Decision for dispute CAC-UDRP-103299

Case number	CAC-UDRP-103299
Time of filing	2020-09-22 10:00:40
Domain names	novartisglobalgroups.com

Case administrator

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

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Name	Ambrose Quin

OTHER LEGAL PROCEEDINGS

There is no other legal proceeding related to the disputed domain name.

IDENTIFICATION OF RIGHTS

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

Trademark: NOVARTIS
Reg. no: 5420583
Reg. date: 13 March 2018

Trademark: NOVARTIS
Reg. no: 2997235
Reg. date: 20 Sep 2005
First use in commerce: 1997

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 a strong presence in the United States of America (the "USA") where the Respondent is located. The Complainant has numerous subsidiaries and associated companies based in the USA. Moreover, in 2019, 34 % of Novartis Group's total net sales were constituted in the USA.

The Complainant is the owner of the well-known trademark NOVARTIS registered as both a word and device mark in several classes worldwide, including the USA. The vast majority of the Complainant's trademark registrations significantly predates the registration of the Disputed Domain Name.

The Disputed Domain Name does not resolve to any active website. The Respondent has neither responded to Complainant's cease and desist correspondence, nor provided any reply to the complaint in this proceeding.

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. When searched for the terms "Novartis" "global" and "groups" 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 the USA 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 was named "Ambrose Quin", which is not related to the Complainant nor to the term "Novartis" in any way.

i. THE DISPUTED DOMAIN NAME WAS REGISTERED IN BAD FAITH

It should be highlighted that 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" combined with the terms "global groups", 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.

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 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

First, 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.

Second, the Complainant has tried to reach the Respondent by a cease-and-desist notice sent on 17 August 2020, and as the registrant was under privacy shield, sent via the online contact form in the WHOIS. However, Complainant says that it did not get any timely 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, e.g., “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’.”

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).

The Complainant is the owner of the trademark NOVARTIS registered as both a word and device mark in several classes worldwide, including the USA. Complainant’s trademark registration predates the registration of the Disputed Domain Name. Namely, the Complainant’s trademark registrations in the USA applying to the present proceedings include the following earlier rights:

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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 domain name <novartisglobalgroups.com> (hereinafter referred to as the "Disputed Domain Name"), which was registered on 30 July 2020 according to the WHOIS, incorporates the Complainant's well-known, distinctive trademark NOVARTIS in its entirety combined with the terms "global groups", 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.

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).

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. When searched for the terms "Novartis" "global" and "groups" 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 the USA 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 was named "Ambrose Quin", which is not related to the Complainant nor to the term "Novartis" in any way.

As of the time of the Complaint, the Disputed Domain Name did not resolve to any active websites. The Respondent does not appear to have been using the Disputed Domain Name for any bona fide offering of goods or services.

As argued by Complainant and not rebutted by Respondent, it appears 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 -- which therefore cannot be considered as a bona fide offering of goods or services.

This is a sufficient prima facie argument, requiring rebuttal from Respondent with evidence as to legitimate usage. But there has been no Response filed, and thus the panel draws reasonable inferences in favor of Complainant as to this element and the element of bad faith.

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).

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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 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.:

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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, e.g., "Dr. Martens" International Trading GmbH and "Dr. Maertens" Marketing GmbH v. Godaddy.com, Inc., WIPO Case No. D2017-0246:

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In this case, the panel finds that Respondent's apparent passive holding has no legitimate purpose and is a use of the domain name in bad faith.

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

• NOVARTIS is a well-known, distinctive trademark.

• 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 or online communication.

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 Panel has not been presented evidence of any legitimate right or interest in using the Disputed Domain Name, and thus it appears to have been registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTISGLOBALGROUPS.COM**: Transferred

PANELLISTS

Name	**Mike Rodenbaugh**

DATE OF PANEL DECISION 2020-10-21

Publish the Decision