Decision for dispute CAC-UDRP-102788

Case number	CAC-UDRP-102788
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Domain names	novartis-groups.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Organization	Brian Furry Furry

OTHER LEGAL PROCEEDINGS

There are no other legal proceedings the Panel is aware of which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

US Trademark NOVARTIS, Reg. no: 4986124 (1996);
US Trademark NOVARTIS, Reg. no: 2997235 (1997).

FACTUAL BACKGROUND

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

I. LANGUAGE OF PROCEEDINGS REQUEST:

Since the language of the Registration Agreement of the Disputed Domain Name <novartis-groups.com> is English according to the applicable Registrar, 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 (see www.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 the USA 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: www.novartis.com
- Local Website for NOVARTIS in USA: www.pharma.us.novartis.com

For more information about the Complainant, see the Complainant´s Annual report for 2018 available at:

www.novartis.com/sites/www.novartis.com/files/novartis-annual-report-2018-en.pdf

The Complainant is the owner of the well-known trademark NOVARTIS as a word and figure mark in several classes in numerous of countries all over the world including in the USA. These trademark registrations predate the registration of the Disputed Domain Name.

Trademark registration in the USA

Trademark: NOVARTIS
Reg. no: 4986124
First use in commerce: 1996

Trademark: NOVARTIS
Reg. no: 2997235
First use in commerce: 1997

In the 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 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 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.

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 the USA, where the Respondent is located. 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).

LEGAL GROUNDS:

A. THE DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR

The domain name <novartis-groups.com> (hereinafter referred to as the “Disputed Domain Name”), which was registered on 8 October 2019 according to the WHOIS, incorporates entirely the Complainant’s well-known, distinctive trademark NOVARTIS with the symbol “-“ and a generic term “groups”, which is closely related to the Complainant and its business activities. The addition of the gTLD “.com” does not add any distinctiveness to the Disputed Domain Name. See as an example the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0"), paragraph 1.11. as well as the International Business Machines Corporation v. Sledge, Inc. / Frank Sledge WIPO Case No. D2014-0581 where the Panel stated the following:

“In addition, it is generally accepted that the addition of the top-level suffix in the domain name (e.g., “.com”) is to be disregarded under the confusing similarity test”.

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

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 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” and “groups” in the Google search engine, the returned results point to the Complainant and its business activities. The Respondent could have easily performed 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 the USA and many other countries of the world.

The Dispute Domain Name is inactive. The Respondent has not been using the Disputed Domain Name for any bona fide offering of goods or services.

For the foregoing reasons, it shall be concluded that the Respondent has no right nor legitimate interest in respect of the Disputed Domain Name.

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

i. THE 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 and the Respondent has never been authorized by the Complainant to register the Disputed Domain Name. It is inconceivable that the combination of the well-known trademark NOVARTIS and the generic term “groups” in the Disputed Domain Name is not a deliberate and calculated attempt to improperly benefit from the Complainant’s rights.

Additionally, considering the fact that:

• The Respondent very likely knows about the Complainant and its trademark;
• The Complainant’s trademark NOVARTIS is a distinctive, well-known trademark worldwide and in the USA where the Respondent resides;
• The Respondent has failed in presenting a credible evidence-backed rationale for registering the domain name.

The Disputed Domain Name shall be deemed as registered in bad faith, which is supported by WIPO Overview 3.0, para. 3.1.1.:

“If on the other hand circumstances indicate that the respondent’s intent in registering the disputed domain name was in fact to profit in some fashion from or otherwise exploit the complainant’s trademark, panels will find bad faith on the part of the respondent. While panel assessment remains fact-specific, generally speaking such circumstances, alone or together, include: (i) the respondent’s likely knowledge of the complainant’s rights, (ii) the distinctiveness of the complainant’s mark, … (vii) failure of a respondent to present a credible evidence-backed rationale for registering the domain name,…”

ii. THE DOMAIN NAME IS BEING USED IN BAD FAITH

Firstly, as noted in the previous paragraphs, the Disputed Domain Name has been inactive. In the WIPO Case No. D2000-0003 Telstra Corporation Limited v. Nuclear Marshmellows the Panel established 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.

Secondly, the Complainant has tried to reach the Respondent by a cease-and-desist letter sent on 14 October 2019, via the email address <lindacourage837@gmail.com> and also via the registrar’s email abuse@hostinger.com as provided in the WHOIS record. Without receiving reply from the Respondent, subsequently, the Complainant followed up the cease-and-desist letter by two reminders sent on 31 October 2019 and 12 November 2019. However, until the time the Complainant prepared this Complaint, it has not received any response from the Respondent. Since the amicable approach has been unsuccessful, the Complainant chose to file a UDRP.

SUMMARY

• NOVARTIS is a 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 - accordingly it 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 been passively holding the Disputed Domain Name.
• Respondent has not responded to Complainant’s cease and desist letter and reminders.

Consequently, the Respondent should be considered to have registered the Disputed Domain Name confusingly similar to the Complainant’s well-known, distinctive trademark NOVARTIS. The Complainant has not found that the 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

The disputed domain name <novartis-groups.com> incorporates entirely the Complainant's trademark NOVARTIS with the symbol "-" and a generic term "groups". The addition of the word "groups" is not enough to avoid the risk of confusing similarity. In fact, in the Panel's view, the addition of such word have the opposite effect and accrue the impression the domain names relates to the Complainant and/or its group of companies.

The first condition is satisfied.

The Complainant has established a prima facie case (not challenged by the Respondent who did not filed any response to the complaint) that the Respondent has no rights or legitimate interests in the disputed domain name, since (1) the Respondent is not related in any way with the Complainant ; and (2) there is no indication the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services ; and (3) there is no indication that the Respondent is commonly known as 'Novartis'.

The second condition is satisfied.

Novartis is a global healthcare company whose products are sold in about 155 countries and reached nearly 800 million people globally in 2018. About 125 000 people work at Novartis around the world. Its is very unlikely that the Respondent was not aware of the existence of the Complainant. It can be therefore concluded that the Respondent had or should have the Complainant and its trademarks in mind when registering the disputed domain name and the registration has been realized in bad faith.

The disputed domain name is inactive. However, the Panel notes that it was registered on 8 October 2019, i.e. very recently. If the Respondent had presented evidence of serious and concrete preparatory work, the Panel could have admitted that such a short period of inactivity is not sufficient to conclude that the domain name is used in bad faith. However, Respondent's default leaves the Panel without indication of any bona fide offering of goods or services (or preparation thereof).

The third condition is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTIS-GROUPS.COM**: Transferred

PANELLISTS

Name	**Mr. Etienne Wéry**

DATE OF PANEL DECISION 2019-12-20