Decision for dispute CAC-UDRP-101412

Case number	CAC-UDRP-101412
Time of filing	2017-01-23 09:05:34
Domain names	provigil-shop.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Cephalon, Inc.

Complainant representative

Organization	RiskIQ, Inc

Respondent

Organization	PrivacyGuardian.org a/k/a Zen Distribution, Worldwide Zen Distribution

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided legal proceedings which relate to the Disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of various "PROVIGIL" trademarks, including U.S. Reg. No. 2,000,231, issued September 10, 1996, covering "pharmaceutical preparations for the treatment of human sleep disorders" in International Class 5.

The Disputed domain name was registered on June 16, 2016, i.e. the Complainant’s trademark predates the registration of the Disputed domain name.

FACTUAL BACKGROUND

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

The Complainant Cephalon, Inc. (“Cephalon”) is an indirect, wholly-owned subsidiary of Teva Pharmaceutical Industries Ltd., a global pharmaceutical company. Cephalon’s "PROVIGIL" 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. 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. Buying PROVIGIL requires a prescription in the USA.

The Complainant contends that its PROVIGIL mark is well known within its specialty area. The Complainant uses its mark online in domain names. See, e.g., http://provigil.com.

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. The Respondent has no connection or affiliation with the Complainant whatsoever.

The Respondent uses the Disputed domain names for an automatic website re-direction to the address http://modafinilforbitcoin.com/. On this website the Complainant's PROVIGIL packaging and mark are prominently displayed to promote the sale of modafinil for bitcoin in the USA without a prescription.

The Complainant finally contends that the Respondent's use of a ProtonMail account behind the proxy service of PrivacyGuardian.org, together with the name of the registrant organization that cannot be found when searching through a search engine like Google, is an indicator that the Respondent is taking extraordinary measures to conceal its identity.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that 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). Apart from the descriptive suffix "shop" the Disputed domain name is identical to the Complainant’s protected brand name "PROVIGIL".

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown that the Respondent has no rights or legitimate interests in respect of the Disputed domain name (within the meaning of paragraph 4(a)(ii)of the Policy). The Disputed domain name is not being used to host any legitimate site, but merely to promote online sales of the Complainant's prescription drug without the necessary prescription.

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown that 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). By using the Disputed domain name to redirect internet users to the web site described above the Respondent intentionally attempts to attract, for commercial gain, internet users to an illegal online shop by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of this web site.

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 Panel finds that the Disputed domain name is confusingly similar to the Complainant's trademark cited above. The only difference between the Disputed domain name and the "PROVIGIL" mark is the descriptive suffix "-SHOP", which is insignificant to the overall impression.

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, nor is the Respondent making a legitimate non-commercial or fair use of the Disputed domain name, nor is the

Respondent commonly known under the Disputed domain name. This prima facie evidence was not challenged by the Respondent.

In the absence of a Response, the Panel infers that the Respondent had the Complainant's trademark in mind when registering and using the Disputed domain name as described above, which was therefore registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PROVIGIL-SHOP.COM**: Transferred

PANELLISTS

Name	**Dr. Thomas Schafft**

DATE OF PANEL DECISION 2017-03-05

Publish the Decision