Decision for dispute CAC-UDRP-100835

Case number	CAC-UDRP-100835
Time of filing	2014-07-23 11:30:02
Domain names	BUYNUVIGILONLINE.COM, GENERICPROVIGIL.NET, BUY-PROVIGIL-GENERIC.COM, BUYPROVIGILMED.COM, PROVIGILGENERIC4SALE.NET, PROVIGILONLINECHEAP.NET, PROVIGILONLINESALE.NET

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Cephalon, Inc.

Complainant representative

Organization	Matkowsky Law PC

Respondent

Name	Jack n Oliver

OTHER LEGAL PROCEEDINGS

None of which the Panel is aware.

IDENTIFICATION OF RIGHTS

See "Factual Background" and "Principal Reasons for Decision" below.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant claims that Cephalon, Inc. (“Cephalon”), an indirect wholly-owned subsidiary of Teva Pharmaceutical Industries Ltd., is a global biopharmaceutical company with a marketed portfolio and pipeline of specialty products dedicated to improving the quality of life of individuals around the world. Since its inception in 1987, Cephalon has brought first-in-class and best-in-class medicines to patients in several therapeutic areas.

According to the Complainant, Cephalon’s Provigil® and Nuvigil® are prescription medicines indicated to improve

wakefulness in adults who experience excessive sleepiness due to obstructive sleep apnea, shift work disorder, or narcolepsy. In the United States, the schedules of controlled drugs are determined by the Drug Enforcement Agency (DEA) and are based on a drug's potential for abuse. Both Provigil and Nuvigil are Schedule IV [C-IV] medications, because they have the potential to be abused or lead to dependence.

The Complainant relies on the PROVIGIL® Trademark and claims that the federally registered PROVIGIL® mark is well-known in its specialty field. The mark has been in continuous use is in commerce since 1995. Cephalon owns numerous registrations for the PROVIGIL® mark around the world, including but not limited to federal trademark registrations in the United States, such as: Reg. No. 2,000,231, first used in 1995, with a priority application-filing date of March 31, 1994, issued in 2006, in International Class 5.; Reg. No. 2,499,937, first used in 1995, with a foreign priority application-filing date of November 9, 1999, issued October 23, 2001, in International Class 5; and others.

According to the Complainant, these registrations also evidence the wide scope of protection to which the PROVIGIL® mark is entitled. These registrations are incontestable pursuant to the Lanham Act, 15 U.S.C. § 1065(b), and constitute evidence of Complainant's exclusive right to use the mark for the products and services specified in those registrations pursuant to 15 U.S.C. § 1065 and 1115(b). Provigil® is a famous and well-known mark.

The Complainant also relies on the NUVIGIL® mark and claims that since at least as early as 2009, the NUVIGIL® mark has been in continuous use in commerce. Cephalon owns numerous registrations for the NUVIGIL® mark around the world, including without limitation, federal trademark registrations in the United States, such as: Reg. No. 3,538,564, issued November 25, 2008 with a priority filing date of December May 27, 2004, in Intl. Class 5; U.S. Reg. No. 3,782,440, issued April 27, 2010, with a priority application filing date of February 11, 2009, in Intl. Class 5; and others. These registrations also evidence the wide scope of protection to which the NUVIGIL® mark is entitled. These registrations constitute evidence of Cephalon's exclusive right to use the mark for the goods specified in these registrations pursuant to 15 U.S.C. § 1065 and 1115(b).

The Complainant states it has established rights in its PROVIGIL® and NUVIGIL® marks through registrations with the USPTO.

The Complainant claims it acquired its rights in its marks significantly prior to when the disputed domains were created in May 2014.

According to the Complainant, the disputed domain names incorporates either the NUVIGIL® or PROVIGIL® trademark in its entirety. Moreover the Complainant contends, that it is well-settled that the addition of generic top-level domain suffix ".com" is non-distinctive because it is required for the registration of the domain name. All of the disputed domains contain the entirety of either the Nuvigil or Provigil mark with the addition of generic terms or phrases describing the offering for sale of the trademarked-medicines (i.e., "buy," "generic," "med," "4sale" "online cheap").

Therefore, in the Complainant's view the disputed domain names are clearly confusingly similar to the NUVIGIL or PROVIGIL trademarks and, as a result, the requirement of paragraph 4(a)(i) of the Policy is met.

The Complainant states that the Respondent has never been licensed, authorized or otherwise permitted to use the disputed domain names or any other domain name using the Complainant's trademark. The Respondent is not known by the disputed domain names, nor has the Respondent acquired any trademark rights in respect of the domain names. Furthermore, the Respondent's use of the disputed domain names do not satisfy the test for bona fide use established in prior UDRP panel decisions as the disputed domain names are being, or have been, used to re-direct visitors to two rogue online pharmacies, <pillburry.com>, and <storesea.com>, offering competitive products and purported generic versions or variations of the trademarked medicines.

The Complainant contends that the Respondent has used and/or continues to use the disputed domain names to intentionally attempt to attract, for commercial gain, Internet users to websites by creating a likelihood of confusion with the Complainant's trademarks as to source, sponsorship, affiliation, or endorsement of the websites or of products available at

the websites or through the sites.

The Respondent currently continues to use <buy-provigil-generic.com> to divert users to <http://www.storesea.com/> and <buyprovigilmed.com>, <provigilonlinesale.net>, and <provigilonlinecheap.net> to divert users to <http://www.pillbury.com/>.

