Decision for dispute CAC-UDRP-103038

Case number	CAC-UDRP-103038
Time of filing	2020-04-29 14:06:12
Domain names	officialnovartis.com, realnovartis.com, theofficialnovartis.com, therealnovartis.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Organization	DYVenture

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the well-known, distinctive trademark NOVARTIS as a word and figure mark in several classes in numerous of countries all over the world including in the USA, Reg. no: 4986124 and Reg. no: 2997235. These trademark registrations predate the registration of the Disputed Domain Names. The NOVARTIS trademarks are valid and registered in 1996/1997. Further is the Complainant owner of Novartis Domains, e.g. novartis.com since 1996.

FACTUAL BACKGROUND

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

I. LANGUAGE OF PROCEEDINGS REQUEST:

Since the language of the Registration Agreement of the Disputed Domain Names officialnovartis.com, realnovartis.com, theofficialnovartis.com, therealnovartis.com is English according to the applicable Registrar, the language of the proceeding should be English.

II. ABOUT COMPLAINANT AND THE BRAND NOVARTIS

Novartis AG (hereinafter referred to as Complainant) is the proprietor of the NOVARTIS trademarks. Novartis is a global healthcare company based in Switzerland that provides solutions to address the evolving needs of patients worldwide (see www.novartis.com). Novartis 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 a strong presence in the USA where the Respondent is located. The below links connect customers to the official local sales and service locator and to the official websites of the Complainant:

- Global Website for NOVARTIS: https://www.novartis.com;

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

For more information about the Complainant, see the Complainant´s Annual report for 2018 available at:

https://www.novartis.com.

The Complainant is the owner of the well-known, distinctive trademark NOVARTIS as a word and figure mark in several classes in numerous of countries all over the world including in the USA. These trademark registrations predate the registration of the Disputed Domain Names.

Trademark registration in USA

Trademark: NOVARTIS
Reg. no: 4986124
First use in commerce: 1996

Trademark: NOVARTIS
Reg. no: 2997235
First use in commerce: 1997

In the case No. D2016-1688, Novartis AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org, / Sergei Lir regarding the domain name <novartis-bio.com>, the Panel confirmed that NOVARTIS is a well-known worldwide trademark as follows:

"When the disputed domain name was registered by the Respondent in June 2016, the trademark NOVARTIS was already well-known worldwide and directly connected to the Complainant's activities in the pharmaceutical business".

The Complainant has registered a number of domain names containing the term "NOVARTIS", for example, <novartis.com> (created on April 02, 1996) and <novartis.net> (created on April 25, 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.

Due to extensive use, advertising and revenue associated with its trademarks worldwide, the Complainant enjoys a high

degree of renown around the world, including in 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).

LEGAL GROUNDS:

A. THE DOMAIN NAMES ARE IDENTICAL OR CONFUSINGLY SIMILAR

The domain names officialnovartis.com, realnovartis.com, theofficialnovartis.com, therealnovartis.com (hereinafter referred to as the "Disputed Domain Names"), which were all registered on 26 March 2020 according to the WHOIS, incorporate the Complainant's well-known, distinctive trademark NOVARTIS in its entirety combined with generic terms "official", "real", "the official", or "the real", 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 Names. 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 where the Panel stated the following:

"In addition, 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 Names should be considered as confusingly similar to the trademark NOVARTIS.

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

The Complainant has never granted the Respondent any right to use the NOVARTIS trademark within the Disputed Domain Names, 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 Names or that it has interest over the Disputed Domain Names or the major part of them. The Registrant is named "DYVenture", however, when entering the terms "NOVARTIS" and "official" or "real" 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 Names 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 Names as such.

By the time the Complainant prepared this Complaint on 26 April 2020, the Disputed Domain Names resolved to pay-per-click websites. From the Complaint's perspective, the Respondent deliberately chose to use the well-known, distinctive trademark NOVARTIS as the distinctive part of the Disputed Domain Names, 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.

For the foregoing reasons, it shall be concluded that the Respondent has no right nor legitimate interest in respect of the Disputed Domain Names.

