

Decision for dispute CAC-UDRP-104338

Case number CAC-UDRP-104338

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Domain names NovartisPharma.online

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization Novartis AG

Complainant representative

Organization BRANDIT GmbH

Respondent

Name YXP Li

OTHER LEGAL PROCEEDINGS

The Panel is unaware of any other pending or decided legal proceedings in respect of the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant relies upon the following registered trade marks:

- International trade mark registration no. 666218, dated 31 October 1996, for the word mark NOVARTIS, in classes 41 and 42 of the Nice Classification; and
- International trade mark registration no. 663765, dated 1 July 1996, for the word mark NOVARTIS, in classes 01; 02; 03; 04; 05; 07; 08; 09; 10; 14; 16; 17; 20; 22; 28; 29; 30; 31; 32; 40; and 42 of the Nice Classification.

(hereinafter, collectively or individually “the Complainant’s trade mark”; “the Complainant’s trade mark NOVARTIS”; or “the trade mark NOVARTIS”).

The Complainant has provided a list of trade mark applications and registrations for NOVARTIS worldwide, as well as evidence of its ownership of domain names composed of the trade mark NOVARTIS. Of particular note, <novartis.com> (registered on 2 April 1996); <novartis.com.cn> (registered on 20 August 1999); and <novartispharma.com> (registered on 27 October 1999).

The Complainant's contentions can be summarised as follows:

I. The disputed domain name is confusingly similar to a trade mark in which the Complainant has rights

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

The Complainant's products are manufactured and sold in many regions worldwide including China, the Respondent's location, and where the Complainant has a strong presence.

The Complainant is the owner of the well-known trade mark NOVARTIS, which has been registered as both a word and device mark in several classes worldwide, including in China.

The disputed domain name <novartispharma.online> was registered on 28 November 2019, and it incorporates the Complainant's well-known and distinctive trade mark NOVARTIS in its entirety. The additional term "pharma" is closely related to the Complainant and its business activities, and the generic Top-Level Domain (gTLD) <.online> does not add any distinctiveness to the disputed domain name.

The Complainant therefore claims that the disputed domain name is confusingly similar to the trade mark NOVARTIS.

II. The Respondent has no rights or legitimate interests in respect of the disputed domain name

The Complainant states that the Respondent is not related in any way with the Complainant, nor has it carried out any activity for, or have any business with, the Respondent.

In addition, the Respondent is not known by the disputed domain name; the Respondent is not making a bona fide offering of goods or services by means of the disputed domain name, nor is the Respondent using the disputed domain name for legitimate non-commercial or fair use.

The Complainant informs that it has prevailed in a recent URS dispute against the Respondent, which resulted in the disputed domain name being suspended ("the URS dispute"). The Complainant alludes to the URS dispute to further evidence the Respondent's lack of rights or legitimate interests in connection with the disputed domain name.

In view of the above, the Complainant concludes that the Respondent has no rights or legitimate interests in the dispute domain name.

III. The Respondent registered and is using the disputed domain name in bad faith

Registration in bad faith

The Complainant claims that most of its trade mark registrations predate the registration of the disputed domain name, and that the Respondent has never been authorised by the Complainant to register the disputed domain name. Given the renown of the Complainant and its trade mark NOVARTIS, and the overall composition of the disputed domain name, i.e. using the term "Novartis" in combination with the term "pharma" which is closely related to the Complainant and its business activities, it follows that the use of the well-known trade mark NOVARTIS in the disputed domain name is a deliberate and calculated attempt to improperly benefit from the Complainant's rights and reputation.

Furthermore, the Complainant articulates the following additional factual statements:

- The Respondent was very likely aware of the Complainant and its trade mark NOVARTIS;

- The Complainant's trade mark NOVARTIS is a distinctive, well-known trade mark worldwide, and in China, where the Respondent resides;
- The Respondent has failed to present credible evidence-backed rationale for registering the disputed domain name; and
- The disputed domain name shall be deemed as registered in bad faith, which is supported by WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0"), paragraph 3.1.1 and paragraph 3.1.4.

