

Decision for dispute CAC-UDRP-104026

Case number CAC-UDRP-104026

Time of filing 2021-09-22 08:57:00

Domain names Novartis-Usa.com

Case administrator

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

Complainant

Organization Novartis AG

Complainant representative

Organization BRANDIT GmbH

Respondent

Organization Merit Pharmaceutical

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 submitted evidence that it is the registered owner of the following:

(i) the US trademark registration No. 5420583 for "NOVARTIS" (word), registered since 13 March 2018 for the classes 9, 10, 41, 42, 44 and 45;

(ii) the US trademark registration No. 2997235 for "NOVARTIS", registered since 20 September 2005 for the class 5, which was first used in commerce on 30 September 1997; and

(iii) numerous other trademark registrations and applications for "NOVARTIS" as both a word and a device mark in several classes around the world.

The Complainant claims that its trademark "NOVARTIS" is well-known and supports such claim by referring to decisions of previous UDRP Panels, namely the WIPO Case No. D2016-1688.

The Complainant also provided information, supported by evidence, that it is the registered holder of numerous domain names composed of either its trademark NOVARTIS alone, including <novartis.us> (created on 19 April 2002) and <novartis.com> (created on 2 April 1996), or in combination with other terms, such as <novartispharma.com> (created on 27 October 1999). The Complainant uses these domain names to promote the NOVARTIS mark with related products and services. In addition, the Complainant alleges to enjoy a strong presence online also via its official social media platforms, as outlined in provided evidence.

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 especially a strong presence in the United States of America (the "USA") where the Respondent is located. The Complainant has numerous subsidiaries and associated companies based in the USA. Moreover, in 2019, 34% of Novartis Group's total net sales were constituted in the USA.

The disputed domain name <Novartis-Usa.com> was registered on 7 August 2021.

The Registrar confirmed that the Respondent is the current registrant of the disputed domain name and that the language of the registration agreement is English.

The Respondent has not filed a Response.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Complainant made the following contentions:

A. THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR

The disputed domain name incorporates the Complainant's well-known, distinctive trademark "NOVARTIS" in its entirety, in combination with a term "usa" (which commonly refers to the country United States of America) separated by the symbol "-", which is closely related to the Complainant's business activities. The addition of the gTLD ".com" does not add any distinctiveness to the disputed domain name.

The Complainant thus concludes that the disputed domain name should be considered as confusingly similar to its trademark.

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

The Complainant submits that it has never had any previous relationships with the Respondent, nor has the Complainant ever granted the Respondent any rights to use the "NOVARTIS" trademark in any form.

The Complainant also states that it has not found that the Respondent was commonly known by the disputed domain name or that it had legitimate interest over the disputed domain name. When searching for the term "Novartis-Usa" in the Google

search engine, the returned results all pointed to the Complainant and its business activities.

In view of the Complainant, the Respondent could have easily performed a similar search before registering the disputed domain name and would have quickly learnt that the trademarks are owned by the Complainant and that the Complainant has been using its trademarks in the USA, where the Respondent resides, and many other countries worldwide, especially as the Respondent, "Merit Pharmaceutical", operates its own business in the same field as the Complainant. However, the Respondent still chose to register the disputed domain name as such.

In addition, according to the Registrar Verification, the Respondent is named "Rebecca Jenkins / Merit Pharmaceutical", which is not connected to the Complainant nor to the term "Novartis" in any form.

By the time the Complainant prepared the amended Complaint on 28 September 2021, the disputed domain name resolved to a page with the message "404 Not Found".

The Respondent has not been using the disputed domain name for any bona fide offering of goods or services.

When Internet users, who search for information about the Complainant and/or about the brand "Novartis", see the disputed domain name and the error page, 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.

From the Complainant's perspective, the Respondent deliberately chose to use the well-known, distinctive trademark "NOVARTIS" as the main part of the disputed domain name, very likely with the intention to benefit from the Complainant's worldwide renown and to confuse Internet users as to the source or sponsorship and therefore cannot be considered as a bona fide offering of goods or services.

For the foregoing reasons, the Complainant concludes that the Respondent has no right nor legitimate interest in respect of the disputed domain name.

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

i. THE DISPUTED DOMAIN NAME WAS REGISTERED IN BAD FAITH

The Complainant emphasises the fact that most of the Complainant's trademark registrations predate the registration of the disputed domain name and that 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 the Complainant's well-known, distinctive trademark "NOVARTIS" in its entirety, in combination with a geographic term "usa", which is closely related to the Complainant's business activities, 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.

In addition, the Complainant submits that the disputed domain name should be deemed to be registered in bad faith for the following reasons:

- the Respondent very likely knew about the Complainant and its trademark when it registered the disputed domain name;
- the Complainant's trademark "NOVARTIS" is a distinctive, well-known trademark worldwide and in the USA where the Respondent resides; and
- the Respondent has failed in presenting a credible evidence-backed rationale for registering the disputed domain name.

ii. THE DISPUTED DOMAIN NAME IS BEING USED IN BAD FAITH

Regarding the use of the disputed domain name, the Complainant points out that the disputed domain name resolves to an error page which constitutes passive holding and may be interpreted as use in bad faith.

