Decision for dispute CAC-UDRP-103016

Case number	CAC-UDRP-103016
Time of filing	2020-04-15 08:45:55
Domain names	novartispublishers.com

Case administrator

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

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Name	unocking guru

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is, inter alia, a registered owner of the following trademark containing a word element "NOVARTIS":

(i) NOVARTIS (word), India Trademark, priority date 28 February 1996, registration date 28 February 1996, trademark registration no. 700020, registered for goods in int. class 5;

(ii) NOVARTIS (word), International trademark, priority date 1 July 1996, registration date 1 July 1996, trademark registration no. 663765, registered for goods in int. classes 1, 2, 3, 4, 5, 7, 8, 9, 10, 14, 16, 17, 20, 22, 28, 29, 30, 31, 32, 40, 41;

(iii) NOVARTIS (word), International Trademark, priority date 31 October 1996, registration date 31 October 1996, trademark registration no. 666218, registered for goods in int. classes 41, 42;

(iv) NOVARTIS (word), International Trademark, priority date 28 April 2015, registration date 28 April 2015, trademark registration no. 1249666, registered for goods in int. classes 1, 3, 5, 9, 10, 16, 29, 30, 31, 32, 35, 40, 41, 42, 44;

besides other national, EU and International (WIPO) trademarks consisting of the "NOVARTIS" denomination.

(collectively referred to as "Complainant's trademarks").

The word element "NOVARTIS" is also a part of Complainant's registered company name NOVARTIS AG and various other companies affiliated with the Complainant.

The Complainant has also registered a number of domain names under generic Top-Level Domains ("gTLD") and country-code Top-Level Domains ("ccTLD") containing the term “NOVARTIS”, inter alia:

(i) novartis.com, registered on 2 April 1996;

(ii) novartis.net, registered on 25 April 1998.

FACTUAL BACKGROUND

The Complainant (NOVARTIS AG) is a global healthcare company based in Switzerland that provides solutions to address the evolving needs of patients worldwide. 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 has also strong presence in India where the Respondent is located.

The disputed domain name <novartispublishers.com> was registered on 9 February 2020 and is held by the Respondent.

The domain name website (i.e. website to which the disputed domain name resolves) has no genuine content apart from the displayed phrase "website coming soon – please check back soon to see if the site is available".

The Complainant seeks transfer of the disputed domain name to the Complainant.

PARTIES CONTENTIONS

The Parties' contentions are the following:

COMPLAINANT:

CONFUSING SIMILARITY

The Complainant states that:

- The disputed domain name contains the distinctive “NOVARTIS” word element, and it is thus almost identical (i.e. confusingly similar) to Complainant’s trademarks.

- The addition of the term “PUBLISHERS” is not sufficient to escape the finding that the disputed domain name is confusingly similar to the Complainant's trademarks, as it is descriptive and therefore does not prevent the likelihood of confusion between the disputed domain name and the Complainant, Complainant's trademarks and its business. On the contrary, as the term refers to an activity relevant with that of the Complainant, it may further mislead consumers.

Thus, according to the Complainant the confusing similarity between Complainant’s trademarks and the disputed domain name is clearly established.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant states that:

- The Respondent has not been commonly known by the disputed domain name as the returned Google search engine results for the words composing the domain name, i.e. "NOVARTIS" and "PUBLISHERS" point to the Complainant. Furthermore, there is no evidence showing that the Respondent is in any form affiliated to or authorized by the Complainant.

- The Complainant has not authorized, permitted or licensed the Respondent to use Complainant's trademarks in any manner.

- Furthermore, the domain name website has been inactive, which implies that there is no Respondent's intention to use the disputed domain name for legitimate purposes.

BAD FAITH REGISTRATION AND USE

The Complainant states that:

- The Complainant's trademarks pre-date the registration of the disputed domain name and the Respondent has never been authorized by the Complainant to register it.

- The Complainant's trademarks enjoy status of well-known trademark both in India and the world and the Respondent must have been aware of their existence while registering the disputed domain name.

- The purpose of the use and registration of the disputed domain name has been, inter alia, an intentional attempt to attract, for commercial gain, users by creating a likelihood of confusion with the Complainant's trademarks and its company name.

- Disputed domain name website presents only the phrase "website coming soon – please check back soon to see if the site is available", which constitutes passive holding. Registration and passive holding of a domain name, which has no other legitimate use and clearly refers to the Complainant's trademark, may constitute registration and use in bad faith.

- Complainant has tried to reach the Respondent by a cease-and-desist letter. Without receiving reply from the Respondent, subsequently, the Complainant followed up by two reminders (on 2 March 2020 and 20 March 2020). However, the Complainant has not received any response from the Respondent. The Respondent's non-response to the cease-and-desist letter infers bad faith use of the disputed domain name.

- Additionally, the Respondent has failed to provide credible evidence-backed rationale for registering the disputed domain name. Such conduct adds up to the clear indication of bad faith.