Use in bad faith

The Complainant states that the panel in the previous URS dispute has determined that the Respondent lacked rights or legitimate interests in respect of the disputed domain name, and found that the Respondent had registered and was using the disputed domain name in bad faith.

The Complainant further states that, before the suspension of the disputed domain name, as a result of the determination in the URS dispute, the disputed domain name did not resolve to any active website, which constitutes passive holding/non-use.

Lastly, the Complainant alludes to paragraph 4(b)(iv) of the Policy to reinforce its bad faith claim.

The Complainant therefore concludes that the Respondent has registered and is using the disputed domain name in bad faith.

In summary, the Complainant advances the following under these UDRP proceedings grounds:

- NOVARTIS is a well-known, distinctive trade mark worldwide;
- The Complainant's trade mark registration predates the registration of the disputed domain name;
- The Respondent has no rights in the trade mark NOVARTIS, bears no relationship to the Complainant, and is not commonly known by the disputed domain name - accordingly, it has no legitimate interests in the disputed domain name;
- It is highly unlikely that the Respondent was not aware of the Complainant's prior rights in the trade mark NOVARTIS at the time of registering the disputed domain name, given the Complainant's worldwide renown;
- The panel in the previous URS dispute had already asserted the Respondent's lack of legitimate interest and bad faith, such that the disputed domain name was suspended;
- The Respondent has been passively holding the disputed domain name; and
- The Respondent has been using a privacy shield to conceal its identity.

PARTIES CONTENTIONS

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 trade 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

A. General

Pursuant to Rule 15 of the UDRP Rules, the Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the UDRP Policy, the UDRP Rules, and any rules and principles of law that the Panel deems applicable.

Paragraph 4(a) of the UDRP Policy provides the following threshold for the Complainant to meet in order to divest the Respondent of the disputed domain name:

- i. The disputed 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 disputed domain name; and
- iii. The disputed domain name has been registered and is being used in bad faith.

It is therefore incumbent on the Complainant the onus of meeting the above threshold. The evidentiary standard under the UDRP proceedings is the balance of probabilities and, on that basis, the Panel will now proceed to determine each of the three Policy elements in turn.

B. Identical or Confusingly Similar

The UDRP test under the first element provides for a juxtaposing approach, according to which the textual components of the disputed domain name and the Complainant's trade mark are to be compared side by side.

In order to succeed under the first element of the Policy, the Complainant must provide evidence that it has rights in a trade mark or service mark, following which the Panel shall assess whether or not the disputed domain name is identical or confusingly similar to the Complainant's trade mark.

The Panel is satisfied that the Complainant owns trade mark rights in "NOVARTIS" since 1996.

The disputed domain name is <novartispharma.online>, and the Complainant's trade mark is NOVARTIS.

The Panel notes that the disputed domain name wholly incorporates the Complainant's trade mark NOVARTIS. The adjacent term "pharma" in the disputed domain name string increases the confusion with the Complainant's trade mark given that the word "pharma" evokes the Complainant's core business.

Furthermore, the Panel notes that TLD suffixes are typically disregarded in the assessment of this Policy ground, the reason being that the TLD is part of the anatomy of a domain name (see WIPO Jurisprudential Overview 3.0, paragraph 1.11).

Notwithstanding the above, there are instances in which the TLD suffixes may operate to enhance the confusion, such that panels should be wary of this eventuality while determining this Policy ground.

For example, in CAC Case No. 103774, BOURSORAMA SA v Benjamin Kors (domain names <espace-boursorama.life> and <espace-boursorama.live>, the panel determined that the suffixes <.life> and <.live> could resonate with the complainant's core businesses, and might cause Internet users to assume that the domain names were somehow associated with the complainant's customer services and offering of its products.

In the present matter, the Panel is of the view that the suffix <.online> effectively contributes to cause Internet users to infer that there is a connection between the disputed domain name and the Complainant's trade mark NOVARTIS.

The Panel therefore finds that the Complainant has met the requirement under paragraph 4(a)(i) of the UDRP Policy.

C. Rights or Legitimate Interests

The Respondent has not participated in these UDRP proceedings. The Panel is however empowered to draw adverse inferences from the Respondent's disinclination to participate (UDRP Rule 14 (b)).

