

Decision for dispute CAC-UDRP-104232

Case number	CAC-UDRP-104232
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Time of filing	2021-12-10 11:09:05
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Domain names	Metanovartis.com
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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	Youngseo Oh
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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 well-known trademark NOVARTIS registered as both a word and device mark in several classes worldwide, including the Republic of Korea. The trademark registrations with the Korean Intellectual Property Office (KIPO) include: trademark 'NOVARTIS' (reg. no. 0389597; registered on January 5, 1998); and trademark 'NOVARTIS' (reg. no: 1349878; registered on April 17, 2019).

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. Novartis AG (the "Complainant"), 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 a strong presence in the Republic of Korea where the Respondent is located. The Complainant has several subsidiaries based in the Republic of Korea . In 2019, Novartis Korea has reached a sales volume of 525.7 billion KRW by selling 122 products and

ranked number 3 among the top pharma companies in the Republic of Korea.

The disputed domain name was registered on October 31, 2021.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

i) The Complainant has rights in 'NOVARTIS' mark (reg. no. 0389597, registered on January 5, 1998; reg. no. 1349878, registered on April 17, 2019) through its registrations of the mark with the KIPO. The disputed domain name is confusingly similar to the Complainant's NOVARTIS mark.

ii) The Respondent has no rights or legitimate interests in respect of the disputed domain name: the Respondent does not have any previous relationships with the Complainant, nor has the Complainant ever granted the Respondent with any rights to use the NOVARTIS trademark in any forms, including the disputed domain name; the Respondent is not commonly known by the disputed domain name; the Respondent registered the disputed domain name for cyber-squatting purpose, without legitimate interest and did not intend to use it for any bona fide offering of goods or services; and the disputed domain name resolved to the Registrar's parked page.

iii) The Respondent has registered and is using the disputed domain name in bad faith: the Respondent has registered and used the disputed domain name with actual knowledge of the Complainant's rights in the NOVARTIS mark; the disputed domain name resolved to a parked page, and such a passive holding constitutes bad faith registration and use of the disputed domain name; and the Respondent has also registered other domain names composed in the same pattern, i.e. "meta" + "(well-known brand)," and such pattern of conduct constitutes typical cybersquatting.

RESPONDENT:

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

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

Preliminary Issue: Language of the Proceedings

The Panel notes that the Registration Agreement is written in Korean, thereby making the language of the proceedings in Korean. The Complainant has requested that the proceeding should be conducted in English. The Panel has the discretion under UDRP Rule 11(a) to determine the appropriate language of the proceedings taking the particular circumstances of the administrative proceeding into consideration. See Section 4.5, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition; see also Lovehoney Group Limited v yan zhang, CAC 103917 (CAC August 17, 2021) (finding it appropriate to conduct the proceeding in English under Rule 11, despite Japanese being designated as the required language

in the registration agreement).

The Complainant contends that (i)reverse WHOIS search of the Respondent's email showed that it has registered a number of domain names that are composed by English terms, e.g. metagentlemonster.com, metaleagueoflegends.com, metaphammall.com, metarolls-roycemotorcars.com, which demonstrates that the Respondent understands English; (ii)the disputed domain name is composed by the English term "meta" and the Complainant's name "Novartis", both are correctly spelt further demonstrating that the Respondent understands English; (iii)the Complainant has sent the Respondent a cease-and-desist letter written in English, and the Respondent replied although in Korean, stating that "I have read the material you sent me carefully" and the content of the response reflected that it fully understood the cease-and-desist letter; (iv)the Complainant is a Swiss-based company, and the Respondent is located in the Republic of Korea. The English language, being commonly used internationally, would be considered as neutral for both parties in the present case; and (v)a translation of the Complaint to Korean would entail significant additional costs for the Complainant and delay in the proceedings.

Pursuant to UDRP Rule 11(a), the Panel finds that persuasive argument has been adduced by the Complainant. After considering the circumstance of the present case, in the absence of the Response and no objection to the Complainant's request for the language of proceeding, the Panel decides that the proceeding should be in English.

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

Paragraph 15(a) of the Rules for the UDRP ('the Policy') instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (2) Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

In view of the Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. See *Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (FORUM July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); see also *Talk City, Inc. v. Robertson*, D2000-0009 (WIPO February 29, 2000) ("In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.").

Rights

The Complainant contends that it is the owner of the registered trademark 'NOVARTIS' with the Korean Intellectual Property Office (KIPO) (reg. no. 0389597, registered on January 5, 1998; reg. no. 1349878, registered on April 17, 2019). The Panel notes that a trademark registration with a national trademark agency such as the KIPO is sufficient to establish rights in that mark. As such, the Panel finds that the Complainant has established its rights in the mark 'NOVARTIS.'

