Decision for dispute CAC-UDRP-101652

Case number	CAC-UDRP-101652
Time of filing	2017-08-15 09:43:40
Domain names	NOVARTIS.SHOP

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BrandIT GmbH

Respondent

Organization	Yu Ke Rong

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings related to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the registered holder of the following International trade mark registrations:

NOVARTIS, registered no. 666218 in classes 41; 42, which was registered on 31.10.1996;
NOVARTIS, registered no.663765 in classes: 01; 02; 03; 04; 05; 07; 08; 09; 10; 14; 16; 17; 20; 22; 28; 29; 30; 31; 32; 40; 42, which was registered on 01.07.1996;
NOVARTIS, registered no. 1155214 including classes 41; 42, which was registered on 24.01.2013.

FACTUAL BACKGROUND

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

The Complaint is a global healthcare company based in Switzerland. It is the owner of registered trade marks for NOVARTIS.

The Complainant has registered a number of domain names including <novartis.com> (registered April 02, 1996), <novartis.net> (registered April 25, 1998), <novartis.com.cn> (registered August 20, 1999), and <novartis-bio.com> (registered June 30, 2016). The Complainant uses these domain names to connect to a website through which it informs

potential customers about its NOVARTIS mark and its products and services.

The disputed domain name <novartis.shop> was registered on 26 April 2017.

PARTIES CONTENTIONS

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

Under Paragraph 11(a) of the Rules, the language of the administrative proceeding shall be the language of the Registration Agreement, but the Panel may allow the proceeding to be conducted in another language, having regard to the circumstances of the case.

The language of the registration agreement for the disputed domain name is Chinese. The Complaint has been filed in English and the Complainant has requested the proceedings to be in English.

The Complainant submits that:

1. Although Respondent replied in Chinese to the cease and desist letter, he did not reply that he did not understand the content of the letter, but instead asked in Chinese the way to transfer the domain name.
2. The disputed domain name includes the Complainant’s mark NOVARTIS. Complainant is a global company whose business language is English.
3. Respondent has registered many other domains with words in English. It is unlikely that Respondent is not at least familiar with the English language.
4. Respondent has chosen to register the disputed domain name under the top level domain (TLD) “.shop”, which is applicable to a broader audience than merely China. The term “shop” is related to the Complainant’s area of commercial activity. As a major pharmaceutical brand it is likely that consumers would search for NOVARTIS products on the TLD “.shop”. A more suitable TLD if only addressing the Chinese market would be the ".cn" extension.
5. The proceeding will likely be put through unnecessary trouble and delay if Chinese were made the language of the proceeding and there would be no discernible benefit to the parties or the proceeding, in the circumstances, that may be gained by maintaining the default language.

The Respondent has not responded to the Complainant's submissions.

The Panel accepts that although the registration agreement is in Chinese, the Respondent appears to understand English. The Respondent has chosen to register the Complainant's trade mark NOVARTIS under the TLD ".shop". The disputed domain name is not in Chinese characters but in Latin script. The Respondent has registered other domain names with words in English. The Respondent has responded to the Complainant's cease and desist letter and the offer to sell the disputed domain name is expressed in US dollars. Further, the offer to sell the disputed domain name on SEDO.COM is in the English language.

The proceeding will likely be put through unnecessary trouble and delay if Chinese were made the language of the proceeding. The Panel finds that the proceedings should be conducted in English. In reaching this decision the Panel has also considered the decisions in Lovehoney Group Limited v Li Wei Wei (CAC Case No. 101557) and Orlane S.A. v Yu Zhou He/ HeYu Zhou (WIPO Case No D2016-1763).

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

Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements:

(i) The disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complaint has rights.
(ii) The Respondent has no rights or legitimate interests in the disputed domain name.
(iii) The disputed domain name has been registered and used in bad faith.

(i) Identical or confusingly similar
The Panel is satisfied that the Complainant is the owner of International trade mark registrations for NOVARTIS that predate the registration of the disputed domain name.

The disputed domain name is comprised of the Complainant's well-known trade mark NOVARTIS, plus the TLD ".shop". The most distinctive part of the disputed domain name is the Complainant's mark, NOVARTIS. The addition of the TLD ".shop" does not prevent the disputed domain name being confusingly similar to the Complainant's trade mark NOVARTIS.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trade mark NOVARTIS, and that the requirements of paragraph 4(a)i of the Policy have been met.

(ii) No rights or legitimate interest in the disputed domain name
The Complainant asserts that the Respondent has no rights or interests in the disputed domain name. The Complainant says that:
1. The Respondent is not commonly known by disputed domain name.
2. The disputed domain name is not active and there is nothing to indicate that the disputed domain name has, or will be used, or that there are preparations to use it, in connection with a bona fide offering of goods or services. The Respondent has made no claims to have any relevant prior rights of its own, or to have made legitimate, non-commercial use of the disputed domain name.
3. The Complainant is identified as associated with the term NOVARTIS and has not authorised the Respondent to use its trade mark.
4. The intention of the Respondent in registering the disputed domain name is to take advantage of an association with the business of Complainant.

The Panel finds that the Complainant has established a prima facie case that the Respondent lacks rights or a legitimate interest in the disputed domain name. The Respondent has not filed a Response, nor contested any of the Complainant's submissions, nor provided any evidence of any rights or legitimate interests in the disputed domain name. There is nothing to indicate that he Respondent has any relevant rights itself. The Respondent is not commonly known by the disputed domain name and has not been authorised by the Complainant to use the name NOVARTIS.

Panel finds that the Respondent does not have any rights or legitimate interest in the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

(iii) The disputed domain name has been registered and is being used in bad faith
The Complainant asserts that:

1. The Respondent is not authorised to register the disputed domain name and it is inconceivable that registering the unique combination of the well-known mark NOVARTIS in the disputed domain name along with the TLD suffix “shop” is not a deliberate and calculated attempt to improperly benefit from the Complainant’s rights.
2. The Respondent has registered approx. 98 domain names including well-known brands such as <american-express.info>, <americaneagleoutfitters.site> and <calvin-klein.club>. Such pattern of abusive conduct constitutes evidence of bad faith according to Paragraph (6) (ii) of the Policy.
3. The trade mark NOVARTIS is a well-known mark worldwide, including in China where the Respondent is located, and there is no way in which the disputed domain name could be used legitimately by the Respondent.
4. Inference of bad faith registration and use of the disputed domain name is also given by the fact that the Respondent replied to the Complainant’s cease and desist letter requesting a high price for the disputed domain name.
5. Further, the disputed domain name was listed for sale at SEDO.COM with a minimal offer of 90 USD.

The Complainant’s well-known registered trade mark NOVARTIS predates the registration of the disputed domain name. The Panel finds that there appears no reason why the Respondent would register the Complainant's well-known mark as part of the disputed domain name, other than to create the impression that it is connected to the Complainant's business. The offer to sell the domain name at a price that exceeds out-of- pocket expenses, and the pattern of registering other well-known bands as domain names also indicates bad faith.

The Panel finds that the disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(a) (iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTIS.SHOP**: Transferred

PANELLISTS

Name	**Mrs Veronica Bailey**

DATE OF PANEL DECISION 2017-09-19

Publish the Decision