

Decision for dispute CAC-UDRP-104628

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| Case number | CAC-UDRP-104628 |
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| Time of filing | 2022-06-03 10:30:56 |
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| Domain names | Novartisit.com |
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Case administrator

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

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| Organization | Novartis AG |
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Complainant representative

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| Organization | BRANDIT GmbH |
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Respondent

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| Name | Novartis it |
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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 name.

IDENTIFICATION OF RIGHTS

The Complainant proved to be the owner of numerous "NOVARTIS" trademark registrations all over the world including the following Indian trademark registration:

Trademark: NOVARTIS

Application. no: 700020

Application date: 28 February 1996

User date: 28 July 1997

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:**I. COMPLAINANT**

The Complainant is one of the biggest global pharmaceutical and healthcare groups. Novartis AG (the "Complainant"), 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 sold in about 155 countries and they reached nearly 800 million people globally in 2018. About 125 000 people of 145 nationalities work at Novartis around the world.

According to the Complainant's submissions, the NOVARTIS trademark has a strong presence in India where the Respondent is located, this also thanks to its official website Novartis.in, dedicated to India, and social media platforms.

Moreover, previous UDRP panels have stated that the NOVARTIS trademark is well-known (inter alia Novartis AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org, / Sergei Lir, WIPO Case No. D2016-1688).

The Complainant owns numerous domain names composed of either its trademark NOVARTIS alone, including <Novartis.in> (created on 15 February 2005), <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.

II. The Disputed Domain Name and the Respondent

<Novartisit.com> was registered on 20 March 2022 and currently links to an inactive website. According to the information provided by the Registrar, the Respondent is Novatris it, based in India.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Disputed Domain Name is confusingly similar to the Complainant's trademark as it entirely incorporates the NOVARTIS trademark, in combination with the term "IT", which could be easily interpreted by the public as "Information technology" or the country abbreviation for "Italy", therefore 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.

The Complainant denies that the Respondent has rights or legitimate interests in respect of the disputed domain name and Novartis AG has never had any business relationship with the Respondent. Moreover, the Complainant excludes that the Respondent is known with the disputed domain name as there is no evidence that NOVARTISIT is an active business.

The Complainant supports that the disputed domain name is registered and used in bad faith, given the high reputation of the NOVARTIS trademark and the fact that <novartisit.com> has never been actively used.

RESPONDENT:

The Respondent did not file any administrative reply to the Complaint.

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

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

The Panel agrees that the disputed domain name is confusingly similar to the NOVARTIS trademark.

As a matter of fact, the disputed domain name entirely incorporates the NOVARTIS trademark and this is sufficient to meet the threshold of the First Element of the UDRP policy. Moreover, the combination of the element "IT" has no significant impact on the confusing similarity assessment as this element could be associated to possible descriptive or geographical meanings ("it" as information technology, or "it" as a reference to Italy) and in any case the NOVARTIS element is the dominant part of the disputed domain name.

The Complainant agrees that the ".com" extension has no impact in the confusing similarity assessment due to its technical function.

As a consequence, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark, for the purposes of the First Element of the Policy.

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

Pursuant to paragraph 4(a)(ii) of the Policy, a complainant is required to make out a prima facie case that a respondent lacks rights or legitimate interests in the disputed domain name. Once such a prima facie case is made, the respondent carries the burden of demonstrating its rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

In this case, the Panel finds that the Complainant's submitted evidence and allegations are sufficient to establish a prima facie case of Respondent's lack of rights and legitimate interests in the disputed domain name also considering the fact that the Respondent had the chance to justify the registration and use of <novartisit.com> but failed to do so.

According to the information provided by the Complainant and not contested, the Respondent is not commonly known by the disputed domain name nor he is authorized to use the Complainant's trademark "NOVARTIS". The fact that the name of the Respondent's organization appears to be "NOVARTIS IT" does not automatically grant to the Respondent a right / legitimate interest in the disputed domain name. To that effect, the Respondent should have proved that "NOVARTIS IT" is and was effectively used in the market. Moreover, it appears that the contact information associated with NOVARTIS IT are false and this confirms the lack of rights or legitimate interests in registering the disputed domain name.

<novartisit.com> is not used; as a consequence, there is no evidence of a bona fide or legitimate non commercial use of the domain name as required by the UDRP.

For these reasons, the Panel takes the view that the Respondent lacks rights or legitimate interests in the disputed domain name for the purposes of the Policy.

3. The disputed domain name was registered and is used in bad faith.

The Panel finds the following circumstances as material in order to establish the Respondent's bad faith in the registration of the disputed domain name:

(i) the disputed domain name was registered well after the Complainant acquired rights on the trademark NOVARTIS;

(ii) the Complainant's trademark is widely known as confirmed by previous Panels. The reputation of the trademark NOVARTIS, including in India, makes it very improbable that the Respondent was not aware of the Complainant's exclusive rights on such trademark at the time of the registration of the disputed domain name;

(iii) the Respondent appears to have used false information at the time of the registration of the disputed domain name. This fact is considered by the Panel as a further index of registration in bad faith.

As concerns the use in bad faith requirement, the Panel points out that <novartisit.com> is not used in connection with an active website. Previous panels have found that the non-use of a domain name (including a blank or "coming soon" page) does not prevent a finding of bad faith under the doctrine of passive holding.

Factors that have been considered relevant in applying the passive holding doctrine include: (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 (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.

In this case, these factors suggest that the actual use of the disputed domain name could be qualified as a use in bad faith. As said before, the NOVARTIS trademark enjoys a high degree of reputation all over the world which also excludes a possible use in good faith of the disputed domain name. Furthermore, the Respondent did not file any response providing information on a possible good faith use of the disputed domain name. Last, in the Panel's view, some of the contact details provided by the Respondent in the WHOIS are false.

For these reasons, the Panel takes the view that the disputed domain name is registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTISIT.COM**: Transferred

PANELLISTS

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| Name | Andrea Mascetti |
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| DATE OF PANEL DECISION | 2022-07-05 |
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Publish the Decision