Decision for dispute CAC-UDRP-103621

Case number	CAC-UDRP-103621
Time of filing	2021-05-06 11:13:03
Domain names	Novarticcareers.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 is the owner of the well-known, distinctive trademark NOVARTIS as a word and figurative mark in several classes in numerous countries all over the world including in Panama. These trademark registrations predate the registration of the Disputed Domain Name.

Details of NOVARTIS Trademark registration in Panama:

Trademark: NOVARTIS
Reg. no: 80548
Registration date: 25 April 1996

Trademark: NOVARTIS
Reg. no: 253960
First use in commerce: 25 October 2016

Previous UDRP panels have stated that the NOVARTIS trademark is well-known (inter alia Novartis AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org, / Sergei Lir, WIPO Case No. D2016-1688).

The Complainant owns numerous domain names composed of its trademark NOVARTIS, including <novartis.com> (created on 2 April 1996) and <novartis.net> (created on 25 April 1998). The Complainant uses these domain names to promote the NOVARTIS mark with related products and services.

FACTUAL BACKGROUND

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

The Novartis Group is one of the biggest global pharmaceutical and healthcare groups. Novartis AG (the "Complainant"), was 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 an active presence in Panama, where the Respondent is located. The Complainant has established a company "Novartis Pharma (Logistics), Inc." and has carried out more than 25 clinical studies in the country in coordination with the competent authorities and researchers.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant's contentions can be summarised as follows:

A. THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR

The domain name <Novarticcareers.com> (hereinafter referred to as the "Disputed Domain Name"), which was registered on 22 March 2021, incorporates a sign "novartic" which differs from the Complainant's well-known, distinctive trademark NOVARTIS by merely replacing the last letter "s" with a "c", adding the generic term "careers". The addition of the gTLD ".com" does not add any distinctiveness to the Disputed Domain Name. See as an example the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), paragraph 1.11. as well as the International Business Machines Corporation v. Sledge, Inc. / Frank Sledge WIPO Case No. D2014-0581 where the Panel stated the following:

"In addition, it is generally accepted that the addition of the top-level suffix in the domain name (e.g., ".com") is to be disregarded under the confusing similarity test".

The same reasoning should apply in the current case and the Disputed Domain Name should be considered as confusingly similar to the trademark NOVARTIS.

B. RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN RESPECT OF THE DISPUTED DOMAIN NAME

The Complainant and the Respondent have never had any relationship, nor has the Complainant ever granted the Respondent any rights to use the NOVARTIS trademark in any form, including the Disputed Domain Name.

The Respondent is not commonly known by the Disputed Domain Name and does not have rights or a legitimate interest in the Disputed Domain Name. When the Complainant searched for "Novartic careers" in the Google search engine, the search engine always suggested first "Novartis careers" and returned numerous results about the Complainant and its business

activities.

The Respondent could have easily performed a similar search before registering the Disputed Domain Name and would have quickly learnt that the NOVARTIS trademarks is owned by the Complainant and that the Complainant has been using its trademarks in Panama, where the Respondent resides, and many other countries worldwide. However, the Respondent still chose to register the Disputed Domain Name.

By the time the Complainant prepared this amended Complaint on 11 May 2021, the Disputed Domain Name resolved to random third party websites.

The Respondent has not been using the Disputed Domain Name for any bona fide offering of goods or services. The fact that the Respondent has the Disputed Domain Name listed for sale further supported this point.

When Internet users, who search for information about the Complainant and/or about the brand “Novartis”, see the Disputed Domain Name and the random websites, they would very likely be confused and be led to believe that the Disputed Domain Name is somehow related to the Complainant and be disappointed as they would not find the information as expected – which will lead to trademark tarnishment for the Complainant.

Additionally, the Respondent “Carolina Rodrigues / Fundacion Comercio Electronico” has already been involved in several UDRP proceedings which has generated a pattern of bad faith domain name registration.

From the Complainant’s perspective, the Respondent deliberately chose to incorporate a sign that is confusingly similar to the well-known, distinctive trademark NOVARTIS in the Disputed Domain Name, very likely with the intention to attract Internet traffic by benefiting from the Complainant’s worldwide renown.

For the foregoing reasons, it shall be concluded that the Respondent has no right nor legitimate interest in respect of the Disputed Domain Name and has not been using the Disputed Domain Name for any bona fide offering of goods or services or legitimate non commercial or fair use.

C. THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITH

It should be highlighted that most of Complainant’s trademark registrations predate the registration of the Disputed Domain Name and the Respondent has never been authorized by the Complainant to register the Disputed Domain Name. Considering the renown of the Complainant and its trademark NOVARTIS, and the overall composition of the Disputed Domain Name, i.e. using a sign “novartic” which differs from the Complainant’s well-known, distinctive trademark NOVARTIS by only replacing the last letter “s” with “c”, in combination with the generic term “careers”, it follows that incorporating the well-known trademark NOVARTIS in the Disputed Domain Name is a deliberate and calculated attempt to improperly benefit from the Complainant’s rights and reputation.

Considering the facts that:

• The Respondent very likely knew about the Complainant and its trademark;

• The Complainant’s trademark NOVARTIS is a distinctive, well-known trademark worldwide and in Panama where the Respondent resides;

• The Respondent has failed in presenting a credible evidence-backed rationale for registering the Disputed Domain Name.

The Disputed Domain Name shall be deemed as registered in bad faith under the UDRP Policy (‘the Policy’), which is

supported by WIPO Overview 3.0, para. 3.1.1.:

“If on the other hand circumstances indicate that the respondent’s intent in registering the disputed domain name was in fact to profit in some fashion from or otherwise exploit the complainant’s trademark, panels will find bad faith on the part of the respondent. While panel assessment remains fact-specific, generally speaking such circumstances, alone or together, include: (i) the respondent’s likely knowledge of the complainant’s rights, (ii) the distinctiveness of the complainant’s mark, … (vii) failure of a respondent to present a credible evidence-backed rationale for registering the domain name,…”.

and para.3.1.4:

“Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.”

THE DISPUTED DOMAIN NAME IS BEING USED IN BAD FAITH

For the reasons mentioned in sector B.:

- The Respondent has no right nor legitimate interest in the Disputed Domain Name;

- The Respondent has been using the Disputed Domain Name to resolve to random third-party websites;

- The Respondent has listed the Disputed Domain Name for sale;

- The Respondent has been involved in numerous previous domain name disputes of similar conduct which has formed a pattern of conduct.

It is obvious that the Respondent is exploring the reputation of the Complainant for commercial gain.

Additionally, the Complainant tried to reach the Respondent by a cease-and-desist letter sent on 31 March 2021 to: 1). the Respondent’s e-mail as provided in the WHOIS database; 2). via the Registrar. However, until the time the Complainant prepared this Complaint, it has not yet received a response from the Respondent.

In terms of paragraph 4(b)(iv) of the Policy, the above facts demonstrate the Respondent’s use of the Disputed Domain Name in bad faith. See “Dr. Martens” International Trading GmbH and “Dr. Maertens” Marketing GmbH v. Godaddy.com, Inc., WIPO Case No. D2017-0246:

“The Domain Name was not resolving to an active website at the time of filing. However, the consensus view amongst WIPO panellists is that ‘the apparent lack of so-called active use (e.g., to resolve to a website) of the domain name without any active attempt to sell or to contact the trade mark holder (passive holding), does not as such prevent a finding of bad faith. The panel must examine all the circumstances of the case to determine whether the respondent is acting in bad faith. Examples of what may be cumulative circumstances found to be indicative of bad faith include the complainant having a well-known trade mark, no response to the complaint having been filed, and the registrant’s concealment of its identity’.”

SUMMARY

• NOVARTIS is a well-known, distinctive trademark worldwide.

• Complainant's trademarks registration predates the registration of the Disputed Domain Name.

• Respondent has no rights in the mark NOVARTIS, has no relationship with 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 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.

• Respondent failed in responding to the cease-and-desist letter sent by the Complainant.

• Respondent has exhibited a pattern of conduct of bad faith domain name registration and use.

Consequently, the Respondent should be considered to have registered the Disputed Domain Name as confusingly similar to the Complainant's well-known, distinctive trademark NOVARTIS. The Respondent did not have 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:

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

The Disputed Domain Name registered in 2021 is confusingly similar to the Complainant's trademark NOVARTIS (registered, inter alia, in Panama since 1996 for pharmaceuticals) just replacing the letter 's' with a letter 'c' and adding the generic term 'careers' and the gTLD .com none of which prevents said confusing similarity for the purposes of the Policy.

The Disputed Domain Name has been offered for sale for a sum well in excess of the costs of registration of the Disputed Domain Names and pointed to several third party web sites which is not a bona fide offering of goods or services or a legitimate non commercial or fair use. It is registration and use in bad faith registering a domain name containing a well known trade mark in order to sell it for profit and diverting Internet users using the Disputed Domain Name to cause confusion on the internet and disrupt the business of the Complainant in opposition to its interests.

In addition the Respondent has been the subject of a large number of adverse decisions for cybersquatting activities under the Policy demonstrating a pattern of conduct.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTICCAREERS.COM**: Transferred

PANELLISTS

Name	**Dawn Osborne**

DATE OF PANEL DECISION 2021-06-02

Publish the Decision