Decision for dispute CAC-UDRP-102779

Case number	CAC-UDRP-102779
Time of filing	2019-11-15 14:08:18
Domain names	asknovartis.com

Case administrator

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

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Name	dr john reeves

OTHER LEGAL PROCEEDINGS

The Complainant has declared that there are no other legal proceedings, pending or decided, which relate to the disputed domain name. The Panel is not aware of any such proceedings.

IDENTIFICATION OF RIGHTS

The Complainant is the proprietor of various trade marks in respect of the string NOVARTIS, including EUTM 000304857 (first registered 5 July 1996) and US trade mark 2336960 (first registered 4 April 2000), and a registration in the international (Madrid) system (663765, first registered 1 July 1996, on the basis of a Swiss mark), in various classes including class 5 (pharmaceutical products). Amongst its national marks are NOVARTIS in Canada (TMA523129, first registered 15 February 2000. In essence, the process for registering many of the Complainant's marks commenced at its foundation in 1996.

FACTUAL BACKGROUND

The Complainant, a company with its seat in Basel, Switzerland, was established in its present form in 1996, and operates around the world and manufacturers various drugs. Its products are sold in over 150 countries. Canada is one of the countries in which the Complainant has operations. The Complainant operates various websites, including <NOVARTIS.COM> (domain name first registered 2 April 1996) and, concerning its Canadian operations, <NOVARTISPHARMA.CA>.

The Respondent, an individual with an address in Toronto, Canada, registered the disputed domain name on 26 August 2019.

PARTIES CONTENTIONS

No administratively compliant Response has been filed. The Respondent, who never accessed the online platform, appears to have supplied an incomplete postal address, as notice of this Complaint could not be delivered to the address supplied.

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it. The Complainant points to its general activities as well as, on account of the Respondent's supplied address, its specific activities in Canada.

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).

Disregarding the generic TLD in accordance with the normal approach under the UDRP, the Panel notes that the only differences between the remaining text in the disputed domain name ASKNOVARTIS and the Complainant's trade mark NOVARTIS is the text ASK. This is therefore a case where confusing similarity needs to be considered. It is well established that the addition of generic text to text in which a Complainant had rights is unlikely to displace a finding of the disputed name being confusingly similar to the Complainant's mark; see e.g. WIPO AMC Case No. D2011-0203, Advance Magazine Publishers v Arena International, <BUYVOGUE.COM>.

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).

The Complainant has declared that the Respondent has not been granted any right to use its marks, nor is the Respondent affiliated with the Complainant in any way. The Respondent's personal name is not linked to the text included in the disputed domain name in any way.

The Panel must also consider whether there are any plausible grounds through which the Respondent might be exercising rights or legitimate interests. No such grounds are apparent, for various reasons. The Respondent has not engaged in the present proceedings, nor indeed responded to the multiple attempts made by the Complainant to make contact in advance of the commencement of these proceedings. Moreover, the Complainant already publishes information on its own website (since at least 2009), under the heading 'Ask Novartis', which is also formed through a subdomain (WWW.ASK.NOVARTISPHARMA.CA). In contrast, the Respondent has not yet published a substantive website at the disputed domain name which might (however implausibly) show the exercise of rights or legitimate interests. The Panel notes that the addition of descriptive text to a mark can in various circumstances be further considered under paragraph 4(a)(ii) even if confusing similarity has been found under paragraph 4(a)(i). Such disputes concern matters such as criticism, fan sites, resellers, and the like, and may also turn on the presence of reasonable efforts to avoid confusion (e.g. disclaimers, differences in design); in the present case, the Panel has no plausible basis, and certainly no relevant evidence, on which to consider such scenarios.

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).

The Panel is satisfied that the Respondent has acted in bad faith. It is noted, on the basis of the evidence presented by the Complainant, that the Respondent has registered a large number of domain names relating to pharmaceutical products or health issues. While this is not evidence of a pattern of conduct for the purposes of para 4(b)(ii) of the Policy (as, at first glance, most of the other domain names neither relate to the Complainant nor present a prima facie violation of the Policy), the Respondent can on this basis reasonably be assumed to be aware of the Complainant's activities, as the Complainant is a famous and globally-operating company in this sector. Moreover, the Respondent must have been aware (or readily capable of becoming aware of) the specific combination of 'ask' and 'novartis' in the Complainant's long-established web

presence (as already outlined, above). It is further noted that the Respondent has supplied an address in Canada, while the Complainant's 'Ask Novartis' web presence also relates to its Canadian operations and domain name.

The Respondent has neither participated in these proceedings nor responded to the Complainant's efforts to establish contact; indeed, it is likely, on the basis of the Provider's attempts to contact the Respondent, that an incomplete address was supplied at the point of registration.

The Panel also notes the Complainant's contention, supported by authority, that the NOVARTIS mark is distinctive and well-known, and has been acknowledged as such in various decisions made under the Policy.

The disputed domain name is currently being used for an 'under construction' web page, with the text "Website coming soon!

Please check back soon to see if the site is available". The Complainant points to the decision in WIPO AMC D2000-0003, Telstra Corporation v Nuclear Marshmellows, the much-cited early consideration of the application of the Policy in cases of 'passive holding' of domain names. The Panel accepts the relevance of this line of cases, and in particular that of the non-exclusive factors set out in the WIPO Jurisprudential Overview, version 3, para 3.3 ((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)), all four are found.

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under the Policy were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

In the absence of any Response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name. On the other hand, it is clear that the Complainant has rights in respect of the trade mark and company name NOVARTIS, and that the disputed domain name is confusingly similar to this mark (differing only by the addition of the text ASK). In light of the evidence presented by the Complainant, the Panel finds that the disputed domain name was registered and is being used in bad faith, noting in particular the established use of the combination of the words ASK and NOVARTIS in the Complainant's actual web presence. The requirements for the acceptance of a Complaint under paragraph 4 of the Policy have therefore been met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ASKNOVARTIS.COM**: Transferred

PANELLISTS

Name	**Prof Daithi Mac Sithigh**

DATE OF PANEL DECISION 2019-12-24

Publish the Decision