Decision for dispute CAC-UDRP-103262

Case number	CAC-UDRP-103262
Time of filing	2020-09-02 09:36:36
Domain names	novartis-ca.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Organization	andre cole

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any legal proceeding pending or decided between the parties which relate to the disputed domain name

IDENTIFICATION OF RIGHTS

The Complainant's products are sold in about 155 countries and they reached nearly 1 billion people globally in 2017. About 126 000 people of 145 nationalities work at Novartis around the world. Novartis has a strong presence in the UK where has the following trademark registrations which cover the whole European Union:

i. NOVARTIS (word mark), EUTM Registration number EU000304857; date of entry in register: 25 June 1999; priority date: 15 February 1996.

ii. NOVARTIS (word mark), EUTM Registration number EU013393641, date of entry in register: 17 March 2015.

iii. NOVARTIS (word mark), WIPO Registration number WE00001349878, date protection granted in EU: 17 November 2017

The Complainant is the owner of the registered well-known trademark NOVARTIS as a word in several classes in numerous of countries all over the world including the following European Union registrations:

The Complainant has also several domain names comprising NOVARTIS such as NOVARTIS.com created in 1996 and enjoys a strong presence on online platforms such as social media.

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 Name novartis-ca.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 UK 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 the UK: https://www.novartis.co.uk/
Local Website for Novartis in Canada: https://www.novartis.ca/en

The Complainant’s subsidiary is registered at Companies House under the name NOVARTIS UK LIMITED and under the name NOVARTIS PHARMACEUTICALS UK LIMITED .

The Complainant has been awarded 2019 UK Top Employer Certification for sixth consecutive year in UK (https://www.novartis.co.uk/news/media-releases/novartis-uk-gains-top-employer-status-sixth-consecutive-year-recognition) and has partnership or cooperation with numerous UK organizations (https://www.novartis.co.uk/). Furthermore, each year Novartis UK staff will volunteer their time to local organisations and charities, and this has been going on for over 20 years. (https://www.novartis.co.uk/stories/hope/novartis-uk-proudly-continues-over-20-years-community-partnership)

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

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.ca> (created on 26 November 2000) and <novartis.com> (created on 2 April 1996) or in combination with other terms, e.g. <novartispharma.com> (created on 27 October 1999) (page 1-19, Annex 5). 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.

LEGAL GROUNDS:

A. THE DOMAIN NAME IS CONFUSINGLY SIMILAR

The domain name <novartis-ca.com> (hereinafter referred to as the “Disputed Domain Name”), which was registered on 10 February 2020 according to the WHOIS , incorporates entirely the Complainant’s well-known, distinctive trademark NOVARTIS joint by the symbol “-“ with 2 letters “ca”, which very often refers to the country Canada and 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 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 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. When searched for “Novartis” and “ca” in the Google search engine, the returned results all pointed to the Complainant and its business activities. Moreover, the top results pointed to Novartis Canada (novartis.ca), which further demonstrated that the Disputed Domain Name strongly refers to the Complainant’s business activities in Canada.

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 UK, in Canada, and many other countries worldwide. However, the Respondent still chose to register the Disputed Domain Name as such.

According to the Registrar Verification, the Respondent is named “andre cole”, which is not related to the term “Novartis” in any way. Neither does Google search results show any connection between the Complainant and the Respondent .

By the time the Complainant prepared this Complaint on 28 August 2020, the Disputed Domain Name did not resolve to any active websites. From the Complaint’s perspective, the Respondent deliberately chose to use the well-known, distinctive trademark NOVARTIS for the Disputed 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.

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 most of Complainant's trademark registrations 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 "ca" which very often refers to the country Canada 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 facts 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 UK 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 DOMAIN NAME IS BEING USED IN BAD FAITH

Firstly, as noted in the previous paragraphs, the Disputed Domain Name does not resolve to any active websites, which constitutes passive holding/non-use of the Disputed Domain Name.

