033426 "PROVIGIL" filed on April 21, 2000, registered on October 23, 2001, duly renewed, in Class 5 for Cachets, pills, pastilles and drops for pharmaceutical purposes stimulating daytime vigilance and cognitive + psychomotor performances.

International (device) trademark no. 735867 "PROVIGIL" registered on May 9, 2000, duly renewed, in Class 5 for Pharmaceutical products, with designation under the Madrid Protocol in the United Kingdom, Italy.

Isreali (word) trademark no. 147877 "PROVIGIL" filed on March 23, 2001, registered on March 5, 2002, duly renewed, in Class 5 for Pharmaceutical preparations namely, pharmaceutical preparations stimulating daytime vigilance, cognitive and psychomotor performances.

EUTM (word) no. 003508843 "PROVIGIL" filed on October 31, 2003, registered on August 25, 2008, duly renewed, in Class 5 for Pharmaceutical preparations for combatting excessive daytime sleepiness associated with narcolepsy, idiopathic hypersomnia, attention deficit, hyperactivity disorders, obstructive sleep apnea and other conditions related to excessive daytime sleepiness.

Mexican (word) trademark no. 900042 "PROVIGIL" filed on August 4, 2004, registered on September 22, 2005, duly renewed, in Class 5 for pharmaceutical preparations for the treatment of human sleep disorders.

The above-mentioned trademarks are hereinafter referred to as the PROVIGIL Trademark.

FACTUAL BACKGROUND

The Complainant asserts and provides evidentiary documentation of the following facts, which are not contested by the Respondent.

The Complainant, is an indirect, wholly-owned subsidiary of Teva Pharmaceutical Industries Ltd., a global pharmaceutical company. 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.

The Complainant's product commercialized as PROVIGIL is part of Teva’s CNS (Central Nervous System) line of specialty medicines. It contain modafinil, a Schedule IV federally 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. PROVIGIL is well known within its specialty area, and safety information is available at the website <provigil.com>.

The Complainant contends that the disputed domain names are confusingly similar to its distinctive and well-known PROVIGIL Trademark, because they incorporate the entirety of the Complainant's trademark with the addition of terms and characters which appear to descriptively relate to purchase PROVIGIL with cryptocurrency and blockchain tecnology and, thus, are inadequate to negate the confusing similarity but rather to imply an authorized connection with the Complainant or its mark. Moreover, according to the Complainant, the content of the relevant websites advertising the online purchase of PROVIGIL supports the confusing similarity between the domain names and the Complainant's mark.

The Complainant submits that the Respondent does not have any rights or legitimate interest in the disputed domain names.

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

All of the disputed domain names except <provigilcht.com> land on a commercial ad to an online pharmacy offering the “Highest Quality Generic Drugs” specifically including purportedly PROVIGIL dosages in 100 or 200 mg packages of between 10 and 360 pills. The ad on each landing page invites to click on a link to “Buy Provigil (Modafinil) Without Prescription” with bitcoin or a credit card. With respect to <provigilcht.com>, it is currently showing an error that may be due to misconfiguration of the server, but given the totality of the circumstances with all of the other disputed domain names pointing to the same commercial ad to buy PROVIGIL online without a prescription, it is implausible that <provigilcht.com> has any good faith intended use to which the domain name may be put and was or is likely to be used in the same manner

as all of the other ones Respondent registered and uses. When clicking on the link, most browsers appear to block the online pharmacy <http://worldpharm24.com/> displaying a malware warning that an infection was detected, and that the requested URL contains malicious code that can damage your computer. According to LegitScript, this online pharmacy is a rogue Internet Pharmacy website. The site itself holds itself out as a Canadian pharmacy offering a wide range of products in a wide range of categories but there is no information available when clicking on "About Us". Furthermore, the checkout page clearly ships to the United States where it is unlawful to purchase PROVIGIL online without a prescription.

