Decision for dispute CAC-UDRP-103248

Case number	CAC-UDRP-103248
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Domain names	otcnovartis.com

Case administrator

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

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Name	guiqiang deng

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceeding related to the Disputed Domain Name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the trademark NOVARTIS in different jurisdictions, including but not limited to the following registrations

- HK Trademark: NOVARTIS
Reg. no: 199809187
Priority Date: 15 February 1996

- HK Trademark: NOVARTIS
Reg. no: 199809188
Priority Date: 15 February 1996

The Complainant has also registered numerous domain names including the trademark NOVARTIS, such as <novartis.com> registered on April 2, 1996.

The Disputed Domain Name was registered on April 13, 2020.

FACTUAL BACKGROUND

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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 Name <otcnovartis.com> is English according to the Registrar Verification, the language of the proceeding should be English.

II. ABOUT COMPLAINANT AND THE BRAND NOVARTIS

The Novartis Group is one of the biggest global pharmaceutical and healthcare groups. It provides solutions to address the evolving needs of patients worldwide by developing and delivering innovative medical treatments and drugs. Novartis AG (the "Complainant"), created in 1996 through a merger of two other companies Ciba-Geigy and Sandoz, is the holding company of the Novartis Group.

The Complainant's products are manufactured and sold in many regions worldwide. The Complainant has a strong presence in the region Hong Kong where the Respondent is located. The Complainant has subsidiaries based in Hong Kong, and "has received the 'Caring Company' award from the Hong Kong Council of Social Service for the 10th consecutive year since 2004, in recognition of Novartis' continuous practice of good corporate citizenship."

The Complainant is the owner of the well-known trademark NOVARTIS registered as both a word and device mark in several classes worldwide, including Hong Kong. The vast majority of the Complainant's trademark registrations significantly predates the registration of the Disputed Domain Name. Namely, the Complainant's trademark registrations in Hong Kong applying to the present proceedings include the following earlier rights:

Trademark: NOVARTIS
Reg. no: 199809187
Priority Date: 15 February 1996

Trademark: NOVARTIS
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Priority Date: 15 February 1996

Moreover, previous UDRP panels have stated that the NOVARTIS trademark is well-known (inter alia Novartis AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org, / Sergei Lir, WIPO Case No. D2016-1688).

The Complainant owns numerous domain names composed of either its trademark NOVARTIS alone, including <novartis.us> (created on 19 April 2002) and <novartis.com> (created on 2 April 1996) or in combination with other terms, e.g. <novartispharma.com> (created on 27 October 1999). The Complainant uses these domain names to promote the NOVARTIS mark with related products and services.

Beside its official domain name and website <novartis.com.hk> dedicated to Hong Kong, the Complainant enjoys a strong presence online also via its official social media platforms.

LEGAL GROUNDS:

A. THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR

The domain name <otcnovartis.com> (hereinafter referred to as the "Disputed Domain Name"), which was registered on 13

April 2020, incorporates the Complainant's well-known, distinctive trademark NOVARTIS in its entirety combined with a generic term "otc", which very often refers to the term "Over-The-Counter" as a medical term, therefore 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 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 Name should be considered as confusingly similar to the trademark NOVARTIS.

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

The Complainant and the Respondent have never had any previous relationships, nor has the Complainant ever granted the Respondent with any rights to use the NOVARTIS trademark in any forms, including the Disputed Domain Name.

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. According to the Registrar Verification, the Respondent is named "guiqiang deng", which is not related to the Complainant nor to the term "Novartis".

When searched for "otcnovartis" in the Google search engine, the returned results all 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 Hong Kong and many other countries worldwide. However, the Respondent still chose to register the Disputed Domain Name as such.

Furthermore, the Disputed Domain Name has been used for resolving to an active website displaying adult content and gambling information. For example, by the time the Complainant prepared this Complaint on 18 August 2020, in the banner of the website, it displayed a domain name "http://hm035.com/ which resolved to a gambling site. When Internet users visit the Disputed Domain Name looking for information about the Complainant and its business, they would only find the inappropriate content described above.

By using the Disputed Domain Name, the Respondent not only illegally and commercially benefits from the Complainant's renown as the term "Novartis" in the Disputed Domain Name foreseeably attracts more traffic, but also will very likely cause trademark tarnishment to the Complainant's reputable trademark NOVARTIS. Therefore, the Respondent's use of the Disputed Domain Name to host such website cannot be bona fide. See in AREVA Société Anonyme à Directoire et Conseil de Surveillance v. wangyongqiang, WIPO Case No. D2016-1100 where the panel states that:

"The Panel does not find the Respondent's use of the Disputed Domain Name to host an adult-content website to be bona fide, legitimate noncommercial or fair use. Various prior UDRP panels have reached a similar conclusion when reviewing a domain name incorporating a trademark having no connection with a respondent which directs to an adult-content website (e.g., MatchNet plc v. MAC Trading, WIPO Case No. D2000-0205)."

