

ADMINISTRATIVE PANEL DECISION

Cephalon Inc. v. Gurin Evgenui
Case No. D2023-2231

1. The Parties

The Complainant is Cephalon Inc., United States of America, represented by SILKA AB, Sweden.

The Respondent is Gurin Evgenui, Ukraine.

2. The Domain Name and Registrar

The disputed domain name <comprar-provigil.com> is registered with Gransy, s.r.o. d/b/a subreg.cz (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 23, 2023. On May 24, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 25, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Domain Admin Whois protection, this company does not own this domain name s.r.o.) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 2, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on June 7, 2023.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on June 7, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 27, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 11, 2023.

The Center appointed Fabrizio Bedarida as the sole panelist in this matter on July 16, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of

Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a biopharmaceutical company established in 1987 in the United States. In October 2011, it was acquired by TEVA Pharmaceuticals and is now a wholly-owned subsidiary. The Complainant's Provigil trademark is the name of a prescription medicine and contains modafinil, a Schedule IV federally-controlled substance in the United States.

The Complainant has several registrations for the PROVIGIL trademark around the world.

The Complainant is, *inter alia*, the owner of:

- United States trademark PROVIGIL (word), registration number 2000231, registered on September 10, 1996;
- European Union Trade Mark PROVIGIL (word), registration number 003508843, registered on March 25, 2008.

In addition, the Complainant holds, *inter alia*, the following domain names: <provigil.com> registered on May 4, 1998, <provigil.net> registered on June 9, 1998, <provigil.org> registered on June 9, 1998, <provigil.info> registered on December 31, 2012.

The disputed domain name was registered on March 1, 2021.

The disputed domain name hosts a website in Spanish with the title: "Comprar Provigil Genérico online", *i.e.*, "Buy Generic Provigil online", and provides a "Comprar Ahora" (Buy Now) button, which links to the inactive website of a purported online pharmacy. The website at the disputed domain name also contains information about the Complainant's Provigil product under section headings, such as:

- What is Provigil?
- Other indications for use
- How should I take Provigil?
- Can I take Modafinil every day?
- Where can I buy Provigil without a prescription in Spain?
- How much does Provigil cost in Spanish pharmacies?
- What are the main differences between Provigil and Adderall

5. Parties' Contentions

A. Complainant

The Complainant claims that:

(a) the disputed domain name is confusingly similar to the Complainant's trademark; (b) the Respondent lacks any rights or legitimate interests in the disputed domain name; and (c) the Respondent has registered and is using the disputed domain name in bad faith.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Under paragraph 10 of the Rules, the Panel is required to ensure that the Parties are treated with equality, that each Party is given a fair opportunity to present its case and that the administrative proceeding takes place with due expedition.

Since the Respondent's country is stated to be in Ukraine, which is subject to an international conflict at the date of this Decision, it is appropriate for the Panel to consider, in accordance with its discretion under paragraph 10 of the Rules, whether the proceeding should continue.

The Panel notes that the Complaint and the amendment to the Complaint were successfully delivered to the Respondent's email address, as provided by the Registrar. The Panel also notes that the Notification of Complaint has been successfully delivered to the privacy service.

The Panel further notes that the disputed domain name resolves to a website in Spanish to buy generic Provigil in Spain. The Panel also notes that the Complainant has specified in the Complaint that any challenge made by the Respondent to any decision to transfer the disputed domain name shall be referred to the jurisdiction of the courts of the location of the principal office of the concerned registrar. In this case, the Registrar is in the Czech Republic.

The Panel concludes that the Parties have been given a fair opportunity to present their case and will proceed to a Decision accordingly.

In order for the Complainant to obtain a transfer of the disputed domain name, paragraphs 4(a)(i) – (iii) of the Policy require that the Complainant must demonstrate to the Panel that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has established rights in the PROVIGIL trademark.

The disputed domain name contains the Complainant's PROVIGIL trademark with the addition of the term "comprar" (*i.e.* "buy" in Spanish) and the generic Top-Level Domain ("gTLD") ".com". The addition in the disputed domain name of the term "comprar" does not prevent the PROVIGIL trademark from being recognizable in the disputed domain name.

Pursuant to section 1.8 of the Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)) which states: "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements."

Therefore, the Panel finds the disputed domain name to be confusingly similar to the PROVIGIL trademark in which the Complainant has rights.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

This Panel finds that the Complainant has made a *prima facie* case that the Respondent does not have rights or legitimate interests in the disputed domain name. The Respondent has no connection or affiliation with the Complainant, and the Complainant has not licensed or otherwise authorized the Respondent to use or register any domain name incorporating the Complainant's trademark. The Respondent does not appear to engage in any legitimate noncommercial or fair use of the disputed domain name, nor any use in connection with a *bona fide* offering of goods or services.

Indeed, it appears that the Respondent has attempted to usurp the Complainant's goodwill in the trademark, in an attempt to confuse and deceive Internet users into doing business with the Respondent. In fact, the disputed domain name resolves to a website where purported Provigil goods and detailed information about Provigil are displayed, thus reinforcing the (false) association between the Complainant's trademark and the disputed domain name. In addition, the Respondent does not appear to be commonly known by the disputed domain name or by a similar name. Moreover, the Respondent has not replied to the Complainant's contentions, claiming any rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Based on the evidence put forward by the Complainant, the Panel is of the opinion that the Respondent was aware of the Complainant's trademark registrations and rights to the PROVIGIL mark when it registered the disputed domain name.

The Complainant's PROVIGIL trademark has been registered and used for many years.

The disputed domain name is used for a website where the content displayed shows the Complainant's trademark and logo as well as purported PROVIGIL-branded goods.

Consequently it is clear that the Respondent registered the disputed domain name while aware of the Complainant's trademark and activity, and did so with the intention to attract, for commercial gain, Internet users to its own website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of either the Respondent and/or its website, so as to trick those users into doing business with the Respondent. This constitutes bad faith registration and use as well as a disruption of the Complainant's business under the Policy.

Inference of bad faith can also be found in the failure to respond to the Complainant's contentions, and the Respondent's lack of any rights or legitimate interests in the disputed domain name.

Another factor supporting the conclusion of bad faith registration and use of the disputed domain name, based on the documents filed by the Complainant, can be seen in the fact that the Respondent registered the disputed domain name with a privacy shield service to hide the registrant's identity.

Accordingly, the Panel finds, on the basis of the evidence presented, that the Respondent registered and is using the disputed domain name in bad faith.

Therefore, the Complainant has satisfied paragraph 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <comprar-provigil.com> be transferred to the Complainant.

/Fabrizio Bedarida/

Fabrizio Bedarida

Sole Panelist

Date: July 23, 2023