Decision for dispute CAC-UDRP-103258

Case number	CAC-UDRP-103258
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Domain names	copaynovartisoncology.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Name	Zhichao Yang

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 International (IR) trademark registrations relating to its company name and brand “Novartis” with protection, inter alia, for the territory of China:

- Word mark NOVARTIS, World Intellectual Property Organization (WIPO), registration No.: 666218, registration date: October 31, 1996, status: active;

- Word mark NOVARTIS, WIPO, registration No.: 663765, registration date: July 1, 1996, 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.com.cn, 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:

According to the Registrar Verifications (Annex 1.1, 1.2), the language of the registration agreement for the Disputed Domain Names is English for Copaynovartisoncology.com and Chinese for copaynovartis.com.

Pursuant to paragraph 11 of the UDRP Rules, in the absence of an agreement between the parties, or unless otherwise agreed by the parties, the language of the proceeding is the language of the registration agreement, subject to the authority of the panel to determine otherwise, exercising its "discretion in the spirit of fairness to both parties, which pursuant to paragraph 10(b) of the Rules have to be treated with equality, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs" (for example Carrefour v. Contact Privacy Inc. Customer 1242379769 / Le Berre, WIPO Case No. D2018-1552).

Since the language of one of the Registration Agreements is different from English, the Complainant hereby requests that the language of the present administrative proceeding be English based on the following reasons:

1. The language of the Registration Agreement for Copaynovartisoncology.com is English, which demonstrates that the Respondent clearly understands English and falls into paragraph 11 of the UDRP Rules;
2. The Disputed Domain Names - copaynovartisoncology.com and copaynovartis.com, are composed of the mark NOVARTIS in combination with English terms "copay" and/or "oncology" which are correctly spelt and therefore proves that the Respondent can understand English well. Moreover, the choice of registering and using a domain name with English terms shows that the Respondent's intention is to target Internet users who understand English;
3. On the websites of the Disputed Domain Names, for example, Copaynovartisoncology.com, it displays terms in English, such as "Accept Credit Card Payments", which demonstrates that the Respondent clearly understands English.

Moreover, if the Complainant had to translate the Complaint's subsequent communications in another language, such translation would entail significant additional costs for the Complainant and delay in the proceedings (for instance Ape & Partners S.p.A. and PJS International S.A. v. Pjs Parajumpers, supra).

Consequently, the Complainant requests the Panel to exercise its discretion and allow the proceedings to be conducted in 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 including China. The Complainant has a strong presence in China where the Respondent is located. The below link connects 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/about-us/contact/office-locations?tid=All&name_list=CN
- Local Website for NOVARTIS in China: see www.novartis.com.cn

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

Overview of trademark registrations:

IR = International Registration

Trademark: NOVARTIS
Reg. No: IR666218
Class: 41; 42
Date of Registration: 31.10.1996 (ink. China)

Trademark: NOVARTIS
Reg. No: IR663765
Class: 01; 02; 03; 04; 05; 07; 08; 09; 10; 14; 16; 17; 20; 22; 28; 29; 30; 31; 32; 40; 42
Date of Registration: 01.07.1996 (ink. China)

See Annex 4.1 for trademark registrations extracts and Annex 4.2 for a list with some Novartis trademarks and application in the world.

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.com.cn> (created on 20 Aug 1999) 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 DOMAIN NAMES ARE IDENTICAL OR CONFUSINGLY SIMILAR

The domain names - copaynovartisoncology.com & copaynovartis.com (hereinafter referred to as the “Disputed Domain Names”), which were registered on 28 March 2020 and 21 July 2020 according to the WHOIS incorporate the Complainant’s well-known, distinctive trademark NOVARTIS in its entirety combined with the terms “copay” “copay oncology”, 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 Names.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 Names should be considered as confusingly similar to the trademark NOVARTIS.

B. RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN RESPECT OF THE DOMAIN NAMES

The Complainant has never granted the Respondent any right to use the NOVARTIS trademark within the Disputed Domain Names, 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 Names or that it has legitimate interest over the Disputed Domain Names or the major part of them. When entering the terms “NOVARTIS”

“copay” and “oncology” in the Google and Baidu search engine (Baidu is the leading search engine in China), the returned results all pointed to the Complainant and its business activities and not to the Respondent.

