Decision for dispute CAC-UDRP-107023

Case number	CAC-UDRP-107023
Time of filing	2024-11-04 09:24:26
Domain names	provigilbuysafely.shop

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Cephalon, Inc.

Complainant representative

Organization	SILKA AB

Respondent

Name	Valeriy Margulis

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 is Owner of trademarks in Russia and all over the world. The Complainant is the owner of the distinctive mark PROVIGIL, the predominant part of many of the trademarks of the Complainant. The Complainant has several registrations for the word mark and label for PROVIGIL globally, including the international trademark registration number 438439 before WIPO dated June 28, 1978, that covers Russia, and EU trademark registration number 003508843 before EUIPO dated March 25, 2008.

The Complainant also provided evidence that it owns domain names containing the name “Provigil”, (e.g., see <provigil.com>, <provigil.shop>, <provigilshop.com>), well before the Respondent registered the Disputed Domain Name.

FACTUAL BACKGROUND

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

The Complainant is a pharmaceutical company based in West Chester, USA. The Complainant is active in the pharmaceutical business for many decades and is part of a bigger pharmaceutical company since 2011.

The Complainant's PROVIGIL Tablets [C-IV] contain modafinil, a Schedule IV federally controlled substances in the United States. The product name is trademark protected.

The Complainant uses domain names to promote the Provigil mark with related products and services. The Complainant enjoys a strong presence online also via its official social media platforms.

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.

The Respondent is a russian citizen, using a hidden domain holder name, who is represented by his Registry. On October 2, 2024 the Respondent registered the Disputed Domain Name. He used the Disputed Domain Name active for commercial gain.

SUMMARY OF COMPLAINANT´S CONTENTIONS

- Provigil is a well-known, distinctive trademark worldwide.
- The Complainant's trademarks registration predates the registration of the Disputed Domain Name.
- The Respondent has no rights in the mark Provigil, bears no relationship to the Complainant, and is not commonly known by the Disputed Domain Name - accordingly it has no legitimate interest in the Disputed Domain Name.
- It is highly unlikely that the Respondent was not aware of Complainant's prior rights in the trademark Provigil at the time of registering the Disputed Domain Name, given the Complainant's worldwide renown.
- The Respondent has directed the Disputed Domain Name to a commercial homepage.
- The Respondent failed in responding to cease-and-desist letter sent by the Complainant.
- The Respondent has been using privacy shield to conceal its identity.

Consequently, the Respondent should be considered to have registered the Disputed Domain Name confusingly similar to the Complainant's well-known, distinctive trademark Provigil. Especially the generic term "buy" and "safely" in the Disputed Domain Name makes obvious that the Respondent was aware what he has done. The Complainant has not found that the Respondent is of any legitimate right or interest in using the Disputed Domain Name, but rather registered and has been using the Disputed Domain Name in bad faith.

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

It is necessary for the Complainant, if it is to succeed in this administrative proceeding, to prove each of the three elements referred

to in paragraph 4(a) of the Policy, namely that:

(A) the disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights; and

(B) the Respondent has no rights or legitimate interest in respect of the disputed domain name; and

(C) the disputed domain name has been registered and is being used in bad faith.

(A)

The Panel finds that the Disputed Domain Name <Provigilbuysafely.shop> is confusingly similar to the trademarks of the Complainant. The Disputed Domain Name, which was registered on October 2, 2024 (according to the Registrar Verification), incorporates entirely the Complainant's well-known, registered trademark Provigil with generic indications "buy" and "safely" and the generic Top level domain .shop. The Disputed Domain Name in its structure directly refers to the Complainant, its trademark and business. Moreover, previous UDRP panels have stated that the Provigil trademark is well-known, especially for the pharmaceutical business. They have recognized that incorporating a trademark in its entirety is normally sufficient to establish that the disputed domain names are at least confusingly similar to a registered trademark, see WIPO Overview 3.0, section 1.7 and also see AFS Wealth Management and Insurance Advisers Limited v. Gemini, WIPO Case No. DEU2022-0007.

