Decision for dispute CAC-UDRP-101173

Case number	CAC-UDRP-101173
Time of filing	2016-02-25 15:23:19
Domain names	PROVIGIL.INFO

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Cephalon, Inc.

Complainant representative

Organization	Matkowsky Law PC

Respondent

Organization	Stanislav Cernevic

OTHER LEGAL PROCEEDINGS

No legal proceeding has been commenced or terminated in connection with the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant has provided evidence of the following trademark registrations:

United States trademark registration No. 2000231 for PROVIGIL (word mark), registered on September 10, 1996, in International class 5;

Community trademark registration No. 003508843 for PROVIGIL (word mark), registered on March 25, 2008, in International class 5.

The Complainant is also the owner of the domain name <provigil.com>, registered on May 4, 1998.

FACTUAL BACKGROUND

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

The Complainant is a wholly-owned subsidiary of Teva Pharmaceutical Industries Ltd (hereinafter, “Teva”), one of the leading pharmaceutical companies in the world.

The Complainant's PROVIGIL tablets are part of Teva's central nervous system line of specialty medicines. They contain modafinil, a Schedule IV federally controlled substance in the United States. PROVIGIL is indicated to improve wakefulness in adult patients with excessive sleepiness associated with narcolepsy, obstructive sleep apnea or shift work disorder.

The Complainant contends that the disputed domain name is identical to the registered mark in which the Complainant has rights, except for the ".info" gTLD suffix, which has no weight in assessing this element of the Policy as it is a technical requirement.

The Complainant submits that the Respondent has no rights or legitimate interest in the disputed domain name since the Respondent has not been commonly known by the disputed domain name, the Complainant has not authorized, permitted or licensed the Respondent to use its trademarks in any manner and the Respondent has no connection or affiliation with Complainant whatsoever. The Complainant further asserts that the Respondent is luring consumers in search of the well-known PROVIGIL brand to a documented rogue online pharmacy that features a counterfeit picture of the PROVIGIL branding in connection with promoting a generic substitute.

The Complainant points out that the Respondent was aware of the Complainant's prior registered and well-known trademark when it registered the disputed domain name, as also shown by the use of the disputed domain name made by the Respondent.

The Complainant also states that, in light of the use of the disputed domain name as evidenced by documents attached to the Complaint, 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. Therefore, the Complainant contends that the requirement of bad faith registration and use of the disputed domain name pursuant to paragraph 4(a)(iii) of the Policy has been met.

As an additional circumstance of bad faith, the Complainant submits that the Respondent has a history of registering and using domain names incorporating the PROVIGIL mark in bad faith, since it also registered, using the same email address used for the disputed domain name but a different name and address, the domain name <provigils.com>, that was transferred to the Complainant in CAC Case No. 100833. The Complainant therefore concludes that the Respondent presumably used false contact information to register the disputed domain name. Both the history in CAC Case No. 100833 and the false contact information also supports a finding of bad-faith registration and use.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT 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.

The language of the Registration Agreement is Russian. The Complaint was submitted in English and the Complainant requested that English be the language of the proceeding since the web site to which the disputed domain name resolved was entirely in English. Furthermore, the Complainant claims not to be familiar with Russian language and therefore conducting the proceedings in Russian would disadvantage the Complainant as it would have to incur added expense and inconvenience in having the Complaint translated into Russian. In view of the circumstances of the case, including the undisputed Complainant's allegations and the evidence on records showing that the web site corresponding to the disputed domain name (currently inactive) was entirely in English, and in light of the fact that Respondent has been given a fair chance to object but has not done so, the Panel determines in accordance with paragraph 11(a) of the UDRP Rules that the language of the proceeding be English.

PRINCIPAL REASONS FOR THE DECISION

1. The Panel finds that the disputed domain name is identical to the Complainant's trademark PROVIGIL as it encompasses the trademark in its entirety with the mere addition of the ".info" gTLD suffix, which can be disregarded being a mere technical requirement of registration.

2. The Panel finds that the Complainant successfully submitted prima facie evidence that the Respondent has made no use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, and that the Respondent is not making a legitimate non-commercial or fair use of the disputed domain name. In fact, the Complainant has submitted screenshots showing that the disputed domain name was used in the past in connection with a web site where the Complainant's trademark PROVIGIL was featured and a generic substitute of the Complainant's drug was promoted. The Complainant also stated that the Respondent is not commonly known by the disputed domain name and has no trademark rights on PROVIGIL. Under these circumstances and in absence of a Response, the Panel finds that the Complainant has proven that the Respondent has no rights or legitimate interest in the disputed domain name.

3. The Panel also finds that the disputed domain name has been registered and used in bad faith for the following reasons. The disputed domain name was registered on December 31, 2012, several years after the registration of the Complainant's trademark PROVIGIL. In view of the identity of the disputed domain name with the Complainant's prior trademark and of the Respondent's reference to the Complainant's trademark on the correspondent web site, it is more likely than not that the Respondent was aware of the Complainant's trademark at the time of registration. Moreover, as mentioned above, the disputed domain name was pointed to a web site where the Complainant's trademark was displayed and a generic substitute of the Complainant's PROVIGIL product was promoted. Therefore, the Panel finds that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its web site by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of its web site or of the products promoted therein.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PROVIGIL.INFO**: Transferred

PANELLISTS

Name	**Luca Barbero**

DATE OF PANEL DECISION 2016-04-12

Publish the Decision