Decision for dispute CAC-UDRP-102685

Case number	CAC-UDRP-102685
Time of filing	2019-09-24 11:36:45
Domain names	novartis.company

Case administrator

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

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Organization	agencija RAPTOR

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant bases its Complaint on the Serbian trademark registration “NOVARTIS”, No. 43554, registration date 4.12.2000 and the International trademark registration “NOVARTIS”, No. 663765, which designates, among others, Serbia as country for protection, registration date 1.07.1996.

The Complainant is the owner of other NOVARTIS trademark registrations throughout the world.

FACTUAL BACKGROUND

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

I. LANGUAGE OF PROCEEDINGS REQUEST:

As the language of the Registration Agreement of the disputed domain name is English according to the Registrar Verification, the language of 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. 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 is the owner of the well-known trademark NOVARTIS, registered as a word and figurative mark in several classes across numerous countries all over the world (see the overview of the registered trademarks below). In addition, Complainant has an actively strong presence in Serbia and has set up offices for local business operation. 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 Serbia: www.novartis.rs/

For more information about the Complainant, please see the Complainant´s Annual report for 2018 available at www.novartis.com/.

Serbia Trademark Registrations

Trademark: NOVARTIS
Reg. no: 43554
Registration date: 2000-12-04

Trademark: NOVARTIS
Reg. no: 663765
Registration date: 1996-07-01

These trademark registrations predate the registration of the Disputed Domain Name. 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 Serbia. 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 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 several domain names containing the term "NOVARTIS", for example, <novartis.com> (created on April 2, 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 DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR

The domain name <novartis.company> (the "Disputed Domain Name"), which was registered on 31 July 2019 according to the WHOIS record, wholly incorporates the Complainant's well-known trademark, NOVARTIS. The addition of the gTLD ".company" does not add any distinctiveness to the Disputed Domain Name. To the contrary, as "company" is a dictionary word and it is a synonym to "corporation" and "enterprise", the Disputed Domain Name creates the impression that the Respondent is the official entity of the Complainant.

Referring to Sanofi v. Yangkai, Case No. D2018-0054, the panelist states that: "The disputed domain name <sanofi.ink> integrates the Complainant's SANOFI trademark in its entirety. The disputed domain name and the Complainant's trademark differ in the addition of the generic Top-Level Domain ('gTLd') '.ink' to the disputed domain name. This addition does not avoid confusing similarity (see F. Hoffmann-La Roche AG v. Macalve e-dominios S.A., WIPO Case No. D2006-0451; Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003; and Volkswagen AG v. Hui Min Wang, Wang Hui Min, WIPO Case No. D2017-0860). The gTLD '.ink' is without significance in the present case since the use of a gTLD is technically required to operate a domain name."

The same reasoning should apply in the current case and the Disputed Domain Name should be considered as identical to the trademark NOVARTIS.

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

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.

UDRP panels in previous cases have found that in the absence of any license or permission from the Complainant to use such widely-known trademarks, no actual or contemplated bona fide or legitimate use of the domain name could be claimed (Groupe Auchan v. Gan Yu, WIPO Case No. D2013-0188; and LEGO Juris A/S v. DomainPark Ltd., David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host Master, WIPO Case No. D2010-0138).

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 "Novartis" or "Novartis Serbia" in the Google search engine, the returned results all point to the Complainant and its business activities.

The Respondent could easily perform a similar search before registering the Disputed Domain Name and would have quickly learnt that: i) NOVARTIS is the name of a global pharmaceutical company and its products, ii) trademarks NOVARTIS are owned by the Complainant, iii) the Complainant has been using its trademarks in Serbia.

By the time the Complainant prepared this Complaint on 19 September 2019, the Disputed Domain Name resolved to an active website with clusters of various information, e.g. information about jobs, cars and motorcycles, crypto currency, etc. with the term "novartis.company" displayed in the upper-left corner of the webpage. Furthermore, the Respondent has the Disputed Domain Name listed for sale on Afternic.com for an amount of USD 25 000. The Respondent has been using the Disputed Domain Name for its own business and for commercial gain, which is far in excess of any apparent registration costs. Therefore it has not by virtue of the content of the website, nor by its use of the Disputed Domain Name shown that the Disputed Domain Name will be used in connection with a bona fide offering of goods or services.