The Complainant presents the following evidence which has been assessed by the Panel:

- Information about the Complainant and its business;
- Copies of the correspondence made by the Complainant to the Respondent (cease and desist letters; follow-up correspondence; filled-in online contact forms);
- Excerpt from WHOIS database regarding disputed domain name;
- Screenshots of the relevant websites and Google search engine results;
- Excerpts from trademark databases and list of Complainant's Trademarks.

RESPONDENT:

The Respondent has not provided any response to the complaint.

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

RIGHTS

Since the disputed domain name and the Complainant’s trademarks are not identical, the key element investigated and considered by the Panel is whether the disputed domain name consisting of a term “NOVARTISPUBLISHERS” is confusingly similar to the Complainant’s trademarks.

The threshold test for confusing similarity under the UDRP involves a comparison between the trademark and the disputed domain name itself to determine likelihood of Internet user confusion. In order to satisfy this test, the relevant trademark would generally need to be recognizable as such within the disputed domain name. An addition of common, dictionary, generic, or other descriptive terms is typically insufficient to prevent threshold Internet user confusion. Confusing similarity test under the UDRP typically involves a straightforward visual and aural comparison of the trademark with the domain name in question.

Applying the principles described above, the Panel contends that incorporation of a dominant “NOVARTIS” element of Complainant’s trademarks (which standalone enjoys high level of distinctiveness) into the disputed domain name constitutes confusing similarity between the Complainant’s trademark and the disputed domain name. Addition of a non-distinctive element – descriptive term “PUBLISHERS” - cannot prevent the association in the eyes of internet consumers between the disputed domain name and the Complainant’s trademarks and thus the likelihood of confusion still exists. On the contrary, it may mislead the internet users that the disputed domain name is somehow related to Complainant's business.

For sake of completeness, the Panel asserts that the top-level suffix in the disputed domain name (i.e. the “.com”) must be disregarded under the identity and confusing similarity tests as it is a necessary technical requirement of registration.

Therefore, the Panel has decided that there is identity in this case, it also concludes that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant’s assertions that the Respondent is not commonly known by the disputed domain name and is not

affiliated with nor authorised by the Complainant are sufficient to constitute a prima facie showing of absence of rights or legitimate interest in the disputed domain name on the part of the Respondent. Moreover, no evidence showing that the Respondent is in any form indeed affiliated to or authorized by the Complainant, has been provided by the Respondent.

In addition, given the fact that (i) the disputed domain name has not been genuinely used and (ii) in the absence of the Respondent's response, the Panel concludes that there is no indication that the disputed domain name was intended to be used in connection with a bona fide offering of goods or services as required by UDRP.

Consequently, the evidentiary burden shifts to the Respondent to show by concrete evidence that it does have rights or legitimate interests in that name. However, the Respondent failed to provide any information and evidence that it has relevant rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a) (ii) of Policy).

BAD FAITH

The Panel finds it grounded that the Respondent registered and used the disputed domain name in bad faith.

The Respondent has not used the disputed domain name in any genuine manner, however, the Panel concludes (as it has been ruled in many similar cases, as for example Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, <telstra.org>, Jupiters Limited v. Aaron Hall, WIPO Case No. D2000-0574, <jupiterscasino.com>, Ladbroke Group Plc v. Sonoma International LDC, WIPO Case No. D2002-0131, <ladbrokespoker.com>) that the apparent lack of so-called active use (e.g., to resolve to a website) of the domain name(s) without any active attempt to sell or to contact the trademark holder (passive holding), does not as such prevent a finding of bad faith.

Examples of what may be cumulative circumstances found to be indicative of bad faith include cases in which (i) the Complainant has a well-known trademark and (ii) there is no genuine use (e.g. a mere "parking") of the disputed domain name by the Respondent (irrespective of whether the latter should also result in the generation of incidental revenue from advertising referrals).

The Respondent has not been using the disputed domain name and it remains merely "parked"; also the Panel concludes that Complainant's Trademarks enjoy status of well-known trademarks. Consequently, both conditions for finding of the bad faith under the case law above are duly met.

Based upon the concepts above, which the Panel finds satisfied in this case, even though there is no real use of the dispute domain name, the Panel contends, on the balance of probabilities, that the disputed domain name has been registered and is being used (held) by the Respondent in bad faith, in order to attract, for commercial gain, Internet users to the contested website, by creating a likelihood of confusion with the Complainant's mark and the affiliation of domain with the Complainant.

Thus, the Panel has taken a view that the disputed domain name has been registered and is being used in bad faith [within the meaning of paragraph 4(a)(iii) and 4(b)(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. **NOVARTISPUBLISHERS.COM**: Transferred

PANELLISTS

Name	**JUDr. Jiří Čermák**

DATE OF PANEL DECISION 2020-05-25

Publish the Decision