The cryptocurrency-related abbreviations appended to the PROVIGIL mark do nothing in and of themselves to negate an affiliation with the trademark owner, but in the context of advertising the online purchase of PROVIGIL to be mailed anywhere in the world (which is illegal in the United States where it is a controlled substance) or of a purported competitive generic equivalent using a bait-and-switch tactic, weighs in favor of finding no legitimate interest by Respondent.

Considering that PROVIGIL is a prescription medicine not offered for sale online by the Complainant, and the Respondent is diverting traffic to a rogue Internet pharmacy not approved the Complainant, it appears the domain names are a pretext for commercial gain inhering to Respondent's benefit. The domains do not praise or criticize, which may otherwise suggest Respondent believed use of the disputed domain names to be truthful and well-founded. Respondent did not go out of his way to ensure that it would be clear to Internet users visiting the Respondent's website that it is not operated by the Complainant as there is no disclaimer of any kind on the landing pages leading to the rogue Internet pharmacy, and no prominent link or explanatory text provided to the Complainant's website. Furthermore, the fact that the commercial ads for purchasing PROVIGIL without a prescription online lead to a documented rogue Internet pharmacy possibly infested with malware and purporting to sell related "sleep-aid" drugs manufactured by the competitors of the Complainant placed in the same category as PROVIGIL on the site does not support any possible claim to rights or legitimate interests. The record in the instant case does not reflect the Respondent's observance of the Oki Data criterias.

Respondent is luring consumers in search of the well-known PROVIGIL brand to a website that assuming is not malware-infested, promotes purchasing PROVIGIL illegally by mail including in the United States (the check-out page to the United States and the display of the US Postal Service icon), or substitutes a generic variation using the PROVIGIL packaging and mark to promote the sale of, and confuse people into thinking they are buying PROVIGIL by falsely claiming it is known by other brand names such as "Modalert" and "Modvigil" not offered by the Complainant.

The Complainant also states that the disputed domain names have been registered and are being used in bad faith.

The trademark registration rights predate the domain name registrations, and the allegations that the trademark is well-known in its field has not been rebutted. The Respondent can be considered to be aware of the Complainant's trademark when registering the domain names, as obviously also follows from the way the domain names are currently being used and the number of domains registered in the instant proceeding.

The Respondent is clearly attempting to attract, for commercial gain, Internet users to an online location by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the online location and of the products offered for sale thereon.

Moreover, PROVIGIL comes with safety precautions and warnings as well drug interactions and adverse reactions that Respondent omits from his description of what he deems to be important to know about taking PROVIGIL. For example, Respondent says in plain small type beneath the offering that PROVIGIL can cause skin reactions that may be severe enough to need treatment in a hospital, but the one from PROVIGIL says that it that may affect parts of your body such as your liver or blood cells, and need to be treated in a hospital because it may be life-threatening. Other warnings are omitted such as that PROVIGIL is not approved for use in children for any medical condition, and that it is not known if PROVIGIL is safe or effective in children under 17 years of age. Exploiting the PROVIGIL mark to sell even a generic equivalent (assuming this is a bait and switch tactic as opposed to actual illegal sales of PROVIGIL over the Internet to the United States contrary to the FDA) in a manner that confuses people into thinking that they have the most important information they need to take PROVIGIL safely constitutes bad-faith registration and use.

The Complainant, therefore, requests the transfer of the disputed domain names.

PARTIES CONTENTIONS

No administratively complaint Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed 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 disputed 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 disputed 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

In order to obtain the transfer of the disputed domain names the UDRP Policy (paragraph 4(a)) requires that the Complainant proves each and all of the following elements:

(i) the disputed domain names are 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 names; and

(iii) the disputed domain names have been registered and are being used in bad faith.

I. RIGHTS OF THE COMPLAINANT AND IDENTITY OR CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAMES TO THE COMPLAINANT'S MARK

The Complainant has provided sufficient documentary evidences to demonstrate to be owner of the PROVIGIL Trademark since 1978.

