Decision for dispute CAC-UDRP-103419

Case number	CAC-UDRP-103419
Time of filing	2020-11-20 08:36:22
Domain names	NovartisChina.com

Case administrator

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

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Name	wenwu tang

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 the trademark NOVARTIS (International Registration No. 666218 and 663765) designating China and other countries, which were registered on October 31, 1996 and July 1, 1996 respectively.

The Complainant also holds the domain name registrations which contain the NOVARTIS trademark, <novartis.com> and <novartis.com>.

FACTUAL BACKGROUND

The Complainant, Novartis AG, was established in 1996 through a merger of two other companies, Ciba-Geigy and Sandoz. The Complainant is the holding company of the Novartis Group which is one of the biggest global pharmaceutical and healthcare groups. The Complainant's group solutions to address the evolving needs of patients worldwide by developing and delivering innovative medical treatments and drugs. 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 Complainant has been present in China for the last three decades, during which it launched about 62 medicines. The Complainant's official global and local websites in China connect customers to its official sales and service locations.

The disputed domain names, <novartischina.com> and <novartis-china.com>, were registered on October 26, 2020, and October 29, 2020, respectively which resolve to inactive webpages.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

COMPLAINANT' CONTENTIONS IN BRIEF:

The Complainant contends that the disputed domain names are confusingly similar to the NOVARTIS marks on the basis that the disputed domain names wholly incorporate the Complainant's trademark and the addition of a hyphen and geographical term "China" and generic top-level domain name suffix ("gTLD") ".com" are insufficient to avoid the finding that the disputed domain names are confusingly similar to its NOVARTIS mark.

The Complainant also argues that the Respondent does not have any rights or legitimate interests in the disputed domain names. The Respondent is not commonly known by the disputed domain names. In addition, the Respondent is not affiliated with the Complainant nor did the Complainant license or authorize the Respondent to use the NOVARTIS mark.

The Complainant further asserts that the disputed domain names have been registered and are being used in bad faith as the Respondent should have known of the Complainant's NOVARTIS mark at the time of registration of the disputed domain name. The Complainant also asserts that the Respondent is attempting to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or of a product or service on the Respondent's website.

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.

Preliminary Issue: Request for Consolidation

A preliminary issue raised by the Complainant relates to the consolidation of two domain names in the same complaint against a single respondent. Paragraph 3(c) of the UDRP Rules provides that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder. Since in this case, the Respondent is the same for both of the disputed domain names, consolidation is not an issue.

Preliminary Issue: Language of Proceedings

Paragraph 11 of the Rules provides that:

“(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.”

The language of the Registration Agreement for the disputed domain names <novartis-china.com> is English and <novartischina.com> is Chinese.

The Complainant requested that the language of the proceeding be English for the following reasons:

(i) the disputed domain names are in English;

(ii) the registration agreement for one of the disputed domain names is in English; and

(iii) the proceeding will be put through unnecessary trouble and delay if Chinese were made the language of the proceeding.

The Respondent did not comment on the language of the proceeding.

The Panel cites the following with approval: “Thus, the general rule is that the parties may agree on the language of the administrative proceeding. In the absence of this agreement, the language of the Registration Agreement shall dictate the language of the proceeding. However, the Panel has the discretion to decide otherwise having regard to the circumstances of the case. The Panel’s discretion must be exercised judicially in the spirit of fairness and justice to both parties taking into consideration matters such as command of the language, time and costs. It is important that the language finally decided by the Panel for the proceeding is not prejudicial to either one of the parties in his or her abilities to articulate the arguments for the case.” (See Groupe Auchan v. xmxzl, WIPO Case No. DCC2006 0004).

Having considered the above factors, the Panel determines that English be the language of the proceeding. The Panel agrees that the Respondent appear to be familiar with the English language, taking into account their selection of the English-language trademark and the domain names in dispute. In the absence of an objection by the Respondent, the Panel does not find it procedurally efficient to have the Complainant translate the Complaint and evidence into Chinese.

PRINCIPAL REASONS FOR THE DECISION

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a complainant to show that a domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. The Complainant has provided evidence that it owns the NOVARTIS trademark.

The differences between the disputed domain names and the Complainant’s NOVARTIS trademark are the addition of a hyphen, geographic term “China” and a gTLD “.com”.

It is established that the addition of a geographical term would not prevent a finding of confusing similarity under the first element (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”), section 1.8).

