Decision for dispute CAC-UDRP-103364

Case number	CAC-UDRP-103364
Time of filing	2020-10-27 09:52:50
Domain names	novartischem.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Organization	EU Network

OTHER LEGAL PROCEEDINGS

The Panel is unaware of any other pending or decided legal proceedings in respect of the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant relies upon the following registered trade marks:

(i) US trade mark registration no. 5420583, dated 13 March 2018, for the word mark NOVARTIS, in classes 9,10, 41, 42, 44 and 45 of the Nice Classification; and

(ii) US trade mark registration no. 2997235, dated 20 September 2005, for the word mark NOVARTIS, in class 5 of the Nice Classification.

The Complainant has provided a list of trade mark applications and registrations for NOVARTIS worldwide. The Complainant has also provided evidence of its ownership of domain names composed of the NOVARTIS trade mark, including, but not limited to, <novartis.com> (registered on 2 April 1996), <novartis.us> (registered on 19 April 2002), and <novartispharma.com> (registered on 27 October 1999).

FACTUAL BACKGROUND

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

The Complainant asserts that the Novartis Group is one of the largest 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. Moreover, in 2019, 34% of Novartis Group's total net sales were constituted in the USA.

The Complainant is the owner of the well-known trade mark NOVARTIS registered as both a word and device mark in several classes worldwide, including in the USA. The vast majority of the Complainant's trade mark registrations significantly predate the registration of the disputed domain name.

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 trade mark 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 trade mark with related products and services.

The Complainant enjoys a strong presence online also via its official social media platforms.

The Complainant's contentions can be summarised as follows:

I. The disputed domain name is confusingly similar to a trade mark in which the Complainant has rights

The Complainant contends that the disputed domain name <novartischem.com> (registered on 20 September 2020) incorporates the Complainant's well-known trade mark NOVARTIS in combination with the term "chem" which can refer to "chemistry", a word closely related to the Complainant and its business activities.

Supported by the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0"), paragraph 1.11, the Complainant further contends that the generic Top-Level Domain (gTLD) suffix (".com") is typically disregarded in the assessment under paragraph 4(a) of the Policy when comparing disputed domain names and trade marks. Therefore, the dispute domain name should be considered as confusingly similar to the trade mark NOVARTIS.

II. The Respondent has no rights or legitimate interests in respect of the disputed domain name

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant does not carry out any activity for, or has any business or relationship with, the Respondent. The Complainant has not authorised the Respondent to make any use of the Complainant's NOVARTIS trade mark.

The Complainant also asserts that the Respondent is not commonly known by the disputed domain name, nor has the Respondent an interest over it. The Complainant contends that when "Novartischem" is searched for in the Google search engine, the returned results all pointed to the Complainant and its business activities.

The Complainant states that, on 1 October 2020, the disputed domain name resolved to an active website which displayed the NOVARTIS logo in a prominent position – in the upper-left corner, in combination with the term "chem". The Complainant further states that, by the time it had sent a cease-and-desist letter to the Respondent (on 2 October 2020), the disputed domain name resolved to the same active website but that the logo had been removed, although the website continued to

display “Novartis” as a user ID. The Complainant notes that, in the upper-right corner of the website to which the domain name presently resolves there is an icon headed “Make Appointment”. Although the pop-up box is not showing any active link, the presence of the pop-up box demonstrates that the Respondent had very likely intended to use the website to impersonate the Complainant and to offer “appointments” to Internet users.

The Complainant further argues that the website to which the disputed domain name resolves is very likely to confuse Internet users and lead them to be believe that the disputed domain name is somehow related to the Complainant.

In the Complainant’s view, the Respondent deliberately chose to incorporate the well-known, distinctive trade mark NOVARTIS in the disputed domain name, very likely with the intention to attract Internet traffic by benefiting from the Complainant’s worldwide renown.

The Complainant concludes that the Respondent has no right or 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.

III. The Respondent registered and is using the disputed domain name in bad faith

Registration in bad faith

The Complainant contends that most of its trade mark registrations predate the registration of the disputed domain name and that the Respondent has never been authorised by the Complainant to register the disputed domain name. Considering the renown of the Complainant and its trade mark NOVARTIS, and the overall composition of the disputed domain name, i.e. using the term “Novartis” in combination with the term “chem” which is closely related to the Complainant and its business activities, it follows that the use of the well-known trade mark 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 trade mark;

• The Complainant’s trade mark NOVARTIS is a distinctive, well-known trade mark 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 Jurisprudential Overview 3.0, para. 3.1.1 and para. 3.1.4.

Use in bad faith

The disputed domain name first resolved to an active website with the Complainant’s trade mark NOVARTIS displayed as logo and username in prominent positions, then removed, although the present website still maintains the user name as “Novartis”. By using the disputed domain name and the website associated to it, the Complainant argues that it is obvious that the Respondent is trying to suggest affiliation to the Complainant or even to impersonate the Complainant, which is blatant bad faith.

