

Decision for dispute CAC-UDRP-104564

Case number	CAC-UDRP-104564
Time of filing	2022-05-10 09:30:54
Domain names	novartisbenefit.com, novartisbenifits.com

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	Hua De Wang
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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 names.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the trademark NOVARTIS in different jurisdictions, including but not limited to the following registrations:

Trademark: NOVARTIS
Reg. No: IR666218 (International Registration)
Class: 41 and 42
Date of Registration: 31.10.1996 (including China)

Trademark: NOVARTIS
Reg. No: IR663765 (International Registration)
Class: 01, 02, 03, 04, 05, 07, 08, 09, 10, 14, 16, 17, 20, 22, 28, 29, 30, 31, 32, 40 and 42
Date of Registration: 01.07.1996 (including China)

The Complainant owns a number of domain names composed of either its trademark NOVARTIS alone, including

<novartis.com.cn> (created on 20 Aug 1999) 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.

FACTUAL BACKGROUND

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

The Complainant 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. The Complainant, with headquarter in Switzerland, 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 including China. The Complainant has a strong presence in China where the Respondent is located. The below link connects customers to the official local sales and service locator and to the official websites of the Complainant:

- Global Website for NOVARTIS: <https://www.novartis.com/>
- Local Website for NOVARTIS in China: <https://www.novartis.com.cn/>

The disputed domain names were both registered on 25 April 2022.

The Respondent has not submitted an official response within the required period of time.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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).

The Complainant asserts rights in the NOVARTIS mark based upon the international registrations. International Registration of a mark is a valid showing of rights in a mark. See *Avast Software s. r. o. v Milen Radumilo*, 102384, (CAC 2019-03-12). The Panel finds that the Complainant has rights in the NOVARTIS mark under paragraph 4(a)(i) of the Policy.

The Complainant argues the disputed domain names incorporate the whole of the Complainant's trademark NOVARTIS and the generic term "benefit" (or a typo of the term "benefit" – "benifits"). The addition of the generic term "benefit" or "benifits" as well as the addition of a gTLD fail to sufficiently distinguish a disputed domain name from a mark per Policy paragraph 4(a)(i). See *TOD'S S.p.A. vs.shikai qiang*, 104283, (CAC 2022-02-19). The Panel accepts that the disputed domain names are confusingly similar to Complainant's NOVARTIS trademark.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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 names (within the meaning of paragraph 4(a)(ii) of the Policy). More specifically, the Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain names, and the burden of prove then shifts to the Respondent to show it does have rights or legitimate interests. See *PepsiCo, Inc. v Smith power production*, 102378, (CAC 2019-03-08) ("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.").

The Complainant has never granted the Respondent any right to use the NOVARTIS trademark within the disputed domain names, nor is the Respondent affiliated to the Complainant in any form. Upon information and belief, the Complainant has not found that the Respondent is commonly known by the disputed domain names or that it has legitimate interest over the disputed domain names or the major part of them. When entering the term “novartisbenefit” or “novartisbenefits” in the search engines Google and Baidu, the returned results pointed to the Complainant and its business activities and not to the Respondent.

In addition, the Complainant further contends that the disputed domain names resolved to Pay-Per-Click (PPC) pages. The Respondent has not been using the disputed domain names for any bona fide offering of goods or services. The Respondent deliberately chose to use the well-known, distinctive trademark NOVARTIS as the main part of the disputed domain names, very likely with the intention to benefit from the Complainant’s worldwide renown and to confuse Internet users as to the source or sponsorship and therefore cannot be considered as a bona fide offering of goods or services.

The Panel finds that the Complainant has established a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain names. The burden of proof has been shifted to the Respondent to prove that it has right or legitimate interests to the disputed domain name. However, the Respondent has not submitted any response to rebut the assertion within the required period of time.

For the foregoing reasons, the Panel finds the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

Registration of the disputed domain names in bad faith

The Complainant claims that most of the Complainant’s trademark registrations predate the registration of the disputed domain names and the Respondent has never been authorized by the Complainant to register the disputed domain names. The Respondent very likely knew the Complainant and its trademark when it registered the disputed domain names considering NOVARTIS is a distinctive, well-known trademark worldwide and in China where the Respondent resides. Furthermore, the Respondent has failed in presenting a credible evidence-backed rationale for registering the disputed domain names.

Pursuant to paragraph 3.1.4 of the WIPO Overview 3.0 which states that "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." Considering the distinctiveness of the NOVARTIS trademark and its reputation, the Panel agrees that the disputed domain names were registered in bad faith.

Use of the disputed domain names in bad faith

The Complainant claims that the disputed domain names resolved to pay-per-click websites. In terms of paragraph 4(b)(iv) of the Policy, this conduct constitutes bad faith as it has been confirmed in previous cases. In addition, as the Respondent has registered 2 domain names with very similar composition in the second level portion of the disputed domain names containing the Complainant’s well-known, distinctive trademark NOVARTIS in combination with the term / typo of the term “benefit”, such registration constitutes a pattern of conduct that prevents a trademark holder from reflecting its mark in a domain name. The Complainant further contends that the Respondent has registered numerous domain names composed in a similar fashion, i.e. a trademark plus a term, with or without typo, further evidenced its bad faith. Pursuant to paragraph 3.5 of the WIPO Overview 3.0 which provides that "Particularly with respect to “automatically” generated pay-per-click links, panels have held that a respondent cannot disclaim responsibility for content appearing on the website associated with its domain name (nor would such links ipso facto vest the respondent with rights or legitimate interests)." The Panel also agrees that the Respondent is engaging in a pattern of cybersquatting/typosquatting by holding dozens of domain names that infringe third party trademark rights, which is evidence of bad faith registration and use of the disputed domain names, see Novartis AG vs. hui zhang,

101931 (CAC 2018-05-21).

For the foregoing reasons, the Panel finds the Complainant has satisfied 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.

PRELIMINARY FINDINGS - LANGUAGE OF PROCEEDING:

The Panel notes that the language of the Registration Agreement is Chinese as confirmed by the Registrar, Cloud Yuqu LLC. The official Complaint was submitted in English and no response has been received within the required period. Pursuant to paragraph 11 of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

The Complainant requests to use English as the language of proceeding, with the arguments that the websites resolved by the disputed domain names are in English language, the Respondent has registered numerous domain names composed by English terms and it is unfair for the Complainant to spend a significant additional cost to translate the Complaint which will also delay the proceeding. The Respondent has not declined to use English as the language of proceeding of the current case.

The Panel is bilingual and is well equipped to deal with the proceeding in both Chinese and English. Having considered the circumstances, Panel believes that it would be fair to both parties to use English as the language of proceeding and it can also uphold the principle of UDRP being a swift dispute resolution process. On this basis, the Panel determines that the language requirement has been satisfied through the English language Complaint and proper bilingual notices served by CAC, and decides that the language of proceeding to be English.

PRINCIPAL REASONS FOR THE DECISION

Having established all three elements required under the UDRP Policy, the Panel concludes that relief shall be granted.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTISBENEFIT.COM**: Transferred
2. **NOVARTISBENIFITS.COM**: Transferred

PANELLISTS

Name	Mr Paddy TAM
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DATE OF PANEL DECISION	2022-06-08
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Publish the Decision