Decision for dispute CAC-UDRP-103459

Case number	CAC-UDRP-103459
Time of filing	2020-12-14 12:10:39
Domain names	NovartisCoVid-19Vaccine.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Organization	Digital Marketing

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 numerous registrations for the trademark "NOVARTIS", including the international trademark No 663765, registered on July 1, 1996, for goods and services in classes 1, 2, 3, 4, 5, 7, 8, 9, 10, 14, 16, 17, 20, 22, 28, 29, 30, 31, 32, 40 and 42.

The disputed domain name was registered by the Respondent on November 9, 2020.

FACTUAL BACKGROUND

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, 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 Spain where the Respondent is located. The Complainant has subsidiaries and associated companies based in Spain.

The Complainant is the owner of the trademark NOVARTIS registered as both a word and device mark in several classes worldwide, including Spain.

The vast majority of the Complainant's trademark registrations predates the registration of the disputed domain name.

The Complainant owns numerous domain names composed of either its trademark NOVARTIS alone, including <novartis.es> and <novartis.com> or in combination with other terms, e.g. <novartispharma.com>. 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.

The Respondent is a specialised journalist, based in Spain.

No website has been created in connection with the disputed domain name.

On December 3, 2020, the Complainant sent the Respondent a cease and desist letter.

An exchange of emails between the parties took place until December 16, 2020, when the Respondent informed the Complainant that someone offered him 3600 Euros for the disputed domain name and invited the Complainant to make a better offer by the end of that week, otherwise he would have sold the disputed domain name to the first bidder.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

NOVARTIS is a well-known, distinctive trademark worldwide.

The 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 not been making a bona fide offering of goods or services of the disputed domain name.

The Respondent has provided false contact information in the WHOIS to conceal its identity.

The Respondent has been offering the disputed domain name for sale and has directly contacted the Complainant threatening to sale the disputed domain name to a third party.

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 had 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.

RESPONDENT:

Novartis AG does not exist. The Complainant should be Novartis Pharma Services AG.

No authorization of Novartis Pharma Services AG to the Complainant's representative has been attached to the Complaint.

The Respondent's intention is not to use the Complainant's trademark, but to use the contraction of the generic Latin words NOVA and ARTIS, together with the generic words COVID-19 and VACCINE. The meaning of the disputed domain name is "a new craft COVID-19 vaccine".

The word NOVARTIS consists of 8 characters, while the wording novartiscovid-19vaccine consists of 23 characters, therefore they are neither identical nor confusingly similar. For these reasons, the Respondent had the right to register and keep the disputed domain name.

The Respondent has the intention to create a public and informative website about the societal transformation caused by COVID-19. The new website would describe the new society, the art and the new way of working. The website is not yet hosted and the content is being redeveloped.

The disputed domain name, together with the domain <thecovid-19vaccines.com> and its Spanish version <lasvacunascovid-19.com>, are intended to be international fora for personal experiences of COVID-19 vaccines.

The Respondent was committed to cooperate with the Complainant, therefore cannot be accused of bad faith.

The Complainant's correspondence with the Respondent constitutes a scam and should be considered as spam.

The Respondent did not have any profit from the disputed domain name because he did not sell it.

There is no harm to the Complainant's interests because no content has been published using the disputed domain name.

The Respondent wanted to collaborate with the Complainant, but did not receive the supporting documents from the Complainant's representative proving the power to act on behalf of Novartis Pharma Services AG. He contacted the Complainant's Spanish subsidiary, and no confirmation about the powers of the Complainant's representative was received.

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

In accordance with paragraph 4(a) of the Policy, in order to obtain the transfer of the disputed domain name, the Complainant has to demonstrate that:

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

IDENTICAL OR CONFUSINGLY SIMILAR

The first requirement that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to the Complainant's trademark or service mark rights.

There are two elements of this test: the Complainant must demonstrate that it has rights in a trademark or service mark and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark or service mark.

The Complainant has proven ownership, among others, of the registered trademark "NOVARTIS", identified in section "Identification of rights" above.

On the question of identity or confusing similarity, what is required is simply a comparison and assessment of the disputed domain name itself to the Complainant's trademark.

The disputed domain name differs from the Complainant's trademark "NOVARTIS" only by the addition of the wording "COVID-19VACCINE", and of the top-level domain ".COM".

It is a common view that where a trademark is the distinctive part of a domain name, the domain name is considered to be confusingly similar to the trademark (see, for example, WIPO case No. D2017-1266).

