Decision for dispute CAC-UDRP-101918

Case number	CAC-UDRP-101918
Time of filing	2018-03-14 09:46:39
Domain names	novartiis.com

Case administrator

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

Complainant

Organization	Novartis AG

Complainant representative

Organization	BrandIT GmbH

Respondent

Organization	chenxinqi

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other legal proceedings.

IDENTIFICATION OF RIGHTS

Various trademarks, including :

TM: NOVARTIS
Reg. No: IR666218
Classes: 41; 42
Date of Registration: 31.10.1996 (inc. China)

TM: NOVARTIS
Reg. No: IR663765
Classes: 01; 02; 03; 04; 05; 07; 08; 09; 10; 14; 16; 17; 20; 22; 28; 29; 30; 31; 32; 40; 42
Date of Registration: 01.07.1996 (inc. China)

TM: NOVARTIS
Reg. No: IR1155214
Classes: 41; 42

Date of Registration: 24.01.2013 (inc. China)

FACTUAL BACKGROUND

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

i) LANGUAGE OF PROCEEDINGS REQUEST:

If the language of the Registration Agreement of the disputed domain name <novartiis.com> is a language other than English, according to the applicable Registrar, Complainant filed a language of proceeding request that the language of the proceeding should be English based on the following facts:

Respondent has not replied to the cease and desist letter ("C&D letter"), nor responded that they did not understand the content of the letter. This conduct has a relevancy when deciding on the language of the proceeding, as it was stated on WIPO Case no. D2015-0298 where the "The Respondent did not reply to the Complainant's request, therefore it did not express in any way that it cannot answer the allegations since it does not understand English."

The disputed domain name includes a typo variant word of Complainant's mark NOVARTIS. Complainant is a global company whose business language is English. Furthermore, Respondent has registered many other domains with words in English, it is unlikely that Respondent is not at least familiar with the English language.

In addition, Respondent has chosen to register the disputed domain name under the Top Level domain name ".com" which is a commercial TLD, and is applicable to a broader audience than merely China. A more suitable TLD if only addressing the Chinese market would be the ".cn" extension. 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. In WIPO decisions D2015-1508 and D2015-0614 the Panel decided to accept the Complaint to be filed in English despite the fact that the Registrar had informed the Center that the language of the Registration Agreement was Turkish.

ii) ABOUT COMPLAINANT AND THE BRAND NOVARTIS

Novartis AG (hereinafter referred to as Complainant) is the proprietor of the NOVARTIS trademarks. Novartis is a global healthcare company based in Switzerland that provides solutions to address the evolving needs of patients worldwide (please see, https://www.novartis.com). Novartis 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 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 China. (See the overview of the registered trademarks below). Complainant has a strong presence in China where the Respondent is doing business with the Disputed Domain Name.

The below link connects customers to the official local sales and service locator and to the official websites of the Complainant:

- Global Website for NOVARTIS; https://www.novartis.com/
- Local Website for NOVARTIS in the China: see www.novartis.com.cn

Overview of trademark registrations:
IR = International Registration

Trademark: NOVARTIS
Reg. No: IR666218
Classes: 41; 42
Date of Registration: 31.10.1996 (inc. China)

TM: NOVARTIS
Reg. No: IR663765
Classes: 01; 02; 03; 04; 05; 07; 08; 09; 10; 14; 16; 17; 20; 22; 28; 29; 30; 31; 32; 40; 42
Date of Registration: 01.07.1996 (inc. China)

TM: NOVARTIS
Reg. No: IR1155214
Classes: 41; 42
Date of Registration: 24.01.2013 (inc. China)

These trademark registrations predate the registration of the Disputed Domain Name. Due to extensive use, advertising and revenue associated with its trademarks worldwide, Complainant enjoys a high degree of renown around the world, including in China, where the Respondent offers its business. 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).

