Decision for dispute CAC-UDRP-103365

Case number	CAC-UDRP-103365
Time of filing	2020-10-27 09:58:20
Domain names	novartid.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Name	Wei Zhang

OTHER LEGAL PROCEEDINGS

The Panel is unaware of any pending or decided legal proceeding(s) which relate to the Disputed Domain Name.

IDENTIFICATION OF RIGHTS

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 Name.

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)

FACTUAL BACKGROUND

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

I. LANGUAGE OF PROCEEDINGS REQUEST:

To the best of the Complainant's knowledge, the language of the registration agreement for the Disputed Domain Name is Chinese in accordance with the Registrar Verification.

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" (see Carrefour v. Contact Privacy Inc. Customer 1242379769 / Le Berre, WIPO Case No. D2018-1552).

The Complainant hereby requests that the language of the present administrative proceedings be English based on the following reasons:

The website of the Disputed Domain Name resolved to a pay-per-click website the following terms in English: e.g. Pharma, Pharma Easy, Auto Occassion, which demonstrates that the Respondent clearly understands English.

By reverse search of the email address cn@9yz.com of the Respondent, the Complainant found that it has registered at least 5530 domain names, many of which are composed by correctly spelt English terms, such as: 1001freefonts.co, 10youtube.co, 1223greetings.com, 13network.co, alcatel-mobile.co. Again, it demonstrates that the Respondent clearly understands English.

Moreover, if the Complainant had to translate the Complaint'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).

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: 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 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 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 NAME IS IDENTICAL OR CONFUSINGLY SIMILAR

The domain name novartid.com (hereinafter referred to as the "Disputed Domain Name"), which was registered on 30 September 2020 according to the WHOIS, incorporates a typo of the Complainant's well-known, distinctive trademark NOVARTIS, by replacing the letter "s" with letter "d", which are right next to each other in the keyboard.

The addition of the gTLD ".com" does not add any distinctiveness to the Disputed Domain Name. 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 Name should be considered as confusingly similar to the trademark NOVARTIS.

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

The Complainant has never granted the Respondent any right to use the NOVARTIS trademark within the Disputed Domain Name, 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 Name or that it has legitimate interest over the Disputed Domain Name. When entering the terms "novartid" in the Google and Baidu (the leading search engine in China) search engine, the returned results either pointed to the Complainant and its business activities, or to irrelevant content – but not to the Respondent.

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 China and many other countries of the world.

According to the Registrar Verification, the Respondent is an individual named “Zhang Wei”, which is not connected to the Complainant nor to the term “Novartis” in any way.

By the time the Complainant prepared this Complaint on 22 October 2020, the Disputed Domain Name resolved to a pay-per-click website. Pursuant to WIPO Overview 3.0, para. 2.9, the Respondent has not been using the Disputed Domain Name 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 Name, and that it has not been using the Disputed Domain Name for any bona fide offering of goods or services.

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

THE 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 a typo of the distinctive trademark “Novartis”, it follows that incorporating 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 China 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.”

THE DOMAIN NAME IS BEING USED IN BAD FAITH

Firstly, as noted in the previous paragraphs, the Disputed Domain Name resolved to a pay-per-click website. 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, the Complainant has tried to reach the Respondent by a cease-and-desist letter sent on 7 October 2020. As the registrant was under privacy shield, the Complainant sent the cease-and-desist letter via online contact form https://whois.cloud.tencent.com/domain?domain=novartid.com. However, until the time the Complainant prepared the 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 Name, see Arla Foods Amba v. Mlanie Guerin, CAC case No. 101640; Medela AG v. Donna Lucius, CAC case No. 101808.

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 not been actively using the Disputed Domain Name.

Respondent has not responded to the Complainant's cease-and-desist letter.

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.

The Complainant requests that the language of this administrative proceeding be English pursuant to UDRP Rule 11(a): 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. Complainant makes this request in light of the potential Chinese language Registration Agreement of the Disputed Domain Name involved at this Complaint. Paragraph 10 of the UDRP Rules vests a panel with authority to conduct the proceedings in a manner it considers appropriate while also ensuring both that the parties are treated with equality, and that each party is given a fair opportunity to present its case. UDRP panels have found that certain scenarios may warrant proceeding in a language other than that of the registration agreement. Such scenarios were summarized into WIPO Jurisprudential Overview 3.0, 4.5.1.

In this particular instance, the Complainant tried to request change of languages of proceedings in light of Chinese language Registration Agreement by showing that 1) the website of the Disputed Domain Name resolved to a pay-per-click website the following terms in English; and 2) having the Complainant translating subsequent communications in Chinese would entail significant additional costs for the Complainant and delay in the proceedings. Relevant decisions have been cited to support the Complainant's positions, In light of the scenarios and the displayed information on the website resolved to by the Disputed Domain Name (containing pay-per-click websites including Pharma, Pharma Easy, Auto Occasion etc.), the Panel is of the view that Respondent can understand the English language based on a preponderance of evidence test. Without further objection from the Respondent on the issue, the Panel will proceed to issue the decision in English.

