

Decision for dispute CAC-UDRP-104560

Case number	CAC-UDRP-104560
-------------	-----------------

Time of filing	2022-05-06 10:18:19
----------------	---------------------

Domain names	Allnovartisbio.com
--------------	--------------------

Case administrator

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

Complainant

Organization	Novartis AG
--------------	-------------

Complainant representative

Organization	BRANDIT GmbH
--------------	--------------

Respondent

Name	a.K. allnovartisbio Kulik
------	---------------------------

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 one of the biggest global pharmaceutical and healthcare groups. The Complainant provides solutions to address the evolving needs of patients worldwide by developing and delivering innovative medical treatments and drugs. The Complainant, Novartis AG, based in Basel, Switzerland was 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 in Ukraine where the Respondent is located.

The Complainant holds an ample portfolio of the well-known trademark NOVARTIS registered as both a word and device mark in several classes at a worldwide level, including in Ukraine. As an example of some of them:

- International Trademark NOVARTIS, Reg. No. 663765 granted on July 1, 1996, in force until July 1, 2026, in connection with classes 01, 02, 03, 04, 05, 07, 08, 09, 10 14, 16, 17, 20, 22, 28, 29, 30, 31, 32, 40 and 42.

- International Trademark NOVARTIS, Reg. No. 1349878 granted on November 29, 2016, in force until November 29, 2026, in connection with classes 09, 10, 41, 42, 44 and 45.

- International Trademark NOVARTIS AND DESIGN, Reg. No. 1/129100 granted on September 9, 2020, in connection with class 41.

The disputed domain name <allnovartisbio.com> was registered on September 24, 2021, and by the time of this Decision, resolves to an inactive website.

FACTUAL BACKGROUND

The Complainant has requested English as the Language of the Proceedings, which will be addressed in this Decision.

The Complainant is one of the biggest global pharmaceutical and healthcare groups. The Complainant provides solutions to address the evolving needs of patients worldwide by developing and delivering innovative medical treatments and drugs. The Complainant, Novartis AG, based in Basel, Switzerland was 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. The Complainant has an active presence in Ukraine where the Respondent is located. The Complainant has subsidiaries and associated companies based in Ukraine and has been playing an active role on the local market and in Ukraine society since 2013.

The Complainant holds Trademark Rights over the name NOVARTIS since July 1, 1996.

The Complainant also owns its domain names portfolio, composed of either its trademark NOVARTIS alone: <novartis.com> registered on April 2, 1996; <novartis.net> registered on April 25, 1998; <novartis.us> registered on 19 April 2002 or in combination with other terms, e.g. <novartispharma.com> registered on 27 October 1999. The Complainant uses these domain names to promote the NOVARTIS mark with related products and services.

According to the submitted evidence before the Panel, the disputed domain name <allnovartisbio.com> was registered on September 24, 2021. By April 21, 2021, the website was active impersonating the Complainant, by reproducing Complainant's Business, Trademark, Logo, offering for sale a pharmaceutical drug, a human growth hormone (hGH) named SOMATROPIN in liquid presentation. By April 25, 2022, the content of the website was removed, resolving in an inactive website.

By the time of this Decision, the disputed domain name and the website are inactive.

PARTIES CONTENTIONS

Response:

The Respondent did not reply to any of the Complainant's contentions.

COMPLAINANT CONTENTIONS:

1) The Complainant asserts that the disputed domain name is confusingly similar to its trademark NOVARTIS, since incorporates the Complainant's well-known, distinctive trademark NOVARTIS in its entirety in combination with the terms "all" and "bio", which is closely related to the Complainant and its business activities.

2) The Complainant asserts that it has never had any previous relationships with the Respondent, nor has the Complainant ever granted the Respondent with any rights to use the NOVARTIS trademark in any forms, including the disputed domain name.

3) The Complainant asserts that 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. When searched for “All Novartis bio” in the Google search engine, the search results all pointed to the Complainant and its business activities.

