Decision for dispute CAC-UDRP-102723

Case number	CAC-UDRP-102723
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Domain names	novartisclub.com

Case administrator

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

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Organization	luo tian

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

According to the Complainant, Novartis AG 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 China, where the Respondent is located."

The Complainant is the owner of registered trademarks for "NOVARTIS" as a word and figure mark in several classes in numerous countries all over the world, including in China. These trademark registrations predate the registration of the disputed domain name.

The Complainant has registered several domain names including <novartis.com> (registered April 2, 1996) and <novartis.net> (registered 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.

The disputed domain name <novartisclub.com> was registered on October 19, 2019.

FACTUAL BACKGROUND

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

PARTIES' CONTENTIONS:

COMPLAINANT:

• The disputed domain name is identical or confusingly similar to the protected mark

According to the Complainant, the disputed domain name <novartisclub.com>, registered on 19 October 2019 according to the WHOIS, incorporates entirely the Complainant's well-known, distinctive trademark NOVARTIS with a generic term "club", which could be related to the Complainant and its 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 Complainant argues that the same reasoning should apply in the current case and the disputed domain name should be considered as confusingly similar to the trademark NOVARTIS.

• Respondent does not have any rights or legitimate interest in the disputed domain name

The Complainant states that it 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 legitimate interest over the disputed domain name or the major part of it. When entering the terms "Novartis" and "club" in the Google search engine and Baidu search engine, the leading search engine in China, the returned results point to the Complainant and its business activities.

According to the Complainant, 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 China and many other countries of the world. However, the Respondent still chose to register the disputed domain name as such.

From the Complainant's perspective, the Respondent deliberately chose to use the term "club" combined with its well-known, distinctive trademark NOVARTIS in order to confuse internet users as to the source or sponsorship, and/or to attract internet traffic to its own gambling site by benefiting from the Complainant's global renown. The Respondent, therefore, has not been using the disputed domain name for any bona fide offering of goods or services.

Therefore, the Complainant contends that the Respondent has no right nor legitimate interest in respect of the disputed domain name.

• The disputed domain name has been registered and is being used in bad faith

According to the Complainant, the Respondent has registered the disputed domain name and is using it in bad faith. The Complainant states 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.

Given the Complainant's strong presence in China, the Complainant argues that it is inconceivable that the combination of the well-known, distinctive trademark NOVARTIS and the generic term “club” in the disputed domain name is not a deliberate and calculated attempt to improperly benefit from the Complainant’s rights.

Furthermore, the Complainant states that the disputed domain name has been actively used to associate to a website displaying gambling information and providing a link to another gambling website “jyw90.com”. Taking into account the fact that the Complainant is well-known worldwide, the Complainant considers that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or location by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website or location or of a product or service on the Respondent’s website or location.

Considering the fact that i) the Respondent very likely knows about the Complainant and its trademark; ii) the Complainant’s trademark NOVARTIS is a well-known, distinctive trademark worldwide and in China where the Respondent resides; and iii) the Respondent has failed in presenting a credible evidence-backed rationale for registering the disputed domain name, the disputed domain name shall be according to the Complainant deemed as registered in bad faith, which is supported by WIPO Overview 3.0, para. 3.1.1. and para. 3.1.4.

Finally, the Complainant submits that it has tried to reach the Respondent by a cease-and-desist letter sent on 12 November 2019 and without receiving a reply from the Respondent, subsequently, the Complainant followed up the cease-and-desist letter by two reminders sent on November 21, 2019 and December 2, 2019. The Complainant has not received any response from the Respondent. Since the amicable approach has been unsuccessful, the Complainant chose to file a UDRP complaint.

PARTIES CONTENTIONS

RESPONDENT:

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

Under Paragraph 11(a) of the Rules, the language of the administrative proceeding shall be the language of the Registration Agreement, but the Panel may allow the proceeding to be conducted in another language, having regard to the circumstances of the case.

The language of the registration agreement for the disputed domain name is Chinese. The Complaint has been filed in English and the Complainant has requested the proceedings to be in English.