It is also established that gTLD is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test (WIPO Overview 3.0, section 1.11). The addition of a gTLD to a disputed domain name does not avoid confusing similarity as the use of a TLD is technically required to operate a domain name (see Accor v. Noldc Inc.

WIPO Case No. D2005-0016; F. Hoffmann-La Roche AG v. Macalve e-dominios S.A., WIPO Case No. D2006-0451; Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003; L'Oréal v Tina Smith, WIPO Case No. 2013-0820; Titoni AG v Runxin Wang, WIPO Case No. D2008-0820; and Alstom v. Itete Peru S.A. WIPO Case No. D2009-0877).

The disputed domain names consist of the Complainant's NOVARTIS mark and the addition of a hyphen, geographical term "China" and a gTLD ".com" which in the Panel's view does not avoid confusing similarity with the Complainant's trademark (see Schneider Electric S.A. v. Domain Whois Protect Service / Cyber Domain Services Pvt. Ltd., WIPO Case No. D2015-2333; WIPO Overview 3.0, section 1.9).

Therefore, the Panel finds that the disputed domain names are confusingly similar to the NOVARTIS mark and the element under paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires the complainant to show that the respondent has no rights or interests in respect of the domain name. Once the complainant establishes a prima facie case that the respondent lacks rights or legitimate interests in the domain name, the burden of production shifts to the respondent to show that it has rights or legitimate interests in respect to the domain name (see WIPO Overview 3.0, paragraph 2.1).

In the present case, the Complainant has demonstrated prima facie that the Respondent lacks rights or legitimate interests in respect of the disputed domain names and the Respondent has failed to assert any such rights or legitimate interests.

The Complainant submitted evidence that it did not authorize or license the Respondent to use the NOVARTIS mark (See OSRAM GmbH. v. Mohammed Rafi/Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org, WIPO Case No. D2015-1149; Sanofi-Aventis v. Abigail Wallace, WIPO Case No. D2009-0735).

In addition, the evidence submitted by the Complainant shows that the Respondent is not commonly known by the disputed domain names.

The Respondent did not submit a response in the present case and did not provide any explanation or evidence to show rights or legitimate interests in the disputed domain names which is sufficient to rebut the Complainant's prima facie case.

The Panel is therefore of the view that the Respondent has no rights or legitimate interests in respect of the disputed domain names and accordingly, paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

The complainant must show that the respondent registered and is using the disputed domain name in bad faith (Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy provides circumstances that may evidence bad faith under paragraph 4(a)(iii) of the Policy.

The Complainant has submitted evidence that the disputed domain names resolve to inactive webpages. It is well established that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding (see WIPO Overview 3.0, paragraph 3.3). The test to apply is that of the totality of circumstances. In doing so we must look to: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.

In this case, the evidence shows that the Complainant's mark is distinctive and has attained significant reputation. The

strong reputation and distinctive character of the Complainant's mark is evidence that the Respondent is unlikely to have registered the disputed domain names without sight and knowledge of the Complainant's marks and it is implausible that there is any good faith use to which the disputed domain names may be put to. It is also the Complainant's evidence that the Respondent could not have registered the disputed domain names without prior knowledge of the Complainant's mark as the Respondent's name has no connection with the Complainant's NOVARTIS mark which was registered long ago. This is another indicator of bad faith on the part of the Respondent (see Boursorama SA v. Estrade Nicolas, WIPO Case No. D2017-1463).

The Respondent did not submit a Response in this proceeding which is a further indication of the Respondent's bad faith, which was considered by the Panel.

The Complainant submitted evidence that they had issued a cease-and-desist letter to the Registrar prior to the proceedings as the Respondent had hidden behind a privacy shield. The Complainant never received a response from the Respondent. Based on the particular circumstances of the present case, the Panel also draws an adverse inference from the Respondent's use of a privacy shield to hide its identity which is another indication of the Respondent's bad faith.

Based on the evidence presented to the Panel, including the confusing similarity between the disputed domain names and the Complainant's mark, the fact that the disputed domain names are being passively held and the fact that no Response was submitted by the Respondent in response to the Complainant's cease-and-desist letter and to the Complaint, the Panel draws the inference that the disputed domain names were registered and are being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTISCHINA.COM**: Transferred
2. **NOVARTIS-CHINA.COM**: Transferred

PANELLISTS

Name	**Mr. Jonathan Agmon**

DATE OF PANEL DECISION 2021-01-11

Publish the Decision