Decision for dispute CAC-UDRP-103397

Case number	CAC-UDRP-103397
Time of filing	2020-11-06 15:32:06
Domain names	Novartis724.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Name	Eren Ucar

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 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 Turkey.

The vast majority of the Complainant's trademark registrations significantly predates the registration of the disputed domain name. Namely, the Complainant's trademark registrations in Turkey applying to the present proceedings include the following earlier rights:

- Trademark: NOVARTIS Grant No: 178690 Grant date: November 17, 1997;

- Trademark: NOVARTIS Grant No: 2015 08359 Grant date: October 21, 2015;

- Trademark: NOVARTIS Reg. No: 1349878 Reg. date: November 29, 2016.

The Complainant owns numerous domain names composed of either its trademark NOVARTIS alone or in combination with other terms, including:

- <novartis.com.tr> (created on November 5, 1999);

- <novartis.com> (created on April 2, 1996);

- <novartispharma.com> (created on October 27, 1999).

FACTUAL BACKGROUND

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

The Complainant 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, created in 1996 through a merger of two other companies CibaGeigy 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 a strong presence in Turkey where the Respondent is located. The Complainant has been developing its business activities in Turkey for more than 60 years. Today it is already one of the leading companies in the sector and has 2,000 employees locally. In 2019, the Complainant's total export of Turkey was USD $136 million. Over the last decade, its exports have exceeded USD $1.6 billion in total. The Complainant also takes the lead in clinical research with more than 100 clinical trials in Turkey.

In 2020, Novartis Turkey was awarded the Top Employers Turkey and Top Employers Europe certification.

The Complainant challenges the Respondent's registration of the disputed domain name <Novartis724.com> under paragraph 4(a)(i) of the Uniform Dispute Resolution Policy ("Policy") and seeks relief that the disputed domain name be transferred to the Complainant.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Complainant's Legal Grounds are set out in its Complaint filed on November 5, 2020.

The Panel refers to and repeats them herein seriatim.

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.

The Complainant contends that the disputed domain name <Novartis724.com> incorporates the Complainant's trademark NOVARTIS in its entirety in combination with the number '724', which is closely related to the Complainant and its business activities.

The term 'Novartis' contained in the disputed domain name is, in the Panel's view, identical to the Complainant's trademark and thereby wholly incorporates the trademark. This is sufficient to establish identity or confusing similarity for the purposes of the Policy. See Oki Data Americas, Inc. v. ASD, Inc, WIPO Case No. D2001-0902; Dr. Ing. h.c. F. Porsche AG v Vasiliy Terkin, WIPO Case No D2003-003-0888.

The Panel also considers that the addition of the number '724' does not distinguish the disputed domain name from the

Complainant's trademark. When part of a domain name is identical to a well-known trademark, it increases the likelihood of confusion or association between the domain name holder and the trademark owner.

The addition of the suffix '.com' is also irrelevant when assessing whether a domain name is identical or confusingly similar to a trademark as the gTLDs are only required for the functionality of a website.

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.

The evidence from WHOIS adduced by the Complainant does not indicate that the Respondent is commonly known by the disputed domain name, but the Respondent's name suggests one 'Eren Ucar'.

The evidence shows that the disputed domain name was registered on October 13, 2020 many years after the registration of the Complainant's trademarks and domain names.

The disputed domain name also did not resolve to any active website nor has the disputed domain name been used for any offering of goods or services. A message 'This site can't be reached' is being displayed instead. The Panel considers that this suggests that there is no bona fide offering of goods or services nor a legitimate non-commercial or fair use of the disputed domain name. See Ustream.TV, Inc. v. Vertical Axis, Inc, WIPO Case No. D2008-0598.

The Panel is prepared to draw the adverse inference that the Respondent is likely profiting from the confusion likely to arise from consumers believing that the disputed domain name is connected to or associated with the Complainant's trademark NOVARTIS and its business.

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.

The Panel accepts the Complainant's evidence to support this ground. In particular, the Panel is persuaded by the evidence that the Complainant's trademark registrations predate the registration of the disputed domain name and the Respondent has never been authorised by the Complainant to register the disputed domain name.

