

Decision for dispute CAC-UDRP-103879

Case number	CAC-UDRP-103879
Time of filing	2021-06-24 10:35:45
Domain names	Novartis-AdaCap.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	Novartis AG
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Complainant representative

Organization	BRANDIT GmbH
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Respondent

Name	Mike Sanders
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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 a large portfolio of word and device trade marks consisting of the name NOVARTIS in multiple classes and numerous countries around the world, including the International trade mark NOVARTIS, registration number 663765, first registered on 1 July 1996 in international classes 01-05, 07-10, 14, 16, 17, 20, 22, 28-32, 40 and 42. The trade mark registration predates the registration of the disputed domain name. Furthermore, the Complainant owns multiple domain names consisting of the name NOVARTIS, including <novartis.com>, registered on 2 April 1996, <novartis.de>, registered on 25 January 2008, <novartis.us>, registered on 19 April 2002, and <novartispharma.com>, registered on 27 October 1999, which are all connected to the Complainant's official websites.

The Panel further notes that previous panels have found the Complainant's trade mark NOVARTIS to be well-known worldwide (see WIPO Case No. D2016-1688, Novartis AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org/Sergei Lir <novartis-bio.com>). The Panel accepts that the Complainant's trade mark NOVARTIS is well-known around the world, including in Germany, where the Respondent is located.

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. It provides solutions to address the evolving needs of patients worldwide by developing and delivering innovative medical treatments and drugs. The Complainant, 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's products are manufactured and sold in many regions worldwide. The Complainant has a strong presence in Germany, where the Respondent is located. The Complainant has numerous subsidiaries and associated companies based in Germany. Moreover, in 2020, 9% of Novartis Group's total net sales were achieved in Germany. Furthermore, the Complainant enjoys a strong presence online also via its official website dedicated to Germany: <https://www.novartis.de/> and its social media platforms

The Respondent registered the disputed domain name <Novartis-AdaCap.com> on 9 May 2021. As at the date of this decision, the disputed domain name resolves to an error page and is inactive. The Complainant submitted evidence to show that the disputed domain name previously resolved to a parking page. There is no evidence before the Panel that the disputed domain name has ever been used for an active website since it was registered.

PARTIES CONTENTIONS

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 trade mark 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

By non-standard communication dated 3 August 2021, the Panel observed that the disputed domain name <Novartis-AdaCap.com> included, in addition to the name element NOVARTIS, the further name element ADACAP. The Complainant submitted that this was a reference to Advanced Accelerator Applications, an affiliate company of the Complainant and a member of the Novartis Group. The rights of Advanced Accelerator Applications therefore appeared also to be affected by the registration and/or use of the disputed domain name and by the present administrative proceedings.

It was unclear from the Complainant's submissions whether the name Advanced Accelerator Applications, or the abbreviation AdaCap, were subject to separate trade mark protection and/or other rights and, if so, who the rightsholder in respect of these names was. Given that Advanced Accelerator Applications appeared to be a separate legal entity from Novartis (albeit a member of the same group), it was not inconceivable that this separate legal entity owned rights in the names Advanced Accelerator Applications and/or the abbreviation AdaCap.

Against this background, the Panel raised certain questions with the Complainant and gave further procedural directions, inter alia, for the owner of the rights in the name Advanced Accelerator Applications and/or the abbreviation AdaCap either to be joined to the present administrative proceedings as a joint complainant, if these rights were not also owned by the Complainant, or for the Complainant to demonstrate the agreement of the rightsholder in the name Advanced Accelerator

Applications and/or the abbreviation AdaCap to the transfer of the disputed domain name to the Complainant.

Following a further exchange of non-standard communications, the Complainant produced evidence of agreement by Advanced Accelerator Applications to the transfer of the disputed domain name to the Complainant. The agreement was executed by the holders of a power of attorney on behalf of that company. Although a copy of the power of attorney, pursuant to which the document is said to have been executed, was not produced by the Complainant (which would clearly have been normal procedure), the Complainant of course certified in the Complaint, and again in the Amended Complaint, that "the information contained in this Complaint is to the best of Complainant's knowledge complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass, and that the assertions in this Complaint are warranted under these Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument."

