Decision for dispute CAC-UDRP-102724

Case number	CAC-UDRP-102724
Time of filing	2019-10-21 13:24:04
Domain names	novartis.fun

Case administrator

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

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Organization	Zhao Zhi Yong

OTHER LEGAL PROCEEDINGS

This Panel is not aware of any of other legal proceedings.

IDENTIFICATION OF RIGHTS

The Complainant has numerous NOVARTIS trademark registrations worldwide such as, but not limited to:

- Switzerland trademark NOVARTIS No. 2P-427370, registered on July 1, 1996;
- Switzerland trademark NOVARTIS No. 2P-432588, registered on October 31, 1996;
- European Union trademark NOVARTIS No. 000304857, registered on June 25, 1999;
- International trademark NOVARTIS No. 663765, registered on July 1, 1996, designating China;
- International trademark NOVARTIS No. 1249666, registered on April 28, 2015.

Also, the Complainant also owns several domain names containing the trademark NOVARTIS, among them <novartis.com> (created on April 2, 1996), <novartis.net> (created on April 25, 1998) and <novartis.com.cn> (August 20, 1999).

FACTUAL BACKGROUND

Novartis AG (the “Complainant”) is a global pharmaceutical and healthcare company, based in Switzerland and created in 1996 through a merger of two other companies Ciba-Geigy and Sandoz. The Complainant provides solutions to address the

evolving needs of patients worldwide by developing and delivering innovative medical treatments and drugs.

The Complainant is one of the world's largest healthcare companies. Its products are sold in about 155 countries and, in 2018, reached 817 million people in total globally. More than 129 900 people of 147 nationalities are employed by Novartis. The Complainant also have a strong activity and commercial presence in China where the Respondent is located. The Complainant has 8 subsidiaries and associated companies based in China.

The Complainant also enjoys a strong online presence via its official website and social medias. Due to extensive use, advertising and revenue associated with its trademarks worldwide, Complainant enjoys a high degree of renown around the world.

Moreover, the NOVARTIS trademark is well-known as recognized by previous UDRP Panels (See Novartis Ag v. Susan Christensen, WIPO Case No. D2015-0476; Novartis AG v. Hoang Le, WIPO Case No. D2016-0552; Novartis AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org, / Sergei Lir, WIPO Case No. D2016-1688; Novartis AG v. Chenxinqi, CAC Case No. 101918; Novartis AG v. Milen Radumilo, CAC Case No. 102302; Novartis AG v. Anderson Paul, CAC Case No. 102292).

LEGAL GROUNDS:

In accordance with Paragraph 4(a) of the Uniform Dispute Resolution Policy (the "Policy"), in an administrative proceeding the complainant must prove that (i) the domain name registered by the respondent is identical or confusingly similar to a trademark or service mark in which the complainant has rights, (ii) the respondent has no right or legitimate interests in respect of the domain name, and (iii) the domain name has been registered and is being used in bad faith.

A. THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

The Complainant owns numerous NOVARTIS trademarks registered many years before the disputed domain name was created (on August 23, 2019). The disputed domain name incorporates, in its second-level portion, the Complainant's trademark NOVARTIS in its entirety and, in its first-level portion, the generic Top-Level Domain ("gTLD") ".fun". The generic Top-Level Domain ".fun" is a standard registration requirement and should be disregarded when assessing whether a disputed domain name is confusingly similar to the trademark in which the Complainant has rights (see, Sanofi v. Francisco Sánchez Fernández, inserious, WIPO Case No. D2019-0169; Bugatti International S.A. v. Ruanxiaojiao, WIPO Case No. D2017-2555).

The disputed domain name is therefore identical to the Complainant's NOVARTIS trademark.

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

The disputed domain name was registered on August 23, 2019, twenty-three years after the first registrations of the Complainant's NOVARTIS trademarks.

The Complainant has not licensed or authorized the Respondent to register or use the disputed domain name, nor is the Respondent affiliated to the Complainant in any form.

There is no evidence that the Respondent is known by the disputed domain name or owns any registered trademark including the term "novartis" or "novartis.fun". When conducting searches on online trademark databases, no information is found in relation with trademarks corresponding to term "novartis.fun". On the same databases, when entering the term "novartis", the corresponding results are related to the Complainant's NOVARTIS trademarks (Annex 7). Moreover, when

conducting an online search on popular search engines regarding the term “novartis.fun”, no direct results are found in relation with the Respondent organization name. When searching for the terms “novartis” or “novartis.fun” on the same popular Internet search engines, the majority of the hits refer to the Complainant and its trademark NOVARTIS.

