Decision for dispute CAC-UDRP-102629

Case number	CAC-UDRP-102629
Time of filing	2019-08-20 09:56:33
Domain names	novartispharmaceutical.website

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Name	elobb y

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

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 India.

Amongst many other trademarks worldwide, the Complainant is the proprietor of the Indian trademark registration NOVARTIS 700020 applied for on February 28, 1996.

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 Respondent registered the disputed domain name on 3 April 2019.

The trademark registrations and the domain names registrations predate the registration of the disputed domain name.

The Complainant has previously successfully challenged several NOVARTIS disputed domain names through UDRP processes (see among others the following CAC cases: 101726, 101736, 101652, 101653, 101654. 102542, 102602,

102627).

FACTUAL BACKGROUND

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

I. LANGUAGE OF PROCEEDINGS

The language of the proceeding is English.

Reasons:

The Complainant requested that the proceeding language should be English because the Respondent obviously understands English even though the language of the Registration Agreement of the disputed domain name is a language other than English.

The Panel met the request raised by the Complainant because according to the WHOIS record the Respondent is located in India where English is a widely-spoken language, The Respondent chose to register the disputed domain name incorporating the trademark NOVARTIS and the term “pharmaceutical”. This term is in English and as such correctly spelled. The Complainant is a global company whose business language is English, and the main website operated by the Complainant is in English (see novartis.com). The proceeding will likely be put through unnecessary trouble and delay if any other languages used in India were made as 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. Moreover the Respondent has chosen to register the disputed domain name under the Top-Level domain name “.com” which is a commercial TLD, applicable to a broader audience than merely India.

II. ABOUT COMPLAINANT AND THE BRAND NOVARTIS

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

The Complainant has a strong presence in India where the Respondent is located. 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: <novartis.com>

Local Website for NOVARTIS in India: <novartis.in>

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

In order to succeed in its claim, the Complainant has to prove that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied:

(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 rights or legitimate interests with respect to the disputed domain name; and

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

It was well established that the Complainant is among others the proprietor of the worldwide trademark NOVARTIS.

A. THE DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR

The disputed domain name is identical and accordingly confusingly similar to the Complainant´s mark. The disputed domain was registered in April 2019 and incorporated the Complainant's distinctive trademark NOVARTIS combined with the term "pharmaceutical", which is closely related to the Complainant's business.

The gTLD .website does not create any distinctiveness to the disputed domain name.

The Panel therefore considers the disputed domain name to be confusingly similar to the trademark NOVARTIS in which the Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

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 Respondent has not found that it 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 "novartis" and "pharmaceutical" in the Google search engine, the returned results pointed to the Complainant's business activities only.

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 the Complainant and that the Complainant has been using its trademarks in India. The 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.

Even though the Complainant sent out the cease-and-desist letter, the disputed domain name did not resolve to any active website.

The Panel has not found that the Respondent's use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, nor is it making a legitimate noncommercial or fair use of the

disputed domain name.

The Panel therefore finds that the Respondent does not have rights or legitimate interests in the disputed domain name in accordance with paragraph 4(a)(ii)of the Policy).

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

i. THE DOMAIN NAME WAS REGISTERED IN BAD FAITH

The Complainant's trademark rights pre-date 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. It is inconceivable that incorporating the well-known trademark NOVARTIS in the disputed domain name combined with a closely relevant term "pharmaceutical" is not a deliberate and calculated attempt to improperly benefit from the Complainant's rights.

ii. THE DOMAIN NAME IS BEING USED IN BAD FAITH

The finding of bad faith is supported by the Panels finding that the mere registration of the disputed domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.

The Panel finds the non-use of a domain name which would not prevent a finding of bad faith under the doctrine of passive holding and can refer to the WIPO Case No. D2000-0003 Telstra Corporation Limited v. Nuclear Marshmellows that the registration and passive holding of a domain name which has no other legitimate use and clearly refers to the Complainant's trademark may constitute registration and use in bad faith.

The Panel finds that the Complainant tried to contact the Respondent on 13 May 2019 through a cease-and-desist letter by contacting the Registrar. 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. Despite two reminders on 24 May 2019 and 31 May 2019 the Respondent has disregarded the communication from the Complainant. Moreover, the Registrar has replied on 31 May 2019 as follows: "Please note, the domain name has been suspended from our end due to fraudulent activities." Since then the website associated to the disputed domain name has been suspended. The Registrar's response confirmed that the Respondent has been using the disputed domain name in bad faith. The Complainant attempted to contact the Respondent via email address on 20 June 2019 and 23 July 2019 in order to solve the matter amicably but the Respondent has not responded to such communication. Since the efforts of trying to solve the matter amicably were unsuccessful, the Complainant chose to file a Complaint according to the UDRP process. The failure of a respondent to respond to a cease-and-desist letter, or a similar attempt at contact, is considered relevant in a finding of bad faith.

The Panel therefore finds that the Respondent does not have rights or legitimate interests in the disputed domain name in accordance with 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. **NOVARTISPHARMACEUTICAL.WEBSITE**: Transferred

PANELLISTS

Name	**JUDr. Vojtěch Trapl**

DATE OF PANEL DECISION 2019-10-23