Decision for dispute CAC-UDRP-103442

Case number	CAC-UDRP-103442
Time of filing	2020-12-02 14:54:14
Domain names	novartis-int.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Name	Eric Ballora

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 has provided evidence of ownership of the numerous trademarks, including:

- International trademark NOVARTIS registered on 1 July 1996 under No. 001555705, duly renewed and designating goods and services in international classes 01, 02, 03, 04, 05, 07, 08, 09, 10, 14, 16, 17, 20, 22, 28, 29, 30, 31, 32, 40 and 42.

FACTUAL BACKGROUND

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

I. LANGUAGE OF PROCEEDINGS REQUEST:

Since the language of the Registration Agreement of the Disputed Domain Name <novartis-int.com> is English according to the Registrar Verification, the language of the proceedings should be 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. The Complainant has a strong presence in Italy where the Respondent is located. The Complainant has subsidiaries and associated companies based in Italy. At the end of 2015, the Complainant had 2,316 local employees and the total net sales amounted to 1,629 million euro (+ 2.7%, on a comparable basis, versus the previous year). Furthermore, the Complainant has been active in innovation - it supported more than 250 clinical trials, involving over 15,000 patients at about 1,100 centers.

The Complainant is the owner of the well-known trademark NOVARTIS registered as both a word and device mark in several classes worldwide, including Italy. 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 Italy applying to the present proceedings include the following earlier rights:

Trademark: NOVARTIS
Reg. no: 663765
Reg. date: 1 July 1996

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.it> (created on 17 April 1998) 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.

In particular, the Complainant uses the domain name <novartis.it> to communicate with its local customers.

LEGAL GROUNDS:

A. THE DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR

The disputed domain name <novartis-int.com> (hereinafter referred to as the “Disputed Domain Name”), which was registered on 3 November 2020 according to the WHOIS, incorporates the Complainant’s well-known, distinctive trademark NOVARTIS in combination with a term “int”, separated by the symbol “-“, 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 Name:WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO 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 and the Respondent have never had any previous relationships, nor has the Complainant ever granted the Respondent with any rights to use the NOVARTIS trademark in any forms, including the Disputed Domain Name.

The Complainant has not found that the Respondent is commonly known by the Disputed Domain Name or that it has interest over the Disputed Domain Name. When searched for “Novartis” and “int” in the Google search engine, the returned results pointed to the Complainant and its business activities.

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 Italy and many other countries worldwide. However, the Respondent still chose to register the Disputed Domain Name as such.

In addition, according to the Registrar Verification, the Respondent is named “Eric Ballora”, which in not connected to the Complainant nor to the term “Novartis” in any way.

By the time the Complainant prepared this Complaint on 1 December 2020, the Disputed Domain Name resolved to a website under construction. The Respondent has not been using the Disputed Domain Name to offer any goods or services.

When Internet users, who search for information about the Complainant and/or about the brand “Novartis”, see the Disputed Domain Name and the website under construction, would very likely be confused and be led to believe that the Disputed Domain Name is somehow related to the Complainant and be disappointed as they would not find the information as expected – which will lead to trademark tarnishment for the Complainant.

From the Complainant’s perspective, the Respondent deliberately chose to incorporate the well-known, distinctive trademark NOVARTIS in the Disputed Domain Name, very likely with the intention to attract Internet traffic by benefiting from the Complainant’s worldwide renown.

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 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

i. 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 the term “Novartis” in combination with a term “int”, which often refers to “international” or “internal” and therefore closely related to the Complainant and its business activities, it follows that the use of 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 Italy 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.”

ii. THE DOMAIN NAME IS BEING USED IN BAD FAITH

Firstly, as noted in the previous paragraphs, the Disputed Domain Name resolved to a website under construction, which falls into the category of passive holding.

The Complainant tried to reach the Respondent by a cease-and-desist letter sent on 6 November 2020 to the Respondent’s email: gdpr-masking@gdpr-masked.com as provided in the WHOIS and to the online form https://gdpr-masked.com. However, until the time the Complainant prepared the Complaint, it has not received response from the Respondent.

Additionally, according to the Registrar Verification, the Respondent’s address is “1829 road delhi, Itarao, AQ, Italy 89881”, which did not generate any result in Google map search. It appears that the Respondent has deliberately provided false WHOIS information, which has added up to the finding of bad faith.

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 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 trade mark 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 trade mark, no response to the complaint having been filed, and the registrant’s concealment of its identity’.”

SUMMARY

• NOVARTIS is a well-known, distinctive trademark worldwide.
• Complainant’s trademarks registration predates the registration of the Disputed Domain Name.
• The 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 the 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.