The disputed domain name is being passively held. It does not resolve to an active website. There is no evidence showing 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, nor that it is making a legitimate, non-commercial or fair use of the disputed domain name.

For the foregoing reasons, the Respondent must be considered as having no rights or legitimate interests in respect of the disputed domain name.

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

i. The disputed domain name was registered in bad faith

The Respondent registered the disputed domain name twenty-three years after the registrations of the Complainant’s NOVARTIS trademarks. Moreover, the NOVARTIS trademark is well-known, as previously held by UDRP panels, registered in many countries, and the Complainant enjoys a strong online presence. On the most popular search engines, when searching for the term “novartis”, most of the results directly relate to the Complainant, its website, its social medias accounts or related topics. The Complainant is very active on social medias (Facebook, Twitter, Instagram) to promote its mark, products and services. The Complainant is followed by 359,241 on Facebook, 255,000 people on Twitter and 53,700 on Instagram (see, Laboratoires M&L v. Zhaoxingming, CAC Case No. 102277). By conducting a simple online search regarding the term “novartis”, the Respondent would have inevitably learnt about the Complainant, its trademark and business. As previously stated by UDRP panels, in such circumstances, the Respondent would have learnt about the Complaint, its mark and activities (see Intesa Sanpaolo S.p.A. v. Abayomi Ajileye, CAC Case No. 102396) and “it is inconceivable that the Respondent was unaware of the existence of the Complainant when he registered the disputed domain name” (See, Novartis AG v. Chenxinqi, Case No. 101918).

The registration of the disputed domain name combining the well-known trademark NOVARTIS, incorporated entirely in the second-level portion, and the gTLD “.fun” in the first-level portion, is therefore not a coincidence. It is most likely that the Respondent registered the disputed domain name having the Complainant in mind. It reflects the Respondent’s clear intention to create an association, and a subsequent likelihood of confusion, with the Complainant’s trademark in Internet users’ mind. It is most likely that the Respondent registered the disputed domain name to take advantage of the Complainant’s trademark.

Therefore, the Respondent knew the Complainant’s trademark at the time it registered the disputed domain name and registered the disputed domain name in bad faith.

ii. The disputed domain name is being used in bad faith

The disputed domain name is passively held. Previous UDRP panels have held, under the doctrine of passive holding, that “the non-use of a domain would not prevent a finding of bad faith” (see “WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition”, section 3.3). More precisely, “it is possible, in certain circumstances, for inactivity by the Respondent to amount to the domain name being used in bad faith.” (see Telstra Corporation Limited v. Nuclear Marshmallows). The circumstances of the case may indeed be such that “it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant’s rights under trademark law” (see Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003).

In the present case, several factual considerations are clear indicators of bad faith use under the passive holding doctrine.

The disputed domain name entirely comprises the Complaint's well-known NOVARTIS trademark, registered in China where the Respondent is located and used for many years (see Advance Magazine Publishers Inc. and Les Publications Condé Nast S.A. v. ChinaVogue.com, WIPO Case No. D2005-0615; Statoil ASA v. IVAN RASHKOV, WIPO Case No. D2013-1583; Compagnie Générale des Etablissements Michelin v. Pan Jing, WIPO Case No. D2017-1040). In similar circumstances, the high degree of distinctiveness or reputation of the Complainant's trademark is considered as "an indication of bad faith registration and use of the disputed domain name by the Respondent" (see Compagnie Générale des Etablissements Michelin v. Le Van Dong, WIPO Case No. D2018-1522; Carrefour v. Ye Mao, WIPO Case No. D2018-0719). Moreover, the Respondent could not ignore the Complainant and its trademark when it registered the disputed domain name because the Complainant has a strong online presence and several of their subsidiaries have been established in China for many years.

The disputed domain name is passively held. It does not resolve to an active website. There is therefore no evidence of any actual or contemplated good-faith use of the disputed domain name, as previous UDRP panels held (see British Airways Plc. v. David Moor, WIPO Case No. D2006-1224; Boehringer Ingelheim Pharma GmbH & Co.KG v. Raju Khan, CAC Case No. 101517).

The Respondent also did not to reply to the cease and desist letters sent by the Complainant which infers bad faith (see Arla Foods Amba v. Mlanie Guerin, CAC case No. 101640; Medela AG v. Donna Lucius, CAC case No. 101808).