Secondly, the Complainant has tried to reach the Respondent by a cease-and-desist notice sent on 18 February 2020 and as the registrant was under privacy shield, sent via the Registrar's email domainabuse@tucows.com and the Registration Service Provider's email domains@fasthosts.co.uk with reminders sent on 4 March 2020 and 20 March 2020. The Registration Service Provider confirmed that it had forwarded the communication to the Respondent on 18 February 2020 . 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. See "Dr. Martens" International Trading GmbH and "Dr. Maertens" Marketing GmbH v. Godaddy.com, Inc., WIPO Case No. D2017-0246:

"The Domain Name was not resolving to an active website at the time of filing. However, the consensus view amongst WIPO panellists is that 'the apparent lack of so-called active use (e.g., to resolve to a website) of the domain name without any active attempt to sell or to contact the trade mark holder (passive holding), does not as such prevent a finding of bad faith. The panel must examine all the circumstances of the case to determine whether the respondent is acting in bad faith. Examples of what may be cumulative circumstances found to be indicative of bad faith include the complainant having a well-known trade mark, no response to the complaint having been filed, and the registrant's concealment of its identity'."

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 has been passively holding the Disputed Domain Name.
• Respondent has not responded to Complainant's cease-and-desist letter.
• Respondent has been using privacy shield to conceal its identity.

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

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

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 is English, the proceeding should be English.

LEGAL GROUNDS:

A. THE DOMAIN NAME IS CONFUSINGLY SIMILAR

The domain name <NOVARTIS-CA.COM> (hereinafter referred to as the “disputed domain name”) incorporates the Complainant’s well-known, registered trademark NOVARTIS. The addition of the gTLD “.com” does not add any distinctiveness to the disputed domain name. The addition of the term “CA” is not distinctive and may refer to Canada or as an acronym can refer to different meanings.

As the term “NOVARTIS” is distinctively recognizable in 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 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 in the Google search engine, the returned results all point to the Complainant and its business activity.
The Respondent does know the reputation of the trademark NOVARTIS and could have easily performed a search before registering the Disputed Domain Name and would have known immediately that NOVARTIS as a trademark or name belongs to the Complainant.The web site connected to the domain name at issue is not an active web site.
There is no evidence showing that the Respondent’s use of the disputed domain name is in connection with a bona fide offering of goods or services. T

Taking into account of the above, the Respondent shall be considered as having 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

It has to be highlighted that the Complainant’s famous trademarks predate the registration of the disputed domain name and the Respondent has never been authorized by the Complainant to use these trademarks nor to register the disputed domain name. The Respondent has chosen to incorporate the well-known trademark NOVARTIS in the disputed domain name combined with the general term “CA” as a suffix, which is confusingly similar to ‘www.novartis.com’. From the Complainant’s perspective, it is very likely that the Respondent had the trademark in mind when he registered the disputed domain name and registered it only to mislead Internet users. The Respondent was in bad faith at the moment of the registration of the disputed domain name as well as in its use later on through phishing mails.

The Respondent did not answer to the Complainant’s cease and desist letter sent on February 18, 2020. The domain name was not resolving to an active web site at the time of filing and still is in a passive holding situation. The three factual circumstances of 1) no reply to the Complaiant’s letter 2) domain name identical to a well known trademark and 3) attempt of the Registrant to conceal his identity are all leading to the finding of bad faith upon the Respondent.

Therefore, it is reasonable to conclude that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or website of others, by creating a likelihood of confusion with the Complainant’s trademark.

To summarize, 1) the trademark NOVARTIS is a well-known trademark worldwide and is in the use and registered in the Country where the Respondent and the Registrar are located. 2) The Respondent bears no relationship to the trademarks or the Complaint; it is not commonly known by the disputed domain name nor that has it interest over the disputed domain name or the major part of it; 3) The Respondent has not been using the domain name and never replied to the Complainant

hiding his identity at the moment of registration.

Consequently, the Respondent should be considered to have registered the disputed domain name confusingly similar to the Complainant's registered without any legitimate right or interest and above all the domain name was registered and used in bad faith.

Massimo Cimoli

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTIS-CA.COM**: Transferred

PANELLISTS

Name	**Massimo Cimoli**

DATE OF PANEL DECISION 2020-10-07

Publish the Decision