The Respondent could have easily performed a similar search before registering the Disputed Domain Names and would have quickly learnt that the trademarks are owned by the Complainant and that the Complainant has been using its trademarks in China and many other countries of the world. However, the Respondent still chose to register the Disputed Domain Names as such.

According to the Registrar Verification, the Respondent is named “Zhichao Yang”, which is not related to the Complainant nor to the term “Novartis” in any way.

Moreover, at the time of filling the Complaint on 3 September 2020, the Respondent’s identity was not disclosed on the publicly available WHOIS. The Respondent has been indeed using a privacy shield service. Hence, the Respondent is most likely aiming at hiding its identity rather than being known by the Disputed Domain Names.

By the time the Complainant prepared this Complaint on 3 September 2020, the Disputed Domain Names resolved to pay-per-click websites. Pursuant to WIPO Overview 3.0, para. 2.9, the Respondent has not been using the Disputed Domain Names for any bona fide offering of goods or services as the panels hold the opinion that:

“Applying UDRP paragraph 4(c), panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant’s mark or otherwise mislead Internet users.”

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

C. THE DOMAIN NAMES WERE REGISTERED AND ARE BEING USED IN BAD FAITH

i. THE DOMAIN NAMES WERE REGISTERED IN BAD FAITH

It should be highlighted that most of Complainant’s trademark registrations predate the registration of the Disputed Domain Names and the Respondent has never been authorized by the Complainant to register the Disputed Domain Names. Considering the renown of the Complainant and its trademark NOVARTIS, and the overall composition of the Disputed Domain Names, i.e. using the term “Novartis” in connection with the term “copay” and “copay” “oncology”, which are closely related to the Complainant and its business activities, it follows that incorporating the well-known trademark NOVARTIS in the Disputed Domain Names 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 when it registered the Disputed Domain Names;
• The Complainant’s trademark NOVARTIS is a distinctive, well-known trademark worldwide, including China where the Respondent resides;
• The Respondent’s registration of the Disputed Domain Names follows a pattern of abusive registrations;
• The Respondent has failed in presenting a credible evidence-backed rationale for registering the Disputed Domain Names,

the Disputed Domain Names 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 NAMES ARE BEING USED IN BAD FAITH

Firstly, as noted in the previous paragraphs, the Disputed Domain Names resolved to pay-per-click websites. In terms of paragraph 4(b)(iv) of the Policy, this conduct constitutes bad faith as it has been confirmed in previous cases, e.g. WIPO Case No. D2016-0245, Heraeus Kulzer GmbH. v. Whois Privacy Services Pty Ltd / Stanley Pace, wherein the Panel stated:

"The Panel finds that the Domain Name was registered and is being used to attract, for commercial gain, Internet users to the Respondent's Website or other online location, by creating a likelihood of confusion with the Complainant's KULZER Mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's Website. In particular the Respondent's Website is a page that offers sponsored-links to third-party sites that have in the past and may in the future sell products that directly compete with the Complainant's dental equipment. Such sites generally advertise by paying registrants on a pay-per-click basis for Internet users redirected to their sites. This means that the Respondent receives a financial reward for every Internet user redirected from the Respondent's Website to those third-party sites.

Accordingly, the Panel finds that the Respondent has registered and is using the Domain Name in bad faith under paragraph 4(a)(iii) of the Policy."

Secondly, as the Respondent has registered two domain names containing the Complainant's well-known, distinctive trademark Novartis combined with the term "copay" "copay oncology", such registration constitutes a pattern of conduct that prevents a trademark holder from reflecting its mark in a domain name. For instance WIPO Case No. D2017-0391, Arla Foods Amba and Mejeriforeningen Danish Dairy Board v. Mohammad Alkurdi, where the panel concluded that:

"In the Panel's opinion, this list demonstrates that Respondent has clearly engaged in a pattern of registering domain names in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, and that the registration of the disputed domain names was in bad faith under Policy paragraph 4(b)(ii)."