Furthermore, the publicly available WhoIs associated with the disputed domain name has been disclosing partial information on the registrant without showing its full contact details. The registrant's name, city and country only appear. The Respondent's e-mail address, fax and phone numbers have been missing. It is likely that the Respondent is intentionally trying to conceal its identity. Such behaviour is further evidence of bad faith (see Amundi Asset Management v. Amundi, CAC Case No. 102288).

The overall described circumstances are clear demonstration of the implausibility of any good faith use of the disputed domain name (see Alstom v. Itete Peru S.A., WIPO Case No. D2009-0877).

In view of the above, the Complainant registered and has been using the disputed domain name in bad faith.

SUMMARY

In conclusion, Novartis AG – one of the world's largest healthcare companies – owns the well-known trademark NOVARTIS which was registered before the disputed domain name. (i) The disputed domain name is identical to the Complainant's trademark as it fully incorporates the NOVARTIS trademark. (ii) Moreover, the Respondent has no relationship whatsoever with the Complainant or its NOVARTIS trademark, and is not commonly known by the disputed domain name. The disputed domain name is not actively used and there is no evidence showing 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, nor that it is making a legitimate, non-commercial or fair use of the disputed domain name. Hence, the Respondent has no rights or legitimate interest in respect of the disputed domain name. (iii) The Respondent knew the Complainant's well-known trademark when it registered the disputed domain name. The disputed domain name has been passively held and, in light of the circumstances of the case, it is implausible that it could be used in good faith. Consequently, the Respondent has 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

LANGUAGE OF PROCEEDINGS REQUEST

In accordance with Paragraph 11 of the UDRP Rules, unless otherwise agreed by the parties, the language of the proceeding is the language of the registration agreement, subject to the authority of the panel to determine otherwise, exercising its "discretion in the spirit of fairness to both parties, which pursuant to paragraph 10(b) of the Rules have to be treated with equality, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs" (see Carrefour v. Contact Privacy Inc. Customer 1242379769 / Le Berre, WIPO Case No. D2018-1552).

According to the Registrar Verification transmitted by the Czech Arbitration Court on October 22, 2019, the language of the registration agreement is Chinese.

However, the Complainant requests that the language of the proceeding be English based on the following reasons:

The disputed domain name incorporates the Novartis AG's trademark NOVARTIS with the addition of the generic Top-Level Domain ".fun". The term "fun" is a very commonly used adjective in daily English language. The fact that the Respondent chose to register the disputed domain name under such extension shows that the Respondent understands English.

The Respondent has registered other domain names comprising English terms such as the expression "labor law" in <laborlaw.online>, the words "talents" in <tjabtalents.org> or "flow" in <kubeflow.group> . These domain name registrations are further evidence that the Respondent speaks or understands English.

The Complainant is a global company whose business language is mainly English and its main official website at "www.novartis.com" is in English.

Moreover, the language of the registration agreement being Chinese, a translation of the Complaint and subsequent communications in such a language would entail significant additional costs for the Complainant and delay in the proceedings.

The Complainant therefore requests the Panel to exercise its discretion and allow the language of the proceeding to be English.

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 in the language requested by the Complainant.

PRINCIPAL REASONS FOR THE DECISION

Confusing similarity:

The Panel agrees with the Complainant that the disputed domain name is identical to both the Complainant's trademarks and domain names and that the addition of the gTLD .fun must be disregarded in the assessment of identity as per pervious

panel decision.

Consequently, the disputed domain name must be considered identical.

No rights or legitimate interest

The Panel agrees with the Complainant that the trademark NOVARTIS is – at least to some extend – well-known, also outside the Complainant's general business area of pharmaceuticals.

As there have been presented no evidence and as it is considered unlikely that the Respondent is known or has any rights to NOVARTIS, the Panel agrees with the Complainant that the Respondent has no rights or legitimate interest in the disputed domain name.

Bad Faith

Given the fact that the Respondent just recently registered the disputed domain name, the Complainant's claim that 3 months of non-use is "automatically" considered bad faith is not immediately recognised by the Panel.

However, the non-use period, as well as the other factors, including lack of legitimate interest and the notoriety of the NOVARTIS trademark also contribute to the assessment.

Finally, although not essential nor decisive in the assessment of bad faith, the Panel takes into consideration that no administrative response was filed.

The Panel, therefore, concludes, based on all the evidence presented, that the Respondent has registered the disputed domain name 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.FUN**: Transferred

PANELLISTS

Name	**Lars Karnoe**

DATE OF PANEL DECISION 2019-11-28

Publish the Decision