Decision for dispute CAC-UDRP-102920

Case number	CAC-UDRP-102920
Time of filing	2020-02-17 12:52:52
Domain names	novartis-digital-ar.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Organization	INVIVO Communications Inc.

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

The Complainant is - among others - the owner of the Canadian trademark registration No. TMA523129 "NOVARTIS", granted in 2000 and duly renewed in Respondent's country of origin, as well as of other trademark registrations all around the world.

The Complainant also owns the domain names <novartis.com> and <novartis.net> since 1996 and 1998 respectively.

FACTUAL BACKGROUND

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

The Complainant is a global healthcare company based in Switzerland that provides solutions to address the evolving needs of patients worldwide and which owns many brands, including the well-known "NOVARTIS" trademark and business name.

The Respondent has registered the disputed domain name on October 11, 2019. Such domain entirely incorporates the Complainant's trademark, with the addition of the generic terms "digital" and "ar".

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain name and is not related in any way with the Complainant's business. The Respondent is not affiliated with Novartis, nor authorized by such company in any way. In addition, the Complainant affirms it currently does not carry out any activity for, nor has any business with the Respondent. Neither license nor authorization has been granted to the Respondent to make any use, or apply for registration of the disputed domain name by the Complainant.

The Complainant contends that the disputed domain name has been registered and being used in bad faith, considering that - despite having sent a C&D letter to the Respondent - the latter did not reply and continue to passively held <novartis-digital-ar.com>.

The disputed domain name points to a blank page and the Respondent did not provide any explanation concerning the registration (and the passive use) of the disputed domain name.

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

1. The Complainant has, to the satisfaction of the Panel, shown that the disputed domain name is identical or confusingly similar to the Complainant's trademarks (within the meaning of paragraph 4(a)(i) of the Policy). In particular, the Panel finds that the disputed domain name is identical to the Complainant's trademark "NOVARTIS".

In this regard, it shall be reminded how several previous UDRP panels have held that the addition of a generic term associated to a trademark does not create a new or different right to the mark, nor diminish confusing similarity, especially if the trademark at stake is well-known, circumstance which has been widely confirmed in the present case.

Therefore, the disputed domain name should be considered as confusingly similar to the trademark NOVARTIS.

2. 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 Panel finds that the Complainant successfully submitted prima facie evidence that the Respondent has made no use of, or demonstrable preparations to use, neither of the disputed domain name in connection with a bona fide offering of goods

or services, nor is making a legitimate non-commercial or fair use of the disputed domain name, nor is commonly known under the disputed domain name. This prima facie evidence was not challenged by the Respondent, which did not file any Response to the complaint of Novartis.

As a matter of fact, there are no arguments why the Respondent could have own rights or legitimate interests in the disputed domain name. "NOVARTIS" definitely is a distinctive sign used by the Complainant as business name and trademark in order to denote its products and services, also online. Therefore, the Panel accepts the contentions of the Complainant that the Respondent has no such rights or legitimate interests in the disputed domain name.

3. The Complainant has, to the satisfaction of the Panel, shown the disputed domain name to have been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

As stated above, the Panel finds that the Complainant successfully submitted prima facie evidence that the Respondent has made no use of, or demonstrable preparations to use, neither of the disputed domain name in connection with a bona fide offering of goods or services, nor is making a legitimate non-commercial or fair use of the disputed domain name, nor is commonly known under the disputed domain name. This prima facie evidence was not challenged by the Respondent.

In the absence of a Response and given the reputation of the Complainant and its trademarks, the Panel infers that the Respondent had the Complainant's trademarks "NOVARTIS" in mind when registering the disputed domain name.

As prior WIPO UDRP panels have held, the incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use (WIPO - D2000-0003 - Telstra Corporation Limited v. Nuclear Marshmallows and WIPO - D2000-0400 - CBS Broadcasting, Inc. v. Dennis Toeppen).

Furthermore, the fact that the Respondent did not reply to the Complainant's C&D letter represents a demonstration of a potential bad faith on the Respondent's side.

Consequently, the Panel believes that the disputed domain name was registered and is being (passively) used in bad faith, in order to prevent the Complainant from reflecting the mark in the disputed domain name.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTIS-DIGITAL-AR.COM**: Transferred

PANELLISTS

Name	**Tommaso La Scala**

DATE OF PANEL DECISION 2020-03-25

Publish the Decision