PRINCIPAL REASONS FOR THE DECISION

1. Identical or confusingly similar

The Complainant contended that the Disputed Domain Name <novartid.com> is confusingly similar to its registered trademark "Novartis". The Novartis Group is one of the biggest global pharmaceutical and healthcare groups. The Complainant's products are manufactured and sold in many regions worldwide including China. 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 Name.

The Disputed Domain Name "novartid.com" incorporates a typo of the Complainant's well-known, distinctive trademark NOVARTIS, by replacing the letter "s" with letter "d". Letter "s" and letter "d" are adjacent keyboard letters. In accordance with WIPO Jurisprudential Overview 3.0 §1.9, a domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for UDRP purposes. Therefore, a misspelled trademark does not preclude the finding of confusing similarity within the meaning of paragraph 4(a)(i) of the

Policy and the Panel needs to consider other relevant evidence in finding the Respondent's intention to confuse users.

Further, as the Complainant contends, "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" (WIPO Jurisprudential Overview 3.0 §1.11).

The Panel therefore concludes that the Disputed Domain Name is confusingly similar to a trademark in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

2. No rights or legitimate interests

Although the Respondent did not file an administratively compliant (or any) response, the Complainant is still required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Complainant has offered three arguments to support its contention that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. Firstly, the Respondent is not known as the Disputed Domain Name; secondly, neither license or authorization has been granted to the Respondent; thirdly, current websites did not indicate any sign of bona fide offering of goods or services,

According to the information of the Respondent as provided by the Registrar, the name of the Respondent's organization is protected by privacy shield WHOISGUARD Inc. The Registrar has provided the Respondent's name "Wei Zhang" and contact email, neither indicates Respondent's any connection with the Complainant's businesses and/or its brands. In addition, there is no evidence suggests that the Respondent is in anyway associated with the name "Novartid". The Complainant also contended that it does not carry out any activity for, nor has any business with the Respondent. It has never licensed nor authorized the Respondent to make any use of the Complainant's trademark. As the website resolved to by the Disputed Domain Name does not contain any information related to bona fide offering of goods or services, it has not suggested the Respondent's association with "Novartid".

On the basis of preponderance of evidence, and in the absence of any evidence to the contrary or any administratively compliant response being put forward by the Respondent, the Panel finds that the Respondent does not have rights or legitimate interests in the Disputed Domain Name within the meaning of paragraph 4(a)(ii) of the Policy.

3. Bad faith
By trying to establish the bad faith element of paragraph 4(a) of the Policy, the Complainant has primarily attempted to rely on paragraph 4(b)(i) and 4(b)(iv) of the Policy.

There are a couple of instances cited by the Complainant that can be used to prove that the domain name is registered and used in bad faith.

As far as registration goes, UDRP panels have consistently held that the mere registration of a domain name that is confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. The Complainant's trademark "Novartis" is distinctive and well known all around the world. The fact that the Respondent has registered a domain name on 30 September 2020, long after the Complainant's trademark became known, and uses a typo of the distinctive trademark "Novartis" indicates that the Respondent had knowledge of the Complainant's trademark at the time of registration of the Disputed Domain Name. The Complainant's trademark "Novartis" is not a common word and a simple Google search reveals all results and references related to the Complainant's brand. Therefore, it is reasonable to conclude that the Respondent registered the Disputed Domain Name with the knowledge of the Complainant's trademark and/or brand influence.

The Disputed Domain Name is not used for any bone fide offerings. As far as usage of the Disputed Domain Name, it has been resolved to a pay-per-click ("PPC") website. Panels have recognized that the use of a domain name to host a page

comprising PPC links would be permissible – and therefore consistent with respondent rights or legitimate interests under the UDRP (WIPO Overview 3.0 §2.9). However, in this case, the Disputed Domain Name hosts a parked page comprising multiple PPC links, and the Respondent shows no efforts to suppress PPC advertising related to the Complainant's trademark. The Panel is of the view that the Respondent's bad faith use can be inferred.

In addition, the Complainant has tried to reach the Respondent by a cease-and-desist letter sent on 7 October 2020 The Respondent has not responded to the Complainant's letter.

In view of the above, in the absence of any evidence to the contrary (or any administratively compliant response) being put forward by the Respondent, the Panel determines that the Disputed Domain Name was registered and is being used in bad faith within the meaning of 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. **NOVARTID.COM**: Transferred

PANELLISTS

Name	**Carrie Shang**

DATE OF PANEL DECISION 2020-12-07

Publish the Decision