The Complainant has sent the Respondent a cease-and-desist letter on 12 August 2019 to its e-mail address and via the Registrar, notifying Respondent about the prior rights of Complainant and requested transfer. The Complainant found the Respondent's e-mail by clicking the "About" on the bottom line of the webpage of Disputed Domain Name as it directs to the Respondent's official website <rapttor.com>, then found the Respondent's contact e-mail office@rapttor.com on its website.

In the public WHOIS, such e-mail information was not disclosed.

The Respondent replied on 28 August 2019 after the Complainant sent it a reminder on 26 August 2019. In its email, it considered itself not infringing the Complainant's rights, however, without providing valid argument of any prior rights or legitimate interest over the Disputed Domain Name.

There is no evidence that the Respondent has a history of using, or preparing to use, the Disputed Domain Name in connection with a bona fide offering of goods and services. As a fact, since the trademark NOVARTIS is well-known and distinctive, the intention of the Respondent, when registering the Disputed Domain Name, was to take advantage of the reputation of the Complainant.

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

i. THE DISPUTED DOMAIN NAME WAS REGISTERED IN BAD FAITH

It should be highlighted that the registration of the Complainant's trademarks pre-dates the registration of the Disputed Domain Name, moreover, the active business presence of the Complainant in the Serbian market in the last years shows that it is unlikely that the Respondent was not aware of the unlawful registration of the Disputed Domain Name. However, the Respondent still has chosen to incorporate the well-known, distinctive trademark NOVARTIS in the Disputed Domain Name – such conduct, from the Complainant's perspective, it is inconceivable that the Respondent did not have the well-known trademark NOVARTIS in mind when it registered the Disputed Domain Name and registered it only for the purpose to improperly gain benefit from the Complainant's rights.

ii. THE DISPUTED DOMAIN NAME IS BEING USED IN BAD FAITH

As noted in the previous paragraphs, the Disputed Domain Name resolves to an active website with clusters of various information, e.g. information about jobs, cars and motorcycles, crypto currency, etc. with the term "novartis.company" displayed in the upper-left corner of the webpage. Furthermore, the Respondent has the Disputed Domain Name listed for sale on Afternic.com for an amount of USD 25 000.

Also noted in the previous paragraphs that on the website associated to the Disputed Domain Name, the Respondent has put "novartis.company" on the upper-left corner and a link to its own website in the "About" sector.

Since the Disputed Domain Name incorporates the well-known, distinctive trademark NOVARTIS in its entirety, it is reasonable to infer that 1. the Respondent intends to benefit from the reputation of the Complainant's trademark and generate more traffic to its own website associated to the Disputed Domain Name; 2. when consumers see this website under such domain name, it is very likely that they will be confused and be lead to think that the website is in some way related to the Complainant and the Complainant's trademark.

Therefore, by using the Disputed Domain Name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, 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 sent a cease-and-desist letter to the Respondent on 12 August 2019, followed by reminders sent on 26 August 2019. The Respondent replied on 28 August 2019 but refused to comply. The Complainant attempted once more to put Respondent on notice of its earlier trademark rights in a response on 29 August 2019, however, the Respondent not only rejected the Complainant's efforts, but continued to actively use the Disputed Domain Name. The Respondent has further ignored its opportunity to provide possible good faith considerations as to why it registered and is using the Disputed Domain Name, and consequently Complainant has filed this Complaint in accordance with the UDRP process.

From the Complainant's point of view, the Respondent intentionally chose the Disputed Domain Name based on a well-known, distinctive trademark in order to only use it for non-legitimate purposes.

SUMMARY

• NOVARTIS is a distinctive, well-known trademark worldwide.

• Complainant's trademark registrations predate the registration of the Disputed Domain Name.

• Respondent has no rights in the mark NOVARTIS, bears no relationship to the Complainant, and is not commonly known by the Disputed Domain Name, therefore, accordingly has no legitimate interest in the disputed domain name.

• It is highly unlikely that Respondent was not aware of Complainant's prior rights in the trademark NOVARTIS at the time of registering the Disputed Domain Name, given the Complainant's worldwide renown.

• Respondent has the Disputed Domain Name listed for sale for a considerable amount of money.

