Decision for dispute CAC-UDRP-103013

Case number	CAC-UDRP-103013
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Domain names	novartispodcast.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Organization	Negotiation Matters Inc.

OTHER LEGAL PROCEEDINGS

There are no other proceedings the Panel is aware of.

IDENTIFICATION OF RIGHTS

The Complainant relies on its distinctive name and mark, NOVARTIS, used as word and figurative mark and registered in several classes as national and regional trade-marks in many regions of the world. These trade mark registrations predate the registration of the Disputed Domain Name.

In particular, it relies on its registered US trade- marks, the word mark Reg. no: 4986124, first used in commerce in 1996 and Reg. no: 2997235, first used in commerce in 1997. It also submits and relies on its international portfolio of registered marks.

It also relies on its common law marks arising from use in those countries that recognise them and says it is a well- known mark due to extensive use and advertising worldwide, including in the USA, where the Respondent is located. It cites that finding in WIPO Case No. D2016-1688.

It further relies on its domain name portfolio which includes <novartis.com> (registered on 2 April 1996) and <novartis.net> (registered on 25 April 1998).

FACTUAL BACKGROUND

FACTUAL BACKGROUND

The Complainant, Novartis AG, is the registered proprietor of the registered and common law NOVARTIS trademarks. It is a global pharmaceutical and healthcare company based in Switzerland and manufactures many well-known drugs such as clozapine (Clozaril), diclofenac (Voltaren), carbamazepine (Tegretol), valsartan (Diovan) and many others. The Complainant's products are sold in about 155 countries to 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 the USA where the Respondent is located. The main website links connect customers to the official local sales/service locator and to the official local websites of the Complainant. The Global Website is at www.novartis.com. The local website in the USA is at www.pharma.us.novartis.com.

The Disputed Domain Name was registered on 20 December 2019 and by April 2020, the Disputed Domain Name redirected to an active website www.globalpodcast.com/ where the Respondent operates a business named "Chicago Business Podcast and includes content about the Complainant and its business activities and performance.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

A. THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR

The Disputed Domain Name was registered on 20 December 2019 according to the WHOIS and incorporates the Complainant's well-known, distinctive trademark NOVARTIS in its entirety combined with a generic term "podcast", which is closely related to the Complainant and its business 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 ("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 same reasoning should apply in the current case and the Disputed Domain Name should be considered as confusingly similar to the trademark NOVARTIS.

B. RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN RESPECT OF THE DOMAIN NAME

The Complainant 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 interest over the Disputed Domain Name or the major part of it. When entering the terms "NOVARTIS" and "podcast" in the Google search engine, the returned results pointed to the Complainant and its business activities. 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 the USA and many other countries of the world. However, the Respondent still chose to register the Disputed Domain Name as such.

By the time the Complainant prepared this Complaint on 08 April 2020, the Disputed Domain Name redirected to an active website "www.globalpodcast.com" where the Respondent operates its own business "Chicago Business Podcast." From the Complainant's perspective, the Respondent deliberately chose to use the well-known, distinctive trademark NOVARTIS as a distinctive component of its domain name, very likely with the intention to benefit from the Complainant's worldwide renown and to confuse internet users as to the source or sponsorship and therefore cannot be considered as a bona fide offering of goods or services.

The Complainant a cease-and-desist letter on 30 December 2019, followed by a reminder sent on 16 January 2020. As the Respondent was using privacy shield, such communication was sent through the email k4hn2lsolkff@contactprivacy.email, to the Registrar through the email registrar-abuse@google.com and sent via online contact form. The Respondent replied on 20 January 2020 with the contact information as Drew Sikula <drew@negotiationmatters.com>, claiming that it is a "developing venture" which "aimed at providing news reporting, comment, and, in some cases, criticism about companies known to, and important to, American consumers and the global marketplace."

The Respondent did not deny the fact that it knew about the Complainant and its well-known trademark NOVARTIS, and still did not justify the reason why it picked the term "Novartis" as the distinctive component in its domain name while it operated its own business under the name "globalpodcast.com"/"Chicago Business Podcast". Moreover, when searched for the term "Novartis" on the website of "globalpodcast.com", the Complainant did not find any result. In its response, it has proposed 2 options: sell the Disputed Domain Name to the Complainant for an out-of-pocket expense or let the Disputed Domain Name expire. The Complainant followed up on 24 January 2020, intending to accept the first option: "Kindly inform us the amount of the out-of-pocket costs." The Respondent replied on 7 February 2020 stating the "out-of-pocket expense" of "$12 plus attorney's fees."