Please note that in the case No. D2016-1688, Novartis AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org, / Sergei Lir regarding the domain name <novartis-bio.com>, the Panel confirmed that NOVARTIS is a well-known worldwide trademark as follows:

“When the disputed domain name was registered by the Respondent in June 2016, the trademark NOVARTIS was already well-known worldwide and directly connected to the Complainant’s activities in the pharmaceutical business”

Complainant has registered a number of domain names under generic Top-Level Domains ("gTLD") and country-code Top-Level Domains ("ccTLD") containing the term “NOVARTIS”, for example, <novartis.com> (created on April 2, 1996), <novartis.net> (created on April 25, 1998), <novartis.com.cn> (created on August 20, 1999), and <novartis-bio.com> (created on June 30, 2016). 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. See information attached for examples of Complainant`s domain name registrations.

LEGAL GROUNDS:

i) THE DISPUTED DOMAIN NAME IS CONFUSINGLY SIMILAR

The disputed domain name <novartiis.com>, which was registered on December 28, 2017, incorporates a typo variant Complainant’s well-known, registered trademark NOVARTIS. The addition of the generic Top-Level Domain (gTLD) “.com” does not add any distinctiveness to the disputed domain name. These references exaggerate the impression that Respondent is somehow affiliated with Complainant, and Respondent is somehow doing business in China using Complainant‘s trademark. See as an example the WIPO Overview of on WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0"), paragraph 1.11. as well as the International Business Machines Corporation v. Sledge, Inc. / Frank Sledge WIPO Case No. D2014-0581 where the Panel stated the following “In addition, it is generally accepted that the addition of the top-level suffix in the domain name (e.g., “.com”) is to be disregarded under the confusing similarity test”. The following should apply in the current case and the disputed domain name should be considered as confusingly similar to the trademark NOVARTIS.

ii) THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN RESPECT OF THE DISPUTED DOMAIN NAME

Complainant has not found that Respondent is commonly known by the disputed domain name or that it has interest over the disputed domain name or the major part of it. The WHOIS information “chenxinqi” is the only evidence in the WHOIS record, which relates Respondent to the disputed domain name. When entering the terms “NOVARTIS”, and “CHINA” in the Google search engine, the returned results point to Complainant and its business activity. The Respondent could easily perform a similar search before registering the disputed domain name and would have quickly learnt that the trademarks are owned by Complainant and that the Complainant has been using its trademarks in China. Respondent has not by virtue of the content of the website, nor by its use of the disputed domain name shown that they will be used in connection with a bona fide offering of goods or services.

There is no evidence that Respondent has a history of using, or preparing to use, the disputed domain name in connection with a bona fide offering of goods and services. It is clear that Complainant has become a distinctive identifier associated with the term “NOVARTIS” and that the intention of the disputed domain name is to take advantage of an association with the business of Complainant.

THE WEBSITE

At the time of preparing this Complaint, the disputed domain name is not active with a print screen on the disputed domain name from March 12, 2018. The Respondent has made no claims to either having any relevant prior rights of its own, or to having become commonly known by the disputed domain name. Clearly, the Respondent is not known by the disputed domain name, nor does the Respondent claim to have made legitimate, non-commercial use of the disputed domain name. Moreover, Complainant had never authorized the Respondent to use its trademark in any form.

Relevantly in the WIPO case No. D2016-0253 Aldi GmbH & Co. KG Aldi Store Limited v. Greg Saunderson, the Panel found:

“While there is nothing per se illegitimate in using a domain name parking service, linking a domain name to such a service with a trademark owner's name in mind in the hope and expectation that Internet users searching for information about the business activities of the trademark owner will be directed to the parking page is a different matter. Such activity does not provide a legitimate interest in that domain name under the Policy.”

The Respondent has been granted an opportunity to present some compelling arguments that it has rights in the disputed domain names but has failed to do so. The Respondent has made no claims to neither having any relevant prior rights of its own, nor to having become commonly known by the disputed domain name.

iii) THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITH

THE DISPUTED DOMAIN NAME WAS REGISTERED IN BAD FAITH

It has to be highlighted that Complainant’s trademarks predate the registration of the disputed domain name and Respondent has never been authorized by Complainant to register the disputed domain name. It is inconceivable that the typo combination of the well-known mark “NOVARTIIS” in the disputed domain name is not a deliberate and calculated attempt to improperly benefit from the Complainant’s rights.

