

Decision for dispute CAC-UDRP-104557

Case number CAC-UDRP-104557

Time of filing 2022-05-05 09:23:07

Domain names Novartis-india.com

Case administrator

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

Complainant

Organization Novartis AG

Complainant representative

Organization BRANDIT GmbH

Respondent

Organization NOVARTIS INDIA LIMITED

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 owns many trademark registrations for "NOVARTIS" which enjoy protection in numerous countries.

In particular, the Complainant outlines to be the owner of the Indian word mark "NOVARTIS", filed on February 28, 1996 (application No. 700020), and duly registered and renewed.

FACTUAL BACKGROUND

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

- 1) The Complainant declares to be one of the biggest pharmaceutical and healthcare groups worldwide. According to the Complainant, Novartis AG products are sold in about 155 countries and reached nearly 800 million people globally in 2018.
- 2) The Complainant has duly proved to be the owner of the registered well-known trademark "NOVARTIS" in several classes and in numerous countries all over the world including India, where the Respondent is located and that these trademark registrations long predate the registration of the disputed domain names which was created only on March 14, 2022.

3) In the Complainant's view, due to extensive use, advertising and revenue associated with its trademarks worldwide, the Complainant enjoys a high degree of renown around the world, including India, where the Respondent is located. The Complainant has previously successfully challenged several domain names including the word "NOVARTIS" through UDRP processes.

4) The Complainant outlines that in the WIPO Case No. D2016-1688, Novartis AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org, / Sergei Lir, the Panel confirmed that "NOVARTIS" is a well-known trademark.

5) The Complainant has registered a number of domain names under generic Top-Level Domains ("gTLD") and country-code Top-Level Domains ("ccTLD") containing the term "NOVARTIS", for example, <novartis.com> (created on April 2, 1996), <novartis.in> (created on February 15, 2005) and Novartis.us (created on April 19, 2002). The Complainant uses these domain names to connect to a website through which it informs potential customers about its "NOVARTIS" mark and its products and services.

6) According to the Complainant, the domain name in dispute is similar to its "NOVARTIS" trademark since the disputed domain name resolves in the "NOVARTIS" mark along with the geographic identifier "INDIA".

7) The Complainant has never granted the Respondent with any rights to use the "NOVARTIS" trademark. In addition, the Complainant has duly noted that the Respondent's name "NOVARTIS INDIA LIMITED" fully corresponds to the Complainant's Indian subsidiary name. From the Complainant's point of view, it proves that the Respondent wishes to impersonate the Complainant with a false address and it cannot constitute a valid right or legitimate interest in respect of the domain name in dispute.

8) Furthermore, the Complainant outlines that the domain name <novartis-india.com> used to resolve to a mere pay-per-click page and that currently it has been suspended due to pending WHOIS verification.

9) The Complainant informs that an attempt to contact the owner of the disputed domain names was made on March 29, 2022 through a cease-and-desist letter. The Respondent has never answered.

10) In the Complainant's view, by using the domain name <novartis-india.com> the Respondent has clearly and intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's mark and business.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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

Paragraph 4(a) of the Policy provides that to obtain the transfer of the disputed domain name, the Complainant must prove that each of the following elements is present:

- (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.

1) The disputed domain name fully includes the Complainant's trademark. Also, it is added to the word "NOVARTIS" the word "INDIA" (preceded by a simple hyphen). In this respect the Panel notes that many previous panels under the Policy have found that a geographic identifier in a domain name (as in the disputed domain name <novartis-india.com>) does not alter the finding of similarity between the domain name in dispute and the previous registered trademark (Six Continents Hotels, Inc. v. Sdf fdgg, WIPO Case No. D2004-0384 and Credit Agricole SA v. Frederik Hermansen, CAC Case No. 101249). Finally, the generic Top-Level Domain ".com" is obviously a mere standard registration requirement and should be disregarded when assessing whether a disputed domain name is confusingly similar to the trademarks in which the Complainant has rights (see, between many others, Credit Mutuel Arkea vs. Domain Administration - CAC Case No. 102345). Accordingly, the Complainant has, to the satisfaction of the Panel, shown that the domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The Complainant therefore succeeds on the first element of the Policy.