Further, the evidence shows that the Complainant's trademark NOVARTIS is distinctive and well-known around the world, including in Turkey where the Respondent is alleged to reside, and prima would indicate that the Respondent knew or ought to have known of the Complainant or the Complainant's trademark or business.

The Panel accepts the evidence and contention that the disputed domain name does not resolve to any active websites, which constitutes passive holding and/or non-use of the disputed domain name.

The Complainant states that it had sent a cease-and-desist notice to the Respondent at the e-mail address doctorwalk@outlook.com as provided in the WHOIS and also to the Registrar at abuse-contact@publicdomainregistry.com on October 16, 2020 but had not received any response.

Whenever a person registers a domain name, the expectation is that the domain name holder will provide accurate contact details, and ipso facto it will be capable of being contactable through those contact details. It is, therefore, incumbent on the domain name holder to maintain proper and up to date contact details that will allow for contact to be made.

Thus, any concealment of identity of a domain name holder has a propensity to create doubt as to the bona fides of the holder especially when there is a failure to respond to legitimate communications.

The Panel accepts and adopts the helpful remarks by the Panel in “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 trademark 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 trademark, no response to the complaint having been filed, and the registrant’s concealment of its identity’.”

In the present case, the Panel is prepared to infer that the cease-and-desist notice has been received by the Respondent, and by its non-response the Panel is prepared to draw the inference that the Respondent has chosen to ignore the Complainant’s allegations.

Accordingly, the Panel finds that the registration of the disputed domain name and its use were in bad faith.

PROCEDURAL FACTORS

1. Notification of proceedings to the Respondent

When forwarding a Complaint, including any annexes, electronically to the Respondent, paragraph 2 of the Rules states that CAC shall employ reasonably available means calculated to achieved actual notice to the Respondents.

Paragraphs 2(a)(i) to (iii) set out the sort of measures to be employed to discharge CAC’s responsibility to achieve actual notice to the Respondent.

On November 09, 2020 the CAC by its Nonstandard Communication stated as follows (omitting irrelevant parts):

‘Dear Parties,

Please be aware that neither the written notice of the Complaint nor the advice of delivery thereof was returned to the Czech Arbitration Court. The CAC is therefore unaware whether the written notice was received by the Respondent or not.

As far as the e-mail notice is concerned, we received a notification that the e-mail notice sent to postmaster@novartis724.com was returned back undelivered as the e-mail address had permanent fatal errors (please find the notification enclosed). The e-mail notice was also sent to doctorwalk@outlook.com, but we have never received any proof of delivery or notification of undelivery.

No further e-mail address could be found on the disputed site (please find the screenshot enclosed).

The Respondent never accessed the online platform.´

Given the reasonable measures employed by CAC as set out in the above Nonstandard Communication, the Panel is satisfied that CAC has discharged this responsibility.

2. Language of the proceedings request

Paragraph 11(a) of the Rules provides that the language of the proceeding shall be the language of the Registration Agreement unless otherwise specified in that agreement or agreed by the parties.

Since the language of the Registration Agreement of the disputed domain name <Novartis724.com> is English, the Panel is satisfied that the language of the proceeding should be English.

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 disputed domain name is a case of is identical to or confusingly similar to the Complainant's trademark as it wholly incorporates the trademark with a combination of 3 numbers '724'.

The disputed domain name does not resolve to any active websites and is, therefore, a classic case of passive holding or non-use of the disputed domain name. That fact alone does not make it improper but coupled with other cumulative circumstances it can only be inferred that the Respondent does not have any rights or legitimate interests in the disputed domain name.

The Complainant trademark is well-known around the world, including in Turkey where the Respondent allegedly resides. By incorporating the Complainant's trademark NOVARTIS with a combination of 3 numbers '724' into the disputed domain name without any authorisation from the Complainant, the Respondent is likely seeking capitalise on the Complainant's business reputation and trademark. Such registration and use can only be inferred to have been done in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTIS724.COM**: Transferred

PANELLISTS

Name	**Adjunct Prof William Lye, OAM QC**

DATE OF PANEL DECISION 2020-12-11

Publish the Decision