Decision for dispute CAC-UDRP-102305

Case number	CAC-UDRP-102305
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Domain names	wwwnovartis.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BrandIT GmbH

Respondent

Name	Milen Radumilo

OTHER LEGAL PROCEEDINGS

None that the Panel has been made aware of.

IDENTIFICATION OF RIGHTS

Trademark registration in Romania
Trademark: NOVARTIS, Reg. no: 663765, registered: July 01, 1996

Several official websites of the Complainant:
- Global Website for NOVARTIS: ‘www.novartis.com’
- Local Website for NOVARTIS in Romania: ‘www.novartis.com.ro’

FACTUAL BACKGROUND

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

I. LANGUAGE OF PROCEEDINGS REQUEST:

Since the language of the Registration Agreement of the Disputed Domain Name is English, the proceeding should be English.

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 (see 'www.novartis.com'). Novartis manufactures drugs such as clozapine (Clozaril), diclofenac (Voltaren), carbamazepine (Tegretol), valsartan (Diovan) and many others.

The Complainant's products are sold in about 155 countries and they reached nearly 1 billion people globally in 2017. About 126 000 people of 145 nationalities work at Novartis around the world.

The Complainant has a strong presence in Romania. The below links connect customers to the official local sales and service locator and to the official websites of the Complainant:

- Global Website for NOVARTIS: 'www.novartis.com'
- Local Website for NOVARTIS in Romania: 'novartis.com.ro'

For more information about the Complainant, please see the Complainant´s Annual report for 2017 available at:

'www.novartis.com/sites/www.novartis.com/files/novartis-annual-report-2017-en-low-res.pdf'

The 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 Romania (see the overview of the registered trademarks below).

Trademark registration in Romania

Trademark: NOVARTIS
Reg. no: 663765
Registered: July 01,1996

These trademark registrations predate the registration of the Disputed Domain Name, on September 30, 2018 as shown in the WHOIS. Due to extensive use, advertising and revenue associated with its trademarks worldwide, the Complainant enjoys a high degree of renown around the world, including in Romania, where the Respondent is located. The 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"

The Complainant has registered a number of domain names containing the term "NOVARTIS", for example, <novartis.com> (created on April 02, 1996) and <novartis.net> (created on April 25, 1998). The 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.

LEGAL GROUNDS:

A. THE DOMAIN NAME IS CONFUSINGLY SIMILAR

The domain name <wwwnovartis.com> (hereinafter referred to as the “disputed domain name”) incorporates the Complainant’s well-known, registered trademark NOVARTIS and a prefix “www” which indicates the system of Internet servers that support specially formatted documents. The addition of the gTLD “.com” does not add any distinctiveness to the disputed domain name. Referring to WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0"), as the term “NOVARTIS” is distinctively recognizable in the disputed domain name, the disputed domain name should be considered as confusingly similar to the trademark NOVARTIS.

B. RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN RESPECT OF THE DOMAIN NAME

The Complainant 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 Complainant has not found that the 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. When entering the terms “wwwnovartis” in the Google search engine, the returned results all point to the Complainant and its business activity. The Respondent could have easily performed a similar search before registering the disputed domain name and would have quickly learnt that the trademarks are owned by the Complainant and that the Complainant has been using its trademarks in Romania. The Respondent has not by virtue of the content of the website, nor by its use of the disputed domain name shown that he has been commonly known by the disputed domain name

By the time the Complainant sent out the cease-and-desist letter, the Respondent was using the disputed domain name to redirect to a pay-per-click website. On the pay-per-click website, it displays related terms such as “Novartis Company” and offers the disputed domain name for sale with a notice “Click Here To Buy This Domain” in the lower-right corner.

From the Complainant’s perspective, by associating the disputed domain name with a pay-per-click website, the Respondent is intending for commercial gain to misleadingly divert consumers to its website or to website of others, which is obviously not making a legitimate, noncommercial or fair use of the disputed domain name.

There is no evidence showing that the Respondent’s use of the disputed domain name is in connection with a bona fide offering of goods or services.

Taking into account of the above, the Respondent shall be considered as having no right nor legitimate interest in respect of the disputed domain name.

C. THE DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITH

i. THE DOMAIN NAME WAS REGISTERED IN BAD FAITH

It has to be highlighted that the Complainant’s trademarks predate the registration of the disputed domain name and the Respondent has never been authorized by the Complainant to use these trademarks nor to register the disputed domain name. The Respondent has chosen to incorporate the well-known trademark NOVARTIS in the disputed domain name combined with the general term “www” as a prefix, which is confusingly similar to ‘www.novartis.com’. From the Complainant’s perspective, it is very likely that the Respondent had the trademark in mind when he registered the disputed domain name and registered it only to mislead Internet users.

ii. THE DOMAIN NAME IS BEING USED IN BAD FAITH

Firstly, as noted in the previous paragraphs, the Respondent has been using the disputed domain name to redirect to a pay-per-click website. From the Complainant’s perspective, the Respondent has selected the well-known trademark NOVARTIS

for its domain name to attract business to the pay-per-click website, in the belief that the well-known trademark would attract visitors looking for NOVARTIS and give potential for pay-per-click revenue from people who would not otherwise have visited the website.