In addition, the website still appears unfinished and under construction which the Complainant argues falls into the category of passive holding.

The Complainant has tried to reach the Respondent by a cease-and-desist letter sent on 2 October 2020. As the Respondent was under privacy shield, the letter was sent to the privacy email, as provided in the WhoIs. However, by the time the

Complainant prepared the Complaint, it still had not received a 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 Respondent's use of a privacy shield to conceal its identity is an additional element to the finding of bad faith as supported by Facebook Inc. v. Privacy Ltd. Disclosed Agent for YOLAPT, WIPO Case No. D2007-1193.

In summary:

• NOVARTIS is a well-known, distinctive trade mark worldwide;

• the Complainant's trade marks registration predates the registration of the disputed domain name;

• the Respondent has no rights in the trade 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 the Respondent was not aware of the Complainant's prior rights in the trade mark NOVARTIS at the time of registering the disputed domain name, given the Complainant's worldwide renown;

• the Respondent had been using the disputed domain name to resolve to an active website using the Complainant's trade mark as a logo and username; the Respondent later removed the logo and the website remained a site under construction;

• the Respondent failed in responding to cease-and-desist letter sent by the Complainant; and

• the Respondent has been using a 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 name is identical or confusingly similar to a trade mark 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

Pursuant to Rule 15 of the UDRP Rules, the Panel shall decide a complaint on the basis of the statements and documents

submitted and in accordance with the UDRP Policy, the UDRP Rules, and any rules and principles of law that the Panel deems applicable.

Paragraph 4(a) of the UDRP Policy provides the following threshold for the Complainant to meet in order to divest the Respondent of the disputed domain name:

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.

It is therefore incumbent on the Complainant the onus of meeting the above threshold. The evidentiary standard under the UDRP proceedings is the balance of probabilities and, on that basis, the Panel will now proceed to determine each of the three Policy elements in turn.

I. Identical or Confusingly Similar

The UDRP test under the first element provides for a juxtaposing approach, according to which the textual components of the disputed domain name and the Complainant's trade mark are to be compared side by side.

In order to succeed under the first element of the Policy, the Complainant must provide evidence that it has rights in a trade mark or service mark, following which the Panel shall assess whether or not the disputed domain name is identical or confusingly similar to the Complainant's trade mark(s).

Upon review of the case file, the Panel is satisfied that the Complainant has trade mark rights in the term "Novartis", dating back to at least 2005.

The disputed domain name is <novartischem.com>. The trade mark NOVARTIS is wholly incorporated in the disputed domain name. The Panel notes that term "chem" is commonly used as abbreviations for "chemical", "chemist" or "chemistry" (see e.g. Collins Dictionary available at https://www.collinsdictionary.com/dictionary/english/chem). The Panel is of the view that all of these words might allude to both the Complainant's industry sector and its core businesses, bearing in mind that the Complainant is one of the largest global pharmaceutical and healthcare groups. Hence, the Panel finds that the term "chem" can be easily related to the Complainant and, in fact, might even enhance the likelihood of confusion with the Complainant's trade mark NOVARTIS (see Synthite Limited v. Synthite Chemicals, WIPO Case No. D2013-1518; Occidental Chemical Corporation v. Contact Privacy Inc. Customer 0126942866 and Paolo Martin, Oxychem Corporation, WIPO Case No. D2015-1208).

The Panel further notes that TLD suffixes are typically disregarded in the assessment of the first element of the Policy. The reason for that is because a TLD is part of the anatomy of a domain name, being the last component positioned right after the final dot (e.g. ".com", ".org", ".net") (see CAC Case No. 102597, AERO Vodochody AEROSPACE a.s. v Jiří Dvořák; CAC Case No. 101736, Novartis AG v Sam Tetlow / 1970).

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trade mark NOVARTIS, the result of which being that the Complainant has succeeded under the requirement of paragraph 4(a)(i) of the Policy.

II. Rights or Legitimate Interests

The second element of the Policy provides that the Respondent shall demonstrate that it has rights or legitimate interests in the disputed domain name. It therefore falls on the Complainant the burden to refute any such allegations.

Paragraph 4(c) of the Policy sets out a non-exhaustive list of examples by which the Respondent can demonstrate its rights or legitimate interests in the disputed domain name, as follows:

(i) before any notice of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or

(iii) the respondent is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The evidentiary standard under the UDRP proceedings is such that, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production shifts to the respondent to provide evidence to the contrary.

The Respondent did not submit a Response in these UDRP proceedings, nor did it respond to the Complainant's cease-and-desist letter. Therefore, the Panel will make a determination on the basis of the available evidence.

Having reviewed the case file, the Panel notes that the Complainant does not carry out any activity for, or has any business or relationship with, the Respondent. The Complainant has not authorised the Respondent to make any use of the Complainant's trade mark NOVARTIS, and there is no evidence on the record to suggest that the Respondent (as an individual, business, or other organisation) has been commonly known by the disputed domain name.