The Complainant in reply on 18 February 2020 countered "We are ready to compensate [only] out-of-pocket expenses (i.e. costs for registration of the domain name)." The Respondent replied on 19 February 2020, rejecting such offer:
"Per my original reply, I am willing to entertain transferring the domain to you if and when I decide not to use for my legitimate purposes. As I have not made that decision, I am not ready to transfer the domain at this time."

From the Complainant's perspective, the inconsistency of the Respondent's claims only shows that it first attempted to collect commercial gain by selling the Disputed Domain Name to the Complainant at an excessive price which was obviously higher than the out-of-pocket expense, then later it changed its mind and used the Disputed Domain Name for its own business operations.

Therefore, the Respondent cannot be considered making a "legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the [complainant's] trademark or service mark." For the foregoing reasons, it shall be concluded that the Respondent has no right nor legitimate interest in respect of the Disputed Domain Name.

C. THE DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITH

i. THE DOMAIN NAME WAS REGISTERED IN BAD FAITH

It should be highlighted 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. It is inconceivable that the combination of the well-known, distinctive trademark NOVARTIS and the term "podcast" in the Disputed Domain Name is not a deliberate and calculated attempt to improperly benefit from the Complainant's rights.

Additionally, considering the fact that: the Respondent very likely knew about the Complainant and its trademark and the Complainant's trademark NOVARTIS is a distinctive, well-known trademark worldwide and in the USA where the Respondent resides and that the Respondent has failed in presenting a credible evidence-backed rationale for registering the Disputed Domain Name; the Disputed Domain Name shall be deemed as registered in bad faith, which is supported by WIPO Overview 3.0, para. 3.1.1.and para.3.1.4.

ii. THE DOMAIN NAME IS BEING USED IN BAD FAITH

Firstly, as noted in the previous paragraphs, the Disputed Domain Name redirected to the Respondent's own website. As the Disputed Domain Name is confusingly similar to the Complainant's trademark, internet users who look for products and/or services from the Complainant can be led to believe that the Disputed Domain Name and the website associated with it is

somehow authorized or related to the Complainant. Therefore, the Complainant concludes that “by using the Disputed Domain Name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line 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 finding of bad faith is also supported by WIPO DECISION Case No. D2018-1299, Jones Lang LaSalle IP, Inc. v. Rob Monster, DigitalTown, Inc., (“In view of the fact that the disputed domain names fully includes the JONES LANG LASALLE mark, it is easy to infer that Respondent was likely aware of Complainant’s rights in the JONES LANG LASALLE mark when Respondent registered the disputed domain name. In addition, given that Respondent registered and has used the disputed domain name to redirect web traffic to a website at ‘www.digitaltown.com’ that promotes the services of Respondent’s company, it appears more likely than not that Respondent registered the disputed domain name for Respondent’s profit. As Respondent has chosen not to contest the matter, it appears unlikely that Respondent had any legitimate purpose for registering and using the disputed domain name either at the time of registration or going forward.”) Secondly, also as mentioned here-above in the previous paragraphs, the Respondent first offered to sell the Disputed Domain Name to the Complainant for the Respondent’s “out-of-pocket costs in registering the domain name”, then asked for an amount which was obviously excessive to such costs in its responses that followed. When the Complainant insisted on the Respondent’s original offer, it further changed its mind and rejected the request of transfer. From the Complainant’s perspective, the conduct of the Respondent indicates bad faith use of the Disputed Domain Name as it has registered the Disputed Domain Name primarily for the purpose of transferring the Disputed Domain Name to the Complainant who is the owner of the trademark for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly related to the Disputed Domain Name.

RESPONDENT:

The Respondent relies on the correspondence and in particular annexes the exchange with the Complainant. He denies the allegations and relies in his letter on his fair and legitimate use of the Complainant’s name and mark to discuss the Complainant and its business.

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 not, 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 not, 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

There is no question about rights in this case. The Complainant’s mark is both highly distinctive and longstanding and also without doubt famous. There are rights and they are strong.