In a similar case Paris Hilton v. Deepak Kumar, WIPO Case No. D2010-1364 where pay-per-click website is involved, the panel states in the decision that:

“it is use in bad faith within the scope of paragraph 4(b)(iv) of the Policy where the registrant is using the domain name in this manner because of its similarity to a mark or name of another person in the hope and expectation that that similarity would lead to confusion on the part of Internet users and result in an increased number of Internet users being drawn to that domain name parking page (see, for example, Express Scripts, Inc. v. Windgather Investments Ltd, supra). The confusion that is usually relevant here is the confusion that draws the Internet user to the respondent's website in the first place (for example, confusion that leads an Internet user to type the domain name into his Internet browser). It does not matter that when the Internet user arrives at the pay–per-click site that it then becomes clear that the website is unconnected with the trade mark holder.”

Therefore, it is reasonable to conclude that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or website of others, by creating a likelihood of confusion with the Complainant’s trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website.

Secondly, the Complainant tried to contact the Respondent on November 27, 2018 through a cease-and-desist letter. The letter was sent to the email as listed in the WHOIS, to the Registrar and via an online form since the Respondent was using privacy shield service. In the cease-and-desist letter, the Complainant advised the Respondent that the unauthorized use of its trademarks within the disputed domain name violated their trademark rights and the Complainant requested a voluntary transfer of the disputed domain name. Reminders were sent on December 05, 2018 and December 12, 2018 despite of which the Respondent has simply disregarded communication from the Complainant. Since the efforts of trying to solve the matter amicably were unsuccessful, the 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, e.g., WIPO Case No. D2000-1623, News Group Newspapers Limited and News Network Limited v. Momm Amed Ia,; WIPO Case No. D2000-1598 Nike, Inc. v. Azumano Travel; and WIPO Case No. D2000-1460 America Online, Inc. v. Antonio R. Diaz.

Thirdly, the Respondent has been using privacy shield to hide its identity and has been actively offering the disputed domain name for sale to the public. This behavior coupled with the above-mentioned conducts shows that the Respondent is very likely to be using the disputed domain name in bad faith.

Lastly, the Respondent has already been involved in a number of UDRP cases because of registering domain names reproducing or incorporating trademarks of third parties, such as inter alia Swatch AG v. Perfect Privacy, LLC / Milen Radumilo, WIPO Case No. D2016-1370; Groupe IRCEM v. Perfect Privacy, LLC / Milen Radumilo, White & Case, WIPO Case No. D2018-2330; Fenix Outdoor AB v. Milen Radumilo/Perfect Privacy, LLC, WIPO Case No. D2016-0333; Celgene Corporation v. Milen Radumilo, WIPO Case No. D2016-0018; Intesa Sanpaolo S.p.A. v. Milen Radumilo Privacy Protection Service, Communigal Communication Ltd., WIPO Case No. D2015-2290; Carrefour v. Milen Radumilo/United Privacy Corp, WIPO Case No. D2015-1851; Bharti Airtel Limited v. Milen Radumilo, WIPO Case No. D2015-1948.

All of these proceedings resulted in transfers of the corresponding domain names registered by the Respondent, since all panels found bad faith registration and use of the domain names by the Respondent.

SUMMARY

To summarize, 1) the trademark NOVARTIS is a well-known trademark worldwide, including in Romania where the Respondent is located. Its registration predates the registration of the disputed domain name; 2) The Respondent bears no relationship to the trademarks or the Complaint; it is not commonly known by the disputed domain name nor that has it

interest over the disputed domain name or the major part of it; 3) The Respondent has been using the disputed domain name to associate with par-per-click website and therefore has intentionally attempted to attract for commercial gain by misleading the consumers; 4) the Respondent has never replied to communication from the Complainant; 5) the disputed domain name is registered under privacy shield and is being offered actively for sale; 6) the Respondent has already been involved in a number of UDRP cases because of registering domain names reproducing or incorporating trademarks of third parties, all of which resulted in transfers of the corresponding domain names since they were registered in bad faith of the Respondent.

Consequently, the Respondent should be considered to have registered the disputed domain name confusingly similar to the Complainant's registered, well-known trademark NOVARTIS. The Complainant has not found that the Respondent is of any legitimate right or interest in using it, but only registered and has been using it 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 Panel is satisfied with Complainant's arguments and supporting evidence on the three UDRP prongs on (i) confusingly similarity of the disputed domain name with Complainant's well know brand, which has been acknowledged in a series of the judicial and domain name disputes case-law; (ii) the lack of legitimate interest on Respondent, and (iii) the bad faith requirement.

Indeed, the "www+famous trademark" is a "traditional" form of domain name abusive speculation, see Volvo Trademark Holding AB v. Lorna Kang Case No.D2004-0909 where the Panel held that "the entire the trademark is contained in the contentious domain name and constitutes most of it. The domain name is therefore visually similar to the trademark. That similarity inevitably gives rise to confusion. The prefix of the letters “www” does not detract in the slightest from the impression given to the reader and the viewer that the dominant word in the domain name is “volvo”.

Furthermore, notwithstanding the international reputation of Complainant's trademark is of such a nature that it perfectly fits the standing requirement for the ".com" disputes, it has also been demonstrated trademark rights since 1996 in Romania, where Respondent is also domiciled, and where the ‘www.novartis.com.ro’ is actively used before the disputed domain name registration on September 2018.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **WWWNOVARTIS.COM**: Transferred

PANELLISTS

Name	**Roberto Manno**

DATE OF PANEL DECISION 2019-03-06

Publish the Decision