In the present case, the wording "COVID-19VACCINE", which is related to the field of activity of the Complainant, has no impact on the distinctive part "NOVARTIS". It is well established that where the relevant trademark is recognizable within the domain name, the addition of other terms would not prevent a finding of confusing similarity. The fact that the trademark is 8 characters long and the disputed domain name is 23 characters long is not relevant in this comparison.

It is also well established that the top-level domain may generally be disregarded in the confusing similarity test (see, for example, WIPO case No. D2016-2547).

Furthermore, the Panel does not consider credible the Respondent's argumentation that the disputed domain name contains the word "NOVARTIS" because it is the contraction of the generic Latin words "NOVA" and "ARTIS". A simple search of the word NOVARTIS carried out using internet search engines provides results related to the Complainant and not to any generic meaning in Latin.

Therefore, the Panel considers that the disputed domain name is confusingly similar to the Complainant's trademark "NOVARTIS".

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

The second requirement that the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in the disputed domain name:

(i) before any notice to [the Respondent] 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] (as an individual, business, or other organization) [has] been commonly known by the [disputed] domain name, even if [the Respondent] [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.

This is a non-exhaustive list of circumstances in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement falls on the Complainant. UDRP panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative".

Accordingly, it is usually sufficient for a complainant to raise a prima facie case against the respondent and the burden of proof on this requirement shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in a domain name.

The Panel finds that the Complainant has made out a prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain name.

In particular, the Complainant states that:

- the Complainant and the Respondent have never had any previous relationships;

- the Complainant has never granted the Respondent any right to use the "NOVARTIS" trademark in any form, including within the disputed domain name;

- the Respondent is not commonly known by the disputed domain name;

- the Respondent has no legitimate interest over the disputed domain name;

- the disputed domain name was not used for offering goods or services but resolved to a webpage offering the disputed domain name for sale;

- the Respondent rejected the requests contained in the Complainant's cease and desist letter and offered to sell the disputed domain name for an excessive amount of money;

- when internet users who search information about the Complainant find the disputed domain name would be led to believe that the disputed domain name is somehow related to the Complainant and would be disappointed for not finding the expected information; this would lead to a tarnishment for the Complainant.

Furthermore, the Respondent has failed to demonstrate any of the other non-exclusive circumstances evidencing rights or legitimate interests under paragraph 4(c) of the Policy or other evidence of rights or legitimate interests in the disputed

domain name.

The Respondent does not appear to make any legitimate non-commercial or fair use of the disputed domain name, nor any use in connection with a bona fide offering of goods or services. Indeed, the website in relation with the disputed domain name consisted in a page where the disputed domain name was offered for sale.

The Panel does not accept the Respondent's argument related to the freedom of the press, because that right does not encompass the right to register a domain name which contains a third party trademark. Moreover, the Respondent, who is the owner of other two domain names which relate to COVID-19 vaccine, has not demonstrated why registering the disputed domain name would be legitimate and necessary for his initiative intended to describe the societal transformation caused by the pandemic and to create an international forum.

Furthermore, the Respondent has not submitted any pre-dispute evidence of use or demonstrable preparation to use the disputed domain name proving a lack of cybersquatting intent.

The Panel considers that, on the balance of probability, the Respondent knew of the reputation and goodwill that the Complainant had established in the trademark “NOVARTIS” and registered the disputed domain name with knowledge of the Complainant's rights and reputation, and not because of the generic meaning of the contraction of the words "NOVA" and "ARTIS". Indeed, it is not conceivable that the Respondent did not have the Complainant's trademark in mind, when registering and using the disputed domain name. Under these circumstances, it cannot be concluded that the Respondent is making a "fair" use of the disputed domain name.

Taking into account that the Respondent is not commonly known as the disputed domain name, that the Respondent has no relationship with the Complainant, that the Complainant has not authorized the Respondent to register the disputed domain name or to use the Complainant's trademark in any way, that the disputed domain name was used in a webpage offering the disputed domain name for sale and not for any other legitimate purpose, that the Respondent offered to sell the disputed domain name for an excessive amount of money to the Complainant, the Panel cannot imagine any possible legitimate justification for this use, and the Respondent has not come forward with a credible explanation that demonstrates any rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

REGISTERED AND USED IN BAD FAITH

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, including:

(i) circumstances indicating that [the Respondent] [has] registered or [has] acquired the [disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the [disputed] 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 Respondent's] documented out-of-pocket costs directly related to the [disputed] domain name; or

(ii) [the Respondent] [has] registered the [disputed] 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 Respondent] [has] engaged in a pattern of such conduct; or

(iii) [the Respondent] [has] registered the [disputed] domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the [disputed] domain name, [the Respondent] [has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent's] web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the Respondent's] web site or location or of a product or service on [the Respondent's] web site or location.