THE DISPUTED DOMAIN NAME IS BEING USED IN BAD FAITH

Complainant tried to contact Respondent on January 22, 2018 through a cease and desist letter. The letter was sent to the e-mail address listed in the whois record associated with the disputed domain name. In the cease and desist letter, Complainant advised Respondent that the unauthorized use of its trademarks within the disputed domain name violated their trademark rights and Complainant requested a voluntary transfer of the disputed domain name. As no reply was received, e-mail reminders were sent on January 29 and February 19, 2018. Respondent has simply disregarded such communications. 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, e.g., News Group Newspapers Limited and News Network Limited v. Momm Amed Ia, WIPO Case No. D2000-1623; Nike, Inc. v. Azumano Travel, WIPO

Case No. D2000-1598; and America Online, Inc. v. Antonio R. Diaz, WIPO Case No. D2000-1460.

Since the efforts of trying to solve the matter amicably were unsuccessful, Complainant chose to file a complaint according to the UDRP process.

THE WEBSITE

As noted previously, the disputed domain name currently does not resolve to an active website.

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. See as an example WIPO Overview 2.0, paragraph 3.2

In the WIPO Case No. D2000-0003 Telstra Corporation Limited v. Nuclear Marshmellows the Panel established that the registration and passive holding of a domain name which has no other legitimate use and clearly references Complainant's trademark may constitute registration and use in bad faith. In the current case it is clear that Respondent has registered the disputed domain name in bad faith by intentionally adopting Complainant's widely known mark in violation of Complainant's rights.

Further, the inaction in relation to a domain name registration can also constitute a domain name being used in bad faith and any attempt to actively use the disputed domain name would lead to confusion as to the source, sponsorship of the Respondent´s website among the internet users who might believe that the website is owned or in somehow associated with the Complainant.

In addition, Complainant's International and Chinese trademark registrations predate Respondent's disputed domain name registration and the cease and desist letter was not replied. These cumulative factors clearly demonstrate that Respondent should be considered to have registered and to be using the Domain Name in bad faith as stated at the WIPO case No. D2016-0456 Amis Paris v. Amiparis, Amipa, where the Panel found:

"Based on the evidence presented to the Panel, including the late registration of the disputed domain name which includes to the Complainant's marks, the confusing similarity between the Complainant's trademark and the disputed domain name, the Respondent's failure to reply to the cease-and-desist letter, the failure of the Respondent to respond to the Complaint and the Respondent's passive holding of the disputed domain name, the Panel draws the inference that on balance the disputed domain name has been registered and is being used in bad faith."

Moreover, Respondent takes advantage of the NOVARTIS trademark by intentionally attempting to attract visitors to the Respondent's websites by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or a product or service on the Respondent's website or location.

From the Complainant's point of view, the Respondent intentionally chose the disputed domain name based on a registered and well-known trademark in order to only use it for non-legitimate purposes.

Complainant has conducted a search to try to establish whether Respondent would have any rights in the name. This has been accomplished by a search on Google. Complainant cannot find that the Respondent has any registered rights in the names or has become known under the name.

In addition, Complainant notes that the Domain is listed as being for sale at AFTERNIC.COM. This conduct has been considered in previous cases as an additional evidence of bad faith due to the Respondent´s intention to unduly profit from the Complainant´s rights. Please see WIPO Case No. D2016-0771 Facebook, Inc. vs. Domain Admin. Privacy Protection Service Inc. d/b/a Privacy Protection.org/ Ông Trần Huỳnh Lâm, where the Panel found that:

"It also submits that the Respondent's offer to transfer the disputed domain name in return for a payment of USD 100,000 is

a "strong indication" of the Respondent's intention to unduly profit from the Complainant's rights and constitutes additional evidence of bad faith".

In the recent CAC case number 101486, involving the domain name <arla.site>, the Panel relevantly stated:

"the Panel entirely agrees with the submission of the Complainant that, as the Complainant tried to contact the Respondent on February 27, 2017 through a cease and desist letter and as the Respondent then asked for $800 to transfer the domain, this itself amounts to bad faith registration and use within the express provisions of paragraph 4(b) (i) of the Policy."