This is not a legitimate noncommercial or fair use under the Policy. The Respondent uses the disputed domain names for commercial gain with the purpose of capitalizing on the Complainant's trademarks, and the domain names clearly allude to the Complainant.

There is no reason why the Respondent should have any right or interest in any of the disputed domain names. To the extent Respondent is offering generic products under Complainant's marks, and not accurately or prominently disclosing its relationship with the trademark owner, there is no question that the Respondent's use of the disputed domain names does not satisfy the requirements for bona fide use.

The Complainant claims that although currently <BuyNuvigilOnline.com> has recently been suspended by GoDaddy for spam and abuse, this domain previously pointed to the rogue online pharmacy <Storesea.com> to confuse users into buying a purported generic being marketed as "generic Nuvigil" brand.

Similarly, the subject domain names <provigilgeneric4sale.net> and <GenericProvigil.net> were recently suspended by GoDaddy on July 9, 2014 for spam and abuse. They previously pointed to the rogue online pharmacy Pillbury.com.

Although currently, the above domain names <BuyNuvigilOnline.com>, <ProvigilGeneric4Sale.net> and <GenericProvigil.net> resolve to inactive websites presumably after GoDaddy suspended them for spam and abuse, Respondent will again presumably enable the resolving websites through a different website host; after all, Respondent continues to use <buy-provigil-generic.com> to divert users to <http://www.storesea.com/ and <buyprovigilmed.com>, <provigilonlinesale.net>, and <provigilonlinecheap.net> to divert users to http://www.pillbury.com/. Prior panels have frequently concluded that failing to make an active use of the disputed domain name does not establish rights or legitimate interests in the disputed domain name.

In light of the foregoing, the Complainant claims that the requirement of paragraph 4(a)(ii) of the Policy is met.

The Complainant states that there is no doubt the Respondent was aware of the existence of Cephalon's marks. Only someone who was familiar with the Complainant's marks and its activity would have registered the domain names with the addition of a generic term or phrase describing the offering for sale of the trademarked-medicines (i.e., "buy," "generic," "med," "4sale" "online cheap"). There is no information as to the business activity of the Respondent that would justify the registration and the use of the domain names, nor is there evidence of any rights or legitimate interests in the domain names by the Respondent. In the absence of any rights or legitimate interests and in the absence of any contrary evidence from the Respondent, the Respondent's registration of the domain names confusingly similar to the Complainant's trademarks was done in bad faith. The use of the domain names as evidenced is also in bad faith because the Respondent is intending to attract the Internet users to its websites by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its websites. Id.; UDRP Policy Paragraph 4(c)(iv).

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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.

PRINCIPAL REASONS FOR THE DECISION

The Complainant is the owner of various trade marks that comprise or incorporate the term “Provigil. They include US registered trade mark no. 2,000,231 in class 5 with a filing date of 31 March 1994 and a registration date of 10 September 1996.

The Complainant is also the owner of various trade marks that comprise or incorporate the term “Nuvigil”. They include US registered trade mark no 3,538,564 in class 5 with a filing date of 27 May 2004 and a registration date of 25 November 2008.

The domain names <genericprovigil.net>, <buy-provigil-generic.com>,<buyprovigilmed.com>, <provigilgeneric4sale.net>, <provigilonlinecheap.net>, and <provigilonlinesale.net> (the “Provigil Domains) can only sensibly be read as the term “Provigil” combined with generic/descriptive words and a top level domain suffix. Accordingly each of the Provigil Domains is clearly confusingly similar (as that term is understood under the UDRP) to the Complainant’s PROVIGIL mark.

The domain name <buynuvigilonline.com>, (the “Nuvigil Domain”) can only sensibly be read as the term “Nuvigil” combined with generic/descriptive words “buy” and “online” and the “.com” top level domain suffix. Accordingly, the Nuvigil Domain is clearly confusingly similar (as that term is understood under the UDRP) to the Complainant’s NUVIGIL mark.

All of the disputed domain names was first registered in May 2014. For at least some of the time since registration they have each been used to divert internet users to online pharmacies operating from the domain names <pillburry.com> and <storesea.com>. Each online pharmacy purports to offer for sale PROVIGIL and NUVIGIL branded products. Other pharmaceuticals are also offered for sale on those sites.

The Panel accepts the Complainant’s contention that the registration and use of the disputed domain names in this manner does not provide the Respondent with a right or legitimate interest and involves bad faith registration and use. First, the domain names themselves do not adequately make it clear that the domain name pertains to a website unconnected with the Complainants. Second, as the domain names appear to be being used to redirect internet users to a third party site rather than the Respondent’s own sites, it is doubtful whether the Respondent would be entitled to rely upon the conditions laid down in Oki Data Americas Inc v. ASD Inc, WIPO Case No. D2001-0903 so as to claim a right or legitimate interest (See Sanofi-aventis v. M72 Hosting WIPO Case No. D2007-1937). Third, even if the Oki Data conditions were potentially of relevance, the fact that the relevant websites sell other products than the genuine products of the Complainant, makes it clear that those conditions could not be satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BUYNUVIGILONLINE.COM**: Transferred
2. **GENERICPROVIGIL.NET**: Transferred
3. **BUY-PROVIGIL-GENERIC.COM**: Transferred
4. **BUYPROVIGILMED.COM**: Transferred
5. **PROVIGILGENERIC4SALE.NET**: Transferred
6. **PROVIGILONLINECHEAP.NET**: Transferred
7. **PROVIGILONLINESALE.NET**: Transferred

PANELLISTS

Name	**Matthew Harris**

DATE OF PANEL DECISION 2014-08-21

Publish the Decision