Decision for dispute CAC-UDRP-100895

Case number	CAC-UDRP-100895
Time of filing	2014-12-03 11:00:13
Domain names	novonordiskmail1.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	Novo Nordisk A/S

Complainant representative

Organization	Wallberg IP Advice

Respondent

Organization	SOLAR ENERGY HOST

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 various trademark registrations for NOVO NORDISK.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT

The Complainant is a global healthcare company with almost 90 years of innovation and leadership in diabetes care. The Complainant has also leading positions within haemophilia care, growth hormone therapy and hormone replacement therapy.

Headquartered in Denmark, the Complainant employs approximately 40.700 employees in 75 countries, and markets its products in more than 180 countries. The annual turnover was 11.2 billion Euro in 2013.

The Complainant’s B shares are listed on NASDAQ OMX Copenhagen. Its ADRs are listed on the New York Stock Exchange.

The Complainant holds trademark registrations worldwide for NOVO NORDISK, including the Canadian trademark Nos. TMA 449961 (word mark), registered on November 17, 1995, and TMA 688956 (figurative mark), registered on June 4, 2007.

The Complainant operates its main web site at “www.novonordisk.com”. The Complainant’s subsidiary Novo Nordisk, Inc. of Plainsboro, United States, is the owner of the domain name <novonordiskmail.com>, registered on October 6, 2010.

The disputed domain name <novonordiskmail1.com> was registered on October 19, 2014.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS

COMPLAINANT

The Complainant contends that the disputed domain name is identical to a trademark or service mark in which the Complainant has rights, as it contains the trademark NOVO NORDISK in full with the addition of the generic term “mail” and the number “1”.

The Complainant claims that it is a well-established practice under the UDRP-proceedings to consider a domain name, which contains a well-known and invented mark in combination with descriptive words or numbers that combination, to be confusingly similar to said mark.

Also, the Complainant asserts that it is an established and recognized principle under the UDRP that the presence of the top level domain designation - here .com - is irrelevant in the comparison of a domain name to a trademark.

The Complainant states that the Respondent has no rights or legitimate interests in respect of the disputed domain name since:

- The Respondent has not received any license or consent, express or implied, to use the Complainant´s trademark NOVO NORDISK in a domain name or in any other manner from the Complainant, nor has the Complainant acquiesced in any way to such use or application by the Respondent. At no time did the Respondent have authorization from the Complainant to register the disputed domain name;

- The Respondent has no legitimate right in the contested domain name. The Respondent did not use a name corresponding to the disputed domain name as a trademark, company name, business or trade name prior to the registration of the disputed domain name, nor is the Respondent otherwise commonly known in reference to the name. On the contrary, the Respondent undertakes its business under the name Solar Energy Host;

- The Respondent has no legitimate interest in the disputed domain name, as the Respondent´s area of business is described as follows: “Affordable Green Web Hosting powered by Solar energy cells provides 100% green energy , Solar Energy Host is specialized in Joomla, Drupal, Wordpress Hosting Solar energy Host is 100% Carbon Neutral company”;

- The Respondent does not make a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Complainant asserts that the disputed domain name was registered and is being used in bad faith. It claims that, in light of the distinctive nature and worldwide use of the Complainant´s trademark NOVO NORDISK, it is inconceivable that the Respondent registered the disputed domain name without knowledge as to the existence of the Complainant’s trademark at the time the Respondent registered the domain name.

As to the use of the disputed domain name, the Complainant states that the apparent lack of active use (passive holding) does not as such prevent a finding of bad faith use under the UDRP and that, in this case, there is an evident risk that the

disputed domain name is or will be used in a phishing scam since it is almost identical to the domain name “novonordiskmail.com” which is registered by the Complainant´s subsidiary Novo Nordisk, Inc. for outbound marketing emails. The Complainant concludes that the registration of the disputed domain name is likely to seriously disrupt the business of the Complainant.

RESPONDENT

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that 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

1. The disputed domain name includes the registered trademark NOVO NORDISK of the Complainant, with the addition of the word “mail” and the number “1”. In line with a number of prior decisions rendered under the UDRP, the Panel finds that the addition of a suffix constituted of a generic term and of a number to the Complainant’s trademark is not sufficient to exclude the confusing similarity.

2. The Complainant has stated that the Respondent is not affiliated with or authorized by the Complainant in any way. There is no evidence of the fact that the Respondent might have been commonly known by the disputed domain name or by a name corresponding to the disputed domain name. According to the evidence on records, the Respondent has passively held the disputed domain name and has not submitted any evidence showing that it made use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, or that it has made a legitimate non-commercial or fair use of the disputed domain name. In view of the above, the Panel finds that the Complainant has made a prima facie case that the Respondent has no rights or legitimate interest in the disputed domain name.

3. As to bad faith at the time of registration, in light of the prior registration and use of the Complainant’s trademark NOVO NORDISK in connection with the products and services provided by the Complainant, including in Canada, where the Respondent is based, and considering that the disputed domain name differs from another domain name used by a Complainant’s subsidiary, <novonordiskmail.com>, only for the addition of the number “1”, the Panel finds that the Respondent was likely to be aware of the Complainant’s trademark when registering the disputed domain name and that the registration of the disputed domain name cannot be ascribed to a mere coincidence. In any case, given the reputation of the Complainant’s trademark as far as bad faith is concerned the Respondent should have been aware of the Complainant’s rights as it was obliged to determine whether its domain name registration infringes or violates someone else's rights under paragraph 2 of the Policy.

Furthermore, the disputed domain name is not used in connection with an active web site, i.e. is passively held. As established in a number of prior cases, the concept of “bad faith use” in paragraph 4(b) of the Policy includes not only positive action but also passive holding; see the landmark case Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003. Therefore, the Panel concludes that the Respondent has registered and used 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. **NOVONORDISKMAIL1.COM**: Transferred

PANELLISTS

Name	**Luca Barbero**

DATE OF PANEL DECISION 2015-01-16

Publish the Decision