Decision for dispute CAC-UDRP-103426

Case number	CAC-UDRP-103426
Time of filing	2020-11-26 09:53:29
Domain names	NovartisCareer.com

Case administrator

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

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Name	Cathy Simmons

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 following registrations in the United States of America ("United States") of the trademark NOVARTIS (the "NOVARTIS trademark"):

- the United States trademark NOVARTIS with registration No. 2997235, registered on 20 September 2005 for goods in International Class 5; and

- the United States trademark NOVARTIS with registration No.5420583, registered on 13 March 2018 for goods and services in International Classes 9, 10, 41, 42, 44 and 45.

FACTUAL BACKGROUND

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

The Complainant was created in 1996 through a merger of the companies Ciba-Geigy and Sandoz, and is the holding company of the Novartis Group, one of the biggest global pharmaceutical and healthcare groups. The Complainant has a

strong presence in the United States where the Respondent is located, and in 2019, 34% of the total net sales of the Novartis Group were made there.

The Complainant is the owner of the domain names <novartis.us>, created on 19 April 2002, <novartis.com>, created on 2 April 1996, and <novartispharma.com>, created on 27 October 1999. The Complainant uses these domain names to promote the NOVARTIS trademark and its products and services.

The Respondent registered the disputed domain name <novartiscareer.com> on 26 October 2020, and the disputed domain name <novartiscareer.net> on 6 November 2020. The disputed domain names are currently inactive.

The Complainant notes that on 2 November 2020 it sent to the Respondent a cease-and-desist letter in respect of the disputed domain name <novartiscareer.com>, but the Respondent did not respond.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant submits that the disputed domain names are confusingly similar to the NOVARTIS trademark, which they incorporate in its entirety combined with the generic term “career”, which is closely related to the Complainant and its business activities.

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Complainant submits that it has never had any relationship with the Respondent and has not granted to the Respondent any rights to use the NOVARTIS trademark in any forms, including in the disputed domain names. The Respondent is not commonly known by the disputed domain names, and they do not resolve to active websites. According to the Complainant, the Respondent deliberately chose to use the well-known, distinctive NOVARTIS trademark for the disputed domain names, with the intention to attract Internet traffic by benefiting from the Complainant’s worldwide renown. Internet users who search for information about the Complainant are likely to be confused by the disputed domain names and believe that they are somehow related to the Complainant.

The Complainant contends that the disputed domain names were registered and are being used in bad faith. It highlights that its well-known NOVARTIS trademark predates the registration of the disputed domain names, and that, considering the renown of the Complainant and of its NOVARTIS trademark and the overall composition of the disputed domain names, their registration was a deliberate and calculated attempt to improperly benefit from the Complainant’s rights and reputation. The Complainant submits that the disputed domain names do not resolve to active websites, but their passive holding does not prevent a finding of bad faith, because the circumstances of the case are indicative of bad faith – the Complainant’s NOVARTIS trademark is well-known, the Respondent has not filed a Response to the Complaint, and it has concealed its identity through the use of a privacy service.

RESPONDENT:

The Respondent did not submit a Response in this proceeding.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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.

PRINCIPAL REASONS FOR THE DECISION

Pursuant to the Policy, paragraph 4(a), a complainant must prove each of the following to justify the transfer of a domain name:

(i) the 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 domain name; and

(iii) the respondent has registered and is using the domain name in bad faith.

In this case, the Provider has employed the required measures to achieve actual notice of the Complaint to the Respondent, and the Respondent was given a fair opportunity to present its case.

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: "[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name …"

Identical or confusingly similar

The Complainant has provided evidence and has thus established its rights in the NOVARTIS trademark.

The Panel notes that a common practice has emerged under the Policy to disregard in appropriate circumstances the general Top-Level Domain ("gTLD") section of domain names for the purposes of the comparison under the Policy, paragraph 4(a)(i). The Panel sees no reason not to follow the same approach here, so it will disregard the ".com" and ".net" gTLD sections of the disputed domain names.

The relevant part of each of the disputed domain names is therefore the sequence "novartiscareer", which consists of the elements "novartis" and "career". The element "novartis" is identical to the NOVARTIS trademark, while "career" is a dictionary word which has a low effect on the overall impression made by the disputed domain names, in which the "novartis" element dominates. As discussed in section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the "WIPO Overview 3.0"), in cases where the relevant trademark is recognizable within the disputed domain name, the addition of other descriptive terms would not prevent a finding of confusing similarity under the first element.

Taking all the above into account, the Panel finds that the disputed domain names are confusingly similar to the NOVARTIS trademark in which the Complainant has rights.

Rights and legitimate interests

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, 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 Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain names, because the Respondent was not authorized to use the NOVARTIS trademark and is not commonly known under the disputed domain names. The Complainant also points out that the disputed domain names do not resolve to active websites. According to the Complainant, the Respondent targeted the NOVARTIS trademark with the intention to attract Internet traffic. Thus, the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names.

The Respondent has not submitted a Response and has not provided an explanation of the reasons why it has registered the disputed domain names.

In the Panel's view, the circumstances of this case do not support a finding that the Respondent has rights and legitimate interests in the disputed domain names. They are confusingly similar to the popular NOVARTIS trademark and incorporate it with the addition of the dictionary word "careers" which has no distinctiveness. The NOVARTIS trademark is easily distinguishable and dominates in the disputed domain names. In the lack of any arguments or evidence to the contrary, this leads the Panel to the conclusion that it is more likely than not that the Respondent, being aware of the goodwill of the Complainant's NOVARTIS trademark, has registered the disputed domain names targeting this trademark in an attempt to exploit its goodwill by attracting Internet users who may believe that the disputed domain names are affiliated to the Complainant.

Therefore, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain names.

Bad faith

Paragraph 4(b) of the Policy lists four illustrative alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

"(i) circumstances indicating that you have registered or you have 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

(ii) you have 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

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

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location."

The registration of the distinctive NOVARTIS trademark significantly predates the registration date of the disputed domain

names, and it has achieved global reputation, including in the United States, where the Respondent is located. The disputed domain names incorporate it with the addition of the word “careers”, which may lead Internet users to believe that they are affiliated to the Complainant and expect that they will contain reliable information about employment with the Complainant. The Panel is therefore of the view that the Respondent registered the disputed domain names with knowledge of the Complainants' trade mark rights and, on balance, with the intention of taking advantage of such rights.

The disputed domain names are inactive, but in the absence of an authorization by the Complainant, and in view of the fact that the Respondent has not provided any plausible explanation of its choice of domain names, the Panel is not aware of any good faith use to which the disputed domain names may be put. As submitted by the Complainant, their non-use would not prevent a finding of bad faith under the doctrine of passive holding, taking account of the degree of distinctiveness and reputation of the Complainant’s NOVARTIS trademark, the failure of the Respondent to submit a Response, and the implausibility of any good faith use to which the disputed domain names may be put. See section 3.3 of the WIPO Overview 3.0.

This satisfies the Panel that the disputed domain names have been registered and 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. **NOVARTISCAREER.COM**: Transferred
2. **NOVARTISCAREER.NET**: Transferred

PANELLISTS

Name	**Assen Alexiev**

DATE OF PANEL DECISION 2021-01-12

Publish the Decision