C. THE DOMAIN NAMES WERE REGISTERED AND ARE BEING USED IN BAD FAITH

i. THE DOMAIN NAMES WERE REGISTERED IN BAD FAITH

It should be highlighted that the registration of the Complainant's trademarks pre-dates the registration of the Disputed Domain Names and the Respondent has never been authorized by the Complainant to register the Disputed Domain Names. It is inconceivable that the combination of the well-known, distinctive trademark NOVARTIS and the generic terms "the" "official" or "real" in the Disputed Domain Names 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;
• The Complainant's trademark NOVARTIS is a distinctive, well-known trademark worldwide and in the USA where the Respondent resides;
• The Respondent has failed in presenting a credible evidence-backed rationale for registering the Disputed Domain Names,

the Disputed Domain Names shall be deemed as registered in bad faith, which is supported by WIPO Overview 3.0, para. 3.1.1.:

"If on the other hand circumstances indicate that the respondent's intent in registering the disputed domain name was in fact to profit in some fashion from or otherwise exploit the complainant's trademark, panels will find bad faith on the part of the respondent. While panel assessment remains fact-specific, generally speaking such circumstances, alone or together, include: (i) the respondent's likely knowledge of the complainant's rights, (ii) the distinctiveness of the complainant's mark, … (vii) failure of a respondent to present a credible evidence-backed rationale for registering the domain name,…"

and para.3.1.4:

"Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith."

ii. THE DOMAIN NAMES ARE BEING USED IN BAD FAITH

Firstly, as noted in the previous paragraphs, the Disputed Domain Names resolved to pay-per-click websites. In terms of paragraph 4(b)(iv) of the Policy, this conduct constitutes bad faith as it has been confirmed in previous cases, e.g. WIPO Case No. D2016-0245, Heraeus Kulzer GmbH. v. Whois Privacy Services Pty Ltd / Stanley Pace, wherein the Panel stated:

"The Panel finds that the Domain Name was registered and is being used to attract, for commercial gain, Internet users to the Respondent's Website or other online location, by creating a likelihood of confusion with the Complainant's KULZER Mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's Website. In particular the Respondent's Website is a page that offers sponsored-links to third-party sites that have in the past and may in the future sell products that directly compete with the Complainant's dental equipment. Such sites generally advertise by paying registrants on a pay-per-click basis for Internet users redirected to their sites. This means that the Respondent receives a financial reward for every Internet user redirected from the Respondent's Website to those third-party sites.

Accordingly, the Panel finds that the Respondent has registered and is using the Domain Name in bad faith under paragraph 4(a)(iii) of the Policy."

Secondly, as the Respondent has registered four domain names containing the Complainant's well-known, distinctive trademark Novartis combined with generic terms, such registration constitutes a pattern of conduct that prevents a trademark holder from reflecting its mark in a domain name. See WIPO Case No. D2017-0391, Arla Foods Amba and Mejeriforeningen Danish Dairy Board v. Mohammad Alkurdi, where the panel concluded that:

“In the Panel’s opinion, this list demonstrates that Respondent has clearly engaged in a pattern of registering domain names in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, and that the registration of the disputed domain names was in bad faith under Policy paragraph 4(b)(ii).”

Lastly, the Complainant has tried to reach the Respondent by a cease-and-desist notice sent on 6 April 2020, and as the registrant was under privacy shield, sent via the online contact form as required in the WHOIS record. However, until the time the Complainant prepared this Complaint, it has not received any response from the Respondent. Since the amicable approach has been unsuccessful, the Complainant chose to file a UDRP complaint.

The Respondent’s non-response to cease-and-desist letter infers bad faith use of the Disputed Domain Names, see Arla Foods Amba v. Mlanie Guerin, CAC case No. 101640; Medela AG v. Donna Lucius, CAC case No. 101808.

SUMMARY

• NOVARTIS is a well-known, distinctive trademark worldwide.
• Complainant’s trademarks registration predates the registration of the Disputed Domain Names.
• Respondent has no rights in the mark NOVARTIS, bears no relationship to the Complainant, and is not commonly known by the Disputed Domain Names - accordingly it has no legitimate interest in the Disputed Domain Names.
• It is highly unlikely that Respondent was not aware of Complainant’s prior rights in the trademark NOVARTIS at the time of registering the Disputed Domain Names, given the Complainant’s worldwide renown.
• Respondent has been using the Disputed Domain Names to resolve to pay-per-click websites.
• Respondent’s registration of the Disputed Domain Names has constituted a pattern of conduct that prevents a trademark holder from reflecting its mark in a domain name.
• Respondent has not responded to Complainant’s cease-and-desist communication.
• Respondent has been using privacy shield to conceal its identity.