In the light of the above, the Complainant concluded that the Respondent deliberately chose to use the well-known, distinctive trademark NOVARTIS for the Disputed Domain Name and has used it to resolve to an active website displaying adult content and gambling information, obviously with the intention to improperly 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 Name.

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

i. THE DISPUTED DOMAIN NAME WAS REGISTERED IN BAD FAITH

It should be highlighted that most of Complainant's trademark registrations significantly predate the registration of the Disputed Domain Name and the Respondent has never been authorized by the Complainant to register the Disputed Domain Name. Considering the renown of the Complainant and its trademark NOVARTIS, and the overall composition of the Disputed Domain Name, i.e. using the term "Novartis" in connection with the term "otc" which very often refers to the term "Over-The-Counter" as a medical term and therefore is closely related to the Complainant and its business activities, it follows that the combination of the well-known trademark NOVARTIS in the Disputed Domain Name is a deliberate and calculated attempt to improperly benefit from the Complainant's rights and reputation.

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 Hong Kong where the Respondent resides

• 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.:

"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 DISPUTED DOMAIN NAME IS BEING USED IN BAD FAITH

As noted in the previous paragraphs, the Disputed Domain Name has been used to resolve to an active website displaying adult content and gambling information, which is a clear evidence of bad faith use. Again, in the panel statement of WIPO Case No. D2016-1100 cited hereabove, the panel's reasoning of bad faith use is as follows:

"It is the consensus opinion of prior UDRP panels that the intentional tarnishment of a complainant's trademark by conduct such as linking pornographic images or wholly inappropriate information to an unrelated trademark constitutes evidence of

bad faith registration and use of the domain name (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition). The Panel cannot even begin to imagine how the Complainant's nuclear power plants could be related to adult-content. The Complainant is clearly not in the adult industry. The intentional featuring of adult content on the website resolved from the Disputed Domain Name has a real risk of tarnishing the trademark AREVA. The Panel is guided by the consensus and holds that the circumstances evidence bad faith registration and use of the Disputed Domain Name. Therefore, the Panel holds that the third limb of paragraph 4(a) of the Policy is also made out."

Besides, the fact that the Respondent has been using privacy service to conceal its identity further supports the finding of bad faith. In addition to that, according to the Registrar Verification, the Respondent has provided "500055" as postal code and "+852.1111111111" as phone number. "500055" is not a valid postal code in Hong Kong as the allocated postal code is "999077" and the phone number "+852.1111111111" is obviously a fake one. Referring to WIPO Overview 3.0, paragraph 3.6, the provision of false WHOIS adds up to the finding of bad faith:

"Panels additionally view the provision of false contact information (or an additional privacy or proxy service) underlying a privacy or proxy service as an indication of bad faith."

SUMMARY

• NOVARTIS is a well-known, distinctive trademark worldwide

• Complainant's trademarks registration predates the registration of the Disputed Domain Name

• Respondent has no rights in the mark NOVARTIS, bears no relationship to the Complainant, and is not commonly known by the Disputed Domain Name – accordingly it has no legitimate interest in the Disputed Domain Name

• 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 Name, given the Complainant's worldwide renown

• Respondent was using the Disputed Domain Name to resolve to an active website displaying adult content and gambling information

• Respondent has been using privacy service to conceal its identity

• Respondent has provided false WHOIS information

Consequently, the Respondent should be considered to have registered the Disputed Domain Name 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 Name, but rather registered and has been using the Disputed Domain Name in bad faith.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

To satisfy the first element under Policy 4(a), a complainant needs to prove its rights in a trademark and the domain names are identical and/or confusingly similar to the trademark.

First, the Complainant claims rights in the NOVARTIS mark through its global registrations of the Trademarks. By virtue of its global trademark registrations, Complainant has proved that it has rights in the mark under Policy 4(a). See Avast Software s. r. o. v Milen Radumilo, 102384, (CAC 2019-03-12).

