Decision for dispute CAC-UDRP-102688

Case number	CAC-UDRP-102688
Time of filing	2019-10-07 10:08:55
Domain names	novartispharm.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Organization	Fundacion Comercio Electronico

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

In these proceedings, the Complainant relies on the following trademarks, registered in Panama:

- NOVARTIS (word), Panama Registration No. 80548, registered as of April 25, 1996 (and duly renewed), in the name of Novartis AG (the Complainant);
- NOVARTIS (stylized word), Panama Registration No. 253960, registered as of October 25, 2016, in the name of Novartis AG (the Complainant).

As the present case does not concern a Panama ccTLD but a .com domain name, it is worth noting that, the Complainant owns a plethora of “NOVARTIS” trademarks, covering the majority of the countries of the world, which have not been cited in these proceedings.

FACTUAL BACKGROUND

The Complainant is a well-known large global healthcare / pharma company with some 125000 employees, active in as many as 155 countries around the world, including Panama, where Respondent is based.

The Complainant owns a large-sized portfolio of trademarks worldwide including the wording (and its company name) "NOVARTIS", among which a Swiss (home) registration dating back to February 1996. It also owns a multitude of related domain names, like <novartis.com> since April 2, 1996, <novartis.net> since April 25, 1998 and, even, <novartispharma.com> since October 27, 1999.

The disputed domain name <novartispharm.com> was registered on July 29, 2019 by the Respondent.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

The Complainant contends that the disputed domain name is confusingly similar to its NOVARTIS trademark, as it is a combination of this wholly incorporated trademark and of a generic term. This last element is sufficient to support the finding that the disputed domain name is confusingly similar to the Complainant's trademark. The mere addition of a generic term to the Complainant's trademark does not change the overall impression of a most likely connection with the trademark NOVARTIS of the Complainant. The specific term (PHARM) makes the confusion stronger, as it directly relates to the Complainant's activities. As to the gTLD ".com", the Complainant suggests that it should be disregarded, as per the usual practice.

The Complainant maintains that the Respondent lacks rights or legitimate interests in the disputed domain name because the Respondent is not known by the disputed domain name, the Complainant is not affiliated with the Respondent nor has it ever authorised the Respondent to register its trademark as a domain name, and the Complainant has no business with the Respondent.

According to the Complainant, given the seniority, distinctiveness and worldwide reputation of the NOVARTIS trademark, the Respondent registered the disputed domain name with full knowledge of the Complainant's trademark in an intentionally designed way, with the aim to create a likelihood of confusion with the Complainant's trademarks and domain names, and this is evidence of the fact that the disputed domain name was registered in bad faith.

With respect to use in bad faith, the Complainant points out that the Respondent has used the disputed domain name so as to redirect users to what appears to be a fraudulent/inactive website, a fact that -in combination with the incorporation of a famous trademark in a domain name- proves use in bad faith. Further, the Complainant claims that the Respondent has demonstrated a pattern of other bad faith registrations, listed the disputed domain name for sale, did not respond to its cease and desist letter and concealed its identity through a privacy company.
For all these reasons, the Complainant concludes that the Respondent registered and used the disputed domain name in bad faith.

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).

The disputed domain name consists of the Complainant's whole trademark (NOVARTIS), in combination with a generic word (PHARM). The addition of the specific generic word in the disputed domain name is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark of the Complainant. Such word (PHARM) actually reinforces the confusion, as it relates directly to the activities of the Complainant.

As far as the gTLD ".com" is concerned, it is generally recognized that top level domains do not have any bearing in the assessment of identity or confusing similarity, according to paragraph 4(a)(i) of the Policy.

Hence, the Panel is satisfied that the first requirement under the Policy is met.

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).

Since proving a negative fact is almost impossible, panelists in UDRP proceedings have generally agreed that it is sufficient for the Complainant to establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name to shift the burden of proof to the Respondent.

In the case at issue, the Complainant argued that it had never authorised the Respondent to register the NOVARTIS trademark in a domain name, and that it had never licensed its trademarks to the Respondent.

Furthermore, the Respondent has not demonstrated any use of the disputed domain name in connection with a bona fide offering of goods and services or a legitimate non-commercial or fair use of the disputed domain name.

Finally, there is no other evidence in the case file that could demonstrate that the Respondent has been commonly known by the disputed domain name.

In view of the foregoing, the Panel is satisfied that the Complainant has established a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name. In order to rebut the Complainant's arguments, the Respondent had the possibility to make his own defense. However, the Respondent has chosen not to file a Response.

Therefore, the Panel is satisfied that also the second requirement under the Policy is met.

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).

As far as registration in bad faith is concerned, given the seniority and reputation of the Complainant's trademarks and the fact that the disputed domain name fully incorporates these trademarks (even in combination with a generic term), it is evident that, at the time of the registration of the disputed domain name, the Respondent was well aware of the Complainant's trademark. The registration as domain name of a third party's well-known trademark with full knowledge of the fact that the rights over this trademark belong to a third party amounts to registration in bad faith.

With respect to use in bad faith, the disputed domain name resolves to an inactive website. This fact is to be combined with the full incorporation of the Complainant’s reputable trademark in the disputed domain name. For this Panel, same as for many previous panels, such misleading behaviour clearly amounts to use in bad faith. Consequently, it is impossible to conceive any plausible active use of the disputed domain name that would be legitimate.
Further, from the evidence filed by the Complainant and not refuted by the Respondent, it seems that the Respondent demonstrated a pattern of other bad faith registrations, listed the disputed domain name for sale, did not respond to its cease and desist letter and concealed its identity through a privacy company. All these facts combined also help proving the bad faith of the Respondent.
Therefore, the Panel finds it clear that the disputed domain name was used in bad faith.

For all circumstances mentioned above, the Panel is satisfied that also the third requirement under the Policy is satisfied.

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 disputed domain name wholly incorporates the Complainant's trademarks, written in combination with a generic word. The disputed domain name is therefore confusingly similar to the Complainant's trademark.

The Respondent was not authorised to include the Complainant's trademarks in the disputed domain name, and the Complainant never licensed its trademarks to the Respondent. The Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services, or a legitimate non-commercial or fair use.

The Respondent registered the disputed domain name with full knowledge of the Complainant's reputable trademark. His use of the disputed domain name is in bad faith, as there is no conceivable use of the disputed domain name that could amount to a legitimate use.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTISPHARM.COM**: Transferred

PANELLISTS

Name	**Sozos-Christos Theodoulou**

DATE OF PANEL DECISION 2019-11-12

Publish the Decision