4) The Complainant contends that the Respondent obviously knew about the Complainant and its trademark NOVARTIS when it registered the disputed domain name. However, the Respondent still chose to register it, due to in 2021 the Complainant noticed that the website associated to the disputed domain name displayed content that infringed the Complainant’s intellectual property rights. The website displayed content that impersonated Novartis’ official website (<https://www.novartis.com>) and that not only was the general look-and-feel copied from the official website, but it was also using the Novartis logo in a prominent position. Moreover, it offered “Somatropin Human Growth Hormone” products under the name “Novartis-Bio”, printed on the package of the products, as shown on the website. Subsequently, the Complainant filed an abuse report to the hosting provider. The Website was removed on April 25, 2022.

5) The Complainant asserts that the Respondent has been impersonating the Complainant and has been trying to mislead internet user into believing that the Website was authorized by / associated with the Complainant. The Respondent has not been using the disputed domain name for any bona fide offering of goods or services.

6) The Complainant also contends, that the disputed domain name shall be deemed as registered in bad faith, due to a) The Respondent obviously knew about the Complainant and its trademark; b) The Complainant’s trademark NOVARTIS is a distinctive, well-known trademark worldwide and in Ukraine where the Respondent resides; c) The Respondent has failed in presenting a credible evidence-backed rationale for registering the disputed domain name.

7) The Complainant contends, that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website.

8) The Complainant also contends that the Respondent has been using privacy shield to conceal its identity. According to the Registrar Verification, the Respondent has provided its first name as “allnovartisbio” and last name as “Kulik”. The Complainant considers it as deliberate provision of false WhoIs. Both factors have added up to the finding of bad faith.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is 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

Language of Proceedings:

According to Paragraph 11 (a) of the UDRP Rules, which states: “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.” This Panel notes that the Complainant requested English as the Language of the Proceedings, and that on May 12, 2022, the Registrar confirmed English as the Language of the Registration Agreement. In addition, according with the evidence submitted before this Panel, as the content of the website at least until April 25, 2022, was on English, nothing prevents the Respondent to understand the English Language, therefore, English is the corresponding Language of this Proceeding and of its Decision.

Regarding the First UDRP Element:

The Complainant has sufficiently proved before the Panel, that owns International Trademark Registrations over the term NOVARTIS, Reg. No. 663765 granted on July 1, 1996, in force until July 1, 2026, and NOVARTIS, Reg. No. 1349878 granted on November 29, 2016, in force until November 29, 2026.

The disputed domain name <allnovartisbio.com> registered on September 24, 2021, it is composed by the generic term “ALL” plus Complainant’s well-known Trademark NOVARTIS and another generic term as “BIO”, which is intrinsically related to Complainant’s business activity.

The Domain Name Jurisprudence has established that:

“Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements.” (see point 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Jurisprudential Overview 3.0”).

The Complainant’s trademark NOVARTIS was exactly reproduced, and the additional terms which can be considered as generic words, suggesting a connection with the products and services offered by the Complainant which is explored under the second and third elements (see Allbirds, Inc. v. Domain Admin, Whoisprotection.cc, WIPO Case No. 2022-1346 and NOVARTIS AG vs. Hua De Wang, CAC Case No. 104564).

It is well established by the Domain Name Jurisprudence that for the purposes of the analysis of the First UDRP Element, in this case, the gTLD “.com”, “is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test” (see point 1.11.1 of the WIPO Jurisprudential Overview 3.0”).

Therefore, the disputed domain name <allnovartisbio.com> is confusingly similar to Complainant’s NOVARTIS Trademarks.

Regarding the Second UDRP Element, to this Panel it is clear that:

(1) the Respondent is not associated or affiliated or hasn’t been authorized or licensed by the Complainant to register the disputed domain name.

(2) there is no evidence that the Respondent corresponds or has become commonly known by the disputed domain name <ALLNOVARTISBIO.COM>. Certainly, as the Complainant states, through a simple Google Search of the words “ALL NOVARTIS BIO” the Complainant’s official website is displayed as the first reference.

