Decision for dispute CAC-UDRP-103383

Case number	CAC-UDRP-103383
Time of filing	2020-12-07 10:13:51
Domain names	novartis.app

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Name	Antonio G. Pugliese

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 inter alia the owner of the International trademark registration no. 663765 "NOVARTIS", registered on July 1, 1996, for various 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 (hereinafter referred to as the "Trademark").

FACTUAL BACKGROUND

The Complainant is the holding company of the Novartis Group, one of the biggest global pharmaceutical and healthcare groups, which was in 1996 through a merger of two other companies Ciba-Geigy and Sandoz. The Complainant's products are manufactured and sold in many regions worldwide including the Czech Republic, where the Respondent is located. The Complainant also has a subsidiary in the Czech Republic, which is the number one pharma company in the country with more than 1,500 associates in total. The Complainant is the registered owner of numerous domain names, including <novartis.com> and <novartis.cz>.

The disputed domain name was registered on November 27, 2020 and is not used in connection with an active website so far. However, the disputed domain name is listed for sale for an amount of 3,000 USD.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that the disputed domain name is identical to the Trademark as the disputed domain name includes the Trademark in its entirety and as the gTLD ".info" does not add any distinctiveness to the disputed domain name.

The Complainant also states that the Respondent does not have any rights or legitimate interest with regard to the disputed domain name. The Complainant argues that the parties have never had any previous relationships, nor has the Complainant ever granted the Respondent with any rights to use the Trademark in any form, including the disputed domain name. It further contends that the Respondent is neither commonly known by the disputed domain name nor has legitimate interest over the disputed domain name. Finally, the Complainant states that the Respondent's name is "Antonio G. Pugliese", which has no connection to the Complainant nor to the term "Novartis" in any way.

With regard to bad faith, the Complainant states that the disputed domain name was registered and is being used in bad faith. With regard to bad faith registration, it argues that the Respondent very likely knew about the Complainant and its Trademark because the Trademark is well-known (which already has been confirmed in prior UDRP decisions), because the Complainant is very active in the Respondent's home country and because the gTLD ".app" is closely related to the Complainant and its business activities. With regard to bad faith use, the Complainant contends that the disputed domain name is listed for sale for 3,000 USD to the public and that the Respondent has been using a privacy shield to conceal its identity and that the Respondent therefore acted in bad faith.

RESPONDENT:

The Respondent denies the Complainant's assertions and requests the Complaint to be denied. It argues as follows:

- The Complainant does not actually operate as an app developer and that the gTLD ".app" is, according to the sponsoring registrar, „a more secure domain for apps". The Respondent further argues that many domain names with the same SLD and different TLDs are used by different companies in different fields and that this coexistence, per se, does not create any confusion at all, especially if the class of the product or service is absolutely different. The Respondent states that the Complainant has no right to monopolize the Trademark under all Top-Level-Domains.

- The name "NovArtis" comes from the two latin words "nova" and "artis". The Registrant is Italian, and the Italian language is the closest language to Latin, from which it descends via Vulgar Latin. In Italian the two latin words "nova artis" mean the generic concept of "nuova arte" (new art). The word NovArtis is a composite word and the result of a crasis.

- The Respondent chose the disputed domain name exclusively with reference to the theme of "New Art" and there was absolutely no connection to the Complainant. The target of the Respondent's planned app is exclusively the art, offering tools & events for galleries, collectors, artists, and art lovers, which is clearly unrelated to the Trademark.

- The disputed domain name has been registered after several sunrise periods (in which the Complainant had the chance to register it) and was available many times since it was first made available. The Respondent states that it is obvious that the Complainant had no real interest in the disputed domain name.

- The Trademark is well known only by a specific target group (i.e. doctors, pharmacists) and, unlike Amazon, Apple, Coca-Cola, not by the general public. The Respondent states that it is not a doctor nor a pharmacist and it didn't know the Trademark when registering the disputed domain name.

- The disputed domain name is not yet used by the Respondent because the Complainant had locked the disputed domain name less than a week after its registration and the Respondent, therefore, could not use the disputed domain name or

redirect it to its intended website/web app that is still being developed and tested before the launch. The Respondent argues that the lock is causing damages and delay to the developing project.

- The Respondent states that the disputed domain name is not used and will never be used to mislead consumers.

- The Respondent states that the Complainant's assertion that it offered the disputed domain name for sale is false. It argues that, in fact, GoDaddy and other marketplaces are selling the disputed domain name without the Respondent's permission, as a premium domain. It further argues that the disputed domain name may have been listed by a prior owner.

- The Respondent states that it is a lawyer and an entrepreneur who has already signed a NDA (non-disclosure agreement) with a highly qualified HK company involved in investing and developing digital assets. The Respondent asserts that it has already put hours of sweat equity in coding, analysing the market, validating the need, thinking about a suitable brand name and using precious resources in getting a start-up idea off the ground. The Respondent asserts that it registered the disputed domain name in good faith, adding that it capitalized the "N" and "A" because "NovArtis" is a two-word Latin name.

- The Respondent further alleges that the Complaint contains various false allegations and finally requests a finding for Reverse Domain Name Hijacking.

