Decision for dispute CAC-UDRP-102627

Case number	CAC-UDRP-102627
Time of filing	2019-08-15 12:00:36
Domain names	novartisjobsus.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BrandIT GmbH

Respondent

Name	Jack page

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other proceedings, pending or decided, which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following trademarks registered in the United States of America:

- NOVARTIS registration number 4986124 (first use in commerce: 1996);
- NOVARTIS registration number 2997235 (first use in commerce: 1997).

The NOVARTIS trademark as a word and figure mark is also registered in several classes in numerous countries as set out by the Complainant in its evidence put before the Panel.

The Complainant has also 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).

FACTUAL BACKGROUND

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

Novartis AG (Complainant) is the owner of the trademark NOVARTIS as a word and figure mark in several classes in

numerous countries all over the world including in the United States of America. These trademark registrations predate the registration of the disputed domain name.

The Complainant is a global healthcare company based in Switzerland that provides solutions to address the evolving needs of patients worldwide (see www.novartis.com). The Complainant 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 800 million people globally in 2018. About 125 000 people of 145 nationalities work at Novartis around the world.

The Complainant uses its registered domain names to connect to its websites through which it informs potential customers about its NOVARTIS mark and its products and services. These web 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 USA: www.pharma.us.novartis.com.

The Complainant has built a strong presence in the United States of America where the Respondent is located.

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 the USA, where the Respondent is located.

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

A. Introduction

This is a Mandatory Administrative Proceeding under paragraph 4 of the Uniform Domain Name Dispute Policy (Policy or UDRP) of the Internet Corporation for Assigned Names and Numbers (ICANN), and the Procedural Rules for Uniform Domain Dispute Resolution (Rules) including the Czech Arbitration Centre (CAC) UDRP Supplementary Rules.

B. Language of proceeding request

The Complainant requests that the English language should be the language of the proceeding. There is no demurrer to this contention by the Respondent. From the WHOIS information put forward by the Complainant, it appears that the Respondent is located in the United States of America, and given the location of the registration of the disputed domain name, the Panel accepts the Complainant's request and will proceed to determine the proceeding in the English language.

C. Substantive Matters

The Complainant has filed a complaint with supporting evidence disputing the registration of the domain name 'novartisjobus.com' (the disputed domain name) by the Respondent.

The disputed domain name was registered on 16 April 2019.

The Respondent has not filed any administratively compliant response or any materials in response to the Complaint by the deadline set out under the Rules.

Paragraph 15(a) of the Rules provides:

A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

Accordingly, the Complainant carries the onus to prove its case.

Paragraph 4(a) of the Policy lists three elements that the Complainant must prove to merit a finding that the disputed domain name registered by the Respondent be transferred to the Complainant:

(i) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) The Respondent has no right or legitimate interests in respect of the disputed domain name; and

(iii) The disputed domain name has been registered and is being used in bad faith.

The Panel is satisfied the Complainant has satisfied all three elements for the principal reasons set out below.

Taking each of these elements in turn:

Paragraph 4(a)(i) - RIGHTS IN AN IDENTICAL OR CONFUSINGLY SIMILAR TRADEMARK

To prove this element, the Complainant must have trademark rights and the disputed domain name must be identical or confusingly similar to the Complainant's trademark.

The Complainant has adduced evidence that it is the owner of the relevant trademarks and domain names set out in the Identification of Rights section above.

The Panel notes that the Complainant's trademark and domain names predate the registration of the disputed domain name.

The disputed domain name, however, is not strictly identical to the Complainant's trademark or its domain name as the disputed domain name incorporates the Complainant's trademark 'NOVARTIS' with the generic terms 'jobs' and 'us". The Complainant also contends that the incorporation of these terms is closely related to the Complainant's business activities.

Further, the Complainant contends that the addition of the gTLD ".com" does not add any distinctiveness to the disputed domain name and cites WIPO Overview of 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.