• Respondent has chosen to put the term "novartis.company" in the upper-left corner of the website associated to the Disputed Domain Name and a link to its own website in the "About" sector of the website.

• Respondent not only rejected to comply with Complainant's cease and desist letter and numerous communication attempts, but also continued to actively use the Disputed Domain Name after being put on formal notice of Complainant's rights.

Consequently, Respondent should be considered to have registered the Disputed Domain Name identical to Complainant's well-known, distinctive trademark NOVARTIS. Complainant has not found that Respondent is of any legitimate right or interest in using the Disputed Domain Name, but rather registered and has been using the Disputed Domain Name 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

I. Identity

The Panel agrees that the Disputed Domain Name incorporates the Complainant's earlier NOVARTIS trademark and that the extension ".company" is not to be taken into consideration when examining the identity between the Complainant's trademarks and the Disputed Domain Name (WIPO Case No. D2005-0016, Accor v. Noldc Inc.). The mere adjunction of a gTLD such as ".company" is irrelevant as it is well established that the generic Top Level Domain is insufficient to avoid a finding identity / confusing similarity (WIPO Case No. 2013-0820, L'Oréal v Tina Smith, WIPO Case No. D2008-0820 Titoni AG v Runxin Wang and WIPO Case No. D2009-0877, Alstom v. Itete Peru S.A.).

Therefore, the Panel is satisfied that the first condition under the Policy is met.

II. Lack of Respondent's rights or legitimate interests

The complainant is required to make out a prima facie case that a respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of proof shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy.

Based on the available evidence, the Respondent does not appear to be known by the Disputed Domain Name. The Respondent is not a licensee of, nor has any kind of relationship with, the Complainant. The Complainant has never authorised the Respondent to make use of its trademark, nor of a confusingly similar trademark in the Disputed Domain Name.

From the provided evidences, the Complainant is present in Serbia and its invoked Serbian trademark registrations predate the date of registration of the Disputed Domain Name. When entering the terms "Novartis" or "Novartis Serbia" in the Google search engine, the returned results point to the Complainant and its business activities and the Respondent could have made these searches prior to the registration of the domain name.

The Respondent has also been informed by the Complainant about its prior rights through the sent cease and desist letter.

The Disputed Domain Name resolves to an active website with clusters of various information, e.g. information about jobs, cars and motorcycles, crypto currency, etc. with the term "novartis.company" displayed in the upper-left corner of the webpage, but also, from the Panel's independent searches, to health information. Also, the Respondent has the Disputed Domain Name listed for sale on Afternic.com for an amount of USD 25 000.

Such use does not amount to a bona fide offering of goods or services, or to a legitimate non-commercial or fair use of a domain name.

The Panel notes that the Respondent had an opportunity to comment on the Complaint's allegations by filing a Response, which the Respondent failed to do.

Thus, the Panel is satisfied that the Complainant has at least established a prima facie case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. Accordingly, the Panel takes the view that also the second requirement under the Policy is met.

III. Bad Faith

The Complainant's trademark is a well-known one as recognized also by past panel and the Disputed Domain Name is incorporating in its entirety the Complainant's trademark. Therefore, the Panel concludes that at the time of registration of the Disputed Domain Name, the Respondent was well aware of the Complainant's trademark and has intentionally registered

one in order to benefit from the reputation of the Complainant’s trademark.

In the present case, the following factors should be considered:

(i) the Complainant's trademark is a well-known one, being also highly distinctive;

(ii) the Respondent failed to submit any response and has not provided any evidence of actual or contemplated good faith use of the Disputed Domain Name;

(iii) the Respondent registered the Disputed Domain Name containing in its entirety a well-known trademark; and

(iv) any good faith use of the Disputed Domain Name would be implausible, as the trademark NOVARTIS is univocally linked to the Complainant and the Respondent has no business relationship with the Complainant, nor was ever authorised to use a domain name identical to the Complainant's trademark.

In light of the foregoing, the Panel concludes that the Respondent has registered and has been using the Disputed Domain Name in bad faith. Thus, also the third and last condition under 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. **NOVARTIS.COMPANY**: Transferred

PANELLISTS

Name	**Delia-Mihaela Belciu**

DATE OF PANEL DECISION 2019-11-04

Publish the Decision