

ADMINISTRATIVE PANEL DECISION

Cephalon Inc v. Hulmiho Ukolen, Poste restante
Case No. D2023-4400

1. The Parties

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

The Respondent is Hulmiho Ukolen, Poste restante, Finland.

2. The Domain Name and Registrar

The disputed domain name <energyofprovigil.net> 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 October 24, 2023. On the same date, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 25, 2023, the Registrar transmitted by email to the Center its verification response disclosing the 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 October 25, 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 October 26, 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 November 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 22, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 29, 2023.

The Center appointed Iris Quadrio as the sole panelist in this matter on December 8, 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 and acquired by Teva Pharmaceutical Industries in 2011.

Teva Pharmaceutical Industries is an international pharmaceutical leading company - operating since 1901 - with a portfolio of 3,600 different products reaching 200 million people across 60 countries and six continents every day.

The Complainant's PROVIGIL trademark is the name of a prescription medicine containing modafinil, a federally controlled substance in the United States. Provigil is used to treat sleepiness in adult patients suffering from narcolepsy, shift work sleep disorder, among other things.

The Complainant is the owner of the trademark PROVIGIL in many jurisdictions, including international registration No. 438439 registered on June 28, 1978, for class 5; United States Patent and Trademark Office ("USPTO") registration No. 2000231 registered on September 10, 1996, for class 5; and European Union Intellectual Property Office ("EUIPO") registration No. 003508843 registered on March 25, 2008, for class 5.

The Complainant claims to own an important domain name portfolio, including, among others, its primary website at the domain name <provigil.com> registered since May 4, 1998.

Finally, the disputed domain name was registered on September 19, 2023, and resolves to a webpage containing pay-per-click links ("PPC") to pages that seem to be potential competitors of the Complainant's business.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant claims that the disputed domain name is confusingly similar to its trademark PROVIGIL on which the Complainant has prior rights.

The Complainant contends that the Respondent has no rights or legitimate interest in respect of the disputed domain name, nor is the Respondent related in any way to the Complainant. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademark PROVIGIL or apply for registration of the disputed domain name.

More specifically, the Complainant alleged that the Respondent has not used and/or has no demonstrable intention to use the disputed domain name except to create a likelihood of confusion with the Complainant's trademark. In fact, the Complainant claims that the Respondent has selected the disputed domain name only to intentionally lead Internet users to believe they are accessing the Complainant's website.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the disputed domain name, the Complainant must prove each of the following, namely that:

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

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, "energy" and "of", may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Moreover, the ".net" generic Top-Level Domain ("gTLD") is viewed as a standard registration requirement and is generally disregarded under the first element of the confusing similarity test, as set forth in section 1.11.1 of [WIPO Overview 3.0](#).

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, 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 Complainant has claimed not to have authorized, licensed, or permitted the Respondent to register or use the disputed domain name or to use the trademark PROVIGIL nor is there any other evidence in the file suggesting that the Respondent has or could have rights or legitimate interests in the disputed domain name.

Even more, it does not seem that the Respondent made nor is making a legitimate noncommercial or fair use of the disputed domain name. In this regard, the Complainant demonstrated that the disputed domain name is parked with PPC links that redirect users to websites that seem to be potential competitors of the Complainant's business. It is clear that the Respondent's intention is to generate confusion among consumers as to the origin of the website, who may believe that the disputed domain name is related to the Complainant.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In such connection, the Complainant has submitted evidence to support that the trademark PROVIGIL is widely known and was registered and used many years before the Respondent registered the disputed domain name. When registering the disputed domain name, the Respondent has targeted the Complainant's trademark PROVIGIL to generate confusion among the Internet users and benefit from the Complainant's reputation under paragraph 4(b)(iv) of the Policy. Indeed, the Complainant has demonstrated that when searching for "PROVIGIL" or "energyofprovigil" on Google, all the results led to the Complainant.

Therefore, the Panel is satisfied that the Respondent must have been aware of the Complainant and the Complainant's trademark PROVIGIL when it registered the disputed domain name.

Consequently, and in accordance with section 3.1.4 of [WIPO Overview 3.0](#), the Panel considers that the inclusion of the Complainant's PROVIGIL trademark in the disputed domain name creates a presumption that the disputed domain name was registered in bad faith.

Furthermore, the disputed domain name resolves to a PPC parking page with various links. The Panel finds therefore that the Respondent's use of the disputed domain name incorporating the Complainant's distinctive and well-known PROVIGIL trademark is intended to attract and mislead Internet users when searching for the Complainant's website and to redirect them to the links related to the Complainant's potential competitors from which the Respondent most probably derives commercial revenue.

Even more, the Respondent has been involved in 103 previous UDRP proceedings from which 102 were granted relief and the domain names were transferred to the trademark owner. This confirms that the Respondent has already engaged in similar illicit behavior in the past.

Based on the available record, the Panel finds the third element of the Policy has been established.

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 <energyofprovigil.net> be transferred to the Complainant.

/Iris Quadrio/

Iris Quadrio

Sole Panelist

Date: December 22, 2023