Decision for dispute CAC-UDRP-103308

Case number	CAC-UDRP-103308
Time of filing	2020-09-23 09:48:10
Domain names	novartisvaccinesdirect.com

Case administrator

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

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Name	James Browne

OTHER LEGAL PROCEEDINGS

There are no other legal proceedings related to the disputed domain name.

IDENTIFICATION OF RIGHTS

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. 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 September 2005
First use in commerce: 1997

FACTUAL BACKGROUND

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

The Complainant is a big global pharmaceutical and healthcare group. It provides solutions to address the evolving needs of patients worldwide by developing and delivering innovative medical treatments and drugs. 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 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 disputed domain name was registered on 13 May 2019. Respondent has been passively holding the disputed domain name. He has not responded to Complainant’s cease-and-desist letter of 6 April 2020 and uses privacy shield to avoid to tell his 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 disputed domain name,which was registered on 28 February 2019 according to the WHOIS, incorporates the Complainant’s well-known, distinctive trademark NOVARTIS in its entirety, which is closely related to the Complainant and its business activities. The addition of the gTLD “.dev” 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”.

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 “Novartis” 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.

Furthermore, 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 of the Complaiant 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.

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). 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 the gTLD ".dev" which has several interpretations that closely relate 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."

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 6 April 2020, and as the registrant was under privacy shield, sent to the privacy e-mail novartisvaccinesdirect.com@domainsbyproxy.com as provided in the WHOIS. 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.

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'."

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 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 or online communication.

• 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. 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.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTISVACCINESDIRECT.COM**: Transferred

PANELLISTS

Name	**Thomas Hoeren**

DATE OF PANEL DECISION 2020-10-29

Publish the Decision