Decision for dispute CAC-UDRP-103461

Case number	CAC-UDRP-103461
Time of filing	2020-12-17 10:48:57
Domain names	NovartisBenefitsDirectory.com

Case administrator

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

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Organization	Fundacion Comercio Electronico

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 owns several trademark registrations across various jurisdictions, inter alia trademark registrations in Panama, where the Respondent is located. The mentioned trademark registrations in Panama are Trademark No. 80548 “NOVARTIS”, registered since April 25, 1996 and the Trademark No. 253960 "NOVARTIS", registered since October 25, 2016 (hereinafter referred to as the "Trademark").

FACTUAL BACKGROUND

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

The Complainant owns multiple domain names which include the Trademark and provides information on its services online inter alia at <novartis.com>.

The disputed domain name <NovartisBenefitsDirectory.com> was registered on November 23, 2020 and is used in connection with a parking website comprised by pay-per-click links.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that the disputed domain name is confusingly similar to the Trademark.

Furthermore, the Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. In this regard, the Complainant states that the Respondent is not commonly known by the disputed domain name, that it is not affiliated with nor authorized by the Complainant in any way, that the Complainant does not carry out any activity for, nor has any business with the Respondent, and that neither license nor authorization has been granted to the Respondent to make any use of the Trademark or apply for registration of the disputed domain name by the Complainant.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. It contends that the Respondent must have been aware of the Complainant and its well-known Trademark at the time of registration of the disputed domain name, that the Respondent has engaged in a pattern of conduct and that the use of the disputed domain name under a pay-per-click website is evidence of bad faith. The Complainant further contents that the use of a privacy shield and the fact that the disputed domain name has been offered for sale is also evidence of bad faith.

RESPONDENT:

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

Under paragraph 4(a) of the Policy, the Complainant must prove that each of the following three elements is present:

(i) the disputed domain name is identical or confusingly similar to the Complainant's trademark; and

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

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

1. The Panel accepts that the disputed domain name is confusingly similar to the Trademark as it fully incorporates it. It is

well established that a domain name that wholly incorporates a trademark may be confusingly similar to such trademark for purposes of the Policy despite the addition of generic terms.

2. The Complainant has substantiated that the Respondent has no rights or legitimate interests in the disputed domain name. The Panel finds that the Complainant has fulfilled its obligations under paragraph 4(a)(ii) of the Policy. The Respondent did not deny these assertions in any way and therefore failed to prove any rights or legitimate interests in the disputed domain name.

3.1 The Panel is satisfied that the Respondent registered the disputed domain name with full knowledge of the Complainant and its rights in the Trademark as the Trademark is highly distinctive and well-established.

3.2 Furthermore, the Panel accepts the Complainant's contentions that the disputed domain name has been used in bad faith. By creating a PPC parking website that features PPC links, the Respondent used the disputed domain name in bad faith. The purpose of this PPC parking website clearly was to attract Internet users to the site, for profit, based on confusing similarity of the Respondent's domain name and/or website with the Complainants and/or their website. Once on the Respondent's page, some users likely click on advertisers' links, which presumably would confer a commercial benefit of the Respondent. The Panel therefore infers that the Respondent profited from the goodwill associated with the Trademark by collecting click-through revenues.

Moreover, the Panel notes that the Respondent has engaged in a pattern of bad faith registration and use within paragraph 4(b)(ii) of the Policy, as acknowledged by numerous panels before (see Skyscanner Limited v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico, WIPO Case No. D2020-0018).

Finally, the Panel considers the offering of the disputed domain name for sale and the Respondent's use of a privacy shield to hide its true identity further evidence of bad faith registration and use of the disputed domain name.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTISBENEFITSDIRECTORY.COM**: Transferred

PANELLISTS

Name	**Stefania-Despoina Efstathiou, LL.M. mult.**

DATE OF PANEL DECISION 2021-01-23

Publish the Decision