The addition of the gTLD ".shop" does not add any distinctiveness to the Disputed Domain Name. See as an example the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), paragraph 1.11. as well as the International Business Machines Corporation v. Sledge, Inc. / Frank Sledge WIPO Case No. D2014-0581 where the panel stated the following: "In addition, it is generally accepted that the addition of the top-level suffix in the domain name is to be disregarded under the confusing similarity test". The same reasoning should apply in the current case. The first element of the Policy is, therefore, to satisfaction of the Panel fulfilled.

(B)

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. The Complainant has not granted the Respondent any right to use the Provigil trademarks within the Disputed Domain Name, nor is the Respondent affiliated to the Complainant.

Moreover, the Complainant contends and provides evidence that the Respondent has not developed a legitimate use in respect of the Disputed Domain Name. The Complainant contends that the Respondent was seeking to use the Disputed Domain Name only to divert consumers to its own business and that the Respondent has no legitimate interests in respect of the Disputed Domain Name.

In detail: The Complainant and the Respondent have never had any previous relationships, nor has the Complainant ever granted the Respondent with any rights to use the Provigil trademarks in any forms, including the Disputed Domain Name. Until very recently, it has indeed resolved to a page indicating that soon there will be a website associated to the Disputed Domain Name.

The Respondent could have easily performed a similar search before registering the Disputed Domain Name and would have quickly learnt that the trademarks are owned by the Complainant and that the Complainant has been using its trademarks where the Respondent resides, and many other countries worldwide. However, the Respondent still chose to register the Disputed Domain Name as such.

In addition, according to the Registrar Verification, the Respondent's name is not related to the Complainant nor to the term "Provigil" in any way. The Respondent has not been using the Disputed Domain Name for any bona fide offering of goods or services. The Complainant submits that the Respondent lacks rights or legitimate interests in the Disputed Domain Name, see Cephalon, Inc. v. Polina Griffin, CAC Case No. CACUDRP-101175.

When Internet users, who search for information about the Complainant and/or about the brand "Provigil", see the Disputed Domain Name and the pharmacy website, would very likely be confused and be led to believe that the Disputed Domain Name is somehow related to the Complainant and be misled.

The Respondent had no legitimate right to incorporate the Complainant's mark PROVIGIL within the Disputed Domain Name, that incorporates the Complainant's registered mark PROVIGIL along with descriptive words 'buy safely'. The Disputed Domain Name has been contrived for the express purpose of exploiting the goodwill of the Complainant and to mislead the public. The Respondent's Disputed Domain Name is phonetically, visually and conceptually similar to that of the Complainant's mark and in such a nature, which would likely lead the public to believe that the Respondent and the Disputed Domain Name is sponsored by or affiliated to the Complainant, see Cephalon, Inc. v. SRC Domain Service, CAC Case No 101171.

In lack of any Response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and has not been using the Disputed Domain Name for any bona fide offering of goods or services.

(C)

1. THE DISPUTED DOMAIN NAME WAS REGISTERED IN BAD FAITH

The Complainant also referred to the distinctiveness and reputation of its Provigil trademarks. This makes it highly unlikely that the Respondent had no knowledge of the Complainant's prior trademark rights at the time of registration of the Disputed Domain Name. Especially the generic term “buy” as a part of the Disputed Domain Name makes obvious that the Respondent was aware what the combination of the word with Provigil will mean. The Complainant rightfully contended that the Respondent has used the Disputed Domain Name intentionally to attract visitors for commercial gain by creating confusion with the Complainant’s trademarks, and that the Respondent has used the Disputed Domain Name with that intention, namely in bad faith. See e.g., Accor v. Shangheo Heo / Contact Privacy Inc., WIPO Case No. D2014-1471 where the Panel stated that: “The unopposed allegation of phishing, and the evidence submitted in support of phishing, combined with the likelihood of confusion, is sufficient evidence of bad faith. …It seems likely, as Complainant alleges, that Respondent intentionally attempted to deceive consumers into providing personal and financial information, believing that Respondent was associated with the bona fide services offered by Complainant.”