• The Respondent has been passively holding the Disputed Domain Name;
• The Respondent failed in responding to cease-and-desist letter sent by the Complainant;
• The 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.

PRINCIPAL REASONS FOR THE DECISION

Notwithstanding the fact that no Response has been filed, the Panel shall consider the issues present in the case based on the statements and documents submitted by the Complainant.

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following elements:

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

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

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

A. Identical or Confusingly Similar

A complainant must establish that it has a trademark or service mark and that the disputed domain name is identical or confusingly similar to that trademark or service mark for the complainant to succeed.

The Complainant, Novartis AG, is a multinational pharmaceutical company developing and selling medical treatments and drugs worldwide. The Complainant has provided evidence of ownership of the mark "NOVARTIS".

As regards the question of identity or confusing similarity for the purpose of the Policy, it requires a comparison of the disputed domain name with the trademarks in which the complainant holds rights. According to section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), "this test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name".

Also, according to section 1.7 of the WIPO Overview 3.0, "in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing".

The Disputed Domain Name wholly incorporates the Complainant's trademarks "NOVARTIS" in addition to the generic term "int", as well as a hyphen. This addition does not prevent a finding of confusing similarity with the Complainant's trademark. The fact that a domain name wholly incorporates a Complainant's trademark is sufficient to establish identity or confusing similarity for the purpose of the Policy, despite the addition of other words to such mark.

It is well accepted by UDRP panels that a generic Top-Level Domain ("gTLD"), such as ".com", is typically ignored when assessing whether a domain name is identical or confusing similar to a trademark.

This Panel concludes that the Disputed Domain Name is confusingly similar to the Complainant's trademark and therefore finds that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, any of the following circumstances, if found by the Panel, may demonstrate the respondent's rights or legitimate interests in the disputed domain name:

(i) before any notice to it 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; or

(ii) the respondent has been commonly known by the disputed domain name, even if it has acquired no trademark or service mark rights; or

(iii) 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 or to tarnish the trademark or service mark at issue.

The consensus view of UDRP panels on the burden of proof under paragraph 4(a)(ii) of the Policy is summarized in section 2.1 of the WIPO Overview 3.0, which states: "[…] where a Complainant makes out a prima facie case that the Respondent lacks rights or legitimate interests, the burden of production on this element shifts to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the Respondent fails to come forward with such relevant evidence, the Complainant is deemed to have satisfied the second element."

The evidence on record does not show that the Respondent was commonly known, as an individual or an organization, by the Disputed Domain Name.

The Panel also finds, in the absence of a rebuttal from the Respondent, that the Respondent uses the Complainant's trademarks in the Disputed Domain Name without authorization from the Complainant.

Equally, the Panel accepts that the Respondent has not made a legitimate non-commercial or fair use of the Disputed Domain Name.

Therefore, the Panel concludes that the Respondent has no right or legitimate interests in the Disputed Domain Name and therefore finds that the requirement of paragraph 4(a)(ii) of the Policy is satisfied.

C. Registration and Use in Bad faith

For the purpose of Paragraph 4(a) (iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of the domain name in bad faith:

(i) circumstances indicating that the holder 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 the holders documented out-of-pocket costs directly related to the domain name; or

(ii) the holder 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 the holder has engaged in a pattern of such conduct; or

(iii) the holder has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the holder has intentionally attempted to attract, for commercial gain, Internet users to the holder's website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on the holder's website or location.

The NOVARTIS trademark enjoys a long-standing continuous reputation worldwide. Such reputation, coupled with the evidence on record, shows that the Respondent was certainly aware of the existence of the Complainant and of the rights of the Complainant on the trademark. The Panel finds that the Respondent, by registering and using the Disputed Domain Name has intentionally attracted internet users by creating a likelihood of confusion with the Complainant's trademark.

Additionally, the record shows that the Complainant's representative sent a cease-and-desist letter to the Respondent before the submission of the Complaint which apparently remained unanswered. The Panel finds that, from the receipt of the letter by the Respondent, the latter cannot be in a position to ignore the Complainant's rights.

Finally, the Panel agrees that the current use of the Disputed Domain Name does not prevent a finding of bad faith use.

The Panel concludes that the Respondent has registered and is using the Disputed Domain Name in bad faith, and therefore finds that the requirements of paragraph 4(a)(iii) of the Policy is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTIS-INT.COM**: Transferred

PANELLISTS

Name	**Arthur Fouré**

DATE OF PANEL DECISION 2020-12-29

Publish the Decision