Decision for dispute CAC-UDRP-103326

Case number	CAC-UDRP-103326
Time of filing	2020-10-02 10:09:53
Domain names	NovartisGeneTherapies.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Organization	shenchaoyong

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

- International trademark registration number IR666218 “NOVARTIS”, granted January 31, 1996 in classes 41 and 42; and

- International trademark registration number IR663765 “NOVARTIS”, granted January 7, 1996 in classes 01, 02, 03, 04, 05, 06, 07, 08, 09, 10, 14, 16, 17, 20, 22, 28, 29, 30, 31, 32, 40 and 42.

The Complainant also owns the domain names <novartis.com.cn> (created on August 20, 1999), <novartis.com> (created on April 2, 1996) and <novartispharma.com> (created on October 27, 1999).

FACTUAL BACKGROUND

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

A. LANGUAGE OF THE PROCEEDING

The Complainant requested that the Panel adopt English in this proceeding in accordance with paragraph 11 of the UDRP

Rules for the following reasons:

• The disputed domain name is composed of the mark “NOVARTIS” and the English terms “GENE” and “THERAPIES”, both of which are correctly spelled. The Complainant asserts the choice of registering and using a domain name with English terms shows that the Respondent understands English and its intention is to target internet users who understand English.

• The website of the disputed domain name displays the following statement: “This domain name novartisgenetherapies.com is for sale! If you would like to purchase this domain name, please click here to make an offer”. The Complainant asserts this demonstrates that the Respondent clearly understands English.

• On September 15, 2020 the Complainant sent a cease and desist letter to the Respondent, to which it replied on September 16, 2020. The Complainant asserted this also indicated that the Respondent clearly understands English well.

• The Complainant asserts if the Complainant had to translate the Complainant’s subsequent communications in Chinese, such translation would entail significant additional costs for the Complainant and delay in the proceedings (see Ape & Partners S.p.A. and PJS International S.A v Pjs Parajumpers, WIPO Case No. D2015-0637).

Finally, the Complainant asserts the respondent would not be jeopardized by the adoption of English as an alternative language of these UDRP proceedings, while the adoption of Chinese would be troublesome for the Complainant.

B. THE COMPLAINANT

The Complainant is a global pharmaceutical and healthcare group. It provides solutions to address the evolving needs of patients worldwide by developing and delivering innovative medical treatment and drugs. The Complainant was created in 1996 through a merger of two other companies, being Ciba-Geigy and Sandoz, and is the holding company of the Novartis Group.

The Complainant’s products are manufactured and sold in many regions worldwide including China. The Complainant has a presence in China where the Respondent is located.

The Complainant argues that the disputed domain name is confusingly similar to the Complainant’s trademarks, the Respondent has no rights or legitimate interest in the disputed domain name and has registered it in bad faith and is using it in bad faith.

C. THE RESPONDENT

The disputed domain name was registered on September 9, 2020 to shenchaoyong. Currently, the disputed domain name does not resolve to a website with actual content, but at the time of filing of the Complainant, hosted a landing page offering the sale for the disputed domain name.

Screenshots of that website contain the following statement ““This domain name novartisgenetherapies.com is for sale! If you would like to purchase this domain name, please click here to make an offer”. Despite this claim the Complainant denies the Respondent had authorized use to include the trademark in the disputed domain name, or to make any other use of the trademark in any manner whatsoever. The Complainant also confirms that it is not in the possession of, nor aware of the existence of, any evidence tending to demonstrate that the Respondent is commonly known by the domain name, as individual, business, or other organization.

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

A. LANGUAGE OF THE PROCEEDING

The Complainant has made a request under paragraphs 11(a) of the Rules that the language of this administrative proceeding be English. That paragraph reads:

"Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding."

The Complainant has, in its Complaint, accepted the likelihood that the Registrar Agreement is in Chinese and not English.

It has been stated that the discretion to decide upon the language of the proceeding under Rule 11(a) "must be exercised in the spirit of fairness and justice to both parties taking into consideration matters such as command of the language, time and costs" (please see Transtrands Handelsaktiebolag v. Jack Terry; WIPO Case No. D2005-0057). However it is without doubt that the command of language is the most vital consideration in the sense that if a Respondent has no understanding of the language of the complaint, and therefore is unable to even understand that a type of complaint which calls upon a response has been made against them, then there would be an obvious injustice to proceed in a language other than that of the Registrar Agreement to which the Respondent agreed.

However the vital nature of this consideration does not require overwhelming evidence from a Complainant that a respondent is in fact highly proficient in the language in order for the Panel to deem it the appropriate language of the proceeding. No words indicating such a high onus exist in paragraph 11(a) of the Rules. Further it is the Panel's view that if the preliminary matter of the language of the proceeding can be decided on the facts without delaying the proceeding then such a decision ought to be made.

The Panel finds in the present matter on the question of whether the Respondent has sufficient command of the English language that it is enough that the facts show a likelihood that the Respondent had sufficient knowledge of this language to:

1. Understand that a complaint had been made against it; and
2. Be able to make the decision, as it did, to refrain from filing a response.

Such facts have been shown by the registration of the disputed domain name in latin characters together with the email correspondence in the English language. The above question has therefore been answered in the affirmative. It is unnecessary to investigate the proficiency of the Respondent's understanding of English any further. The Respondent has sufficient knowledge to satisfy the above. With such sufficient knowledge, if the Respondent believed it was prejudiced by

the Complainant's request that the language of the proceeding be in English it ought to have filed a response saying so and setting out its reasons. It has not done so, in any language.

