Decision for dispute CAC-UDRP-106898

Case number	CAC-UDRP-106898
Time of filing	2024-09-24 12:27:59
Domain names	provigil24store.shop

Case administrator

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

Complainant

Organization	Cephalon, Inc.

Complainant representative

Organization	SILKA AB

Respondent

Name	Bill Milligan

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant owns numerous trade mark registrations worldwide for its PROVIGIL trade mark including United States trade mark registration 2000231 registered on September 10, 1996 and International trade mark registration 438439 registered on June 28 1978 and designated in various countries. The Complainant owns various domain names from which it operates websites for its PROVIGIL product including <provigil.com>.

FACTUAL BACKGROUND

The Complainant was established in 1987 as a global biopharmaceutical company dedicated to discovering, developing and bringing to market medications to improve the quality of life of individuals worldwide and in 2011 became part of the Teva Group, one of the top pharmaceutical groups in the world and which operates in 60 countries worldwide. The Complainant's PROVIGIL product is a prescription medicine indicated to improve wakefulness in adult patients with excessive sleepiness associated with narcolepsy, obstructive sleep apnoea (but not as treatment for the underlying obstruction), or shift work disorder and the Complainant has used the PROVIGIL mark in relation to this product since the 1990's.

The disputed domain name was registered in August 2024 and resolves to a website that promotes the benefits of the Complainant's PROVIGIL product and provides information about it and also features a photograph of the Complainant's product including its mark and name. The website also includes a link to enable website visitors to buy the product online. The link takes

people to the website of the "Canadian Drug Store" at <coolhealstore1.shop> which according to the Complainant is an illegal pharmacy that sells prescription medicines without requiring a prescription.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.
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.

PRINCIPAL REASONS FOR THE DECISION

The Complainant has demonstrated that it owns registered trade mark rights in its PROVIGIL mark including United States trade mark registration 2000231 registered on September 10, 1996. The disputed domain name wholly incorporates the PROVIGIL mark and is therefore confusingly similar to it. The addition after it of the numeral "24" and of the common English word "store" do not distinguish the disputed domain name or prevent a finding of confusing similarity.

The Complainant has submitted that the Respondent is not affiliated with or authorised by the Complainant in any way to make use of the PROVIGIL mark. It says that its PROVIGIL trade mark is well known in relation to prescription medicine and that the Complainant has painstakingly built up a good reputation worldwide and has invested substantial amounts of resources in promoting its product under that mark. The Complainant has also noted that the disputed domain name was registered recently and long after the registration of the PROVIGIL mark and that its mark is distinctive and not one that the Respondent would legitimately choose as a domain name without having specific rights to such a name. On this basis the Complainant maintains that it is extremely difficult to foresee any justifiable use that the Respondent may have with the disputed domain name.

The Complainant has further submitted that the Respondent has not made use of the disputed domain name in connection with a bona fide offering of goods or services as noted in paragraph 4(c)(i) of the Policy. It has asserted that disputed domain name currently resolves to a webpage that solely refers to the Complainant's pharmaceutical product and notes that the page is titled "Buy now Provigil" and provides information about the Complainant and its medicine: "Provigil (modafinil) is a wakefulness promoting agent prescribed to combat excessive sleepiness associated with conditions like narcolepsy, obstructive sleep apnoea, and shift work sleep disorder," followed by a huge 'Buy Now' button that directs visitors to another .shop site, which the Complainant suspects to be an unauthorised internet pharmacy that does not follow the laws and regulations of the various countries in which it operates. The Complainant has submitted in this regard that the .shop site is headed 'Canadian Drug Store' and features an image of a 'Canadian Maple Leaf,' which claims to be a licensed online pharmacy, but which sells prescription medicines without requiring a prescription.

The Complainant has submitted that such use neither constitutes demonstrable preparations to make a bona fide offering of goods

or services nor a legitimate non-commercial or fair use of the disputed domain name. It says that the Respondent's registration and use of the disputed domain name is a clear case of cyber-squatting with the intention of taking advantage of the Complainant's substantial reputation and goodwill in order to confuse Internet users by offering other products, diverting its business and tarnishing the reputation and goodwill of the Complainant and of its trade marks.

Past panels have held that the use of a domain name for illegal activity, here claimed to be using the disputed domain name to divert users to a website for what appears to be an illegal on-line pharmacy which dispenses the Complainant's product without any prescription, can never confer rights or legitimate interests on a respondent.

The Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The disputed domain name was registered in August 2024 many decades after the Complainant registered its trade mark for PROVIGIL. Since that time the Complainant has made extensive use of its distinctive PROVIGIL mark in relation to its pharmaceutical product in numerous countries. The fact that the disputed domain name resolves to a website that is presented as if it is affiliated with or endorsed by the Complainant and which features and describes its PROVIGIL product, strongly suggests that the Respondent was well aware of the Complainant's mark and product when it registered the disputed domain name.

The use of the disputed domain name to divert Internet users to an online pharmacy based in Canada at which they can purchase a pharmaceutical product which could otherwise only be procured by prescription in that country amounts to illegal activity. The Respondent has not attempted to respond to the Complainant's submissions in this regard and it appears to the Panel that the sale of the Complainant's PROVIGIL product in this manner without a prescription from an online site in Canada is most likely to be illegal and therefore in bad faith under the Policy.

Under paragraph 4(b)(iv) of the Policy there is evidence of registration and use of the disputed domain name in bad faith where a Respondent has used the disputed domain name to intentionally attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant’s trade marks as to the source, sponsorship, affiliation or endorsement of the website

It is apparent that the disputed domain name has been used by the Respondent to divert Internet users to its website which features the PROVIGIL mark and based on its look and feel appears as if it is affiliated with or has been endorsed by the Complainant. It then diverts Internet users through a "buy now" button to the "Canadian Drug Store" at <coolhealstore1.shop> which as noted earlier appears to offer this pharmaceutical product without requiring a prescription. This is all in circumstances that the Complainant has never authorised such use and amounts to the Respondent having used the disputed domain name to intentionally attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant’s trade marks in terms of paragraph 4(b)(iv) of the Policy. Accordingly, the Panel finds that the Respondent has registered and used the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **provigil24store.shop**: Transferred

PANELLISTS

Name	**Mr Alistair Payne**

DATE OF PANEL DECISION 2024-11-01

Publish the Decision