

Decision for dispute CAC-UDRP-104348

Case number CAC-UDRP-104348

Time of filing 2022-02-10 09:26:16

Domain names Shopnovartis.com

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization Novartis AG

Complainant representative

Organization BRANDIT GmbH

Respondent

Organization MNA Strategies & Services

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

Novartis AG (the Complainant) is a global pharmaceutical and healthcare company based in Switzerland that provides solutions to address the evolving needs of patients worldwide by developing and delivering innovative medical treatments and drugs. Novartis AG was created in 1996 through a merger of two other companies Ciba-Geigy and Sandoz. The Complainant has a strong presence in the USA where the Respondent is located.

The Complainant is the owner of registered trademarks for "NOVARTIS" as a word and figure mark in several classes in numerous countries all over the world, including the USA. The vast majority of the Complainant's trademark registrations significantly predate the registration of the disputed domain name.

The Complainant 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). The Complainant uses these domain names to promote the NOVARTIS mark with related products and services.

The Complainant enjoys a strong presence online also via its official social media platforms and official website dedicated to the USA: <https://www.novartis.us/>.

The disputed domain name <shopnovartis.com> was registered on 23 December 2021.

FACTUAL BACKGROUND

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

PARTIES' CONTENTIONS:

COMPLAINANT:

- The disputed domain name is identical or confusingly similar to the protected mark

According to the Complainant, the disputed domain name <shopnovartis.com> incorporates entirely the Complainant's well-known, distinctive trademark NOVARTIS with the term "shop", which is closely related to the Complainant and its business activities. The addition of the gTLD ".com" does not add any distinctiveness to the disputed domain name. See as an example the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential 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 Complainant argues that the same reasoning should apply in the current case and the disputed domain name should be considered as confusingly similar to the trademark NOVARTIS.

- Respondent does not have any rights or legitimate interest in the disputed domain name

The Complainant states that it has never granted the Respondent any right to use the NOVARTIS trademark within the disputed domain name, nor is the Respondent affiliated to the Complainant in any form.

The Complainant has not found that the Respondent is commonly known by the disputed domain name or that it has legitimate interest over the disputed domain name or the major part of it. When searched for "shopnovartis" in the Google search engine, the returned results point to the Complainant and its business activities.

According to the Complainant, 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 USA, where the Respondent resides, and in many other countries worldwide. However, the Respondent still chose to register the disputed domain name as such.

From the Complainant's perspective, the Respondent deliberately chose to use the term "shop" combined with its well-known, distinctive trademark NOVARTIS clearly with the intention to collect commercial gain by benefiting from the Complainant's worldwide renown. The Respondent, therefore, has not been using the disputed domain name for any bona fide offering of goods or services.

By the time the Complainant prepared this complaint on 8 February 2022, the disputed domain name resolved to a pay-per-click page. The Respondent has not been using the disputed domain name for any bona fide offering of goods or services.

Therefore, the Complainant contends that the Respondent has no right nor legitimate interest in respect of the disputed domain name.

- The disputed domain name has been registered and is being used in bad faith

According to the Complainant, the Respondent has registered the disputed domain name and is using it in bad faith. The Complainant states that the registration of the Complainant's well-known and distinctive trademarks predates the registration of the disputed domain name. The Respondent has never been authorized by the Complainant to register the disputed domain name.

The Complainant argues that it is inconceivable that the combination of the well-known, distinctive trademark NOVARTIS and the term "shop" in the disputed domain name is not a deliberate and calculated attempt to improperly benefit from the Complainant's rights.

The Respondent has been using the disputed domain name to resolve to a pay-per-click page. This conduct constitutes bad faith as it has been confirmed by previous panels.

Considering the fact that i) the Respondent very likely knew about the Complainant and its trademark; ii) the Complainant's trademark NOVARTIS is a well-known, distinctive trademark worldwide; and iii) the Respondent has failed in presenting a credible evidence-backed rationale for registering the disputed domain name, the disputed domain name shall be according to the Complainant deemed as registered in bad faith, which is supported by WIPO Overview 3.0, para. 3.1.1. and para. 3.1.4.