The Panel considers that when a domain name wholly incorporates a complainant's registered trademark, it is sufficient to establish identity or confusing similarity for the purposes of the Policy. See Oki Data Americas, Inc. v. ASD, Inc, WIPO Case No. D2001-0902; Dr. Ing. h.c. F. Porsche AG v Vasiliy Terkin, WIPO Case No D2003-003-0888.

Apart from being a registered trademark, on the evidence adduced by the Complainant as to the extensive use, advertising and revenue associated with its trademarks worldwide, the Complainant enjoys a high degree of renown around the world, including the United States of America. The Complainant cites Case No D2016-188 Novartis AG v Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org,/Sergei Lir in support of that panel's finding that the trademark NOVARTIS is well-known worldwide and directly connected to the Complainant's activities in the pharmaceutical business.

The Panel accepts that the Complainant's trademark NOVARTIS is not only widely well-known but considers upon the evidence adduced that it is highly distinctive and well-established of the Complainant's business and reputation in the pharmaceutical business or the classes of goods or services to which its trademarks apply.

The Panel considers that the combination of the terms 'jobs' and 'us' with the Complainant's trademark 'NOVARTIS' as a single term will likely convey the impression of a connection with the Complainant's trademark and/or its business. In particular, the disputed domain name is likely to convey to the public that it is a website where the Complainant is offering jobs in the 'US' market.

The Panel also accepts the Complainant's contention that the top-level suffix '.com' is to be disregarded under the 'confusing similarity test'. In any event, it is generally irrelevant when assessing whether a domain name is identical or confusingly similar to a trademark. This is because gTLDs are only required for the functionality of a website. See Proactiva Medio Ambiente, S.A. v. Proactiva, WIPO Case No. D 2012-0182; F. Hoffman-La Roche AG v Macalve e-dominos S.A., WIPO Case No. D2006-0451.

Although no evidence of actual confusion has been provided by the Complainant, the Panel, having reviewed the evidence of reputation in support of the Complainant's case, is satisfied that the disputed domain name is likely to cause confusion amongst Internet users given the nature and wide use of the Complainant's trademark in the classes of goods or services in which they are registered.

Accordingly, the Panel finds that the disputed domain name <novartisjobsus.com> is confusingly similar to the Complainant's trademark and that paragraph 4(a)(i) of the Policy is satisfied.

Paragraph 4(a)(ii) - NO RIGHTS OR LEGITIMATE INTERESTS

The burden of proof is on the Complainant to establish that the Respondent lacks rights or legitimate interests in the disputed domain name.

Under the Policy, if a prima facie case is established by the Complainant, then the burden of production of evidence shifts to the Respondent to demonstrate that it has rights or legitimate interests in the disputed domain name. See Document Technologies, Inc. v. International Electronic Communications Inc., WIPO Case No. D2000-0270; Belupo d.d. v. WACHEM d.o.o., WIPO Case No. D2004-0110; Croatia Airlines d. d. v. Modern Empire Internet Ltd, WIPO Case No. D2003-0455; Audi AG v. Dr. Alireza Fahimipour, WIPO Case No. DIR2006-0003.

The Complainant advances three contentions in support of this ground:

(a) 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.

(b) The Respondent is not commonly known by the disputed domain name nor has an interest over the disputed domain name nor the major part of it.

(c) The Respondent has not been using the disputed domain name for any bona fide offering of goods or services but has 'parked' the disputed domain name.

The Respondent did not submit any administratively compliant response or attempt to demonstrate any rights or legitimate interests in the disputed domain name. Accordingly, the Panel can draw an adverse inference from the Respondent's failure to respond, in accordance with paragraph 14(b) of the Rules.

The Panel accepts that the Complainant did not grant the Respondent any rights to use the Complainant's trademark, nor is connected with the Complainant. Accordingly, any use by the Respondent of the disputed domain name that incorporates the trademark NOVARTIS is not authorised and therefore likely to be an infringement of the Complainant's legal rights.

The Panel accepts on its face the Complainant's contention that the Respondent is not commonly known by the disputed domain name nor has an interest over the disputed domain name nor the major part of it.

