Decision for dispute CAC-UDRP-103351

Case number	CAC-UDRP-103351
Time of filing	2020-10-15 10:25:59
Domain names	novartisrheumatologyacr2020.com, novartisrheumatologyvirtual.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Organization	ZEIT, Inc.

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 names.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of several trademarks. In particular, Novartis AG owns:

- US trademark NOVARTIS (word) no. 5420583 registered on March 13, 2018 for classes 9, 10, 41, 42, 44 and 45;

- US trademark NOVARTIS (word) no. 2997235 registered on September 20, 2005 and duly renewed for class 5.

FACTUAL BACKGROUND

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

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 declares that 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.

The Complainant informs that Novartis Group products are manufactured and sold in many regions worldwide. According to the Complainant, Novartis Group has especially a strong presence in the United States of America where the Respondent is located. The Complainant, in particular, has duly proved to be the owner of the registered well-known trademark NOVARTIS in several classes in numerous countries all over the world including in the United States of America, where the Respondent is located and that these trademark registrations predate the registration of the disputed domain names (September 2020).

The Complainant outlines that in the WIPO Case No. D2016-1688, Novartis AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org, / Sergei Lir , the panel has stated that NOVARTIS is a well-known trademark. The Complainant has registered a number of domain names including the trademark NOVARTIS such as <novartis.us>, <novartis.com> and <novartispharma.com>. The Complainant uses these domain names to promote the NOVARTIS mark with related products and services.

According to the Complainant, the domain names in dispute are similar to its NOVARTIS trademark since both incorporate the well-known distinctive trademark NOVARTIS in its entirety combined with generic terms

The Complainant has not found that the Respondent is commonly known by the domain names or that it has interest over the domain names. The Complainants has also proved that when searched for “Novartis” “rheumatology acr 2020” “rheumatology virtual” in the Google search engine, the returned results all pointed to the Complainant and its business activities. The Complainant argues that the Complainant trademarks predate the registration of both domain names in dispute and that the Respondent has never been authorized by the Complainant to register the domain names.

In the Complainant's view the overall composition of the disputed domain names, i.e. using the term "Novartis" in connection with the generic terms “rheumatology acr 2020” / “rheumatology virtual”, closely related to the Complainant and its business activities, is a deliberate and calculated attempt to improperly benefit from the Complainant’s rights and reputation. The Complainant informs that an attempt to contact the Respondent was made on September 24, 2020 through a cease and desist letter and that it has never received any response from the Respondent. The Complainant insists that there is no active website associated with the domain names in dispute which constitutes passive holding of the disputed domain names. Finally, Complainant notes that the Respondent has been using privacy shield to conceal 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 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 names (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 names 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

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Paragraph 4(a) of the Policy provides that to obtain the transfer of the disputed domain name, the Complainant must prove that each of the following elements is present:

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

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

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

1) Both the disputed domain names <novartisrheumatologyacr2020.com> and <novartisrheumatologyvirtual.com> reproduce the Complainant's NOVARTIS trademark in its entirety with the addition of other terms namely:
- RHEUMATOLOGY: this is a descriptive term referring to the generic name of the branch of medicine devoted to the diagnosis and therapy of rheumatic diseases. The addition of this descriptive term does not change the overall impression of the designation as being connected to the Complainant and its trademark and more likely strengthens the likelihood of confusion between the disputed domain name and Complainant's trademark as the Complainant activities or products are or could be used in rheumatology (see Novartis AG v. Internet Marketing EOOD, CAC Case No 103251).
-ACR: this element could be perceived as an abbreviation for words with various meanings but could not be distinctive per se (see SoftBank Group Corp., SoftBank Corp. v. WhoisGuard Protected, WhoisGuard, Inc. / Nick Fletcher, WIPO Case No. D2018-2682).
- 2020: this element will be perceived as an indication for a year and as such it could not be distinctive per se (see Sanofi v. WhoisGuard, Inc. / Anna Fisherman, WIPO Case No. D2019-0506).
- VIRTUAL: this element merely suggests that internet users using the website are able to purchase the NOVARTIS goods and services from home online. In other words it conveys the idea that the Complainant's famous mark is online and/or the Complainant goods and services are available on the internet. The impression given to web users is that this Respondent's domain name and the Complainant's marks are one and the same, that is, that any associated goods or services are sponsored endorsed or affiliated with the Complainant (see Harrods Limited v. Virtual World Internet, WIPO Case No D2002-0396).
Finally, the top level ".com" is merely instrumental to the use in Internet - as found in accordance with all previous UDRP decisions - and is absolutely not able to affect the confusing similarity of the disputed domain names to the Complainant's trademark. Therefore, the Panel finds that the disputed domain names are both confusingly similar to the Complainant's trademark NOVARTIS and consequently finds that paragraph 4(a)(i) of the Policy has been established.