The Complainant further contends that the disputed domain name is confusingly similar to its mark 'NOVARTIS' on the grounds that i) the disputed domain name incorporates entirely the Complainant's mark NOVARTIS with generic term "meta"; and ii) the addition of the gTLD ".com" does not add any distinctiveness to the disputed domain name. The Panel agrees with the Complainant and notes that the addition of '.com' gTLD and a descriptive term is generally disregarded in the assessment under paragraph 4(a)(i) of the Policy when comparing a disputed domain name and a trademark. Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark NOVARTIS.

No rights or legitimate interests

Complainant must first make a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy paragraph 4(a)(ii), then the burden shifts to Respondent to show it does have rights or legitimate interests. See *Croatia Airlines d. d. v. Modern Empire Internet Ltd.*, WIPO Case No. D2003-0455 (the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the UDRP). See also *Advanced International Marketing Corporation v. AA-1 Corp*, FA 780200 (FORUM November 2, 2011) (finding that a complainant must offer some evidence to make its prima facie case and satisfy Policy paragraph 4(a)(ii).

The Complainant contends that i) the Respondent does not have any previous relationships with the Complainant, nor has the Complainant ever granted the Respondent with any rights to use the NOVARTIS trademark in any forms, including the disputed domain name; ii) the Respondent is not commonly known by the disputed domain name from the fact that according to the WHOIS, the Respondent is named "Youngseo Oh", which is not connected to the Complainant nor to the term "Novartis" in any form and when entering the term "metanovartis" in the Google search engine, the returned results all pointed to the Complainant and its business activities; iii) considering the fact that the Respondent has also registered other domain names composed by "Meta" + "(well-known brand)", for example metablancpain.com, metabreguet.com, metaroche.com, therefore, it is blatant that the Respondent registered the disputed domain name for cyber-squatting purpose, without legitimate interest and did not intend to use it for any bona fide offering of goods or services; and iv) the disputed domain name resolved to the Registrar's parked page.

The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

Bad faith

Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:

- (i) circumstances indicating that the respondent has registered or 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 the complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has 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 the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 the respondent's website or location or of a product or service on the respondent's website or location.

The Complainant contends that the Complainant's trademark predates the registration of the disputed domain name; and the Respondent very likely knows about the Complainant and its trademark because the Complainant's trademark NOVARTIS is a distinctive and well-known trademark worldwide. While constructive knowledge is insufficient for a finding of bad faith, per Policy paragraph 4(a)(iii), registration of an infringing domain name with actual knowledge of another's trademark rights is sufficient to establish bad faith, and can be shown by the notoriety of the mark and the use Respondent makes of the disputed domain name. See *Orbitz Worldwide, LLC v. Domain Librarian*, FA 1535826 (Forum February 6, 2014) ("The Panel notes that although the UDRP does not recognize 'constructive notice' as sufficient grounds for finding Policy paragraph 4(a)(iii) bad faith, the Panel here finds actual knowledge through the name used for the domain and the use made of it."); see also *AutoZone*

Parts, Inc. v. Ken Belden, FA 1815011 (Forum December 24, 2018) (“Complainant contends that Respondent’s knowledge can be presumed in light of the substantial fame and notoriety of the AUTOZONE mark, as well as the fact that Complainant is the largest retailer in the field. The Panel here finds that Respondent did have actual knowledge of Complainant’s mark, demonstrating bad faith registration and use under Policy paragraph 4(a)(iii).”). The Panel agrees and infers, due to the notoriety of the Complainant’s mark around the world and in the Republic of Korea where the Respondent resides that the Respondent had actual knowledge of the Complainant’s rights in its mark NOVARTIS at the time of registering the disputed domain name, and thus the Panel finds the bad faith registration of the disputed domain name.

Next, the Complainant contends that the disputed domain name resolved to a parked page, which constitutes passive holding which has no other legitimate use and constitutes registration and use of the disputed domain name in bad faith. The Panel agrees that the passive holding of a domain name does not necessarily circumvent a finding that the domain name is being used in bad faith within the requirements of paragraph 4(a)(iii) of the Policy. See Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003 (finding that in considering whether the passive holding of a domain name, following a bad faith registration of it, satisfies the requirements of paragraph 4(a)(iii), the panel must give close attention to all the circumstances of the respondent’s behavior, and a remedy can be obtained under the Policy only if those circumstances show that the respondent’s passive holding amounts to acting in bad faith.). Taking into account the notoriety of the Complainant’s mark and the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the disputed domain name, the Panel concludes that the Respondent’s passive holding of the disputed domain name constitutes bad faith registration and use per paragraph 4(b) (iii) and (iv) under the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **METANOVARTIS.COM**: Transferred

PANELLISTS

Name	Mr. Ho-Hyun Nahm, Esq.
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DATE OF PANEL DECISION	2022-01-08
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Publish the Decision