

Decision for dispute CAC-UDRP-104305

Case number CAC-UDRP-104305

Time of filing 2022-01-28 11:30:04

Domain names Buynovartis.com

Case administrator

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

Complainant

Organization Novartis AG

Complainant representative

Organization BRANDIT GmbH

Respondent

Organization 1111

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 trademark NOVARTIS registered as both a word and device mark in several classes worldwide, including the USA. Most of the Complainant's trademark registrations predate the registration of the disputed domain name on 12 December 2021. For example, the Complainant's trademark registrations in the USA include the following earlier rights. The Trademark: NOVARTIS, Reg. no: 5420583, Reg. date: 13 March 2018 and Trademark: NOVARTIS, Reg. no: 2997235 and Reg. date: 20 Sep 2005 with First use in commerce in 1997. Submitted in evidence is a portfolio list of Novartis trademarks and applications worldwide. 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 also owns 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, e.g. <novartispharma.com> (created on 27 October 1999).

FACTUAL BACKGROUND

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

The Novartis Group is a leading global pharmaceutical and healthcare group. The Complainant's products are manufactured and sold in many regions worldwide but the Complainant has an especially strong presence in the United States where the Respondent is located. The Complainant also has various subsidiaries and associated companies in the US. In 2019, 34% of Novartis Group's total net sales were constituted in the US. The domain name <Buynovartis.com> (hereinafter referred to as the "disputed domain name"), was registered on 12 December 2021 according to the Registrar. According to that Registrar Verification, the Respondent provided WHOIS details as: Organization (English): 1111, Contact (English): ggg hjdddf, Province (English): Arizona. City (English): lu mi na shi, Address (English): lu mi na shi. Country: US, E-mail: jllbbz@163.com, Postal Code: 122346, Country code: 1, Phone number: 1544544777. The Complainant tried to reach the Respondent by a notice sent on 27 December 2021 via the online contact form provided by the Registrar and the notice was also sent to the Registrar's e-mail domainabuse@service.aliyun.com to whom the Complainant has requested forwarding. The Complainant received no response from the Respondent.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

A. THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR

The disputed domain name was registered on 12 December 2021, according to the Registrar Verification and incorporates the Complainant's well-known, distinctive trademark NOVARTIS in combination with the generic term "buy" The addition of the gTLD ".com" does not add anything to the similarity analysis. 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 previous relationship, nor has the Complainant ever granted the Respondent any right to use the NOVARTIS trademark in any form, including the disputed domain name. The Respondent is not commonly known by the disputed domain name nor has it a legitimate interest in it. When one searches for "Buynovartis" in the Google search engine, most of the search results point to 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 trademarks are owned by the Complainant and that the Complainant has been using its trademarks in the US, where the Respondent resides, and many other countries worldwide. However, the Respondent still chose to register the disputed domain name as such.

In addition, according to the Registrar Verification, the Respondent is named "ggg hjdddf" / "1111", which is not related to the Complainant nor to the term NOVARTIS in any way. By the time the Complainant prepared the Complaint on 3 February 2022, the disputed domain name was inactive. 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 inactive website, 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 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.

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

i. THE DISPUTED DOMAIN NAME WAS REGISTERED IN BAD FAITH

It should be highlighted that most of the 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 the Complainant's well-known, distinctive trademark NOVARTIS in combination with the generic term "buy", which is closely related to the Complainant and its 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.

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 the USA where the Respondent resides, the Respondent has failed to come forward and present any or any credible evidence-backed rationale for registering the disputed domain name.

The disputed domain name shall be deemed as registered in bad faith, 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."

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

Taking into account the fact that the Complainant is well-known worldwide, the Complainant considers that by using 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 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. As noted in the previous paragraphs, the disputed domain name was inactive, which constitutes passive holding. In the WIPO Case No. D2000-0003 Telstra Corporation Limited v. Nuclear Marshmallows the Panel established that the registration and passive holding of a domain name which has no other legitimate use and clearly refers to the Complainant's trademark may constitute registration and use in bad faith.

Additionally, the Complainant tried to reach the Respondent by a notice sent on 27 December 2021 via the online contact form provided by the registrar. This notice was also sent to the registrar's e-mail domainabuse@service.aliyun.com to whom the Complainant has requested forwarding. However, until the time the Complainant prepared this Complaint, it has not received any response from the Respondent. The Respondent's lack of response to a cease-and-desist letter infers bad faith use of the Disputed Domain Name, see Arla Foods Amba v. Mlanie Guerin, CAC case No. 101640; Medela AG v. Donna Lucius, CAC case No. 101808.

Furthermore, according to the Registrar Verification, the Respondent has provided WHOIS details as: Organization (English): 1111, Contact (English): ggg hjdddf, Province (English): Arizona, City (English): luo mi na shi, Address (English): luo mi na shi, Country: US, E-mail: jllbbz@163.com, Postal Code: 122346, Country code: 1, Phone number: 1544544777. Obviously, the Respondent has deliberately provided false WHOIS, which adds up to the finding of bad faith. 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'."

In summary, NOVARTIS is a well-known, distinctive trademark worldwide. The Complainant's trademarks registration predates the registration of the disputed domain name. The Respondent has no rights in the mark NOVARTIS, bears no relationship to 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. The disputed domain name has been inactive. The Respondent failed in responding to communication sent by the Complainant. The Respondent has deliberately provided false WHOIS. Consequently, the Respondent should be considered to have registered the disputed domain name confusingly similar to the Complainant's well-known, distinctive trademark NOVARTIS. The Complainant has not found that the Respondent is of 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

There is no question about the Complainant's rights. As well as an international portfolio of registered rights, it is well established that it is a well-known mark and a mark with a reputation. The disputed domain name includes that well-known name and mark plus the generic word "buy." That extra element does not impact the similarity analysis. The disputed domain name is similar to a name and mark in which the Complainant has rights.

The next issue is Legitimate Rights and Interests. Where, as here, the Respondent's name and details as shown in the WHOIS data do not match the disputed domain name, then it cannot be considered as known by the disputed domain name. Indeed, in this case it appears the Respondent has deliberately provided false WHOIS data, a factor relevant to bad faith. There are no other obvious rights and the Respondent has not come forward to assert any. If the Respondent had some

other good reason for selecting the name, we would have expected it to come forward with it. Nor did they answer the cease-and-desist letter, also relevant to bad faith.

There is use by parking, which is not bad faith per se but can be, subject to a fact sensitive analysis that depends on the context and overall circumstances. It is in fact most relevant to eliminate any legitimate uses such as for example a nominative use or use for resales. The domain name looks official as it is a .com. The internet user in a hurry might well think it is an official site. This case falls squarely within the rule in *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003, namely where there is a famous mark, there is no fair or legitimate use and the respondent does not come forward to explain its selection, it will often be appropriate to infer knowledge and also bad faith.

The Panel orders the transfer of the disputed domain name to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BUYNOVARTIS.COM**: Transferred

PANELLISTS

Name	Victoria McEvedy
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DATE OF PANEL DECISION **2022-03-09**

Publish the Decision