Lastly, the Complainant has tried to reach the Respondent by a cease-and-desist letter sent on 15 April 2020 and 17 August 2020. As the registrant was under privacy shield, the Complainant sent the cease-and-desist letter to the privacy email copaynovartisoncology.com@superprivacyservice.com as provided in the WHOIS, and to the Registrar abuse@dynadot.com, requesting the latter to forward it to the Respondent. Also, the Complainant has sent the cease-and-desist letter to the registrant via online contact form https://whois.aliyun.com/whois/whoisForm. However, until the time the Complainant prepared this Complaint, it has not received any response from the Respondent.

The Respondent's non-response to cease-and-desist letter infers bad faith use of the Disputed Domain Names.
SUMMARY

• NOVARTIS is a well-known, distinctive trademark worldwide.
• Complainant's trademarks registration predates the registration of the Disputed Domain Names.
• Respondent has no rights in the mark NOVARTIS, bears no relationship to the Complainant, and is not commonly known by the Disputed Domain Names - accordingly it has no legitimate interest in the Disputed Domain Names.
• 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 Names, given the Complainant's worldwide renown.
• Respondent has been using the Disputed Domain Names to resolve to pay-per-click websites.
• Respondent's registration of the Disputed Domain Names has constituted a pattern of conduct that prevents a trademark holder from reflecting its mark in a domain name.
• Respondent has not responded to Complainant's cease-and-desist communication.
• Respondent has been using privacy shield to conceal its identity.

Consequently, the Respondent should be considered to have registered the Disputed Domain Names 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 Names, but rather registered and has been using the Disputed Domain Names 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 Names are 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 Bame (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 have been registered and are 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

First of all, the Panel decides within its powers set forth by paragraph 11(a) of the Rules that the language of proceedings shall be English as requested by the Complainant. There is reason to believe that the Respondent can well understand the English language as the PPC websites to which the disputed domain names redirect apparently are set up in English plus that the disputed domain names themselves include the English terms "copay" and "oncology". Accordingly, it would constitute an unfair disadvantage to the Complainant had it been forced to translate the Complaint into the Chinese language.

Having said so, the Panel comes to the following decision on the subject of this matter:

The Panel finds that the Disputed Domain Names are confusingly similar to the NOVARTIS trademark in which the Complainant has rights. The Disputed Domain Names both incorporate 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 Names are 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 "copay" and/or "oncology" (the latter of which even directly refers to the Complainant's pharmaceutical business) is not capable to dispel the confusing similarity arising from such incorporation of the Complainant's NOVARTIS trademark in the disputed domain names.

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 names 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 Names, 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 Names and the Respondent does not appear to have any trademark rights associated with the term "Novartis" whatsoever. Moreover, the Disputed Domain Names redirect to standard Pay-Per-Click (PPC) websites with hyperlinks to a variety of third parties' commercial websites. Many UDRP Panels have found that the generation of PPC revenues by using a domain name that is confusingly similar to a trademark neither qualifies as a bona fide offering of goods or services nor as a legitimate noncommercial or fair use under the UDRP. Accordingly, the Panel has no difficulty in finding that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names.

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 Names were registered and are 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 China; also, the way in which the Disputed Domain Names have been set up and registered (namely as a combination of the NOVARTIS trademark together with other terms, such as e.g. "oncology" which directly refers to the Complainant's pharmaceutical business) and are being used leaves little, if no doubt that the Disputed Domain Names both aim at targeting the Complainant's NOVARTIS trademark. Therefore, redirecting the disputed domain names which are confusingly similar to the Complainant's NOVARTIS trademark to a typical PPC website which shows a variety of hyperlinks to active third parties' websites for the obvious purpose of generating PPC revenues, is a clear indication that the Respondent intentionally attempted to attract, for commercial gain, Internet users to its own websites by creating a likelihood of confusion with the Complainant's NOVARTIS trademark as to the source, sponsorship, affiliation or endorsement of this website. Such circumstances are evidence of registration and use of the Disputed Domain Name in bad faith within the meaning of paragraph 4(b)(iv) 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. **COPAYNOVARTISONCOLOGY.COM**: Transferred
2. **COPAYNOVARTIS.COM**: Transferred

PANELLISTS

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

DATE OF PANEL DECISION 2020-11-16

Publish the Decision