The Panel is therefore satisfied in the circumstances that Advanced Accelerator Applications has consented to the transfer of the disputed domain name to the Complainant.

The Panel is satisfied that all other procedural requirements under UDRP were also met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

With regard to the first UDRP element, the Panel finds that the disputed domain name <Novartis-AdaCap.com> is confusingly similar to the Complainant's well-known trade mark NOVARTIS. Indeed, the disputed domain name incorporates the Complainant's trade mark in its entirety, save that the disputed domain name adds the name element "AdaCap", which refers to "Advanced Accelerator Applications", an affiliate company of the Complainant, to the Complainant's trade mark.

While the Complainant makes no submissions in this regard, the Panel considers that the addition of a third-party name or trade mark is insufficient in itself to avoid a finding of confusing similarity with the Complainant's trade mark where the Complainant's trade mark is recognisable within the disputed domain name. To the contrary, given that Advanced Accelerator Applications is a member of the Novartis Group of companies, the addition of the name element "AdaCap" contributes to the overall impression of the designation as being connected to the Complainant's trade mark. The Panel follows in this respect the view established by numerous other decisions (see, for example, WIPO Case No D2001-1142, Chevron Corporation -v- Young Wook Kim <chevron-texaco.com>; and WIPO Case No D2001-0195, Yahoo! Inc -v- CPIC NET and Syed Hussain <yahoobay.org>).

With regard to the second UDRP element, there is no evidence before the Panel to suggest that the Respondent has made any use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services. Neither is there any indication that the Respondent is making legitimate non-commercial or fair use of the disputed domain name. Indeed, the disputed domain name is not being used for any active website but previously resolved to a parking page and now resolves to an error page. A lack of content at the disputed domain has in itself been regarded by other panels as supporting a finding that the Respondent lacked a bona fide offering of goods or services and did not make legitimate non-commercial or fair use of the disputed domain name (see, for example, Forum Case No. FA 1773444, Ashley Furniture Industries, Inc v. Joannet Macket/JM Consultants). The Panel further finds that the Respondent is not affiliated with or related to the Complainant in any way and is neither licensed nor otherwise authorised to make any use of the Complainant's trade mark or to apply for or use the disputed domain name. In addition, the Whois information does not suggest that the Respondent is commonly known by the disputed name <Novartis-AdaCap.com>.

Against this background, and absent any response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

With regard to the third UDRP element, the Panel considers that, if the Respondent had carried out Google search for the names NOVARTIS and ADACAP, the search results would have yielded immediate and obvious references to the Complainant. The Panel concludes that it is difficult in those circumstances to believe that the Respondent was unaware of the Complainant's trade mark. It is therefore reasonable to infer that the Respondent either knew, or should have known, that

the disputed domain name would be identical with or confusingly similar to the Complainant's trade mark and that he registered the disputed domain name in full knowledge of the Complainant's trade mark. Indeed, it is likely that the disputed domain would not have been registered if it were not for the Complainant's trade mark (see, for example, WIPO Case No D2004-0673 Ferrari Spa -v- American Entertainment Group Inc).

Furthermore, the website related to the disputed domain name is currently inactive and resolves to a parking page. The Respondent has not demonstrated any activity in respect of the disputed domain name. First, it is difficult to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate on the grounds that it would constitute passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trade mark law under circumstances where that disputed domain name corresponds to the Complainant's trade mark and is similar to the Complainant's domain names currently used by the latter to promote its goods and services. Secondly, numerous other UDRP decisions have taken the view, which this Panel shares, that the passive holding of a domain name with knowledge that the domain name infringes another party's trademark rights may in itself be regarded as evidence of bad faith registration and use (see, for example, WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows; and WIPO Case No. D2004-0615, Comerica Inc. v. Horoshiy, Inc.).

In the circumstances, the Panel does not need to consider further whether the Respondent's use of a privacy registration service constitutes further evidence of bad faith. Absent any response from the Respondent, or any other information indicating the contrary, the Panel therefore also accepts that the Respondent has registered and is using the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. NOVARTIS-ADACAP.COM: Transferred

PANELLISTS

Name	Gregor Kleinknecht
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DATE OF PANEL DECISION **2021-09-03**

Publish the Decision
