Decision for dispute CAC-UDRP-102551

Case number	CAC-UDRP-102551
Time of filing	2019-08-13 12:31:47
Domain names	novartis.group

Case administrator

Name	Lenka Náhlovská (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BrandIT GmbH

Respondent

Name	Zhi Hong Huang

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the trademark NOVARTIS (International Trademark Registration No. 663765) registered on July 1, 1996.

The Complainant is also the holder of several domain names, including the domain names <novartis.com>, registered on April 2, 1996, and <novartis.net>, registered on April 25, 1998.

FACTUAL BACKGROUND

The Complainant, Novartis AG, is a global healthcare company based in Switzerland. Novartis manufactures many pharmaceutical drugs. In 2018, products manufactured by the Complainant are sold in about 155 countries worldwide and reach nearly 800 million people globally.

The disputed domain name, <novartis.group>, was created on July 19, 2019 and resolves to an inactive page.

On July 26, 2019, the Complainant sent an email to Chengdu West Dimension Digital Technology Co., Ltd, the registrar of the

disputed domain name ("the Registrar"), requesting that the Registrar forward a cease-and-desist letter to the Respondent. On August 6, 2019, the Complainant sent another email to the Registrar, requesting that the Registrar forward a reminder to the Respondent. The Registrar replied to the Complainant's email on August 7, 2019, informing the Complainant that they had forwarded the cease-and-desist letter to Respondent. On the same day, the Registrar sent another email to the Complainant, informing the Complainant that the Respondent was willing to consider selling the disputed domain name for a suitable price.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant contends that the disputed domain name is confusingly similar to the NOVARTIS mark on the basis that the disputed domain name incorporates the Complainant's well-known and distinctive trademark NOVARTIS in its entirety, and the addition of the generic top-level domain ("gTLD") ".group" is insufficient to avoid the likelihood of confusion with the NOVARTIS mark.

The Complainant also argues that the Respondent does not have any rights or legitimate interests in the disputed domain name. The Respondent is not affiliated with the Complainant nor did the Complainant license or authorize the Respondent to use the NOVARTIS mark.

The Complainant further asserts that the disputed domain name has been registered and is being used in bad faith as the Respondent should have known of the NOVARTIS mark at the time of registration of the disputed domain name. The Complainant also asserts that the domain name is being used in bad faith, that the Respondent registered the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name to the Complainant.

RESPONDENT:

The Respondent did not reply to the Complainant's contentions.

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, failed to show 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

Language of the Proceedings

Paragraph 11 of the Rules for Uniform Domain Name Dispute Resolution Policy ("the Rules") provides that:

“(a) Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.”

The language of the Registration Agreement for the disputed domain name is Chinese.

The Complainant requested that the language of the proceeding be English.

The Respondent did not comment on the language of the proceeding.

The Panel cites the following with approval:

“Thus, the general rule is that the parties may agree on the language of the administrative proceeding. In the absence of this agreement, the language of the Registration Agreement shall dictate the language of the proceeding. However, the Panel has the discretion to decide otherwise having regard to the circumstances of the case. The Panel’s discretion must be exercised judicially in the spirit of fairness and justice to both parties taking into consideration matters such as command of the language, time and costs. It is important that the language finally decided by the Panel for the proceeding is not prejudicial to either one of the parties in his or her abilities to articulate the arguments for the case.” (See Groupe Auchan v. xmxzl, WIPO Case No. DCC2006- 0004.).

The Panel finds that in the present case, the following should be taken into consideration upon deciding on the language of the proceeding:

(i) the disputed domain name consists of Latin letters, rather than Chinese characters;

(ii) the gTLD “.group” is an English word;

(iii) the Respondent communicated with the Complainant in both the English and Chinese languages and the Panel assumes the Respondent has a working knowledge of the English language;

(iv) the Complainant may be unduly disadvantaged by having to conduct the proceeding in the Chinese language; and

(v) the Respondent did not object to the Complainant’s request that English be the language of the proceeding.

Having regard to the above, the Panel determines that English be the language of the proceeding.

Principal Reasons for the Decision

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. The Complainant has provided evidence that it owns the trademark NOVARTIS.

The disputed domain name <novartis.group> reproduces the NOVARTIS mark in its entirety. The only difference between the disputed domain name and the NOVARTIS mark is the addition of the gTLD “.group”.

It is widely established that the addition of a gTLD to a disputed domain name does not avoid confusing similarity (see Accor v. Noldc Inc. WIPO Case No. D2005-0016; 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; L'Oréal v Tina Smith, WIPO Case No. 2013-0820; Titoni AG v Runxin Wang, WIPO Case No. D2008-0820; and Alstom v. Itete Peru S.A. WIPO Case No. D2009-0877). The addition of the gTLD ".group" in the disputed domain name is therefore without significance in the present case since the use of a TLD is technically required to operate a domain name.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the NOVARTIS mark and the element under paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires the complainant to show that the respondent has no rights or interests in respect of the domain name. Once the complainant establishes a prima facie case that the respondent lacks rights or legitimate interests in the disputed domain name, the burden of production shifts to the respondent to show that it has rights or legitimate interests in respect to the disputed domain name (see WIPO Overview 3.0, paragraph 2.1).

In the present case, the Complainant has demonstrated prima facie that the Respondent lacks rights or legitimate interests in respect of the disputed domain names and the Respondent has failed to assert any such rights or legitimate interests.