The Panel, on the basis of the evidence presented, agrees with the Complainant's contentions that the disputed domain name was registered in bad faith and that it has been used in bad faith.

Taking into account the distinctiveness and reputation of the trademark “NOVARTIS” also recognized by other panels, the Panel agrees that it is inconceivable that the Respondent was not aware of the Complainant's rights in the trademark “NOVARTIS” when registering the disputed domain name. Other panels considered that knowledge of a corresponding mark at the time of the domain name’s registration can suggest bad faith (see, for example, WIPO Case No. D2017-0100) and the Panel shares this view.

The fact that the Respondent informed the Complainant that someone offered him 3600 Euros for the disputed domain name and invited the Complainant to make a better offer within a few days, otherwise he would have sold the disputed domain name to the first bidder is a clear indication that Respondent primarily registered the disputed domain name for the purpose of selling it to Complainant at a price in excess of its documented out-of-pocket costs. As underlined by other Panels, such circumstances are evidence of registration and use of the disputed domain name in bad faith within the meaning of paragraphs 4(b)(i) of the Policy (see, for example, WIPO Case No. D2020-3053).

As regards the Respondent's argument that he was committed to cooperate with the Complainant, this is in contradiction with the fact that he offered to sell the disputed domain name for a significant amount of money. If he wanted to cooperate with the Complainant, he would have offered to sell it for a price equivalent to its documented out-of-pocket costs. Therefore, the Panel cannot accept this argument.

As regards the Respondent's argument that the Complainant's correspondence with the Respondent (and in particular the cease and desist letter) would constitute a scam, this allegation has not been demonstrated and in any case is outside the scope of the UDRP and not relevant for the decision of the present case. In addition, the Panel incidentally notes that the letter in question is a standard cease and desist letter.

The claim of infringement of provisions of data protection law (as regards spam) is also out of the scope of the UDRP and is not relevant for the decision of the present case. In addition, the Panel incidentally notes that the contractual relationship between the registrar of the disputed domain name and the Respondent, which includes binding provisions on UDRP, in principle should be considered as legal basis for the communications between the Complainant and the Respondent.

The Respondent's argument that he did not have any profit from the disputed domain name because he did not sell it should be rejected, because, as other Panels have found, when the Respondent does not have any legitimate interest in the disputed domain name, the offer is considered as use in bad faith (see, for example, WIPO Case No. D2017-0391).

The Respondent's argument that there is no harm to the Complainant's interests because no content has been published using the disputed domain name should be rejected because under the doctrine of passive holding, it is well-established that passively holding a domain name does not constitute a bona fide offering of goods or services (see, for example, WIPO Case No. D2018-2746).

The Respondent's allegation that "Novartis AG" does not exist is clearly unfounded and should be rejected. Indeed, "Novartis AG" exists and is the owner, among others, of the registered trademark “NOVARTIS”, identified in section “Identification of rights” above. The Panel underlines that Novartis Pharma Services AG, even if it is a company of the Complainant's group, is not the owner of the above-mentioned trademark.

As regards the allegation of the Complainant's representative lack of power to represent the Complainant, the Panel points

out that, unlike other similar procedures (e.g. Rules of Procedure for Dispute Resolution Procedures for “.ch” and “.li” domain names), the Rules for Uniform Domain Name Dispute Resolution Policy do not require a power of attorney as a requirement for the submission of complaints where parties are represented by an authorised representative. Therefore, this argument should be rejected.

With regard to the fact that the Respondent contacted the Complainant's Spanish subsidiary, and no confirmation about the powers of the Complainant's representative was received, the Panel observes that this fact is not relevant. The Panel observes that in a multinational group with more than 100 000 employees, it is possible that not all the staff working for all subsidiaries are supposed to know this kind of information.

The Panel, having taken into account the Respondent's knowledge of the "NOVARTIS" distinctive and well-known trademark at the time of the disputed domain name’s registration, as well as the offer to sell the disputed domain name for a price in excess of its documented out-of-pocket costs, considers that there is sufficient evidence to conclude that the disputed domain name was registered and is being used in bad faith.

Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTISCOVID-19VACCINE.COM**: Transferred

PANELLISTS

Name	**Michele Antonini**

DATE OF PANEL DECISION 2021-01-31

Publish the Decision