The Complainant submits that:

- on the website associated to the disputed domain name, the English term “telegram” is displayed in the title position of the homepage; other English terms such as “SUNCITY CASINO”, “BET”, “SUNCITY GROUP”, “INTERNATIONAL”, “Chelsea Football Club Official Partners”, etc. are also displayed on the same page;

- the disputed domain name includes the Complainant’s trademark NOVARTIS in its entirety combined with a generic term “club”, which is in English and is correctly spelled;

- the Complainant is a global company whose business language is English, and the main website operated by the Complainant is in English (see www.novartis.com).

The Complainant submits that the Respondent obviously understands English. To avoid any potential unfairness or unwarranted delay in ordering the Complainant to translate the Complaint, the Complainant requests that the proceeding language should be in English.

The Panel accepts that although the Registration Agreement is in Chinese, the Respondent seems to understand English. The disputed domain name is not in Chinese characters but in Latin script. It appears that the Respondent has registered other domain names with words in English ("jyw90.com"). The proceeding will likely be put through unnecessary trouble and delay if Chinese were made the language of the proceeding. The Panel finds that the proceedings should be conducted in 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.

PRINCIPAL REASONS FOR THE DECISION

The UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (UDRP) of the Internet Corporation for Assigned Names and Numbers (ICANN) (the “Policy”) provides that complainant must prove each of the following to obtain transfer or cancellation of the domain name:

1. that respondent’s domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights; and

2. that respondent has no rights or legitimate interests in respect of the domain name; and

3. the domain name has been registered and is being used in bad faith.

1) The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights

The Panel is satisfied that the Complainant is the owner of International trademark registrations for NOVARTIS that predate the registration of the disputed domain name.

The disputed domain name is comprised of the Complainant’s well-known trademark NOVARTIS with a generic term "club". The most distinctive part of the disputed domain name is the Complainant’s mark, NOVARTIS. The addition of the gTLD ".com" does not prevent the disputed domain name being confusingly similar to the Complainant’s trademark NOVARTIS.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark NOVARTIS.

2) The Respondent lacks rights or legitimate interests in the disputed domain name

Under the Policy, a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate

interests. Once such prima facie case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP (see WIPO Overview 2.0, paragraph 2.1).

The Panel finds that the Respondent does not have a legal right to use the term "NOVARTIS" as part of its domain name. The Respondent is not in any way affiliated with the Complainant nor is it authorized to register the disputed domain name. The Panel agrees with the Complainant that the Respondent is not commonly known by the disputed domain name or that it has legitimate interest over the disputed domain name. When entering the terms “Novartis” and “club” in the Google search engine and Baidu search engine, the returned results point to the Complainant and its business activities.

The Panel finds that the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interest in the disputed domain name. The Respondent failed to file a Response in which it could have provided evidence in support of its rights or legitimate interests. The Respondent is not commonly known by the disputed domain name and has not been authorised by the Complainant to use the term "NOVARTIS". Therefore, all these circumstances are sufficient to establish a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name.

The Panel thus takes the view that the Respondent lacks rights or legitimate interests in the disputed domain name.

3) The disputed domain name has been registered and is being used in bad faith

The Panel agrees with the Complainant that its trademark NOVARTIS is distinctive and well-known globally. The Complainant’s well-known trademark NOVARTIS predates the registration of the disputed domain name. The Panel finds that there appears no reason why the Respondent would register the Complainant's trademark as part of the disputed domain name, other than to create the impression that it is connected to the Complainant's business. Given the distinctiveness of the Complainant's trademark worldwide and in China where the Respondent resides and reputation, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark.

The fact that the Respondent has registered the disputed domain name that is confusingly similar to them indicates and in the absence of any evidence contrary (or any administratively compliant response at all) being put forward by the Respondent, that the Respondent, according to this Panel, had knowledge of the Complainant’s trademark and that it had such knowledge prior to the registration and use of the disputed domain name. The Panel thus takes the view that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or location by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website or location or of a product or service on the Respondent’s website or location.

For all reasons stated above, the Panel is satisfied that the Complainant has proven the third element of the Policy that is that the Respondent's registration and use of 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. **NOVARTISCLUB.COM**: Transferred

PANELLISTS

Name	**Mgr. Barbora Donathová, LL.M.**

DATE OF PANEL DECISION 2020-01-09