Decision for dispute CAC-UDRP-102030

Case number	CAC-UDRP-102030
Time of filing	2018-08-16 15:21:13
Domain names	tykerb-lapatinib.com

Case administrator

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

Complainant

Organization	Novartis AG

Complainant representative

Organization	BrandIT GmbH

Respondent

Organization	Apple infoway

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided legal proceedings relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

In these proceedings, the Complainant relies on the following trademarks:

- TYKERB (word), Indian Registration No. 1401004, registered as of November 23, 2005, in the name of Novartis Pharma AG (a subsidiary of the Complainant);

- TYKERB (word), International Registration No. 1148838, registered as of December 17, 2012, in the name of Novartis AG (the Complainant), not designating India.

It is worth noting that, the Complainant owns many other trademark registrations for TYKERB in various countries, which have not been relied upon in these proceedings.

FACTUAL BACKGROUND

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

The Complainant is a large global healthcare company with approximately 126000 employees, active in as many as 155

countries around the world, including India, where the Respondent is based.

The Complainant owns a large-sized portfolio of trademarks including the wording "TYKERB", among which two registrations (in the USA and in the EU) dating back to 2003. It also owns a multitude of related domain names, like <tykerb.com> since June 26, 2003.

The pharmaceutical product TYKERB contains the active substance “lapatinib” and is distributed in as many as 28 countries worldwide, including in India, where the Complainant has a strong presence.

The disputed domain name was registered on June 3, 2018 by the Respondent.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT

The Complainant contends that the disputed domain name is confusingly similar to its TYKERB trademark, as it wholly incorporates this trademark. This last element is sufficient to support the finding that the disputed domain name is confusingly similar to the Complainant's trademark. Indeed, the mere addition of the descriptive term “lapatinib” does not change the overall impression of a most likely connection with the trademark TYKERB of the Complainant; on the contrary, it makes it stronger. As to the gTLD “.com”, the Complainant implicitly suggests that it should be disregarded, as per the usual practice.

The Complainant maintains that the Respondent lacks rights or legitimate interest in the disputed domain name because the Respondent is not known by the disputed domain name, the Complainant is not affiliated with nor has it ever authorised the Respondent to register its trademark as a domain name and the Complainant has no business with the Respondent. Further, the Respondent has not used the disputed domain name in connection with a bona fide offering of goods or services.

According to the Complainant, given the distinctiveness and reputation of the TYKERB trademark, the Respondent registered the disputed domain name with full knowledge of the Complainant's trademark in an intentionally designed way with the aim to create a likelihood of confusion with the Complainant’s trademarks and domain names, and this is evidence of the fact that the disputed domain name was registered in bad faith. Further, it would be inconceivable that the unique combination of the Complainant’s trademark together with the the descriptive term “lapatinib” is not deliberate.

With respect to use in bad faith, the Complainant points out that the Respondent has used the disputed domain name as an inactive website, a fact that -in combination with the incorporation of a famous trademark in a domain name- proves use in bad faith. Further, the Respondent did not respond to a cease and desist letter addressed to him by the Complainant. Finally, the Respondent is, according to the Complainant, acting in a certain pattern of conduct.

For all these reasons, the Complainant concludes that the Respondent registered and used the disputed domain name in bad faith.

RESPONDENT

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).

The disputed domain name consists of the Complainant's whole trademark (TYKERB), accompanied by the the descriptive term “lapatinib”. This combination cannot but designate the Complainant and, thus, violates his prior trademark rights.

As far as the gTLD ".com" is concerned, it is generally recognized that top level domains do not have any bearing in the assessment of identity or confusing similarity, according to paragraph 4(a)(i) of the Policy.

Hence, the Panel is satisfied that the first requirement under the Policy is met.

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).

Since proving a negative fact is almost impossible, Panelists in UDRP proceedings have generally agreed that it is sufficient for the Complainant to establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name to shift the burden of proof to the Respondent.

In the case at issue, the Complainant argued that it had never authorised the Respondent to register the TYKERB trademark in a domain name, and that it had never licensed its trademark to the Respondent.

Furthermore, the Respondent has not demonstrated any use of the disputed domain name in connection with a bona fide offering of goods and services or a legitimate non-commercial or fair use of the disputed domain name.

Finally, there is no other evidence in the case file that could demonstrate that the Respondent has been commonly known by the disputed domain name.

In view of the foregoing, the Panel is satisfied that the Complainant has established a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name. In order to rebut the Complainant's arguments, the Respondent had the possibility to make his own defense. However, the Respondent has chosen not to file a Response.

Therefore, the Panel is satisfied that also the second requirement under the Policy is met.

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).

As far as registration in bad faith is concerned, given the reputation of the Complainant's trademark and the fact that the disputed domain name fully incorporates this, it is evident that, at the time of the registration of the disputed domain name, the Respondent was well aware of the Complainant's trademark. The registration as domain name of a third party's well-known trademark with full knowledge of the fact that the rights over this trademark belong to a third party amounts to registration in bad faith. This fact is reinforced by the combination with the the descriptive term “lapatinib”, which cannot be logically considered as random.

With respect to use in bad faith, the disputed domain name resolves to an inactive website. This fact is to be combined with the full incorporation of the Complainant’s reputable trademark in the disputed domain name. For this Panel, same as for many previous panels, such misleading behaviour clearly amounts to use in bad faith. Therefore, it is impossible to conceive any plausible active use of the disputed domain name that would be legitimate.

The Panel does not consider necessary to assess the Complainant’s pattern of conduct argument with regard to the Respondent.

In conclusion, the Panel finds it clear that the disputed domain name was used in bad faith.

For all circumstances mentioned above, the Panel is satisfied that also the third requirement under the Policy is satisfied.

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 wholly incorporates the Complainant's prior trademark, in combination with the the descriptive term “lapatinib”. The disputed domain name is therefore confusingly similar to the Complainant's trademark.

The Respondent was not authorised to include the Complainant's trademark in the disputed domain name, and the Complainant never licensed its trademarks to the Respondent. The Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services, or a legitimate non-commercial or fair use.

The Respondent registered the disputed domain name with full knowledge of the Complainant's reputable trademark. His use of the disputed domain name is in bad faith as there is no conceivable use of the disputed domain name that could amount to a legitimate use.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **TYKERB-LAPATINIB.COM**: Transferred

PANELLISTS

Name	**Sozos-Christos Theodoulou**

DATE OF PANEL DECISION 2018-09-28

Publish the Decision