As to similarity, the Complainant’s name and mark is used in its entirety and accompanied by the word podcast. The

Disputed Domain Name is similar to a name or mark in which the Complainant has rights.

The real issue in this case however is under the second limb of the Policy, namely whether the Respondent has a legitimate interest in, or makes fair use of, the Disputed Domain Name where he uses the Complainant's name to identify it and then discuss it, in a podcast—and registers the title of that podcast.

The Respondent's position is that this is paradigm protected fair use as the use is to refer to and comment on the Complainant's own goods and services.

Put another way, this means the use is nominative fair use and not use as a trade mark impacting its function as a badge of origin. The addition of podcast signals that the Respondent's site is 'about' the Complainant –to avoid impersonation or confusion.

Taking this defence, we must consider for example if a company can stop a newspaper or TV station reporting on a company's business performance by claiming trade mark infringement when its name is used –this is that same scenario.

Use of a name and trade mark for the purposes of criticism is protected by the First Amendment in the US and infringement will not catch news reporting or news commentary. It is descriptive use in a broad sense and would not sustain a trade mark infringement action in the EU as it does not implicate the origin function of the mark.

The Respondent's discussion of the Complainant at his site is protected in the EU by Freedom of Expression and art. 10 of the European Convention on Human Rights –albeit that is not absolute and must be balanced against the rights of others under art. 10(2), including the Complainant's rights as an owner of a name and mark protected by Art. 1, First Protocol to ECHR and also Art. 17 of the Charter (Treaty on the Functioning of the EU). The balance is adequately struck in trade-mark law and norms –as reflected in the Policy –by allowing legitimate and fair uses.

Here the name of the podcast/program is registered to attract viewers—and this is done all the time with article and program titles and also falls within fair use.

So, the use of the Complainant's name to refer to the Complainant and its services is 'nominative' use -that is, it uses a name in a referential sense and not a trade mark sense. It is using the name to identify the Complainant and its services rather than its own as such.

The Complainant says the Respondent knew of the Complainant at the point of acquiring the Disputed Domain Name and it is correct but his registration and use was for a legitimate reason, criticism and commentary as protected in trade mark law norms, as descriptive and nominative use and for news and editorial, both protected speech related purposes.

UDRP cases dealing with similar speech issues tend to have fallen into categories like fan sites, sucks sites or parody sites and newly "brand criticism." It is now accepted that there is the narrow and wide view and an "all circumstances view," see Bettinger Domain Name Law and Practice, Second Edition at pp.1398-1399 paragraph IIIE.334.-339. This panel prefers the final approach and adopts it here.

The Disputed Domain Name is employed in connection with an 'about' site -close to a criticism site. Even if the subject does not like it, it is fair and legitimate use.

The Complainant also relies on the fact that the site is advertising the Respondent's services and suggests its name and mark is used to promote dis-similar services which may be dilution under trade mark law given its fame. Again, this will not trump fair and legitimate protected speech. In US law, The Federal Trademark Dilution Act (FTDA) at 15 USC §1125(c) provides at §1125(c)(3) for exclusions and these exclude news reporting and commentary.

We may assume the Respondent's site uses pay per click or other online advertisements. The Policy says legitimate or fair use should be non- commercial but commercial use does not these days have a significant impact on the analysis. See

Bettinger (above). US trade mark law on fair use also tolerates a significant amount of commerce/advertising.

The addition of the word “podcast” mitigates against any attempt to impersonate the Complainant and signals that the site is informational and about the Complainant. This also negates Bad Faith –as does the fact that the Complainant is being genuinely referred to and discussed.

For the record, the panel was not in agreement that the Complainant can rely for Bad Faith on Respondent’s offer for in excess of out of pocket costs. It appears to the Panel, that this rests on a very general discussion about any potential sale including provision for attorneys’ fees. The identification of this as an option for resolving the dispute, by a lay person, did not offend the spirit of the rules in our view. We also would have preferred to have the correspondence itself than the selected quotes with the Complainant’s “perspective.” We do not find this or any other ground of Bad Faith made out.

Usually if legitimate interests are made out, there will be no Bad Faith and the panel finds it so here.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **NOVARTISPODCAST.COM**: Remaining with the Respondent

PANELLISTS

Name	**Victoria McEvedy**

DATE OF PANEL DECISION 2020-05-26

Publish the Decision