Decision for dispute CAC-UDRP-102137

Case number	CAC-UDRP-102137
Time of filing	2019-01-23 11:25:04
Domain names	novartiscorp.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BrandIT GmbH

Respondent

Name	Black Roses

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

TRADEMARKS
The Complainant owns numerous trademarks registered worldwide characterized by the distinctive term “NOVARTIS”. The Complainant has sufficiently demonstrated to be owner, inter alia, of the US word marks “NOVARTIS” registration no. 2997235, filed on February 10, 2004, granted on September 20, 2005 in class 5 and registration no. 4986124, filed on September 12, 2013, granted on June 28, 2016 in classes 5, 9, 10, 41, 42 and 44.

DOMAIN NAMES
The Complainant has also registered several domain names, such as <novartis.com> created on April 2, 1996 and used as its main website and <novartis.net>, created on April 25, 1998.

TRADE / COMPANY NAME
The Complainant also relies on the trade / company name “NOVARTIS” under which it has carried out business and sold its products all over the globe.

The Complainant has proved its rights in the NOVARTIS Trademark for the purposes of the Policy.

FACTUAL BACKGROUND

The Complainant is a global healthcare company based in Switzerland providing solutions to address the evolving needs of patients worldwide. It manufactures drugs such as clozapine (Clozaril), diclofenac (Voltaren), carbamazepine (Tegretol), valsartan (Diovan), etc. The Complainant's products are sold in 155 countries and in 2017 they reached nearly 1 billion people globally. The Complainant has about 126 000 employees of 145 different nationalities. The Complainant has a strong presence in the United States where the Respondent is located. Due to the extensive use, advertising and revenue associated with the NOVARTIS Trademark worldwide, the Complainant enjoys a high degree of renown around the world.

The disputed domain name was registered with privacy registration service on November 26, 2018. Upon receipt of the Complaint, the Registrar disclosed the registration data, identifying the registrant, Black Roses, in the United States.

At the time of sending the cease and desist letter to the Respondent and before filing the Complaint the disputed domain name pointed to an active website with no content. Pending the present administrative proceeding, the disputed domain name has been redirected to the main website of the Complainant (novartis.com).

The facts asserted by the Complainant are not contested by the Respondent.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS

COMPLAINANT'S CONTENTIONS

The Complainant contends that the disputed domain name is confusingly similar to the NOVARTIS Trademark, since it incorporates such well-known mark combined with the generic term "corp", which is commonly known as abbreviation for the word "corporation". The addition of the gTLD ".com" does not add any distinctiveness to the disputed domain name. Given that the term "NOVARTIS" is distinctively recognizable in the disputed domain name, this latter should be considered as confusingly similar to the trademark NOVARTIS Trademark.

The Complainant asserts that it has never granted the Respondent any right to use the NOVARTIS Trademark within the disputed domain name, nor is the Respondent affiliated to the Complainant in any form. The Respondent is not commonly known by the disputed domain name, nor has any interest over such domain. Should the Respondent have performed a Google or similar search on the Internet before registering the disputed domain name, it would have easily learnt about the Complainant's trademark registered and used worldwide, in particular in the United States. Moreover, neither the content of the website to which the disputed domain name resolved before filing the Complainant (active website with no content) and nor the content of the website to which it redirects during this administrative proceeding (official website of the Complainant) corroborate that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services or is making a legitimate, non-commercial or fair use of such domain. Therefore, the Complainant contends that the Respondent has no right nor legitimate interest in respect of the disputed domain name.

According to the Complainant the Respondent has deliberately chosen to incorporate the well-known NOVARTIS Trademark in the disputed domain name and to add the generic term "corp" with the only purpose to mislead Internet users. The Respondent has also concealed its identity by using privacy shield. The Complainant sent a cease and desist letter and several reminders to the Respondent without obtaining any response. Before filing the Complaint the disputed domain name was passively held and after bringing this administrative proceeding it was redirected to the Complainant's website. All these circumstances show the bad faith of the Respondent in registering and using the disputed domain name.

RESPONDENT'S CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

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

REQUIREMENTS OF PARAGRAPH 4(A) OF THE UDRP POLICY

Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements to obtain the transfer or the revocation of the domain name:
(1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
(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.

1. THE COMPLAINANT'S RIGHTS AND CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAME TO THE COMPLAINANT'S MARK

The Complainant has provided sufficient documentary evidences to demonstrate to be owner of the NOVARTIS Trademark.

In assessing identity or confusing similarity the Panel finds that the disputed domain name incorporates the entirety of the Complainant's NOVARTIS Trademark and differs from such mark by merely adding the generic and descriptive term "corp" (which is the common abbreviation of the word "corporation") and the top-level domain name ".com".

In UDRP cases where the relevant trademark is recognizable within the disputed domain name, Panels agree that the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element (see paragraph 1.7 WIPO Overview 3.0).

UDRP Panels also agree that the top-level domain is usually to be ignored for the purpose of determination of identity or confusing similarity between the disputed domain name and the Complainant's trademark as it is a technical requirement of registration (see paragraph 1.11.1 WIPO Overview 3.0).