Additionally, the Complainant tried to reach the Respondent by sending a cease & desist letter on 25 August 2021 by e-mail to the address provided in the WHOIS and also via the Registrar's e-mail. However, until the time the Complainant prepared the amended Complaint, it has not received a response from the Respondent.

In addition, the Complainant contends that the fact the Respondent has been using a privacy shield service to conceal its identity adds up to the finding of bad faith.

Given all the above, the Complainant argues that the Respondent registered and has been using the disputed domain name in bad faith.

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

This is a mandatory administrative proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") and the CAC Supplemental Rules.

Paragraph 15 of the Rules provides that the Panel shall decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

According to Paragraph 4(a) of the Policy, the Complainant must prove each of the following: (i) the domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; (ii) the Respondent has no rights or legitimate interests in respect of the domain name; (iii) the domain name has been registered and is being used in bad faith.

A. Identical or confusingly similar domain name

The Complainant demonstrated that it owns the asserted US trademark registrations for "NOVARTIS", one of which was registered almost 24 years earlier than the disputed domain name. In addition, the Complainant owns a large portfolio of

national and regional trademark registrations for "NOVARTIS". It is well established that a nationally or regionally registered trademark confers on its owner sufficient rights to satisfy the requirement of having trademark rights for the purposes of standing to file a UDRP case. Therefore, the Panel finds that the Complainant has fully established such rights.

It is also well established that the generic top-level suffix .com may be disregarded when considering whether a disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights, as it is a necessary technical requirement of a domain name.

The disputed domain name incorporates the Complainant's trademark "NOVARTIS" in its entirety. The adding of the suffix "-USA" must be considered insufficient to prevent or diminish confusing similarity. This is true especially given that "USA" is widely recognized as the country code for the United States of America and the suffix would almost certainly be perceived as geographical designation, thus lacking any distinctive character (especially given that the Respondent is allegedly based in the USA). This finding is consistent with earlier decisions of the CAC (eg. CAC Case No. 101270 and CAC Case No. 101503).

The Panel, therefore, finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Lack of rights or legitimate interests

The Respondent has not filed a Response and has neither provided any other information that would oppose the Complainant's allegations. Therefore, the Panel holds that the Complainant successfully presented its prima facie case that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

In particular, the Respondent is not in any way connected with the Complainant nor is it authorized to use the Complainant's trademark for its commercial activities. In addition, the Respondent is not commonly known by the disputed domain name pursuant to Paragraph 4(c)(ii) of the Policy. Furthermore, it was demonstrated by evidence submitted by the Complainant that the disputed domain name has not been used for a bona fide offering of goods or services or a legitimate non-commercial or fair use.

The Panel, therefore, finds that the Respondent has no rights or legitimate interest in the disputed domain name.

C. Registration and use of the disputed domain name in bad faith

With respect to the bad faith argument, the Complainant states, in summary, that the disputed domain name is confusingly similar to its well-known trademark, that the Respondent must have had actual knowledge of the Complainant's rights in the trademark, and that the disputed domain name is resolving to an inactive error webpage. In addition, the Complainant points out that the Respondent never replied to a cease & desist letter from the Complainant and also that it had been using a privacy shield service to conceal its identity.

The Panel has already found that the disputed domain name is confusingly similar to the Complainant's trademark "NOVARTIS". The Complainant submitted evidence that the Panel believes sufficiently demonstrates the Respondent must have or at least should have been aware of the existence of the Complainant, its trademark, its domain names and generally its business activities (online as well as offline). The evidence submitted by the Complainant also shows that, at least upon filing the complaint, the disputed domain name was inactive.

It is well established that mere registration of a domain name that is confusingly similar to a trademark by an unaffiliated entity can lead to the presumption of bad faith. Furthermore, typical circumstances demonstrating respondent's bad faith include a situation where the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's trademark as to the source, sponsorship, affiliation, or

endorsement of the respondent's website or location or of a product or service on the respondent's website or location (see Paragraph 4(b)(iv) of the Policy).

Taking into account the above-described facts and evidence submitted by the Complainant, the Panel is satisfied that several signs of bad faith in registering and use of the disputed domain name by the Respondent can be found, in particular: (i) the degree of similarity between the disputed domain name and the Complainant's trademark that is indeed well-known in view of this Panel; (ii) absence of rights or legitimate interests coupled with no response from the Respondent to both the Complainant's cease & desist letter and this Complaint; (iii) lack of use of the disputed domain name; and (iv) absence of any conceivable good faith use.

Therefore, the Panel finds that the disputed domain name has been registered and has been used by the Respondent in bad faith.

In conclusion, the Panel finds that all three elements required by Paragraph 4(a) of the Policy were met and makes the following decision which is consistent with earlier CAC Cases No. 102292 <USA-NOVARTIS.COM> and No. 103559 <NOVARTISUSA.INFO>.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTIS-USA.COM**: Transferred

PANELLISTS

Name	Mgr. Vojtěch Chloupek
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DATE OF PANEL DECISION 2021-10-24

Publish the Decision
