Decision for dispute CAC-UDRP-103251

Case number	CAC-UDRP-103251
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Domain names	novartisoncologyvpo.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Organization	Internet Marketing EOOD

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other proceedings related to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant (Novartis AG) is the owner of international word trademark No. 663765 “NOVARTIS” registered in 1997. The disputed domain name <novartisoncologyvpo.com> was registered on April 11, 2020.

FACTUAL BACKGROUND

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

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 especially an active presence in Bulgaria where the Respondent is located. The Complainant has a local team of more than 250 professionals and the total turnover was around EUR 90 million. The Complainant also uses its dedicated website https://www.novartis.bg/ to communicate with local consumers in Bulgaria.

The Complainant is the owner of the well-known trademark NOVARTIS registered as both a word and device mark in several

classes worldwide, including Bulgaria. 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 Bulgaria applying to the present proceedings include the following earlier rights: Trademark: NOVARTIS, Reg. no: 663765, Registration in: 1997

Moreover, previous UDRP Panels have stated that the NOVARTIS trademark is well-known.

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.

The Complainant enjoys a strong presence online also via its official social media platforms.

A. THE DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR

The disputed domain name, which was registered on 11 April 2020, incorporates the Complainant's well-known, distinctive trademark NOVARTIS in its entirety combined with a generic term "Oncology" which is closely related to the Complainant and its business activities; the 3 letters "vpo" could have various meanings but cannot be regarded as the distinctive part of the disputed domain name. The addition of the gTLD ".com" does not add any distinctiveness to the disputed domain name. 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 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.

When searched for "novartis oncology vpo" in the Google search engine, the returned results all pointed to the Complainant and its business activities, except for a few that pointed to the disputed domain name.

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 Bulgaria and many other countries worldwide. However, the Respondent still chose to register the disputed domain name as such.

Additionally, when searching by the term "novartis oncology vpo" in combination with the Respondent's name or its organization name in Google search engine, no result was found. 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.

Furthermore, the disputed domain name has been used for resolving to an active website displaying blog related to adult content and other inappropriate information, e.g. the heading of the webpage shows "AVAIL A FREE LIVE CAM PORN", and in the paragraph below it introduces a live cam named "Night Vision Nanny Sex Cam"; at the end of the blog, it displays information about personal loan.

When Internet users visit the disputed domain name looking for the information about the Complainant and about oncology, they would only find the inappropriate content. By using the disputed domain name, the Respondent not only illegally and commercially benefits from the Complainant's renown, but also will very likely cause trademark tarnishment to the Complainant's reputable trademark NOVARTIS by relating the Complainant's trademark in the body of the disputed domain name to a website that promotes live cam associated to adult content and other inappropriate information. 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: "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 blog related to adult content and other 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 DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITH

i. THE DOMAIN NAME WAS REGISTERED IN BAD FAITH

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 “oncology” which 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 Bulgaria where the Respondent resides and 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

The disputed domain name has been used to resolve to an active website displaying adult content and other inappropriate information, which is a clear evidence of bad faith use. Again, in the panel statement of WIPO Case No. D2016-1100, 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.”

Secondly, the Complainant has tried to reach the Respondent by a cease-and-desist notice sent on 9 July 2020, and as the registrant was under privacy shield, sent to the privacy email novartisoncologyvpo.com@superprivacyservice.com as provided in the WHOIS and to the registrar email abuse@dynadot.com, requesting the latter to forward it to the registrant. However, until the time the Complainant prepared this Complaint, it has not received any response from the Respondent.

In terms of paragraph 4(b)(iv) of the Policy, the above facts demonstrate the Respondent’s use of the disputed domain name in bad faith.

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

For the complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.

The Complainant has established the fact that it has valid rights for the international word trademark No. 663765 "NOVARTIS" registered in 1997. The disputed domain name has been registered on April 11, 2020, i.e. more than 20 years after the trademark registration.

There are no doubts that the Complainant's trademark "NOVARTIS" is well-known worldwide as confirmed by the previous Panels (e.g. WIPO Case No. D2016-1688).

The first part of the disputed domain name (NOVARTIS) fully corresponds to the Complainant's trademark. The second part of the disputed domain name (ONCOLOGY) is a descriptive term referring to the generic name of the branch of medicine that deals with the prevention, diagnosis, and treatment of cancer. The addition of this descriptive term does not change the overall impression of the designation as being connected to the Complainant and its trademark and more likely strengthens the likelihood of confusion between the disputed domain name and Complainant's trademark as the Complainant's activities or products are or could be used in oncology.

The third part of the disputed domain name "VPO" could be the abbreviation of the words with various meanings but could not be distinctive. Furthermore, the addition of the generic top level domain ".COM" does not change the overall impression of the designation as being connected to Complainant's trademark.

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is confusingly similar to the Complainant's trademark "NOVARTIS" in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

For the complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that (ii) the respondent has no rights or legitimate interests in respect of the domain name.

The Complainant has established a prima facie case (not challenged by the Respondent who did not filed any response to the complaint) that the Respondent has no rights or legitimate interests in the disputed domain name, since the Respondent is not related in any way with the Complainant and there is no indication that the Respondent is commonly known by the term "NOVARTIS" or "NOVARTISONCOLOGYVPO" or that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services. There is also no evidence, that the Respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. Moreover, the disputed domain name resolved to a web page with the blog related to adult content. The connection of the Complainant's trademark with the adult content cannot constitute a bona fide offering of goods or services.

The Panel therefore considers that 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

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that (iii) the domain name has been registered and is being used in bad faith.

The Respondent has registered the disputed domain name which consists the full content of the Complainant's trademark "NOVARTIS" and generic term "ONCOLOGY" that refers to the branch of medicine, i.e. the part of the marketplace targeted by the Complainant. There are no doubts that the Complainant's trademark is distinctive, famous and is well-known worldwide. It could be therefore concluded that the Respondent had or should have the Complainant and its trademark in mind when registering the disputed domain name.

Furthermore, the disputed domain name redirects to a website with the adult content. The tarnishment of a Complainant's trademark by conduct such as linking pornographic or adult content to an unrelated trademark constitutes evidence of bad faith registration and use of the disputed domain name. The Panel cannot even begin to imagine how the Complainant's pharmaceutical and healthcare products could be related to adult content. The intentional featuring of adult content on the website resolved from the disputed domain name has a real risk of tarnishing the Complainant's trademark (see WIPO Case No. D2016-1100).

Considering the (i) confusing similarity between the Complainant's well-known trademark and the disputed domain name, (ii) long time between the registration of the Complainant's trademark and the disputed domain name, (iii) use of the disputed domain name for the adult content, (iv) distinctiveness of the Complainant's trademark and (v) the failure of the Respondent to submit a response or to provide any evidence of good faith use, the Panel finds that the disputed domain name has been registered and is being used in bad faith.

Thus 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

The Panel considers that the Complainant has shown that the disputed domain name <novartisoncologyvpo.com> is confusingly similar to a trademark in which the Complainant has rights, the Respondent has no rights or legitimate interests in respect of the disputed domain name and the disputed domain name has been registered and is being used in bad faith. The Complainant has thus established all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTISONCOLOGYVPO.COM**: Transferred

PANELLISTS

Name	**JUDr. Petr Hostaš**

DATE OF PANEL DECISION 2020-09-30

Publish the Decision