As to the remaining relevant factors the Panel accepts that the Complainant would incur costs and delay if the proceedings were to be conducted in Chinese which, given the facts set out above, are unjustified. As the Respondent has chosen not to file a response, it is not prejudiced in the same manner even if its preferred language was Chinese.

B. SUBSTANTIVE ISSUES

Paragraph (4)(a) of the Policy lists three elements that the Complainant must prove to merit a finding that the disputed domain name registered by the Respondent be transferred to the Complainant:

1) the disputed domain name is identical or confusingly similar to a trademark or service mark ("mark") in which the Complainant has rights; and

2) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

3) the disputed domain name has been registered and is being used in bad faith.

The Panel is satisfied that the Complainant has satisfied all three elements for the principal reasons set out below.

B(i). RIGHTS IN AN IDENTICAL OR CONFUSINGLY SIMILAR TRADEMARK

As mentioned above the Complainant asserts it has a number of trademark registrations consisting of the word "NOVARTIS". At least two of these registrations predate the registration date of the disputed domain name by over two decades.

To satisfy paragraph 4(a)(i) of the Policy it is enough that the Panel is satisfied that the Complainant has registered rights that predates the registration of the disputed domain name in a single jurisdiction (even if that single jurisdiction is not one in which the Respondent resides or operates) (Koninklijke KPN N.V v. Telepathy Inc D2001-0217 (WIPO May 7, 2001); see also WIPO Case Nos D201200141 and D2011-1436). The Complainant has clearly satisfied such in relation to the trade mark NOVARTIS.

The next question is whether the disputed domain name is confusingly similar to the NOVARTIS trademark.

The Panel disregards the gTLD suffix ".com". It is of no brand significance and it is likely to be totally ignored by web users. It adds no 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 notion of the top-level suffix in the domain name (e.g., ".com") is to be disregarded under the confusing similarity test".

Once the .com is disregarded the remaining elements of the disputed domain name consist of the Complainant's trademark followed by terms descriptive in the industry in which the Complainant operates. The disputed domain name is clearly confusingly similar to the NOVARTIS trademark.

B(ii) NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant must show that the Respondent has no rights or legitimate interests in respect of the disputed domain

name.

The Respondent's name according to information provided by the registrar is "shenchaoyong". This name bears no resemblance to "NOVARTIS". Further, the website to which the disputed domain name resolves does not currently, nor at the time when the complaint was made, have any content which would indicate any right or legitimate interest in the disputed domain name.

The Respondent has no rights or interests in the disputed domain name.

B(iii) BAD FAITH

The Panel accepts that the Complainant has an international reputation in the NOVARTIS trademark in relation to global pharmaceutical and healthcare services. The Panel refers in particular to the detailed social media information contained in one of the annexures attached to the complaint which clearly demonstrates its wide online presence.

The Panel notes that, at the time the complaint was filed, the disputed domain name redirected users to an advertisement page for the purpose of profiting from the sale of the domain name. Considering the reputation of the Complainant and its trademark, in connection with the terms "gene" and "therapies" both of which are closely related to the Complainant and its business activities, the incorporation of trademark NOVARTIS into the disputed domain name is a deliberate attempt to improperly benefit from the Complainant.

Further, the Respondent has been involved in UDRP proceedings leading to the transfer of disputed domain names in the past. For example, (Faurecia v. shenchaoyong, WIPO Case No. 2019-1886, concerning the domain names <faurecia-clarion.com>, <faureciaclarion.com>, <faurecia-clarion-electronics.com> and <faureciaclarionelectronics.com>; see also Facebook Inc. v. Shenchaoyong, WIPO Case No. D2015-1474, concerning the domain name <facebookaudiencenetwork.com>).

These circumstances demonstrate the Respondent engaging in a pattern of registering domain names to prevent the owner of the relevant trademark or service mark from reflecting the mark in a corresponding domain name. WIPO Overview 3.0, para 3.1.4 states that:

"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".

The Panel find also finds the following concerning:

(a) According to the Complainant's uncontested contentions and supporting information NORVATIS is distinctive and well known; and

(b) The only distinctive element in the disputed domain name is NORVATIS; and

(c) the Complainant has evidence long standing registered rights in trademarks consisting of NORVATIS.

These combined facts have led the Panel to the conclusion that in such circumstances it is highly unlikely that the Respondent was unaware of this reputation at the time of registering the disputed domain name.

As the Panel has found the Respondent had such prior knowledge of the NORVATIS trademark at the time of registering the disputed domain name it can only follow that the purpose in registering the disputed domain name was to opportunistically profit from such confusing similarity. The Respondent targeted the Complainant's well-known name for this purpose. Such opportunism has been recognized by numerous panels, the Panel refers to the commentary of the learned Gerald M Levine, Domain Name Arbitration, Legal Corner Press, 1st ed. 2015, pp 258 to 259. The Respondent is clearly misleading consumers

into believing such a connection exists with the Complainant's well-known brand.

Therefore in consideration of all the circumstances the disputed domain name has been registered and is being 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. **NOVARTISGENETHERAPIES.COM**: Transferred

PANELLISTS

Name	**Mr Andrew Norman Sykes**

DATE OF PANEL DECISION 2020-11-14

Publish the Decision