

Decision for dispute CAC-UDRP-102805

Case number	CAC-UDRP-102805
Time of filing	2019-12-23 09:13:05
Domain names	novartis-venturefunds.com

Case administrator

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

Organization	Novartis AG
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Complainant representative

Organization	BRANDIT GmbH
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Respondent

Organization	Soni Consultants Inc
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OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant owns the following trade mark registrations in the United States:

- (i) Word mark NOVARTIS, registration number 4986124, which was registered on 28 June 2016; and
- (ii) Word mark NOVARTIS, registration number 2997235, which was registered on 20 September 2005.

FACTUAL BACKGROUND

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

Novartis is a global healthcare and drug manufacturing company based in Switzerland. Its products are sold in about 155 countries.

The Complainant owns the well-known trade mark NOVARTIS in several classes in numerous countries all over the world, including in the USA, which predate the registration of the disputed domain name.

The Complainant has a strong presence in the USA where the Respondent is located. The Complainant's official websites are:

- Global Website for NOVARTIS: <https://www.novartis.com>
- Local Website for NOVARTIS in USA: <https://www.pharma.us.novartis.com>

The Complainant has registered a number of domain names containing the term "NOVARTIS", for example:

- <novartis.com>, which was created on 2 April 1996.
- <novartis.net>, which was created on 25 April 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 was registered on 22 October 2019.

The Complainant sent a cease and desist letter to the Respondent on 21 November 2019 via the e-mail address <novartis-venturefunds.com@domainsbyproxy.com>. A follow up e-mail was sent on 2 December 2019. The cease and desist letter was also sent via the Registrar online contact form on 31 October 2019, and reminders sent on 21 November 2019 and 2 December 2019. The Complainant received no reply.

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 trade mark 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 the UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements:

- (i) The disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;
- (ii) The Respondent has no rights or legitimate interests in the disputed domain name; and

(iii) The disputed domain name has been registered and is being used in bad faith.

A. IDENTICAL OR CONFUSINGLY SIMILAR

The Complainant contends that the disputed domain name is confusingly similar to its well-known trade mark NOVARTIS.

It is generally accepted that the addition of the top-level suffix “.com” does not add any distinctiveness to a domain name and can be disregarded when assessing whether the disputed domain name is confusingly similar to the Complainant’s trade mark. See *International Business Machines Corporation v. Sledge, Inc./Frank Sledge* (WIPO Case No. D2014-0581).

The disputed domain name is made up of the Complainant’s trade mark NOVARTIS and the generic terms “venture funds”. The most distinctive part of the disputed domain name is the word “NOVARTIS”. The addition of the generic terms “venture funds”, which are related to the Complainant’s business activities, do not avoid the overall impression that the disputed domain name is confusingly similar to the Complainant’s trade mark NOVARTIS.

The Panel finds that the disputed domain name is confusingly similar to the Complainant’s trade mark NOVARTIS and that the requirements of paragraph 4(a)(i) of the Policy have been met.

B. NO RIGHTS OR LEGITIMATE INTEREST

The Complainant asserts that:

(i) It has never granted the Respondent any right to use the NOVARTIS trade mark in the disputed domain name, nor is the Respondent affiliated to the Complainant in any way;

(ii) The Respondent is not commonly known by the disputed domain name nor has an interest over it or the major part of it;

(iii) The Respondent is named “Maxinder Soni”/ “Soni Consultants Inc”, according to the Registrar Verification. When entering the terms “NOVARTIS” and “venture funds” in the Google search engine, the returned results point to the Complainant and its business activities about a project named “Novartis Venture Fund” connected to the domain name <nvfund.com>, which belongs to the Complainant. The Respondent could easily have performed a similar search before registering the disputed domain name and would have quickly learnt that the trade marks are owned by the Complainant and that the Complainant has been using its trade marks in the USA and many other countries of the world. Further, it would have immediately learnt that the Complainant has the “Novartis Venture Fund” project which has an active internet presence. However, the Respondent still chose to register the disputed domain name;

(iv) The Respondent has not been using the disputed domain name for any bona fide offering of goods or services. When the Complainant prepared this Complaint on 17 December 2019, the disputed domain name resolved to a website that stated the website was under construction; and

(v) The Respondent deliberately chose to use the terms “venture funds” combined with the well-known, distinctive trade mark NOVARTIS to benefit from the Complainant’s worldwide renown and to confuse internet users with the Complainant’s own website “Novartis Venture Fund”, which is misleading as to the source or sponsorship and therefore cannot be considered as a bona fide offering of goods or services.

The Panel finds that the Complainant has made out a prima facie case that the Respondent lacks rights or legitimate interest in the disputed domain name. The burden of proof shifts to the Respondent to show that it has rights or legitimate interests in the disputed domain name.

The Respondent has not filed a Response and there is no evidence to show that the Respondent has been commonly known by the disputed domain name, or has used, or has been preparing to use, the disputed domain name in connection with a bona fide offering of goods or services, or for a legitimate non-commercial or fair use, without intent for commercial gain. A website stating that it is under construction, is not by itself evidence of a bona fide offering of goods or services nor a legitimate non-commercial or fair use.

Taking the above factors into consideration the Panel finds that the Respondent has no rights or legitimate interest in the disputed domain name and that the requirements of paragraph 4(a)(ii) of the Policy have been met.

C. REGISTERED AND IS BEING USED IN BAD FAITH

The Complainant asserts that:

- (i) It is very likely that the Respondent knew of the Complainant's distinctive and well-known trade mark when it registered the disputed domain name;
- (ii) The Respondent has never been authorized by the Complainant to register the disputed domain name;
- (iii) The combination of the well-known, distinctive trade mark NOVARTIS and the generic terms "venture funds" in the disputed domain name is a deliberate and calculated attempt to improperly benefit from the Complainant's rights;
- (iv) The Respondent has failed to present any credible evidence-backed rationale for registering the disputed domain name;
- (v) The registration and passive holding of a domain name which has no other legitimate use and clearly refers to the Complainant's trade mark may constitute registration and use in bad faith. See *Telstra Corporation Limited v. Nuclear Marshmallows* (WIPO Case No. D2000-0003); and
- (vi) It has tried to reach the Respondent by a cease and desist letter but has not received a reply, which may infer bad faith use of the disputed domain name. See *Arla Foods Amba v. Mlanie Guerin* (CAC case No. 101640) and *Medela AG v. Donna Lucius* (CAC case No. 101808).

The Complainant's trade marks pre-date the registration of the disputed domain name. The Respondent has not filed a Response nor asserted any reason for incorporating the Complainant's distinctive well known-trade mark, NOVATIS when it registered the disputed domain name.

The Respondent is not commonly known by the disputed domain name. It is most likely that it knew of the Complainant's prior rights in name NOVARTIS when it registered the disputed domain name and registered it with the intention of creating a likelihood of confusion with the Complainant's mark.

The Respondent has used a privacy shield to conceal its identity, and has not responded to Complainant's cease and desist letters. While the disputed domain name points to a website that states that is under construction, there appears no good faith use to which to disputed domain name could be put.

Taking all these factors into account, the Panel finds that the disputed domain name was registered and is being used in bad faith and that the requirements of paragraph 4(a)(iii) of the Policy have been met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	Veronica Bailey
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DATE OF PANEL DECISION	2020-02-04
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Publish the Decision