Consequently, the Respondent should be considered to have registered the Disputed Domain Names confusingly similar to the Complainant’s well-known, distinctive trademark NOVARTIS. The Complainant has not found that the Respondent is of any legitimate right or interest in using the Disputed Domain Names, but rather registered and has been using the Disputed Domain Names in bad faith.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 names have been registered and are 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

It is necessary for the Complainant, if it is to succeed in this administrative proceeding, to prove each of the three elements referred to in paragraph 4(a) of the Policy, namely that:

(i) the disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights; and
(ii) the Respondent has no rights or legitimate interest in respect of the disputed domain name; and
(iii) the disputed domain name has been registered and is being used in bad faith.

The Panel finds that the Disputed Domain Names <officialnovartis.com, realnovartis.com, theofficialnovartis.com, therealnovartis.com> are confusingly similar to the trademarks of the Complainant. All four disputed domain names incorporate entirely the Complainant's well-known, registered trademark NOVARTIS with a generic indication "official", "real", "theofficial", "thereal". The addition of the gTLD ".com" does not add any distinctiveness to the Disputed Domain Names. The panel is convinced that the Complainant owns a well-known trademark in the USA. In the case No. D2016-1688, Novartis AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org, / Sergei Lir regarding the domain name <novartis-bio.com>, the Panel confirmed that NOVARTIS is a well-known worldwide trademark as follows: "When the disputed domain name was registered by the Respondent in June 2016, the trademark NOVARTIS was already well-known worldwide and directly connected to the Complainant's activities in the pharmaceutical business".

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names. The Complainant has not granted the Respondent any right to use the NOVARTIS trademark within the Disputed Domain Names, nor is the Respondent affiliated to the Complainant.

Moreover, the Complainant contends and provides evidence that the Respondent has not developed a legitimate use in respect of the Disputed Domain Names. The Complainant contends that the Respondent was seeking to use the disputed domain names only to divert consumers to its own business and that the Respondent has no legitimate interests in respect of the four Disputed Domain Names.

In lack of any Response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names.

The Complainant also asserted and proved that the Respondent tried to attract internet users for commercial gain by creating a likelihood of confusion with the Complainant's trademarks. The Complainant rightfully contended that the four Disputed Domain Namesare confusingly similar to the prior trademark NOVARTIS of the Complainant. The Complainant also referred to the distinctiveness and reputation of its NOVARTIS trademarks.

This makes it highly unlikely that the Respondent had no knowledge of the Complainant's prior trademark rights at the time of registration of the Disputed Domain Names. The Complainant rightfully contended that the Respondent has used the four Disputed Domain Namesintentionally to attract visitors for commercial gain by creating confusion with the Complainant's trademarks, and that the Respondent has used the Disputed Domain Names with that intention, namely in bad faith. See e.g., Accor v. Shangheo Heo / Contact Privacy Inc., WIPO Case No. D2014-1471 where the Panel stated that: "The unopposed allegation of phishing, and the evidence submitted in support of phishing, combined with the likelihood of confusion, is sufficient evidence of bad faith. …It seems likely, as Complainant alleges, that Respondent intentionally attempted to deceive consumers into providing personal and financial information, believing that Respondent was associated with the bona fide services offered by Complainant."
Reference is made also to: CAC case N° 101036, Boehringer Ingelheim Pharma GmbH & Co. KG vs. SKYRXSHOP - dulcolax.xyz and WIPO Case no. D2014-0306 Boehringer Ingelheim Pharma GmbH & Co. KG v. Klinik Sari Padma, BAKTI HUSADA.

Furthermore, the Respondent is using a hidden identity. But this argument is not to be discussed further because bad faith is evident, whatsoever.

Accordingly, the Panel finds that the Disputed Domain Names were both registered and used in bad faith and that the Complaint succeeds under the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **OFFICIALNOVARTIS.COM**: Transferred
2. **REALNOVARTIS.COM**: Transferred
3. **THEOFFICIALNOVARTIS.COM**: Transferred
4. **THEREALNOVARTIS.COM**: Transferred

PANELLISTS

Name	**Dr. jur. Harald von Herget**

DATE OF PANEL DECISION 2020-06-16

Publish the Decision