Second, the Complaint claims that the additional term "otc", which could mean the medical term "Over-The-Counter", does not distinguish the domain name from Complainant's NOVARTIS trademark. The Panel accepts that the additional term does not alter the underlying trademark or negate the confusing similarity and it does not sufficiently differentiate the disputed domain name from that trademark. In addition, the Panel also finds that the ".com" generic top-level domain ("gTLD") is irrelevant when establishing whether or not a mark is identical or confusingly similar for the purposes of Policy 4(a)(i). See LESAFFRE ET COMPAGNIE v Tims Dozman, 102430, (CAC 2019-04-02).

For the foregoing reasons, the Panel finds the Complainant has satisfied paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

To satisfy the second element under Policy 4(a), the complainant must first make a prima facie case that the respondent lacks rights and legitimate interests in the domain names, and the burden of prove then shifts to the respondent to show it does have rights or legitimate interests. See PepsiCo, Inc. v Smith power production, 102378, (CAC 2019-03-08) ("The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.").

First, the Complainant contends that Respondent has no rights or legitimate interests in the Disputed Domain Name, as Respondent is not commonly known by the Disputed Domain Name, nor has it been authorized to use the NOVARTIS mark in any manner. See MAJE v enchong lin, 102382, (CAC 2019-03-11). There is no record indicates that Complainant authorized Respondent to use the mark for any purpose. Accordingly, the Panel agrees that Respondent is not commonly known by the Disputed Domain Name under Policy 4(c)(ii).

Second, the Complainant argues that Respondent has been used for resolving to an active website displaying adult content and gambling information. The Complainant provides a screenshot of the resolving web page, which displays obscene content. Using a confusingly similar domain name to pass off the Complainant and displace illicit content evince a failure to make a bona fide offering of goods or services or a legitimate noncommercial or fair use, see IN WHITE LLC v clpik-studio.com Pawel Tykwinski, 100899 (CAC 2015-01-29). Accordingly, the Panel finds that Respondent attempts to tarnish Complainant's NOVARTIS trademark and misleadingly diverts the consumers under Policy 4(c)(iii).

For the foregoing reasons, the Panel finds the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

BAD FAITH

To satisfy the third element under Policy 4(a), the Complainant must prove both the registration and use of the domain names are in bad faith.

First, the Complainant argues that Respondent very likely had actual knowledge of Complainant's rights in the NOVARTIS mark at the time of registering the Disputed Domain Name. Actual knowledge of a complainant's rights in a mark prior to registering a confusingly similar domain name evinces bad faith under Policy 4(a)(iii). See O'Neill Brand S.à r.l v Pan Chen, 102363, (CAC 2019-02-20). Complainant contends that Respondent's knowledge can be inferred given the NOVARTIS mark is a distinctive, well-known trademark worldwide and in Hong Kong where the Respondent resides, and the first registration of the NOVARTIS trademark was long before the registration of the Disputed Domain Name. The Panel agrees with Complainant and find that Respondent did have actual knowledge of Complainant's mark, demonstrating bad faith registration under Policy 4(a)(iii).

Second, the Complainant asserts that the Respondent intentionally uses the domain name to tarnish Complainant's

NOVARTIS trademark by resolving to pornographic images. In addition, the Complainant also contends that the Respondent has been using privacy service to conceal its identity and has provided invalid postal code and phone number in Hong Kong. In the Panel's view, it is an obvious case of tarnishment by using a domain name similar to a well known trademark to resolve strong adult content, and the false contact information further evince the use of the Disputed Domain Name in bad faith, see BOEHRINGER Ingelheim Pharma GmbH & Co. KG v Artem Tsvetkov, 102072, (CAC 2018-06-29) and Teva Pharmaceutical Industries Ltd. v RiskIQ, Inc., 101041, (CAC 2015-11-30). The Panel agrees with Complainant and find that Respondent's use of the Disputed Domain Name in bad faith under Policy 4(a)(iii).

For the foregoing reasons, the Panel finds the Complainant has satisfied 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.

PRELIMINARY ISSUE: LANGUAGE OF PROCEEDING

The Panel notes that the language of Registration Agreement is English as confirmed by the domain registrar and the Complaint was filed in English. The Respondent did not file an official response despite the content of the website is in Chinese.

The Panel is bilingual and is well equipped to deal with the proceeding in both Chinese and English.

Having considered the circumstances and in absence of an agreement between the parties, the Panel determines that the language requirement has been satisfied and the Language of Proceeding be English.

PRINCIPAL REASONS FOR THE DECISION

Having established all three elements required under the UDRP Policy, the Panel concludes that relief shall be granted.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **OTCNOVARTIS.COM**: Transferred

PANELLISTS

Name	**Mr Paddy TAM**

DATE OF PANEL DECISION 2020-09-20

Publish the Decision