Decision for dispute CAC-UDRP-101226

Case number	CAC-UDRP-101226
Time of filing	2016-06-13 11:38:33
Domain names	PROVIGILONLINEPOWER.COM

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Cephalon, Inc.

Complainant representative

Organization	Matkowsky Law PC

Respondent

Name	Akul Hossain

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

Complainant states, and provides evidence to support, that it "has extensive trademark rights in Class 5 in its PROVIGIL® mark. For purposes of this proceeding, Complainant relies on rights in the United States and Europe," including U.S. Reg. No. 2,000,231; and OHIM CTM Reg. No. 3,508,843.

Complainant further states that "[a] series of CAC Panels have recognized Cephalon's rights in its PROVIGIL/NUVIGIL marks. CAC Case Nos. 100832-100835 (transferring, amongst others, <provigilmodafinilforsale.com>, <provigilonline.com>, <provigil4bitcoins.com>, <genericprovigil.net>, <buy-provigil-generic.com>, etc.); CAC Case No. 100892 (transferring <buyprovigil-quick.com>, <buyprovigilextra.com>, <buyprovigilmeds.com>, <provigilforsale.com>, among others); CAC Case No. 101170 (transferring <onlineprovigil.com> and <buyprovigiltoday.com>); CAC Case No. 101171 (transferring <generic-provigil.com>); CAC Case No. 101173 (transferring <provigil.info>)."

FACTUAL BACKGROUND

Complainant states that it "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 Complainant uses its mark online in domain names. E.g., see http://provigil.com [...]"

Complainant argues that the disputed domain name is confusingly similar to the PROVIGIL trademark because "[i]t has been ruled many times before that when a registered name is fully incorporated in a domain, it may be sufficient for demonstrating similarity. E.g., WIPO Case No. D2007-1365. The Domain incorporates the entirety of the registered mark, with the addition of a generic term."

Complainant argues that Respondent has no rights or legitimate interests in respect of the disputed domain name because "Respondent has not been commonly known by the disputed domain name, and, further, Complainant has not authorized, permitted or licensed Respondent to use its trademarks in any manner. Respondent has no connection or affiliation with Complainant whatsoever."

Moreover, according to Complainant the pertinent WHOIS information identifies the registrant, which does not resemble the domain name. On this record, 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 Policy ¶ 4(c)(ii)."

"Respondent is luring consumers in search of the well-known PROVIGIL brand to a website that promotes purchasing purported substitutes for Provigil, including some with allegedly the same active pharmaceutical ingredient (API) Modafinil. The site specifically promotes, 'We have listed three modafinil pills that are very popular in US and effective too, below each description we have added links for discounts and checkout page. '[...] Such use does not demonstrate a legitimate right or interest.

Complainant argues that the disputed domain name was registered and is being used in bad faith because "[t]he trademark registration rights predate the domain name registration, and the allegations that the trademark is well-known in its field has not been rebutted [...] 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."

Complaint claims "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."

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

Based on the evidence provided by Complainant and not disputed by Respondent, it is apparent that Complainant has rights to the mark PROVIGIL. The disputed domain name is confusingly similar to the PROVIGIL trademark because it contains the PROVIGIL trademark in its entirety and because the addition of the words "online" and "power" do not serve to distinguish the disputed domain name from the trademark.

As set forth in detail above, Complainant has argued that Respondent has no rights or legitimate interests in respect of the disputed domain name. Under the Policy, “a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP” (WIPO Overview 2.0, paragraph 2.1). The Panel finds that Complainant has established its prima facie case and without any evidence from Respondent to the contrary, the Panel is satisfied that Complainant has satisfied the second element of the Policy.

As stated above, Respondent is using the disputed domain name in connection with a website that offers information about the Provigil drug along with links to purchase supposedly related products. This use of the disputed domain name is an "intentional[] attempt[ion] to attract, for commercial gain, Internet users to [Respondent's] 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 [Respondent's] web site or location or of a product or service on [Respondent's] web site or location," in violation of paragraph 4(b)(iv) of the UDRP.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PROVIGILONLINEPOWER.COM**: Transferred

PANELLISTS

Name	**Douglas M. Isenberg**

DATE OF PANEL DECISION 2016-07-18

Publish the Decision