The case file materials reveal that, on 1 October 2020, the disputed domain name resolved to a website ("the Respondent's website") which displayed the Complainant's trade mark NOVARTIS and its logo in a rather prominent position, in addition to an icon headed "Novartis" and other subsections, most notably "Shop" and "Wishlist". The Panel is of the view that these factors evidence the potential commercial nature of the Respondent's website.

The Panel notes that, at the time of writing this Decision, the Respondent's website no longer displays the Complainant's trade mark NOVARTIS and its logo, nor does it display the subsections referred to above; however, the icon headed "Novartis" remains in use, and there is a new functionality titled "Make Appointment" on the top-right corner.

On balance, the Panel considers that the presence of the above components suggests that the disputed domain name most likely was, and currently is, being used with the intent for commercial gain to misleadingly divert Internet users (and the Complainant's customers for that matter) to the Respondent's website and inviting them to book an appointment via the Respondent's website.

Therefore, the Panel is of the view that the evidence on the available record does not demonstrate that before any notice of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services. In addition, the available record does not demonstrate that the Respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers.

The Panel notes that there is also no evidence on record to suggest that the Respondent is affiliated with, or endorsed by, the Complainant (and, in any event, any affiliation or endorsement has been denied by the Complainant).

In view of all of the above, the Panel considers that there is no indication of use of the disputed domain name giving rise to any rights or legitimate interests.

For the foregoing reasons, and noting that the Respondent has not provided a Response to refute any of the allegations and

evidence produced by the Complainant in these proceedings, the Panel finds that the Complainant has made a prima facie showing of the Respondent's lack of rights or legitimate interests in the disputed domain name under paragraph 4(a)(ii) of the Policy.

III. Registered and Used in Bad Faith

In order to meet the third requirement under the Policy, the Complainant must provide evidence that the disputed domain name was registered and is being used in bad faith.

The Policy enumerates non-exhaustive circumstances which would evidence bad faith registration and use of a domain name, as follows:

1. circumstances indicating that the respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

2. the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

3. the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

4. by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

The Panel has considered the evidence put forward by the Complainant, and has also performed independent, albeit discreet, factual research on certain aspects of this case. The Panel takes the view that the circumstances in this case which are material to the assessment of bad faith registration and use are intertwined and, as such, will be dealt with by the Panel concurrently.

The Panel lists below a number of indicia which points in the direction of the Respondent's bad faith registration and use of the disputed domain name under the Policy:

• The disputed domain name wholly incorporates the Complainant's trade mark, with the addition of the term "chem" which is often used as an abbreviation for "chemical", "chemist" or "chemistry", words which resonate in the Complainant's ambit of activities;

• There is no credible explanation for the Respondent's choice of the disputed domain name, which was registered in October 2020, bearing in mind that the Complainant has been operating in the USA (the country where the Respondent resides) since 1996 and owns trade marks rights dating from as far back as 2005. Therefore, the Panel finds that it is highly unlikely that the Respondent was not aware of the Complainant's prior rights in the trade mark NOVARTIS at the time of registering the disputed domain name, given the Complainant's reputation, which the Panel accepts;

• The Respondent has failed to respond to the Complainant's cease-and-desist letter;

• The Respondent has not provided a Response within the time prescribed under the UDRP Rules, or at all, and the Panel is empowered to draw adverse inferences by such failure (UDRP Rule 14 (b));

• There is nothing on the record suggesting that the Respondent is affiliated or otherwise connected with the Complainant and the Complainant denies any association;

• There is documentary proof that the Respondent's website used to display the Complainant's trade mark NOVARTIS and its logo in a rather prominent position, in addition to an icon headed "Novartis" and other subsections, most notably "Shop" and "Wishlist", which seems to suggest there was an intention to use the website for commercial purposes;

• The Respondent's website still displays an icon headed "Novartis", as well as a functionality titled "Make Appointment" on the top-right corner. This suggests that the disputed domain name was registered and is being used for a potential financial gain, i.e. to misleadingly divert Internet users (most likely the Complainant's customers because of the use of the Complainant's trade mark within the disputed domain name string and on the Respondent's website) to the Respondent's website and inviting them to book an appointment through the Respondent's website (circumstance 4 above). In particular, the Panel finds that the Respondent is trying to suggest an affiliation with, or a connection to, or an endorsement of the Complainant or even to impersonate the Complainant through the use of the Complainant's trade mark in the dispute domain name string and on the Respondent's website in the manner described above; and

• There does not appear to be any plausible good faith use associated with the disputed domain name.

The Panel is of the view that, taken together, the above are compelling indicia that the Respondent has registered and is using the disputed domain name in bad faith under the Policy.

Accordingly, the Panel finds that the Complainant has made a prima facie showing that the Respondent has registered and is 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. **NOVARTISCHEM.COM**: Transferred

PANELLISTS

Name	**Dr Gustavo Moser**

DATE OF PANEL DECISION 2020-11-27

Publish the Decision