Decision for dispute CAC-UDRP-101227

Case number	**CAC-UDRP-101227**
Time of filing	**2016-06-13 11:41:14**
Domain names	**buyprovigil.org**

Case administrator

Name	**Lada Válková (Case admin)**

Complainant

Organization	**Cephalon, Inc.**

Complainant representative

Organization	**Matkowsky Law PC**

Respondent

Name	**Lucia Nidi**

IDENTIFICATION OF RIGHTS

The Complainant relies on rights in the United States and Europe (U.S. Reg. Nos. 2000231; OHIM CTM Reg. No. 003508843 (registered for "Provigil" primarily for Class 5 (Pharmaceutical Products).

FACTUAL BACKGROUND

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

BACKGROUND

The Complainant Cephalon, Inc. (“Cephalon”), is an indirect, wholly-owned subsidiary of Teva Pharmaceutical Industries Ltd. Formed in 1976, through its predecessors-in-interest, Teva Pharmaceutical Industries Ltd., together with its subsidiaries (collectively, “Teva”), was first established in 1901 with its global headquarters in Israel. Operating in sixty countries worldwide, Teva (NYSE and TASE: TEVA) (www.tevapharm.com) is ranked among the top pharmaceutical companies in the world, and the world’s largest generic medicines producer. Teva’s net revenues in 2014 amounted to $20.3 billion.

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.

Cephalon’s PROVIGIL® (modafinil) Tablets [C-IV] are part of Teva’s CNS (Central Nervous System) line of specialty

medicines. They contain modafinil, a Schedule IV federally controlled substances 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.

The PROVIGIL® mark is well known within its specialty area, and the Complainant uses its mark online in domain names, e.g., see http://provigil.com.

CONFUSING SIMILARITY

According to the Complainant, it has been ruled many times before that when a registered name is fully incorporated in a domain, it may be sufficient for demonstrating similarity. The disputed domain name incorporates the entirety of the Complainant's registered mark, with the addition of a generic term. It is also universally accepted that generic top-level domains (gTLDs) such as ".com" or ".org" are not relevant to assessing this element of the Policy e.g., Pomellato S.p.A v. Tonetti, D2000-0493 (WIPO July 7, 2000) (finding <pomellato.com> identical to the complainant's mark because the generic top-level domain (gTLD) ".com" after the name POMELLATO is not relevant).

Therefore, the Complainant claims the disputed domain name is confusingly similar to the registered trademark in which the Complainant has rights.

NO RIGHTS OR LEGITIMATE INTERESTS

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

Moreover, the pertinent WHOIS information identifies the registrant, which does not resemble the domain name. On this record, the Respondent has not been commonly known by the disputed domain name so as to have acquired rights to or legitimate interests in it within the meaning of paragraph 4(c)(ii) of the Policy.

Furthermore, the Complainant states the Respondent is luring consumers in search of the well-known PROVIGIL brand to a website that promotes purchasing through a rogue online pharmacy, a substitute for Provigil purportedly containing the same active pharmaceutical ingredient, and without a prescription. The rogue online pharmacy and homepage are offering a generic substitute falsely advertised online with the PROVIGIL brand and product packaging. The rogue site specifically targets the United States with customer support, where it is illegal to purchase modafinil without a prescription under the Controlled Substances Act. Such use does not demonstrate a legitimate right or interest.

BAD-FAITH REGISTRATION AND USE

The Complainant points out that the trademark registration rights predate the domain name registration, 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 name, as obviously also follows from the way the domain name is currently being used.

In light of the use of the disputed domain name as evidenced in documents submitted by the Complainant, 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 rogue web sites and of the products promoted therein falsely being advertised using the PROVIGIL product packaging and branding. Cf., Cephalon, Inc. v Alen Mironassyan, Alen Mironassyan, CAC Case No. 100892. Therefore, according to the Complainant the requirement of bad faith registration and use of the disputed domain name pursuant to article 4(a)(iii) of the Policy has been met.

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). The registered name "Provigil" is fully incorporated in the disputed domain name. Appendices with the generic top-level domains (gTLDs) such as ".com" or ".org" are not relevant; the term "buy" is a generic word. This is sufficient for demonstrating confusing similarity.

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 Complainant has met its initial burden of proof as to Respondent's lack of rights or legitimate interests in the mark. The Respondent defaults and fails to present any evidence under paragraph 4(c) of the Policy or other evidence that it has rights or legitimate interests in the mark, Therefore, the Complainant will be deemed to have satisfied paragraph 4(a)(ii).

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). PROVIGIL is a prescription medicine used to improve wakefulness in adults who are very sleepy. As the Complainant has stated, the Respondent is attracting consumers in search of the well-known PROVIGIL brand to a website that promotes purchasing through a rogue online pharmacy, a substitute for Provigil purportedly containing the same active pharmaceutical ingredient, and without a prescription. The Respondent is using the domain and the website to offer a generic substitute falsely advertised online with the PROVIGIL brand and product packaging. The Respondent is thus apparently attempting to attract, for commercial gain, Internet users to its web site by creating a likelihood of confusion with the Complainant's well known mark as to the source, sponsorship, affiliation, or endorsement.

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 Respondent is using the domain which clearly is substantially similar to the trademark protected for the Complainant in order to offer generic products similar to the products in question without medical prescription. He has refused from replying to the Complaint so that no legitimate interest could be found justifying his behaviour.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BUYPROVIGIL.ORG**: Transferred

PANELLISTS

Name	**Thomas Hoeren**

DATE OF PANEL DECISION 2016-07-16

Publish the Decision