2) The Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain names as it is not commonly known under the disputed domain names and was never authorized to use the NOVARTIS mark in the disputed domain names by the Complainant. The Respondent, in the absence of any response, has not shown any facts or element to justify prior rights or legitimate interests in the disputed domain names. The Complainant therefore succeeds on the second element of the Policy and consequently the Panel finds that paragraph 4(a)(ii) of the Policy has been established.

3) The Complainant must show that the Respondent registered and is using the disputed domain names in bad faith. In the Panel's view the Respondent has engaged in an opportunistic bad faith registration of the disputed domain names because the Complainant's mark is famous and there is no other good faith explanation for such unauthorized registrations. This Panel finds that the Complainant's NOVARTIS mark is well-known on an international basis. There are previous cases in which panels had clarified that registration of a domain name that is confusingly similar to a well-known trademark by any entity that has no relationship to that mark, may be sufficient evidence of bad faith registration and use (Allianz, Compañía de Seguros y Reaseguros S.A. v. John Michael, WIPO Case No. D2009-0942; Veuve Cliquot Ponsardin, Maison Fondee en 1772 v. The Polygenix Group Co., WIPO Case No. D2000-0163; Pepsico, Inc. v. "null", aka Alexander Zhavoronkov, WIPO Case No. D2002-0562; Pepsico, Inc. v. Domain Admin, WIPO Case No. D2006-0435). It is clear that the Respondent must have known of the Complainant's NOVARTIS mark at the time of registration of the disputed domain names and therefore the

Respondent registered the disputed domain names in bad faith. According to previous decisions the fact that the Respondent is passively holding the disputed domain names can be characterized as bad faith use. In particular, in Intel Corporation v. The Pentium Group, WIPO Case No. D2009-0273 and in Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003 panels concluded that passive holding of a domain name can be in bad faith when complainant's mark has a strong reputation and respondent has provided no evidence of whatsoever of any actual or contemplated good faith use by it of the domain name. In addition, the Complainant insists that bad faith have to be considered also due to the Respondent's lack of reaction to the cease and desist letter sent by the Complainant and in consideration of the fact that the Respondent has been using privacy shield to conceal its identity. In this respect the Panel confirms that the use of a privacy shield and the Respondent's failure to respond to the Complainant contentions and as a result to provide any evidence whatsoever of any good faith registration and use of the disputed domain names are additional indications of bad faith (see, e.g., News Group Newspapers Limited and News Network Limited v. Momm Amed la, WIPO Case No. D2000-1623, Nike, Inc. v. Azumano Travel, WIPO Case No. D2000-1598, America Online, Inc. v. Antonio R. Diaz, WIPO Case No. D2000-1460). Therefore, the Panel finds that the Complainant has also satisfied paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTISRHEUMATOLOGYACR2020.COM**: Transferred
2. **NOVARTISRHEUMATOLOGYVIRTUAL.COM**: Transferred

PANELLISTS

Name	**Avv. Guido Maffei**

DATE OF PANEL DECISION 2020-11-17

Publish the Decision