The Complainant's evidence suggests that the disputed domain name has not been used by the Respondent in connection with bona fide offering of goods or service. The disputed domain name currently is parked with the notice 'website coming soon!' and 'see if the site is available'.

In any event, the Panel considers that it cannot be inferred that the disputed domain name is for use in a fair or legitimate manner, as the disputed domain name pertains to the business, products or services created by the Complainant. Further, by the statement 'see if the site is available' appearing on the disputed domain name website, it infers that the disputed domain name may be for sale, hire or otherwise for a purpose other than use in a fair or legitimate manner.

The Panel is satisfied that the use of the disputed domain name cannot be connected to the Complainant or its business, products or services to which the Complainant's trademark applies.

The Panel is also satisfied that there is no actual or contemplated active use by the Respondent of the disputed domain name that is legitimate even with the statement 'website coming soon' appearing on the disputed domain name website.

Accordingly, the Panel is satisfied that there is no actual or contemplated active use by the Respondent of the disputed domain name that is legitimate.

On the contrary, given the priority date of the Complainant's trademark and registered domain names, any such use by the Respondent, to which no evidence to the contrary has been submitted, of the disputed domain name will likely mislead and direct customer or businesses away from the Complainant's legitimate website.

By the lack of any administratively compliant response from the Respondent, or any other information indicating the contrary, the Panel finds that the Respondent has no rights or legitimate interests in respect of <novartisjobsus.com> and that paragraph 4(a)(ii) of the Policy is satisfied.

Paragraph 4(a)(iii) - BAD FAITH

For the purposes of paragraph 4(a)(iii), paragraph 4(b) of the Policy states that any of the following circumstances shall be considered evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that the Respondent has registered or 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 to a competitor of that complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the Respondent 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 you have engaged in a pattern of such conduct; or

(iii) the Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on the Respondent's web site or location.

The Complainant advances two contentions in support of this ground:

(a) The disputed domain name is being registered in bad faith.
(b) The disputed domain name is being used in bad faith.

The Complainant has generally dealt with contention (a) above concerning its date of registration and authorisation. The Panel accepts the inference, in the context of the evidence adduced by the Complainant and the Respondent's failure to submit any administratively compliant response, that the disputed domain name was registered in bad faith.

Further, upon the evidence adduced by the Complainant, the Panel is also satisfied that the disputed domain name is being used in bad faith.

The Panel has already accepted, as stated above, that the disputed domain name has been parked. The incorporation of a well-known mark into a domain name coupled with an inactive website, as in the present case, may be evidence of bad faith registration and use. See Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003; CBS Broadcasting, Inc. v. Dennis Toeppen, WIPO Case No. D2000-0400.

The Complainant asserts that it sent a cease-and-desist letter to the Respondent on 2019-05-13 via the email address <joeodak@aol.com> as provided in the WHOIS record and a further two reminders sent on 2019-05-24 and 2019-05-31. The Respondent has failed or refused to respond to any of the Complainant's emails.

By the Respondent's silence or lack of response, it is open for the Panel to infer that the Respondent acted in bad faith within any of the circumstances set out in paragraph 4(b) of the Policy when registering the disputed domain name.

The Panel has already accepted, as stated above, that the Complainant's trademark is well-known worldwide, highly distinctive and well-established.

Given the worldwide nature of the Complainant's business and the fact that its trademark is registered and used in the United States of America and numerous other countries, the Panel considers that it is inconceivable that the Respondent may have registered a domain name joining the terms 'jobs' and 'us' with 'novartis' without knowing of the Complainant's trademark and/or domain name.

Accordingly, the Panel considers that the registration and use of the disputed domain name were in bad faith, and paragraph 4(a)(iii) of the Policy is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTISJOBSUS.COM**: Transferred

PANELLISTS

Name	**Professor William Lye, OAM QC**

DATE OF PANEL DECISION 2019-09-18

Publish the Decision