Decision for dispute CAC-UDRP-103349

Case number	CAC-UDRP-103349
Time of filing	2020-10-14 10:47:04
Domain names	novartispharmadelivery.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Name	Van Van Perez

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant has evidenced to be the owner of the following national trademark registrations relating to its company name and brand “Novartis” with protection for the territory of the United States:

- Word mark NOVARTIS, United States Patent and Trademark Office (USPTO), registration No.: 5420583, registration date: March 13, 2018, status: active;

- Word mark NOVARTIS, USPTO, registration No.: 2997235, registration date: September 20, 2005, status: active.

Moreover, the Complainant has demonstrated to own various domain names relating to its NOVARTIS trademarks, e.g. <novartis.com> as well as <novartis.us>, both used to promote the Complainant’s pharmaceutical products and related services under the NOVARTIS trademark.

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 Ddisputed Ddomain Nname <novartispharmadelivery.com> is English according to the Registrar Verification (Annex 1), the language of the proceedings 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 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 (Annex 2.1). Moreover, in 2019, 34% of Novartis Group's total net sales were constituted in the USA (Annex 2.2).
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 Ddisputed Ddomain nName. 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

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.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.

LEGAL GROUNDS:

A. THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR

The disputed domain name <novartispharmadelivery.com> (hereinafter referred to as the "Disputed Domain Name"), which was registered on 7 March 2019 according to the Registrar Verification, incorporates the Complainant's well-known, distinctive trademark NOVARTIS in its entirety combined with generic terms "pharma delivery", 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. 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”.

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 DISPUTED 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.

The Complainant has not found that the Respondent is commonly known by the Disputed Domain Name or that it has legitimate interest over the Disputed Domain Name or the major part of it. When searched for “Novartis” “pharma” “delivery” 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.

In addition, according to the Registrar Verification, the Respondent is named “Van Van Perez”, which is not related to the Complainant nor to the term “Novartis” in any way.

By the time the Complainant prepared it's Complaint on 12 October 2020, the Disputed Domain Name did not resolve to any active websites. From the Complainant’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 attract Internet traffic by benefiting from the Complainant’s worldwide renown.

Furthermore, when Internet users, who search for information about the Complainant and/or about the brand “Novartis”, see the Disputed Domain Name, would very likely be confused and be led to believe that the Disputed Domain Name is somehow related to the Complainant. When they find the website associated to the Disputed Domain Name is inactive, they would be possibly disappointed, which leads to trademark tarnishment for the Complainant.

For the foregoing reasons, it shall be concluded that the Respondent has no right nor legitimate interest in respect of the Disputed Domain Name and has not been using the Disputed Domain Name for any bona fide offering of goods or services.

C. THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITH

i. THE DISPUTED 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 the generic terms “pharma delivery” 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 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 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

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 24 September 2020, and as the registrant was under privacy shield, sent to the privacy email 35aa6bd768ac47a3be5925b9628d366c.protect@whoisguard.com as provided in the WHOIS. 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 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 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

The Panel finds that the disputed domain name is confusingly similar to the NOVARTIS trademark in which the Complainant has rights. The disputed domain name incorporates the NOVARTIS trademark in its entirety. Numerous UDRP panels have recognized that incorporating a trademark in its entirety can be sufficient to establish that the disputed domain name is at least confusingly similar to a registered trademark. Moreover, there also is consensus view among UDRP panels that the mere addition of descriptive or other terms, such as "pharma" (which even directly refers to the Complainant's pharmaceutical business) and/or "delivery" is not capable to dispel the confusing similarity arising from such incorporation of the Complainant's NOVARTIS trademark in the disputed domain name.

Therefore, the Complainant has established the first element under the Policy as set forth by paragraph 4(a)(i).

Also, the Complainant contends, and the Respondent has not objected to these contentions, that the Respondent has neither made use, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, nor is the Respondent making a legitimate noncommercial or fair use of the disputed domain name, nor is the Respondent commonly known thereunder. The Respondent has not been authorized to use the Complainant's NOVARTIS trademark, either as a domain name or in any other way. Also, there is no reason to believe that the Respondent's name somehow corresponds with the disputed domain name and the Respondent does not appear to have any trademark rights associated with the term "Novartis" whatsoever. Moreover, the disputed domain name apparently has not yet been actively used by the Respondent, either on the Internet or in any other way (so-called "passive holding"). Many UDRP panels have recognized, however, that the mere registration of a domain name, even one that is comprised of a confirmed dictionary word or phrase, may not of itself confer rights or legitimate interests in a disputed domain name. Accordingly, the Panel has no difficulty in finding that the Respondent in fact lacks rights or legitimate interests in respect of the disputed domain name.

Therefore, the Complainant has also satisfied paragraph 4(a)(ii) and, thus, the second element of the Policy.

The Panel finally holds that the disputed domain name was registered and is being used by the Respondent in bad faith. It is undisputed between the Parties that the Complainant's NOVARTIS trademark enjoys considerable recognition throughout the world, including in the United States; also, the way in which the disputed domain name has been set up and registered (namely as a combination of the NOVARTIS trademark together with other terms , such as e.g. "pharma" which directly refers to the Complainant's pharmaceutical business) leaves little, if no doubt that the disputed domain name aims at targeting the Complainant's NOVARTIS trademark. Also, there is a consensus view among UDRP panels that a passive holding of a disputed domain name may, in appropriate circumstances, be consistent with the finding of bad faith, in particular in circumstances in which, for example, a complainant's trademark is well-known, and there is no conceivable use that could be made of the disputed domain name and would not amount to an infringement of the complainant's trademark's rights. In the case at hand, given the undisputed reputation of Complainant's NOVARTIS trademark, in the absence of any other reasonable explanation as to why the Respondent should rely on the disputed domain name and in light of the fact that the Respondent has brought forward nothing in substance relating to the intended use of the disputed domain name that would have allowed the Panel to hold for Respondent, the Panel finds that the Respondent has registered and is making use of the disputed domain name in a manner which at least takes unjustified and unfair advantage of the Complainant's trademark's fame and must, therefore, be considered as registered and being used in bad faith within the larger meaning of paragraph 4(b) of the Policy.

Therefore, the Complainant has also satisfied the third element under the Policy as set forth by paragraph 4(a)(iii).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTISPHARMADELIVERY.COM**: Transferred

PANELLISTS

Name	**Stephanie G. Hartung, LL.M.**

DATE OF PANEL DECISION 2020-11-16

Publish the Decision