COMPLAINANT'S SUPPLEMENTAL FILING

The Complainant replied to the Response with the following arguments:

- The Respondent claimed that it "was unaware of the existence of the Complainant (name / company / brand / trademark)." However, the Respondent itself is Italian, it is located in the Czech Republic, and its business partner for the "Novartis.app" project is a UK company. The Complainant is well-known across the world including the above-mentioned three countries, e.g. it has subsidiaries in all three countries and a dedicated official website for the three countries, it is very unlikely that the Respondent was not aware of the Complainant when it registered the disputed domain name.

- The Respondent claimed that it had "already put hours of sweat equity in coding, analyzing the market, validating the need, thinking about a suitable brand name and using precious resources in getting a start-up idea off the ground." Therefore, it is reasonable to assume that the Respondent had conducted sufficient Internet search before it registered the disputed domain name. As provided in the first filing, a public search of the term "Novartis" all pointed to the Complainant and its business activities, it is impossible that the Respondent was not aware of the Complainant.

- The Respondent claimed that it was developing an application and there would be Android and IOS versions, however, search in Google Play and AppStore again pointed to the Complainant. It is impossible that the Respondent was still not aware of the Complainant and its trademark "Novartis" after it spent hours analyzing the market.

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

The first point to be dealt with is the admissibility of the Complainant's supplemental submission. The Rules do not allow the parties to file supplemental submissions on their own volition, and paragraph 12 of the Rules provides that a panel may in its sole discretion request further statements or documents from either of the parties. Thus, no party has the right to insist upon the admission of additional arguments or evidence. Grounds justifying new submissions are generally those regarding the existence of new pertinent facts that did not arise until after the complaint was filed. In the present case, the Respondent refers to a legitimate interest in the disputed domain name. In the view of the Panel, the Complainant was not able to refer to such circumstances in its Complaint. Therefore, the Panel elects to accept the Complainant's supplemental submission and has relied on it in reaching this 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 identical to the Trademark.

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 argues that it registered the disputed domain name to use it in connection with an app for "art, offering tools & events for galleries, collectors, artists, and art lovers", unrelated to the Trademark. It further states that it registered the disputed domain name because of its generic Latin meaning „nova artis".

Under paragraph 4(c) of the Policy, any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate the Respondent's rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
(iii) you are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Respondent has not alleged that the requirements of paragraphs 4(c)(ii) or 4(c)(iii) of the Policy are relevant in the present case. With respect to paragraph 4(c)(i) of the Policy, the Respondent has not provided any evidence to support its alleged use of the disputed domain name. The link to Google Drive files which should contain screenshots of the Respondent's app did not lead to any retrievable content when the panel tried to view it. In this regard, the Respondent also cannot rely on the fact that it has signed an NDA preventing it from disclosing information relating to the alleged preparation of the use of the disputed domain name. It should have been easy to convince the alleged business partners to disclose at least part of the preparatory acts to demonstrate the use in the present proceedings. If the respondent does not provide any evidence, the panel has no possibility to examine its submissions in this respect and to rule in its favor.

Regardless, the Panel also has concerns that the Respondent's alleged offer is a bona fide offer within the meaning of the Policy. The Trademarks enjoys protection in Classes 9 (software) and 42 (software services), and there are demonstrably numerous apps owned by Complainant.

Also, the allegation by the Respondent that the Complainant could have registered the disputed domain name before, is not

convincing. There is no general rule that would allow third parties to register a domain name comprising a registered trademark, just because the trademark owner did not register the respective domain name itself.

Therefore, based on the evidence before the Panel, the Panel cannot find any rights or legitimate interests of the Respondent either. The Panel finds that the Complainant has proven that the Respondent has no rights or legitimate interests in respect of the disputed domain name under paragraphs 4(a)(ii) and 4(c) of the Policy.

3.1 In light of the notoriety of the Complainant and its trademarks, the business activities of the Complainant in the Czech Republic, where the Respondent is based, and the presence of the Complainant on the Internet and - most importantly - also in the largest app stores, the Panel finds it more than unlikely that the Respondent, which intends to launch an app under the disputed domain name, was unaware of the Complainant and its activities when it registered the disputed domain name. The Panel, therefore, finds that the registration was made in bad faith, irrespective of whether the Respondent may have registered the disputed domain name also because of its descriptive appeal.

3.2 The Panel is also satisfied that the disputed domain name is being used in bad faith under paragraph 4(b)(i) of the Policy. The disputed domain name was demonstrably offered for sale for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain name. Such an offer to sell a domain name on a public website has been found to indicate that a domain name has primarily been registered with the intention of selling it to the Complainant or one of its competitors in return for a payment that exceeds the costs directly related to the domain name. In this context, the Respondent has not provided any evidence to support his claims that it is not responsible for the sales offers. Neither has it submitted screenshots showing that the domain name had already been offered for sale prior to the time of its registration by the Respondent, nor has it obtained or submitted confirmations from the sales platforms regarding this fact. Again, if the respondent does not provide any evidence, the panel has no possibility to examine its submissions in this respect and to rule in its favor.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTIS.APP**: Transferred

PANELLISTS

Name	**Peter Müller**

DATE OF PANEL DECISION 2021-02-14

Publish the Decision