This Panel conducted a straightforward side-by-side comparison of the disputed domain names and the textual components of the Complainant's mark to access whether the PROVIGIL Trademark is recognizable within the disputed domain names. The disputed domain names, without exception, incorporate the entirety of the dominant and distinctive part of the PROVIGIL Trademark (i.e. the wording PROVIGIL). While each case is judged on its own merits, in UDRP cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark under the first element of the UDRP (see paragraph 1.7 WIPO Overview 3.0).

In registering the disputed domain names the Respondent added letters and/or numbers to the relevant mark, particularly:

BUYPROVIGILMZ.COM: added the generic word "buy" before the Complainant's mark followed by the letters "mz",
PROVIGIL1ST.COM: added the number and letters "1st" to the Complainant's trademark,

PROVIGILB3.COM: added the letter and number "b3" to the Complainant's trademark,
PROVIGILVUC.COM: added the letters "vuc" to the Complainant's trademark,
PROVIGILBTC.COM: added the letters "btc" to the Complainant's trademark,
PROVIGILINB.COM: added the letters "inb" to the Complainant's trademark,
PROVIGILDCR.COM: added the letters "dcr" to the Complainant's trademark,
PROVIGILLSK.COM: added the letters "lsk" to the Complainant's trademark,
PROVIGILXMR.COM: added the letters "xmr to the Complainant's trademark,
PROVIGILNEM.COM: added the letters "nem" to the Complainant's trademark,
PROVIGILCHT.COM: added the letters "cht" to the Complainant's trademark,
PROVIGILPOD.COM: added the letters "pod" to the Complainant's trademark,
PROVIGILKR.COM: added the letters "kr" to the Complainant's trademark,
PROVIGILKS.COM: added the letters "ks" to the Complainant's trademark,
PROVIGIL17.COM: added the number "17" to the Complainant's trademark,
PROVIGILBIT.COM: added the letters "bit" to the Complainant's trademark.

According to the assertions of the Complainant, accepted as true by this Panel, some of these additional letters and/or numbers are cryptocurrency and blockchain technology-related terms or abbreviations ("b3" for B3Coin, "vuc" for Virta Unique Coin, "btc" for bitcoin, "inb" for INBlockchain, "dcr" for Decred cryptocurrency, "lsk" for Lisk blockchain application platform, "xmr" for Monero cryptocurrency, "nem" for nem distributed ledger technology, "cht" for charitySPACE blockchain-based platform).

In the view of this Panel such additional generic word, letters and/or numbers (even if some of them are to be considered as abbreviations of cryptocurrency or blockchain technology-related terms) neither effects the attractive power of the Complainant's trademark, nor are sufficient to negate the confusing similarity between the disputed domain names and such mark.

The content of the website associated with the domain name is usually disregarded by UDRP Panels when assessing confusing similarity under the first element. In some instances, Panels have however taken note of the content of the website associated with a domain name to confirm confusing similarity whereby it appears prima facie that the respondent seeks to target a trademark through the disputed domain name (see paragraph 1.9 of WIPO Overview 3.0).

In the dispute at hand, nearly all websites associated with the disputed domain names (except for <PROVIGILCHT.COM>) advertise the online purchase of PROVIGIL or a generic equivalant. Thus, it is clear the Respondent had in his mind the Complainant's PROVIGIL Trademark and intended to create confusion with such mark by registering the disputed domain names.

All disputed domain names are registered under the top-level domain (TLD) .com. UDRP Panels agree that TLD is usually disregarded for the purpose of determination of identity or confusing similarity between the disputed domain name and the Complainant’s trademark as it is a technical requirement of registration (see paragraph 1.11.1 WIPO Overview 3.0).

Hence, this Panel finds that the disputed domain names are confusingly similar to the Complainant's mark. The similarity of the disputed domain names to the PROVIGIL Trademark is likely to lead to confusion and/or association for the Internet users.

Accordingly, the Panel finds that the Complainant has proven the first element of the paragraph 4(a) of the UDRP Policy.

II. LACK OF RIGHTS OR LEGITIMATE INTERESTS

It is a consensus view of UDRP Panels that the Complainant shall establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name to shift the burden of proof to the Respondent (see paragraph 2.1 of the WIPO Overview 3.0: "[...] where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant

evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.")