(3) The Complaint has shown that the Respondent is using the disputed domain name to sell a prescribed drug as the SOMATROPIN under the name of NOVARTIS, therefore there is no possible evidence able to confirm that the Respondent is using the disputed domain name with a bona fide offering of goods or services; or even less that the Respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or

to tarnish the NOVARTIS trademark (see Novartis AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org, / Sergei Lir, WIPO Case No. D2016-1688).

(4) the Respondent registered the disputed domain name on September 24, 2021, meaning at least 25 years AFTER the Complainant's acquired its trademark rights over NOVARTIS on July 1, 1996.

Therefore, this Panel finds that the Complainant has successfully made a prima facie case, which was not rebutted in any manner by the Respondent and concludes that the Respondent have no rights or legitimate interests in respect of the disputed domain name.

In relation to the Third Element of the UDRP, the Bad Faith, this Panel analyses the following:

Bad Faith Registration:

The Complainant is a pharmaceutical company with a rich history that roots back more than 250 years. It owns a worldwide strong position with 26 years in the market. The Complainant owns such a well-known trademark as NOVARTIS since July 1, 1996, meaning 25 years BEFORE the Respondent registered the disputed domain name on September 24, 2021, therefore under the circumstances of this Case, to this Panel it is very difficult to believe that the Respondent didn't know the Complainant at the time of the registration of the disputed domain name.

In relation to the assessment of respondent's knowledge, point 3.2.2. of the WIPO Jurisprudential Overview 3.0. titled "Knew or should have known" states:

"Noting the near instantaneous and global reach of the Internet and search engines, and particularly in circumstances where the complainant's mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers), panels have been prepared to infer that the respondent knew, or have found that the respondent should have known, that its registration would be identical or confusingly similar to a complainant's mark. Further factors including the nature of the domain name, the chosen top-level domain, any use of the domain name, or any respondent pattern, may obviate a respondent's claim not to have been aware of the complainant's mark."

Therefore, this Panel concludes that the disputed domain name was registered with Complainant's Trademark's value on mind, meaning that it was registered in bad faith.

Bad Faith Use:

Point 3.1 of the WIPO Jurisprudence Overview 3.0 indicates:

"(...) UDRP paragraph 4(b) provides that any one of the following non-exclusive scenarios constitute evidence of a respondent's bad faith:

"(iv) by using the domain name, you have 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.

(...) Given that the scenarios described in UDRP paragraph 4(b) are non-exclusive and merely illustrative, even where a complainant may not be able to demonstrate the literal or verbatim application of one of the above scenarios, evidence demonstrating that a respondent seeks to take unfair advantage of, abuse, or otherwise engage in behavior detrimental to the complainant's trademark would also satisfy the complainant's burden."

Point 3.4 of the WIPO Jurisprudence Overview 3.0 indicates:

“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.”

In the present Case, the Respondent used the disputed domain name to sell under the Complainant's company identity, and NOVARTIS Trademark a prescribed drug named SOMATROPIN which is a human growth hormone (hGH) without any kind of license, permission, consent, or authorization, constituting such unlawful conduct and an enormous risk to public health (see Novartis AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org, / Sergei Lir, WIPO Case No. D2016-1688; Forest Laboratories, Inc. v. Awad Kajouk, WIPO Case No. D2007-1650). In addition, the Respondent has used the Privacy Service, and provided inconsistent information regarding its identity, which undeniably emphasize its bad faith (see point 3.6 of the WIPO Overview 3.0). Such facts, despite the current website inactivity -due to Complainant's take down hosting request-, are sufficient to this Panel to conclude that the disputed domain name is being used in faith under the Policy.

Therefore, this Panel concludes that, the disputed domain name has been registered and used in faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ALLNOVARTISBIO.COM**: Transferred

PANELLISTS

Name	Ms. MARÍA ALEJANDRA LÓPEZ GARCÍA
------	---

DATE OF PANEL DECISION	2022-06-17
------------------------	------------

Publish the Decision