2) The Complainant has never authorized the Respondent to use the trademark "NOVARTIS". Furthermore, the Complainant has duly proved that the WHOIS information for <novartis-india.com> notes that the name of the Respondent "NOVARTIS INDIA LIMITED" is identical to the name of the Complainant's Indian subsidiary. According to previous Panel determinations, it must be clarified that the fact that the Respondent's name presents some similarities with the disputed domain name cannot automatically lead to the conclusion that the Respondent has been commonly known by the disputed domain name and therefore owns rights or legitimate interests over it. As also confirmed by para. 2.8 of the WIPO Jurisprudential Overview 3.0, in order to enjoy rights or legitimate interests, the Respondent must clearly prove to be "commonly known by" the disputed domain name. The Complainant has duly proved that the Respondent's name is not used to identify the Respondent. Actually, as proved by the Complainant, if one conducts a Google search on "NOVARTIS INDIA" all the results returned by the search engine are related to the Complainant. The Panel has also conducted a search on "NOVARTIS INDIA LIMITED" and, even in this case, all the results refer to the Complainant. This unequivocally means that "NOVARTIS INDIA LIMITED" is not known to be the Respondent's name but only to be the Complainant's Indian subsidiary name and, consequently, that the Respondent cannot be commonly known by the disputed domain name (Avast Software s. r. o. & AVAST Software B.V. vs. Avastcoin Limited, CAC Case No. 101909). This, also in consideration that there is nothing else in the content of the current or past associated website, which relates the Respondent to the disputed domain name (ArcelorMittal vs. SHRUTI MITTAL, CAC case No. 101910). On the contrary it is possible to interfere that the Respondent has chosen said name with the only purpose of disrupting the Complainant's business by impersonating the same Complainant. Hence, the mere fact that the disputed domain name was registered by a company allegedly named "NOVARTIS INDIA LIMITED" is insufficient to conclude that the Respondent owns legitimate rights or interests over them (Intesa Sanpaolo S.p.A. vs. Intesa Trade LTD, CAC Case No. 104118 and VIVENDI vs. K. Vivendi, LLC, CAC Case No. 102284). This also considering that the Respondent, in the absence of any response, has not shown any facts or element to justify prior rights or legitimate interests in the disputed domain name. The Complainant therefore succeeds also on the second element of the Policy.

3) The Respondent has registered the disputed domain name containing in its entirety the well-known trademark of the

Complainant "NOVARTIS" and adding the geographic term "INDIA", creating in such way a likelihood of confusion with the Complainant's trademark. Considering the notoriety of the Complainant's business and its mark worldwide and in particularly in India, where the Respondent is located, it is unlikely that the registration of the disputed domain name may be attributed to a mere chance and not, as is, with a full awareness and intent to exploit the reputation of the Complainant and its mark acquired in many years. The disputed domain name currently resolves to a webpage which displays that: "Whois verification is pending- This domain is suspended". There is no evidence that the Registrant has, after the registration of the domain name and before the introduction of this proceeding, taken any active steps to regain the control over the domain name. UDRP Panels consider the following factors when applying the passive holding doctrine: (i) the degree of distinctiveness or reputation of the complainant's mark (ii) the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use (iii) the respondent's concealing its identity or use of false contact details (iv) the implausibility of any good faith use to which the domain name may be put. Taken into account all circumstances of this case, the Panel finds that it is implausible that there is any legitimate purpose in the registration of the disputed domain name by the Respondent (*ArcelorMittal vs. ANA LEONI KACHAK GONCALVES - CAC Case No. 101550*). Taken into account all circumstances of this case, the Panel finds that it is implausible that there is any legitimate purpose in the registration of the disputed domain name by the Respondent. In addition, the fact that in the past the domain name in dispute has been used in connection with a pay-per-click page reinforces the finding of use in bad faith. Previous Panels have held that using the domain name as a parking page with pay-per-click links to third party websites may be evidence of bad faith when the registrant is using the domain name in this manner because of the similarity to the Complainant's trademark in the hope and expectation that the similarity will lead to confusion on the part of Internet users and results in an increased number of Internet users being drawn to that domain name parking page (*MpireCorporation v. Michael Frey, WIPO Case No. D2009-0258; Paris Hilton v. Deepak Kumar, WIPO Case No. D2010-1364 and La Fee v. Pavol Icik, WIPO Case No. D2013-0526*).

Finally, the Respondent has ignored Complainant's attempt to resolve this dispute outside of this administrative proceeding by refusing to answer the cease-and-desist letters. Past UDRP panels have held that failure to respond to a cease-and-desist letter may properly be considered a factor in finding bad faith (see, for instance, *Encyclopedia Britannica v. John Zuccarini and The Cupcake Patrol a/ka Country Walk a/k/a Cupcake Party, WIPO Case No. D2000-0330 and RRI Financial, Inc., v. Chen, WIPO Case No. D2001-1242*). The Panel, therefore concludes that the Respondent registered and is using the disputed domain names in bad faith pursuant to the paragraph 4(a)(iii) of the Policy. The Complainant therefore succeeds also on the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTIS-INDIA.COM**: Transferred

PANELLISTS

Name	Avv. Guido Maffei
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DATE OF PANEL DECISION 2022-06-16

Publish the Decision