The Complainant has showed that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant also submitted evidence that it did not authorize or license the Respondent to use the NOVARTIS mark (See OSRAM GmbH. v. Mohammed Rafi/Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org, WIPO Case No. D2015-1149; Sanofi-Aventis v. Abigail Wallace, WIPO Case No. D2009-0735). Further, the Complainant has showed that the Respondent is not commonly known by the disputed domain name.

The Respondent did not submit a response in the present case and did not provide any explanation or evidence to show rights or legitimate interests in the disputed domain name which is sufficient to rebut the Complainant's prima facie case.

The Panel is therefore of the view that the Respondent has no rights or legitimate interests in respect of the disputed domain name and accordingly, paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

The complainant must show that the respondent registered and is using the disputed domain name in bad faith (Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy provides circumstances that may evidence bad faith under paragraph 4(a)(iii) of the Policy.

The Complainant has submitted evidence that the disputed domain name was created long after the NOVARTIS mark was registered. The Complainant's evidence has shown that the NOVARTIS mark has been registered since 1996 whereas the disputed domain name was only created in July 2019. Therefore, the prior registration of the NOVARTIS mark is suggestive of the Respondent's bad faith when he acquired the disputed domain name (see Sanofi-Aventis v. Abigail Wallace, WIPO Case No. D2009-0735).

The Complainant argued that the Respondent knew of the NOVARTIS mark at the time when he registered the disputed domain name because the NOVARTIS mark is well known throughout the world and has been registered multiple times. The Complainant further argued that the Respondent would have been aware of the Complainant and the NOVARTIS mark if he had conducted an Internet search on either Google or Baidu (a Chinese search engine). The Complaint has submitted evidence showing the search results on Google and Baidu. The Panel further notes that the Complainant has established that its NOVARTIS trademark has been recognized in prior UDRP cases as well-known in connection with the Complainant's activity.

Given the fame and the distinctive nature of the NOVARTIS mark, the Panel finds that it inconceivable that the Respondent could have acquired the disputed domain name without knowledge of the NOVARTIS mark. (See Leite's Culinaria, Inc. v. Gary

Cieara, WIPO Case No. D2014-0041; WIPO Overview 3.0, paragraph 3.2.2).

Next, the disputed domain name is presently inactive and resolves to a blank page. Where passive holding is found, non-use of a domain name would not prevent a finding of bad faith, and a panel will look at the totality of circumstances in each case (see WIPO Overview 3.0, section 3.3; Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003). Examples of factors considered by previous UDRP panels include: "(i) the degree of distinctiveness or reputation of the complainant's mark; (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use; (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement); and (iv) the implausibility of any good faith use to which the domain name may be put."
In this case, the Panel is of the view that the particular circumstances of the present case strongly suggest that the Respondent's non-use of the disputed domain name is in bad faith. The NOVARTIS mark owned by the Complainant is highly distinctive and has been widely used worldwide, including in China. The Respondent had failed to submit a response and it is implausible that there is any good faith use to which the disputed domain names may be put (see WIPO Overview 3.0, section 3.3; Cloudflare, Inc. v. Private Registrant, Digital Privacy Corporation / Richard Sheng, WIPO Case No. DAI2019-0001; Philip Morris Products S.A. v. Han Ming, Lin Cheng, WIPO Case No. D2018-1635). In addition, the Respondent did not submit a Response in this proceeding and used a privacy shield to hide their identity. These are all further indications of the Respondent's bad faith, which were considered by the Panel.

Paragraph 4(b)(i) of the Policy also provides that it will be evidence of bad faith registration and use by a respondent, if there are 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 or to a competitor of that complainant, for valuable consideration in excess of the documented out-of-pocket costs directly related to the domain name. Factors that a panel would consider include: (i) the respondent's likely knowledge of the complainant's rights, (ii) the distinctiveness of the complainant's mark, and (iii) threats to "sell to the highest bidder" or otherwise transfer the domain name to a third party" (see WIPO Overview 3.0, section 3.1.1; Bayerische Motoren Werke AG v. James Vergis, Stressfree Driving School Pty Ltd, WIPO Case No. D2017-0071).

In the present case, the Complainant has provided evidence of correspondence with the Respondent prior to the commencement of this proceeding. The Complainant issued a cease-and-desist letter to the Respondent. The Respondent responded to the cease-and-desist letter, stating that they could consider selling the disputed domain name and asked for an offer of a suitable price. In response, the Complainant agreed to offer an amount that was not more than the out-of-pocket costs accrued to date, but the Respondent rejected the Complainant's offer, requested for a higher price and threatened to put the disputed domain name for sale online. This is further clear evidence of bad faith registration of the disputed domain name on the Respondent's part.

Based on the evidence presented to the Panel, including the registration of the disputed domain name long after the registration of the Complainant's mark, the confusing similarity between the disputed domain name and the Complainant's mark, the Respondent's offer to sell the disputed domain name at a price in excess of out of pocket expenses, the fact that there is no plausible good faith use the Respondent can put the disputed domain name to, the fact that no Response was submitted by the Respondent, the Panel draws there inference that the disputed domain name was registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTIS.GROUP**: Transferred

PANELLISTS

Name	**Mr. Jonathan Agmon**

DATE OF PANEL DECISION 2019-11-02

Publish the Decision