

Decision for dispute CAC-UDRP-104225

Case number	CAC-UDRP-104225
Time of filing	2021-12-08 09:37:02
Domain names	Novartisenterprises.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (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	richard mcnally
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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 is the owner of the following registrations in the United States of America ("United States") of the trademark NOVARTIS (the "NOVARTIS trademark"):

- the United States trademark NOVARTIS with registration No. 2997235, registered on 20 September 2005 for goods in International Class 5; and
- the United States trademark NOVARTIS with registration No.5420583, registered on 13 March 2018 for goods and services in International Classes 9, 10, 41, 42, 44 and 45.

FACTUAL BACKGROUND

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

The Complainant was created in 1996 through the merger of the companies Ciba-Geigy and Sandoz, and is the holding company of the Novartis Group, one of the biggest global pharmaceutical and healthcare groups. The Complainant has a strong

presence in the United States where the Respondent is located, and in 2019, 34 % of the total net sales of the Novartis Group were made there.

The Complainant is the owner of the domain names <novartis.us>, created on 19 April 2002, <novartis.com>, created on 2 April 1996, and <novartispharma.com>, created on 27 October 1999. The Complainant uses these domain names to promote the NOVARTIS trademark and its products and services.

The Respondent registered the disputed domain name on 22 June 2018. The disputed domain name redirects to the website of the company “Imaginique Enterprises” where various products are offered for sale.

The Complainant notes that on 16 November 2021 it sent to the Respondent a cease-and-desist letter in respect of the disputed domain name, but the Respondent did not respond.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant submits that the disputed domain name is confusingly similar to the NOVARTIS trademark, which it incorporates in its entirety combined with the generic term “enterprises”, which is closely related to the Complainant and its business activities.

According to the Complainant, the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant submits that it has never had any relationship with the Respondent and has not granted to the Respondent any rights to use the NOVARTIS trademark in any forms, including in the disputed domain name, and the Respondent is not commonly known by it.

According to the Complainant, the Respondent deliberately chose to use the well-known, distinctive NOVARTIS trademark for the disputed domain name with the intention to attract Internet traffic by benefiting from the Complainant's worldwide renown. Internet users who search for information about the Complainant are likely to be confused by the disputed domain name and believe that it is somehow related to the Complainant.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. It highlights that its well-known NOVARTIS trademark predates the registration of the disputed domain name, and that, considering the renown of the Complainant and of its NOVARTIS trademark and the overall composition of the disputed domain name, its registration was a deliberate and calculated attempt to improperly benefit from the Complainant's rights and reputation.

The Complainant points out that the disputed domain name redirects visitors to the website of an entity that sells various products. The Complainant submits that by such use of the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or location 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.

RESPONDENT:

The Respondent did not submit a Response in this proceeding.

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

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

Pursuant to the Policy, paragraph 4(a), a complainant must prove each of the following to justify the transfer of a domain name:

- (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; and
- (iii) the respondent has registered and is using the domain name in bad faith.

In this case, the Provider has employed the required measures to achieve actual notice of the Complaint to the Respondent, and the Respondent was given a fair opportunity to present its case.

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: “[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name ...”

Identical or confusingly similar

The Complainant has provided evidence and has thus established its rights in the NOVARTIS trademark.

The Panel notes that a common practice has emerged under the Policy to disregard in appropriate circumstances the general Top-Level Domain (“gTLD”) section of domain names for the purposes of the comparison under the Policy, paragraph 4(a)(i). The Panel sees no reason not to follow the same approach here, so it will disregard the “.com” gTLD section of the disputed domain name.

The relevant part of the disputed domain name is therefore the sequence “novartisenterprises”, which consists of the elements “novartis” and “enterprises”. The element “novartis” is identical to the NOVARTIS trademark, while “enterprises” is a dictionary word which has a low effect on the overall impression made by the disputed domain name, in which the “novartis” element dominates. As discussed in section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the “WIPO Overview 3.0”), in cases where the relevant trademark is recognizable within the disputed domain name, the addition of descriptive terms would not prevent a finding of confusing similarity under the first element.

Taking all the above into account, the Panel finds that the disputed domain name is confusingly similar to the NOVARTIS trademark in which the Complainant has rights.

Rights and legitimate interests

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name, because the Respondent was not authorized to use the NOVARTIS trademark and is not commonly known under the disputed domain name. The Complainant also points out that the disputed domain name redirects to a website that offers various products for sale. According to the Complainant, the Respondent targets the NOVARTIS trademark with the intention to attract Internet traffic. Thus, the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Respondent has not submitted a Response and has not provided an explanation of the reasons why it has registered the disputed domain name.

In the Panel’s view, the circumstances of this case do not support a finding that the Respondent has rights and legitimate interests in the disputed domain name. It is confusingly similar to the popular NOVARTIS trademark and incorporates it with the addition of the dictionary word “enterprises” which has no distinctiveness. The NOVARTIS trademark is easily distinguishable and dominates in the disputed domain name, which resolves to a commercial website that offers goods unrelated to the Complainant. In the lack of any arguments or evidence to the contrary, this leads the Panel to the conclusion that it is more likely than not that the Respondent, being aware of the goodwill of the Complainant’s NOVARTIS trademark, has registered the disputed domain name targeting this trademark in an attempt to exploit its goodwill by attracting Internet users who may believe that the disputed domain name and the website to which it redirects are somehow related to the Complainant.

Therefore, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain name.

Bad faith

Paragraph 4(b) of the Policy lists four illustrative alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

“(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the 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 your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.”

The registration of the distinctive NOVARTIS trademark significantly predates the registration date of the disputed domain

name, and it has achieved global reputation, including in the United States, where the Respondent is located. The disputed domain name incorporates it with the addition of the word “enterprises”, which may lead Internet users to believe that the website to which it resolves is related to the Complainant. The Panel is therefore of the view that the Respondent registered the disputed domain name with knowledge of the Complainants' trademark rights and, on balance, with the intention of taking advantage of such rights.

The disputed domain name redirects to a website offering various products for sale. In the absence of an authorization by the Complainant, and in view of the fact that the Respondent has not provided any plausible explanation of its choice of a domain name, the Panel accepts that it is more likely than not that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the associated website, by creating a likelihood of confusion with the Complainant's NOVARTIS trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or of the products offered on it.

This satisfies the Panel that the disputed domain name has been registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTISENTERPRISES.COM**: Transferred

PANELLISTS

Name	Assen Alexiev
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DATE OF PANEL DECISION	2022-01-05
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Publish the Decision