Finally, the Complainant submits that it has tried to reach the Respondent by a cease-and-desist letter sent on 10 January 2022 and without receiving a reply from the Respondent, which also infers bad faith use of the disputed domain name.

PARTIES CONTENTIONS

RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Respondent sent a reply to an automatic email generated by the online platform via address noreply@adr.eu stating: "Go fuck yourself. How about that as a response?! Pass that response on to the complainants."

The CAC has not acknowledged such email as an administratively compliant response.

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

The UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (UDRP) of the Internet Corporation for Assigned Names and Numbers (ICANN) (the "Policy") provides that complainant must prove each of the following to obtain transfer or

cancellation of the domain name:

1. that respondent's domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights; and
2. that 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.

1) The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights

The Panel is satisfied that the Complainant is the owner of International trademark registrations for NOVARTIS that predate the registration of the disputed domain name.

The disputed domain name is comprised of the Complainant's well-known trademark NOVARTIS with the term "shop". Essentially, the Respondent has appropriated the trademark NOVARTIS by adding the term "shop" to presumably lead consumers to believe that it is affiliated with the Complainant. Previous UDRP panels have found that the fact that a domain name wholly incorporates a complainant's registered mark is sufficient to establish identity or confusing similarity for the purposes of the Policy (see, e.g., *Oki Data Americas Inc. v ASD, Inc.*, WIPO Case No. D2001-0903).

Additionally, the disputed domain name not only fully incorporates the NOVARTIS trademark but also includes a purely generic top-level domain ("gTLD") "com". Previous UDRP panels have also held that the gTLD ".com" is not to be taken into account when assessing whether a domain name is identical or confusingly similar to a trademark. See e.g., *Wiluna Holdings, LLC v. Edna Sherman*, FA 1652781 (Forum 22 January 2016).

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark NOVARTIS.

2) The Respondent lacks rights or legitimate interests in the disputed domain name

Under the Policy, a 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 burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP (see WIPO Overview 2.0, paragraph 2.1).

The Panel finds that the Respondent does not have a legal right to use the term "NOVARTIS" as part of the disputed domain name. The Respondent is not in any way affiliated with the Complainant nor is it authorized to register the disputed domain name. The Panel agrees with the Complainant that the Respondent is not commonly known by the disputed domain name or that it has legitimate interest over the disputed domain name. When entering the terms "Novartis" and "shop" in the Google search engine, the returned results point to the Complainant and its business activities.

The Panel finds that the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interest in the disputed domain name. The Respondent failed to file an administratively compliant Response in which it could have provided evidence in support of its rights or legitimate interests. The Respondent is not commonly known by the disputed domain name and has not been authorised by the Complainant to use the term "NOVARTIS". Therefore, all these circumstances are sufficient to establish a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name.

The Panel thus takes the view that the Respondent lacks rights or legitimate interests in the disputed domain name.

3) The disputed domain name has been registered and is being used in bad faith

The Panel agrees with the Complainant that its trademark NOVARTIS is distinctive and well-known globally. The Complainant's well-known trademark NOVARTIS predates the registration of the disputed domain name. The Panel finds that there appears no reason why the Respondent would register the Complainant's trademark as part of the disputed domain name, other than to create the impression that it is connected to the Complainant's business. Given the distinctiveness of the Complainant's trademark worldwide and reputation, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark.

The fact that the Respondent has registered the disputed domain name that is confusingly similar to them indicates and in the absence of any evidence contrary (or any administratively compliant response at all) being put forward by the Respondent, that the Respondent, according to this Panel, had knowledge of the Complainant's trademark and that it had such knowledge prior to the registration and use of the disputed domain name.

Further, the disputed domain name resolves to a pay-per-click page. This further suggests that the Respondent's sole intention in registering the disputed domain name was to take unfair advantage of the Complainant's NOVARTIS mark and reputation, and suggests registration and use in bad faith

For all reasons stated above, the Panel is satisfied that the Complainant has proven the third element of the Policy that is that the Respondent's registration and use of 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. SHOPNOVARTIS.COM: Transferred

PANELLISTS

Name	Mgr. Barbora Donathová, LL.M.
------	-------------------------------

DATE OF PANEL DECISION 2022-03-15

Publish the Decision
