Decision for dispute CAC-UDRP-101736

Case number	**CAC-UDRP-101736**
Time of filing	**2017-10-17 10:44:17**
Domain names	**Novartis.bio**

Case administrator

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

Complainant

Organization	**Novartis AG**

Complainant representative

Organization	**BrandIT GmbH**

Respondent

Organization	**Sam Tetlow / 1970**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings.

IDENTIFICATION OF RIGHTS

The Complainant is the holder of trademark rights for the word mark NOVARTIS, registered in numerous jurisdictions (e.g. international registration No. 666218 since October 31, 1996 in Classes 41 and 42), including the USA (Reg. No. 4986124 since June 28, 2016 in Classes 5, 9, 10, 41, 42, 44).

FACTUAL BACKGROUND

Novartis AG (hereinafter referred to as Complainant) is the owner of the NOVARTIS trademarks. Novartis is a global healthcare company based in Switzerland that provides solutions to address the evolving needs of patients worldwide. Novartis manufactures drugs such as clozapine (Clozaril), diclofenac (Voltaren), carbamazepine (Tegretol), valsartan (Diovan) and many others.

The Complainant is the owner of the registered trademark NOVARTIS as a word and figurative mark in several classes in numerous countries all over the world including the USA.

The disputed domain name <novartis.bio> has been registered on September 12, 2017. The disputed domain name refers to a parking page.

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

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 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

The onus is on the Complainant to make out its case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainant must show that all three elements set out in Paragraph 4 (a) of the Policy have been established before any order can be made to transfer a domain name. As the proceedings are civil, the standard of proof is the balance of probabilities.

Thus for the Complainant to succeed it must prove, within the meaning of Paragraph 4(a) of the Policy and on the balance of probabilities that:

1. The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

2. The Respondent has no rights or legitimate interests in respect of the domain name; and

3. The domain name has been registered and is being used in bad faith.

The Panel has therefore dealt with each of these requirements in turn.

1. Confusing similarity of the disputed domain name with existing rights

The Complainant must first establish that there is a trademark or service mark in which it has rights. The Complainant provides evidence, that it is the holder of the registered NOVARTIS trademark.

The disputed domain name <novartis.bio> reproduces Complainant’s trademark NOVARTIS in its entirety, merely adding the suffix “.bio”. It is well established that a generic top level suffix may be disregarded when considering whether the disputed domain name is identical or confusingly similar to the trade mark in which the Complainant has rights. When disregarding the “.bio” suffix, the disputed domain name is identical to the Complainant’s trademark.

Accordingly, the Complainant has made out the first of the three elements that it must establish.

2. No legitimate rights

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that Respondent has no rights or legitimate interests in respect of the disputed domain names.

It is established case law that it is sufficient for the Complainant to make a prima facie showing that Respondent has no right or legitimate interest in the disputed domain name in order to shift the burden of proof to the Respondent. (See: Champion Innovations, Ltd. V. Udo Dussling (45FHH), WIPO case No. D2005-1094 (championinnovation.com); Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO case No. D2003-0455 (croatiaairlines.com); Belupo d.d. v. WACHEM d.o.o., WIPO case No. 2004-0110 (belupo.com).)

The Panel notes that the Respondent has not been commonly known by the disputed domain name and that the Respondent has not acquired trademark or service mark rights. Respondent's use and registration of the disputed domain name was not authorized by the Complainant. There are no indications that a connection between Complainant and Respondent existed.

Based on the available record, the Panel finds that the Complainant has established a prima facie case, which was not refuted, and that the Respondent lacks rights or legitimate interests in the disputed domain name. Therefore, the Complainant has satisfied the second requirement that the Respondent has no rights or legitimate interests in the disputed domain name, under paragraph 4(a)(ii) of the Policy.

3. Bad faith

The Complainant must prove on the balance of probabilities that the disputed domain name was registered in bad faith and that it is being used in bad faith (See e.g. Telstra Corporation Limited v. Nuclear Marshmallow, WIPO Case No. D2000-0003; Control Techniques Limited v. Lektronix Ltd, WIPO Case No. D2006 1052).

According to the Panel, the awareness of the Respondent of the Complainant and/or the Complainant's trademark rights at the time of registration can evidence bad faith (See Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz, WIPO Case No. D2011-2209; Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite, WIPO Case No. D2001-1070, where POKÉMON was held to be a well-known mark of which the use by someone without any connection or legal relationship with the complainant suggested opportunistic bad faith). In the instant case, the Panel finds that Respondent must have had knowledge of Complainant's rights in the NOVARTIS trademark at the moment it registered the disputed domain name, since Complainant's trademark is a widely known trademark.

The Respondent is not using the disputed domain name. According to the Panel, the passive holding of the disputed domain name may amount to bad faith when it is difficult to imagine any plausible future active use of the disputed domain name by Respondent that would be legitimate and not infringing Complainant's well-known mark or unfair competition and consumer protection legislation (See Inter-IKEA v Polanski, WIPO Case No. D2000 1614; Inter-IKEA Systems B.V. v. Hoon Huh, WIPO Case No. D2000 0438; Telstra Corporation Limited v. Nuclear Marshmallows, supra). The fact that a Complainant's trademark has a strong reputation and is widely used and the absence of evidence whatsoever of any actual or contemplated good faith use are further circumstances that may evidence bad faith registration and use in the event of passive use of domain names (Telstra Corporation Limited v. Nuclear Marshmallows, supra).

In the present case, the Panel is of the opinion that Complainant's NOVARTIS trademark is widely known, which makes it difficult to conceive any plausible legitimate future use of the disputed domain name by the Respondent.

The Panel also notes that the Respondent did not respond to Complainant's cease and desist letters. Therefore, the Panel considers that the inference of bad faith is strengthened.

Considering the above, the Panel finds that the Complainant has made out the three elements that it must establish.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTIS.BIO**: Transferred

PANELLISTS

Name	**Flip Petillion**

DATE OF PANEL DECISION 2017-11-13

Publish the Decision