Hence, this Panel finds that the Complainant has proven the first element of the paragraph 4(a) of the Policy and the disputed domain name is confusingly similar to the Complainant's mark.

2. THE RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS TO THE DISPUTED DOMAIN NAME

It is a consensus view of UDRP Panels that the Complainant shall 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 (see paragraph 2.1 of the WIPO Overview 3.0: "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 Respondent has never received any approval of the Complainant, expressed or implied, to use the Complainant's trademark or to register and use the disputed domain name, nor is affiliated to the Complainant in any form.

The disputed domain name was registered on November 26, 2018 by Black Roses, located in the United States. There is no evidence that the Respondent has been commonly known by the disputed domain name.

Moreover, the disputed domain name, before filing the Complaint, resolved to an active website with no content. During the present administrative proceeding the Respondent redirected the disputed domain name to the Complainant's website. Such uses of the domain name are clearly not a legitimate non-commercial or fair use, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's mark.

While the Complainant has established its prima facie case, the Respondent has not submitted a Response to the Complaint and, thus, has failed to invoke any of the circumstances, which could demonstrate any rights or legitimate interests in the disputed domain name.

Therefore, the Panel is satisfied that the Complainant has met the second requirement of the paragraph 4(a) of the Policy and finds that the Respondent lacks rights or legitimate interests to the disputed domain name.

3. BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME

The Respondent registered the disputed domain name which is to be considered confusingly similar to Complainant's mark, since it wholly incorporates the NOVARTIS Trademark. The addition of the generic and descriptive term "corp" (common abbreviation of the term "corporation") and the TLD ".com" (technical requirement of the registration) are not sufficient elements to escape the finding of confusing similarity between the disputed domain name and the Complainant's mark.

Given the distinctiveness and reputation of the Complainant's prior mark (see also WIPO Case No. D2016-1688, Novartis AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org, / Sergei Lir, novartisbio.com), it is inconceivable that the Respondent could have registered the disputed domain name for a mere chance without actual knowledge of the Complainant's rights in such well-known mark and the intention to exploit such reputation by diverting traffic away from the Complainant's website.

Even assuming that the Respondent had no knowledge of the Complainant's prior mark at the time of registration of the disputed domain name (which is quite unlikely), it omitted to verify that the disputed domain name would have infringed the Complainant's earlier rights or, even worse, it verified it and deliberately proceeded with the infringing registration and use. The Complainant has submitted the results of a search carried out on Google search engine regarding the term "NOVARTIS", all of them related to the Complainant. Should the Respondent have performed a similar search on the Internet before registering the disputed domain name, it would have easily learnt about the Complainant's activities and trademark registered and used in the United States and worldwide.

This Panel highlights that, according to paragraph 2 of the Policy, it is the Respondent's responsibility to determine whether the domain name registration infringes or violates third party's rights ("By applying to register a domain name, or by asking us to maintain or renew a domain name registration, you hereby represent and warrant to us that (a) the statements that you made in your Registration Agreement are complete and accurate; (b) to your knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party; (c) you are not registering the domain name for an unlawful purpose; and (d) you will not knowingly use the domain name in violation of any applicable laws or regulations. It is your responsibility to determine whether your domain name registration infringes or violates someone else's rights"). By registering the disputed domain name confusingly similar with the Complainant's well-known mark, the Respondent has violated, inter alia, the cited provision of the Policy.

The disputed domain name was registered with privacy registration service. Although the use of such service is not in and of itself an indication of bad faith, the circumstances and the manner in which such service is used, including whether the Respondent is operating a commercial and trademark-abusive website, may however impact the Panel's assessment of bad faith (see paragraph 3.6 of the WIPO Overview 3.0).

At the time of sending the cease and desist letter to the Respondent and before filing the Complaint the disputed domain name pointed to an active website with no content and, pending the present administrative proceeding, the disputed domain name has been redirected by the Respondent to the Complainant's website.

Taken into account the following:
- the disputed domain name is confusingly similar to the Complainant's earlier and well-known NOVARTIS Trademark;
- the Respondent concealed its identity by using privacy registration service;
- before filing the Complaint the disputed domain name was passively held and after such filing it was redirected to the Complainant's website,
the Panel finds that, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his website, by creating a likelihood of confusion with the Complainant and its mark (paragraph 4(b)(iv) of the UDRP Policy).

Finally, the Respondent has neither responded to the cease and desist letter of the Complainant, nor has submitted a Response in this administrative proceeding providing any evidence of actual or contemplated good faith use. Paragraph 14(b) of the Rules provides that: "If a Party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, these Rules or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate".

Considering all the circumstances of the case, the Panel finds that the Complainant has discharged the burden of proof to show that the disputed domain name has been registered and is being used in bad faith (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. **NOVARTISCORP.COM**: Transferred

PANELLISTS

Name	**Avv. Ivett Paulovics**

DATE OF PANEL DECISION 2019-02-20

Publish the Decision