Reference is made also to: CAC case N° 101036, Boehringer Ingelheim Pharma GmbH & Co. KG vs. SKYRXSHOP - dulcolax.xyz and WIPO Case no. D2014-0306 Boehringer Ingelheim Pharma GmbH & Co. KG v. Klinik Sari Padma, BAKTI HUSADA.

It should be highlighted that the Complainant’s trademark registrations predate the registration of the Disputed Domain Name and the Respondent has never been authorized by the Complainant to register the Disputed Domain Name. Considering the renown of the Complainant and its trademark Provigil, and the overall composition of the Disputed Domain Name, i.e. incorporates the Complainant’s well-known, distinctive trademark Provigil in its entirety along with the terms “buy” and “safely”, which are closely related to the Complainant and its business activities, it follows that incorporating the well-known trademark Provigil in the Disputed Domain Name is a deliberate and calculated attempt to improperly benefit from the Complainant’s rights and reputation.

In detail considering the facts that:

- The Respondent very likely knew about the Complainant and its trademark;
- The Complainant’s trademark Provigil is a distinctive, well-known trademark worldwide and in Indonesia where the Respondent resides;
- The Respondent has failed in presenting a credible evidence-backed rationale for registering the Disputed Domain Name,

the Disputed Domain Name shall be deemed as registered in bad faith, which is supported by WIPO Overview 3.0, para. 3.1.1.: “If on the other hand circumstances indicate that the respondent’s intent in registering the disputed domain name was in fact to profit in some fashion from or otherwise exploit the complainant’s trademark, panels will find bad faith on the part of the respondent. While panel assessment remains fact-specific, generally speaking such circumstances, alone or together, include: (i) the respondent’s likely knowledge of the complainant’s rights, (ii) the distinctiveness of the complainant’s mark, … (vii) failure of a respondent to present a credible evidence-backed rationale for registering the domain name, …”

and para.3.1.4: “Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.”

2. THE DISPUTED DOMAIN NAME IS BEING USED IN BAD FAITH

Firstly, as noted in the previous paragraphs, the registration of a domain name that is confusingly similar to another’s mark, despite actual or even constructive knowledge of the mark holder’s rights, constitutes bad faith registration and use, pursuant to Policy 4(a)(iii). See Cephalon, Inc. v. Sandeep Ghume, CAC Case No. CAC-UDRP-101228 (provigilstore.com):

“Since the Respondent registered the domain name to use the Complainant’s trademark on his website, it is obvious that he knew the Complainant’s trademark when he registered the disputed domain name.”

Additionally, the Complainant tried to reach the Respondent by a cease-and-desist letter the Registrar as the Respondent’s contact details were under privacy shield in the publicly available WHOIS. However, until the time the Complainant prepared this Complaint, it has not received response from the Respondent.

In terms of paragraph 4(b)(iv) of the Policy, the above facts demonstrate the Respondent’s use of the Disputed Domain Name in bad faith. Registration of a well-known trademark by a party with no connection to the owner of the trademark and no authorization and no legitimate purpose to utilize the mark reveals bad faith, see: The Caravan Club v. Mrgsale, Forum FA95314.

Indeed, it is evidence of bad faith registration and use in terms of Clause 4 (b)(iv) of UDRP:

“by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website 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 your web site or location or of a product or service on your web site or location.” See: Cephalon, Inc. v. Lucia Nidi, CAC Case No. CAC-UDRP-101227 (buyprovigil.org).

Furthermore, the Respondent was using a hidden identity. But this argument is not to be discussed further because bad faith is evident, whatsoever.

Accordingly, the Panel finds that the Disputed Domain Name was both registered and used in bad faith and that the Complaint succeeds under the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **provigilbuysafely.shop**: Transferred

PANELLISTS

Name	**Harald von Herget**

DATE OF PANEL DECISION 2024-12-16

Publish the Decision