Decision for dispute CAC-UDRP-101726

Case number	CAC-UDRP-101726
Time of filing	2017-10-10 08:53:41
Domain names	novartislife.org

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BrandIT GmbH

Respondent

Name	Katherine John

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that are pending or decided and that relate to the Disputed Domain Name.

IDENTIFICATION OF RIGHTS

Complainant states, and provides evidence to support, that it "is the owner of the registered well-known trademark NOVARTIS as a word and figure mark in several classes in numerous of countries all over the world including in USA," U.S. Reg. No. 4986124 for use in connection with, inter alia, "[p]harmaceutical preparations for use in oncology" (first used in commerce 1996, registered June 28, 2016) and International Reg. No. 666,218 (registered October 31, 1996).

FACTUAL BACKGROUND

Complainant states, in relevant part, as follows:

Complainant "is a global healthcare company based in Switzerland that... manufactures drugs such as clozapine (Clozaril), diclofenac (Voltaren), carbamazepine (Tegretol), valsartan (Diovan) and many others."

"Complainant products are available in more than 180 countries and they reached nearly 1 billion people globally in 2015. About 123 000 people of 144 nationalities work at Novartis around the world."

Complainant's NOVARTIS trademark registrations (see above) "predate the registration of the Disputed Domain Name [on August 13, 2017]. Due to extensive use, advertising and revenue associated with its trademarks worldwide, Complainant enjoys a high degree of renown around the world, including in USA, where the Respondent is located. Complainant has previously successfully challenged several NOVARTIS domain names through UDRP processes see among others the following WIPO cases: D2016-1688; D2016-0552; D2015-1989; D2015-1250 & CAC cases: 101654, 101652 & 101653."

The Disputed Domain Name "directly and entirely incorporates Complainant’s well-known, registered trademark NOVARTIS along with the word 'life'. As Complainant is one of the world’s leading global pharmaceutical businesses, the term 'life' is very closely associated with Complainants business and profile. The addition of the generic Top-Level Domain (gTLD) '.org' does not add any distinctiveness to the Domain Name. These references exaggerate the impression that Respondent is somehow affiliated with Complainant, and Respondent is somehow doing business in the USA using Complainant`s trademark."

"Complainant has not found that Respondent is commonly known by the Domain Name or that it has interest over the Domain Name or the major part of it.... Respondent has not by virtue of the content of the website, nor by its use of the Domain Name shown that they will be used in connection with a bona fide offering of goods or services. It is clear that Complainant has become a distinctive identifier associated with the term NOVARTIS and that the intention of the Domain Name is to take advantage of an association with the Complainant’s business."

"At the time of the filing of this Complaint, the Domain Name does not resolve to an active website... The Respondent has made no claims to neither having any relevant prior rights of its own, or to having become commonly known by the Domain Name. Clearly, the Respondent is not known by the Domain Name, nor does the Respondent claim to have made legitimate, non-commercial use of the Domain Name. Moreover, Complainant had never authorized the Respondent to use its trademark in any form."

"Respondent has been granted several opportunities to present some compelling arguments that it has rights in the Domain Name but has failed to do so. This behavior coupled with the use of the Domain Name cannot be considered as legitimate use of the Domain Name."

"It is inconceivable that the unique combination 'Novartis' and 'life' in the Domain Name is not a deliberate and calculated attempt to improperly benefit from the Complainant’s rights."

"Complainant tried to contact Respondent on September 19, 2017 through a cease and desist letter. The letter was sent to the email address listed in the whois record and to the email address listed on the website associated with the Domain Name. In the cease and desist letter, Complainant advised Respondent that the unauthorized use of its trademarks within the Domain Name violated their trademark rights and Complainant requested a voluntary transfer of the Domain Name... The letter was sent to the email address listed in the Who is record. A reminder was sent on September 26, 2017 and again on October 02, 2017. Despite several reminders from Complainant concerning the use of the Domain Name, the Respondent has simply disregarded such communication. Since the efforts of trying to solve the matter amicably were unsuccessful, Complainant chose to file a complaint according to the UDRP process. It has been mentioned in earlier cases that the failure of a respondent to respond to a cease and desist letter, or a similar attempt at contact, has been considered relevant in a finding of bad faith..."

"Some Panels have found that the concept of passive holding may apply even in the event of sporadic use, or of the mere 'parking' by a third party of a domain name as it happens in the current case."

"To summarize, the confusingly similar nature of the Domain Name to the Complainant's trademarks, the lack of any explanation from the Respondent as to why he registered the Domain Name of a well-known brand indicates bad faith registration. Moreover, Complainant’s international trademark registrations predate Respondents Domain Name registration and it is highly unlikely that the Respondent was not aware of the rights Complainant has in the trademarks and the value of said trademarks, at the point of the registration. Consequently, the Respondent should be considered to have registered and to be using the Domain Name in bad faith."

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

Based upon the trademark registrations cited by Complainant, it is apparent that Complainant has rights in and to the NOVARTIS trademark.

As to whether the Disputed Domain Name is identical or confusingly similar to the NOVARTIS trademark, the relevant comparison to be made is with the second-level portion of the Disputed Domain Name only (i.e., "novartislife") because "[t]he applicable Top Level Domain ('TLD') in a domain name (e.g., '.com', '.club', '.nyc') is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test." WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 1.11.1.

Here, the Disputed Domain Name contains the NOVARTIS trademark in its entirety plus the word "life." As stated in WIPO Overview 3.0, section 1.7, "in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing."

Accordingly, the Panel finds that Complainant has proven the first element of the Policy.

Complainant has argued that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because, inter alia, "Complainant has not found that Respondent is commonly known by the Disputed Domain Name or that it has interest over the Domain Name or the major part of it.... Respondent has not by virtue of the content of the website, nor by its use of the Domain Name shown that they will be used in connection with a bona fide offering of goods or services. It is clear that Complainant has become a distinctive identifier associated with the term NOVARTIS and that the intention of the Domain Name is to take advantage of an association with the Complainant’s business."

WIPO Overview 3.0, section 2.1, states: "While 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 often impossible 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element."

The Panel finds that Complainant has established its prima facie case and without any evidence from Respondent to the contrary, the Panel is satisfied that Complainant has satisfied the second element of the Policy.

Whether a domain name is registered and used in bad faith for purposes of the Policy may be determined by evaluating four (non-exhaustive) factors set forth in the Policy: (i) circumstances indicating that the registrant has registered or the registrant has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the registrant's documented out-of-pocket costs directly related to the domain name; or (ii) the registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the registrant has engaged in a pattern of such conduct; or (iii) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant's website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the registrant's website or location or of a product or service on the registrant's website or location. Policy, paragraph 4(b).

"[T]he scenarios enumerated in UDRP paragraph 4(b) are non-exhaustive." WIPO Overview 3.0, section 3.1.3. Complainant has alleged that bad faith exists under the "passive holding" doctrine, which panels routinely have found can establish bad faith. Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000 0003.

"While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put." WIPO Overview 3.0, section 3.3. Here, given the apparently widespread reputation that Complainant enjoys in the NOVARTIS trademark and Respondent's failure to submit a response or to provide any evidence of actual or contemplated good-faith use, application of the passive holding doctrine is appropriate.

Accordingly, the Panel finds that Complainant has proven 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. **NOVARTISLIFE.ORG**: Transferred

PANELLISTS

Name	**Douglas M. Isenberg**

DATE OF PANEL DECISION 2017-11-27

Publish the Decision