The Panel notes that the Complainant denies any affiliation and/or association with, or authorisation for, the Respondent of any nature. Moreover, the Complainant further argues that the Respondent is not known by the disputed domain name; and that the Respondent is not making a legitimate non-commercial or fair use of the disputed domain name.

The Panel further notes that the Respondent and the disputed domain name were subject to a URS procedure, which resulted in the Complainant prevailing and the disputed domain name being suspended. The Panel notes that the determination of the URS dispute has no binding effect and, therefore, no precedential value. Nevertheless, the Panel recognises that the finding in the URS dispute has a material impact on the assessment of the Respondent's lack of rights or legitimate interests in the disputed domain name.

The Complainant has provided robust evidence to support its contentions, whereas the Respondent did not deny or contradict any of the Complainant's assertions.

In addition, in the Panel's view, the choice of a domain name which incorporates a complainant's trade mark wholly (as in this case) or virtually wholly, and is unaccompanied or unsupported by any credible explanation as to the reason for this coincidence, could further evidence a lack of rights or legitimate interests.

The Panel has perused the available record and considers that substantial evidence sways in favour of the Complainant in this case.

The Panel therefore finds that the Complainant has succeeded under paragraph 4(a)(ii) of the UDRP Policy.

D. Registered and Used in Bad Faith

In order to meet the third requirement under the Policy, the Complainant must provide evidence that the disputed domain name was registered and is being used in bad faith.

The Policy enumerates non-exhaustive circumstances which would evidence bad faith registration and use of a domain name, as follows:

i. circumstances indicating that the respondent has registered or has 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. 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 you have 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 your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

D.1 Registration in bad faith

The following elements are compelling indicia to this Panel that the disputed domain name was registered in bad faith:

- The Complainant has been in operation since 1996, with a major presence in China, where the Respondent appears to be based;
- The disputed domain name is virtually identical to the Complainant's trade mark NOVARTIS differing only by the adjacent term "pharma", which has the effect of enhancing the association with the Complainant (as discussed under section B above);
- The Complainant operates its activities through various domain names which bear the NOVARTIS trade mark. For instance, the domain name <novartis.com>, which was registered in 1996 and, most notably for the present matter, the domain name <novartis.com.cn>, which was registered in 1999;
- The disputed domain name <novartispharma.online> was registered in 2019, i.e. 20 years after the registration of the Complainant's domain name <novartis.com.cn>;
- The lack of any credible evidence-backed rationale for the Respondent's choice of the disputed domain name;
- UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trade mark can by itself create a presumption of bad faith (paragraph 3.1.4 of the WIPO Jurisprudential Overview 3.0), and the Panel accepts that the Complainant's trade mark is widely known; and
- The Respondent's lack of participation in the course of these UDRP proceedings.

D.2 Use in bad faith

The Complainant alleges that the Respondent has engaged in the conduct described in paragraph 4(b)(iv) of the UDRP Policy, which provides as follows:

"(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location".

As further evidence of the Respondent's bad faith, the Complainant alludes to the outcome of the URS dispute (the particulars of which are discussed under the Factual background and section C above), and the fact that disputed domain name has been held passively by the Respondent.

The Panel considers that, despite the lack of binding and precedential value, the findings in the URS dispute are nonetheless influential and material to the outcome of these UDRP proceedings.

The Panel further refers to paragraph 3.3 of the WIPO Jurisprudential Overview 3.0 to determine whether or not there has been bad faith use of the disputed domain name. UDRP panels have found that the non-use of a domain name may support a finding of bad faith under certain circumstances. Factors that have supported such finding include, but are not limited to (i) the degree of distinctiveness or reputation of the complainant's trade mark; (ii) the respondent's default; (iii) the respondent's concealing of its identity; and (iv) the implausibility of any good faith use to which the domain name may be put.

The Panel considers that all four factors listed above are relevant and present in these UDRP proceedings.

The Panel therefore finds that the Complainant has succeeded under paragraph 4(a)(iii) of the UDRP Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTISPHARMA.ONLINE**: Transferred

PANELLISTS

Name	Dr Gustavo Moser
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DATE OF PANEL DECISION 2022-03-08

Publish the Decision