Decision for dispute CAC-UDRP-102790

Case number	CAC-UDRP-102790
Time of filing	2019-12-03 16:40:49
Domain names	novartispatientassistance.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Organization	Health Matrix Direct, Inc.

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the registered well-known trademark NOVARTIS as a word and figure mark in several classes in numerous countries all over the world including the USA. The trademark registrations with the United States Patent and Trademark Office include: trademark 'NOVARTIS' (reg. no. 2997235; registered on September 20, 2005; first use in commerce: 1997); and trademark 'NOVARTIS' (reg. no: 4986124; registered on June 28, 2016; first use in commerce: 1996).

FACTUAL BACKGROUND

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

Novartis AG (hereinafter referred to as Complainant) is the proprietor of the NOVARTIS trademark. The Complainant is a global healthcare company based in Switzerland that provides solutions to address the evolving needs of patients worldwide (see www.novartis.com). The Complainant 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 is the owner of the registered well-known trademark NOVARTIS as a word and figure mark in several classes in numerous countries all over the world including the USA. The trademark registrations with the United States Patent and Trademark Office include: trademark 'NOVARTIS' (reg. no. 2997235; registered on September 20, 2005; first use in commerce: 1997); and trademark 'NOVARTIS' (reg. no: 4986124; registered on June 28, 2016; first use in commerce: 1996). Due to extensive use, advertising and revenue associated with its trademarks worldwide, the Complainant enjoys a high degree of renown around the world, including 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).

The disputed domain name was registered on November 14, 2011.

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

Paragraph 15(a) of the Rules for the UDRP ('the Policy') instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

(1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
(2) 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.

In view of the Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. See Vertical

Solutions Mgmt., Inc. v. webnet-marketing, inc., FA 95095 (FORUM July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); see also Talk City, Inc. v. Robertson, D2000-0009 (WIPO Feb. 29, 2000) ("In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.").

Rights

The Complainant contends that it is the owner of the registered trademark 'NOVARTIS' in the U.S.A. (reg. no. 2997235 registered on September 20, 2005 and reg. no: 4986124 registered on June 28, 2016). The Panel notes that a trademark registration with the USPTO is sufficient to establish rights in that mark. As such, the Panel finds that the Complainant has established its rights in the mark 'NOVARTIS.'

The Complainant further contends that the disputed domain name is confusingly similar to its mark 'NOVARTIS' on the grounds that i) the disputed domain name incorporates entirely the Complainant's mark NOVARTIS with generic terms "patient" and "assistance", which are closely related to the Complainant's business activities; and the addition of the gTLD ".com" does not add any distinctiveness to the disputed domain name.

The Panel agrees with the Complainant, and thus it finds that the disputed domain name is confusingly similar to the Complainant's trademark NOVARTIS.

No rights or legitimate interests

Complainant must first make a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy paragraph 4(a)(ii), then the burden shifts to Respondent to show it does have rights or legitimate interests. See Croatia Airlines d. d. v. Modern Empire Internet Ltd., WIPO Case No. D2003-0455 (the 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 Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the UDRP). See also Advanced International Marketing Corporation v. AA-1 Corp, FA 780200 (FORUM Nov. 2, 2011) (finding that a complainant must offer some evidence to make its prima facie case and satisfy Policy paragraph 4(a)(ii).

The Complainant contends that it has never granted the Respondent any right to use the NOVARTIS trademark within the disputed domain name, nor is the Respondent affiliated with the Complainant in any form; the Respondent is not commonly known by the disputed domain name; when entering the terms "NOVARTIS" "patient" and "assistance" in the Google search engine, the returned results point to the Complainant and its business activities; and the first results that appeared in the search results are a website with title "Patient Assistance Foundation Enrollment | Novartis US" associated to the domain name novartis.com, which belongs to the Complainant.

The Complainant further contends that the disputed domain name has been actively used to resolve to a website offering a discount card for medications with the trademark NOVARTIS in a prominent position of the homepage of the website and in various positions of the website where the owner is named "Health Matrix Direct, LLC."

Using a confusingly similar domain name to compete with a complainant can evince a failure to make a bona fide offering of goods or services or a legitimate noncommercial or fair use under the Policy. See Vanguard Trademark Holdings USA LLC v. Dan Stanley Saturne, FA 1785085 (FORUM June 8, 2018) ("Respondent's use of the disputed domain name does not amount to a bona fide offering of goods or services or a legitimate noncommercial or fair use" where "Respondent is apparently using the disputed domain name to offer for sale competing services."). As such, the Panel holds that the Respondent's competing use of the disputed domain name provides evidence of Respondent's lack of rights and legitimate interests under paragraph 4(c)(i) and/or (iii) of the Policy.

The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or

attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

Bad faith
Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:
(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that the complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or
(ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online 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.
The Complainant contends that the Complainant's trademarks predate the registration of the disputed domain name; and the Respondent very likely knows about the Complainant and its trademark because the Complainant's trademark NOVARTIS is a distinctive, well-known trademark worldwide and in the USA where the Respondent resides.

The Panel infers, due to the notoriety of the Complainant's mark and the manner of use of the disputed domain name by the Respondent that the Respondent had actual knowledge of the Complainant's mark at the time the Respondent registered the disputed domain name. As such, the Panel finds that the Respondent registered the disputed domain name in bad faith.

Next, the Complainant contends that the Respondent has been using the disputed domain name to associate to a website which could probably mislead Internet users to believe that it was in some way authorized or affiliated to the Complainant, and therefore failed in presenting a credible evidence-backed rationale for registering the domain name; specifically the disputed domain name has been actively used to associate to a website offering a discount card for medications with the trademark NOVARTIS in a prominent position of the homepage of the website and in various positions of the website; and 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; the Respondent has not responded to the Complainant's cease-and-desist letter and reminder; and the Respondent has provided false WHOIS information.

The Panel agrees with the Complainant and finds that the above constitutes bad faith registration and use of the disputed domain name per paragraph 4(b) (iii) and (iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTISPATIENTASSISTANCE.COM**: Transferred

PANELLISTS

Name	**Mr. Ho-Hyun Nahm, Esq.**

DATE OF PANEL DECISION 2020-01-10