PATTERN OF CONDUCT

A pattern of conduct can involve multiple UDRP cases with similar fact situations or a single case where the respondent has registered multiple domain names which are similar to trademarks. Here, it has to be highlighted that the Respondent, using the oficial e-mail address, has registered more than 3000 domain names including well-known brands such as <bosch-station.com > and <applevisions.com.>. Such pattern of abusive conduct constitutes evidence of bad faith according to Paragraph (6) (ii) of the Policy and this behavior was declared as bad faith registration according to WIPO case No. D2015-1932 Bayer AG of Leverkusen v. huang cheng of Shanghai where the Panel stated that "The Respondent is engaged in registering domain names containing famous marks… This is evidence of a pattern in the misappropriation of well-known marks which cannot be regarded as registration and use in good faith.". Further, in WIPO Case No DME2015-0010, Arla Foods amba v Ye Li involving the domain <arlafoods.me>, the Panel stated, "Further, the Panel considers it likely that the Respondent was aware of the Complainant's well-known and distinctive trademarks ARLA and ARLA FOODS at the time of registration of the disputed domain name. The Complainant's trademark ARLA is registered in China, which is the Respondent's place of residence, and the Complainant was conducting business in China under the trademarks when the Respondent registered the disputed domain name. The Panel therefore finds that the Respondent's registration of the disputed domain name was in bad faith".

From the Complainant's point of view, the Respondent intentionally chose the disputed domain name based on a registered and well-known trademark in order to only use it for non-legitimate purposes. The conduct of the Respondent in registering domains incorporating other well-known trademarks demonstrates systematic bad faith behavior.

To summarize, the trademark NOVARTIS is a well-known mark worldwide, including in China where the Respondent is located. Respondent bears no relationship to the trademarks and the disputed domain name has no other meaning except for referring to Complainant's business name and trademarks. There is no way in which the disputed domain name using a typo variant term of the brand NOVARTIS could be used legitimately by the Respondent. Inference of bad faith registration and use of the disputed domain name is also given by the fact that the Respondent did not reply the cease and desist letter. Finally, the disputed domain name is being passively held, an additional element of bad faith in accordance with the applicable cases described at this Complaint.

Consequently, the Respondent should be considered to have registered and to be using the disputed 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

The disputed domain name, which was registered on December 28, 2017 by Respondent, incorporates a typo variant of Complainant’s well-known, registered trademark NOVARTIS. In the Panel view, the difference (limited to 1 "i" in the Complainant's trademark and 2 "ii" in the disputed domain name), does not add any distinctiveness to the disputed domain name. It is even more the case since the number of "i" will not make a big difference in the way the two signs are pronounced.

Respondent didn't answer to the complaint stating that the Complainant "has not found that Respondent is commonly known by the disputed domain name or that it has interest over the disputed domain name or the major part of it."

In addition, the website is inactive. While an inactive website is not sufficient per se to conclude to the absence of right, the Panel concludes that due to the silence of the Respondent, there is no evidence that Respondent has a history of using, or preparing to use, the disputed domain name in connection with a bona fide offering of goods and services.

Also, due to the fact that the Complainant is very well-known, including in China, and because a search in any search engine under "NOVARTIIS" will in fact lead to one of the the Complainant's websites, it is inconceivable that the Respondent was unaware of the existence of the Complainant when he registered the disputed domain name.

Moreover, based on the evidence presented to the Panel, including the registration of the disputed domain name which includes the Complainant’s marks, the confusing similarity between the Complainant’s trademark and the disputed domain name, the Respondent’s failure to reply to the cease and desist letter, the failure of the Respondent to respond to the Complaint and the Respondent’s passive holding of the disputed domain name, the Panel takes the view that the disputed domain name has been registered and is being used in bad faith.

Eventually, in the absence of any explanation provided by the Respondent, the Panels takes the view that the Respondent took advantage of the NOVARTIS trademark by intentionally attempting to attract visitors to the Respondent’s websites by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website or location or a product or service on the Respondent’s website or location.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTIIS.COM**: Transferred

PANELLISTS

Name	**Mr. Etienne Wéry**

DATE OF PANEL DECISION 2018-04-26

Publish the Decision