The Panel finds that the Respondent, Ilgam Nurtdinov, lacks rights or legitimate interests in the disputed domain names for the following reasons:

- The Complainant states that it has no relationship with the Respondent whatsoever and the Respondent has never received any approval of the Complainant, expressed or implied, to use the Complainant's trademark or any other mark identical or confusingly similar to such mark.

- There is no evidence that the Respondent has been commonly known by the disputed domain names or has acquired any rights in a trademark or trade name corresponding to the disputed domain names.

- All websites associated with the disputed domain names (except for <PROVIGILCHT.COM>) advertise the online purchase of PROVIGIL or its generic equivalent without prescription. Clicking on the link present on the website redirects to a rogue online pharmacy website involved in propagating malware. Such use is clearly not a bona fide, legitimate or fair use under the UDRP Policy.

- The domain name <PROVIGILCHT.COM> does not resolve to any active website. However, the totality of the circumstances supports the finding that it is unlikely that there is any legitimate interest in the registration of the domain name by the Respondent without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark of the Complainant.

Thus, the Panel finds that the Complainant has established its prima facie case and the Respondent, in not formally responding to the Complaint, has failed to invoke any of the circumstances, which could demonstrate any rights or legitimate interests in the disputed domain names.

The Panel is, therefore, satisfied that the Complainant has met the second requirement of the paragraph 4(a) of the UDRP Policy.

III. REGISTRATION AND USE IN BAD FAITH

The Panel considered the following circumstances in finding that the disputed domain names have been registered and are being used in bad faith.

The Respondent has registered 16 domain names incorporating the entirety the Complainant's well-known prior trademark, hence, confusingly similar to such mark. Given the distinctiveness and reputation of the Complainant's trademark worldwide, it is inconceivable that the Respondent could have registered the disputed domain names without actual knowledge of the Complainant's rights in the trademarks. Thus, the Respondent intentionally attempted to attract, for commercial gain, Internet users to his website, by creating a likelihood of confusion with the Complainant's marks. Such finding is also supported by the content of the websites associated with the domain names. 15 of 16 domain names resolve to a website, containing an ad "BUY PROVIGIL (MODAFINIL) WITHOUT PRESCRIPTION". Clicking on the link present on the website redirects to a rogue online pharmacy website involved in propagating malware. One of the disputed domain names is not actively used, but considering all factors (the degree of distinctiveness and reputation of the Complainant’s mark, the failure of the Respondent to submit a Response or to provide any evidence of actual or contemplated good faith use and the pattern of conduct in which the Respondent is engaged, since he registered other 15 domain names confusingly similar with the Complainant's mark used for malware activities), it is implausible that there is any good faith use to which such disputed domain name may be put.

The Panel finds that the Complainant has discharged the burden of proof to show that the disputed domain names have been registered and are being used in bad faith (paragraph 4(a)(iii) of the UDRP Policy).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BUYPROVIGILMZ.COM**: Transferred
2. **PROVIGIL1ST.COM**: Transferred
3. **PROVIGILB3.COM**: Transferred
4. **PROVIGILVUC.COM**: Transferred
5. **PROVIGILBTC.COM**: Transferred
6. **PROVIGILINB.COM**: Transferred
7. **PROVIGILDCR.COM**: Transferred
8. **PROVIGILLSK.COM**: Transferred
9. **PROVIGILXMR.COM**: Transferred
10. **PROVIGILNEM.COM**: Transferred
11. **PROVIGILCHT.COM**: Transferred
12. **PROVIGILPOD.COM**: Transferred
13. **PROVIGILKR.COM**: Transferred
14. **PROVIGILKS.COM**: Transferred
15. **PROVIGIL17.COM**: Transferred
16. **PROVIGILBIT.COM**: Transferred

PANELLISTS

Name	**Avv. Ivett Paulovics**

DATE OF PANEL DECISION 2018-03-14

Publish the Decision