

Decision for dispute CAC-UDRP-104634

Case number CAC-UDRP-104634

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Domain names novartisphara.com

Case administrator

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

Complainant

Organization Novartis AG

Complainant representative

Organization BRANDIT GmbH

Respondent

Organization YangZhiChao

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 Novartis Group 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. Novartis AG (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 is the owner of the well-known trademark NOVARTIS registered as both a word and device mark in several classes worldwide, including China.

Trademark: NOVARTIS

Reg. No: IR666218

Class: 41; 42

Date of Registration: 31.10.1996 (ink. China)

Trademark: NOVARTIS

Reg. No: IR663765

Class: 01; 02; 03; 04; 05; 07; 08; 09; 10; 14; 16; 17; 20; 22; 28; 29; 30; 31; 32; 40; 42

Date of Registration: 01.07.1996 (ink. China)

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.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. The Complainant and its trademark enjoy a strong presence online also via its official social media platforms.

FACTUAL BACKGROUND

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

I. LANGUAGE OF PROCEEDINGS REQUEST:

In accordance with Paragraph 11 of the UDRP Rules, unless otherwise agreed by the parties, the language of the proceedings is the language of the registration agreement, subject to the authority of the panel to determine otherwise, exercising its “discretion in the spirit of fairness to both parties, which pursuant to paragraph 10(b) of the Rules have to be treated with equality, taking into account all relevant circumstances of the case, including matters such as the parties’ ability to understand and use the proposed language, time and costs” (see Carrefour v. Contact Privacy Inc. Customer 1242379769 / Le Berre, WIPO Case No. D2018-1552).

According to the Registrar Verification, the language of the Registration Agreement is Chinese. The Complainant hereby requests that the language of the present administrative proceedings be English based on the following reasons:

- The Disputed Domain Name resolved to pay-per-click websites with terms in English, such as “Novartis Products”, which demonstrates that the Respondent understands English;
- Reverse WHOIS search showed that the Respondent has registered numerous other domain names composed by English terms, such as <acpcapetinsurance.com>, <facebookn.com>, <spectrumhealth.org>, etc., which demonstrates that the Respondent understands English;
- The Respondent chose to register the Disputed Domain Name with the generic TLD .com. This proves that by registering the Disputed Domain Name the Respondent is trying to target a broad audience, not limited to visitors who speak a specific language;
- Moreover, should the Respondent request the language of the proceedings be a language other than English, a translation of the Complaint in such a language would entail significant additional costs for the Complainant and delay in the proceedings.

The Complainant therefore requests the Panel to exercise its discretion and allow the language of the proceedings to be English.

II. ABOUT COMPLAINANT AND THE BRAND NOVARTIS

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: see www.novartis.com.cn

The Complainant enjoys a strong presence online also via its official social media platforms.

LEGAL GROUNDS:

A. THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR

The domain name <novartisphara.com> (hereinafter referred to as the “Disputed Domain Name”), which was registered on 25 March 2022 according to the Registrar Verification, incorporates the Complainant’s well-known, distinctive trademark NOVARTIS in its entirety in combination with a typo “phara” of the generic term “pharma”, 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 same reasoning should apply in the current case and the Disputed Domain Name should be considered as confusingly similar to the trademark NOVARTIS.

B. RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN RESPECT OF THE DISPUTED DOMAIN NAME

The Complainant 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 entering the term “novartisphara” in the search engines Google and Baidu (the leading search engine in China), the returned results pointed to the Complainant and its business activities and not to the Respondent.

The Respondent could have easily performed a similar search before registering the Disputed Domain Name and would have inevitably learnt that the trademarks are owned by the Complainant and that the Complainant has been using its trademarks in China and many other countries of the world. However, the Respondent still chose to register the Disputed Domain Name as such.

By the time the Complainant prepared its Complaint on 2 June 2022, the Disputed Domain Name resolved to PPC pages. The Respondent has not been using the Disputed Domain Name for any bona fide offering of goods or services.

From the Complainant’s perspective, the Respondent deliberately chose to use the well-known, distinctive trademark NOVARTIS as the main part of the Disputed Domain Name, 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.

C. THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITH

i. THE DISPUTED DOMAIN NAME IS REGISTERED IN BAD FAITH

It should be highlighted that most of the Complainant's trademark registrations predate the registration of the Disputed Domain Name and the Respondent has never been authorized by the Complainant to register the Disputed Domain Name. Considering the renown of the Complainant and its trademark NOVARTIS, and the overall composition of the Disputed Domain Name, i.e. the Complainant's well-known, distinctive trademark NOVARTIS in its entirety in combination with a typo of the generic term "pharma", which is closely related to the Complainant and its business activities, it follows that the combination of the well-known trademark NOVARTIS in the Disputed Domain Name is a deliberate and calculated attempt to improperly benefit from the Complainant's rights and reputation.

Additionally the Complainant states:

- The Respondent very likely knew about the Complainant and its trademark;
- The Complainant's trademark NOVARTIS is a distinctive, well-known trademark worldwide and in China where the Respondent resides;
- The Respondent has failed in presenting a credible evidence-backed rationale for registering the Disputed Domain Name.

ii. THE DISPUTED DOMAIN NAME IS BEING USED IN BAD FAITH

As noted in the previous paragraphs, the Disputed Domain Name 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, e.g. WIPO Case No. D2016-0245, Heraeus Kulzer GmbH. v. Whois Privacy Services Pty Ltd / Stanley Pace, wherein the Panel stated:

"The Panel finds that the Domain Name was registered and is being used to attract, for commercial gain, Internet users to the Respondent's Website or other online location, by creating a likelihood of confusion with the Complainant's KULZER Mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's Website. In particular the Respondent's Website is a page that offers sponsored-links to third-party sites that have in the past and may in the future sell products that directly compete with the Complainant's dental equipment. Such sites generally advertise by paying registrants on a pay-per-click basis for Internet users redirected to their sites. This means that the Respondent receives a financial reward for every Internet user redirected from the Respondent's Website to those third-party sites.

Accordingly, the Panel finds that the Respondent has registered and is using the Domain Name in bad faith under paragraph 4(a)(iii) of the Policy."

Additionally, the Complainant tried to reach the Respondent with the notice of cease-and-desist letter sent on 19 April 2022 to the Respondent via the online form provided by the Registrar, as provided in the WHOIS. However, until the time the Complainant prepared this Complaint, it has not received response from the Respondent.

The Respondent's non-response to cease-and-desist letter infers bad faith use of the Disputed Domain Name, see *Arla Foods Amba v. Mlanie Guerin*, CAC case No. 101640; *Medela AG v. Donna Lucius*, CAC case No. 101808.

The fact 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.

Lastly, the Respondent has been using privacy shield service to conceal its identity, which adds up to the finding of bad faith.

SUMMARY

- NOVARTIS is a well-known, distinctive trademark worldwide.
- Complainant's trademarks registration predates the registration of the Disputed Domain Name.
- Respondent has no rights in the mark NOVARTIS, bears no relationship to the Complainant, and is not commonly known by the Disputed Domain Name - accordingly it has no legitimate interest in the Disputed Domain Name.
- It is highly unlikely that Respondent was not aware of Complainant's prior rights in the trademark NOVARTIS at the time of registering the Disputed Domain Name, given the Complainant's worldwide renown.
- Respondent has been using the Disputed Domain Name to resolve to pay-per-click websites.
- Respondent has not responded to Complainant's cease-and-desist communication.
- Respondent's registration of the Disputed Domain Name has constituted a pattern of conduct that prevents a trademark holder from reflecting its mark in a domain name.
- Respondent has been using privacy shield to conceal its identity.

Consequently, the Respondent should be considered to have registered the Disputed Domain Name confusingly similar to the Complainant's well-known, distinctive trademark NOVARTIS. The Complainant has not found that the Respondent is of any legitimate right or interest in using the Disputed Domain Name, but rather registered and has been using the Disputed Domain Name in bad faith.

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 Complainant requested that the language of this administrative proceeding be English pursuant to UDRP Rule 11(a): 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.

Paragraph 10 of the UDRP Rules vests a Panel with authority to conduct the proceedings in a manner it considers

appropriate while also ensuring both that the parties are treated with equality, and that each party is given a fair opportunity to present its case. UDRP panels have found that certain scenarios may warrant proceeding in a language other than that of the registration agreement. Such scenarios were summarized into WIPO Jurisprudential Overview 3.0, 4.5.1. In this particular instance, the Complainant tried to request change of language of proceedings in light of Chinese language Registration Agreement by showing that 1) The Disputed Domain Name is composed by the Complainant's trademark Novartis and the a typo of the genetic English term "pharma"; 2) The Disputed Domain Name resolved to pay-per-click websites with terms in English, such as "Novartis Products", which demonstrates that the Respondent understands English; 3) The Complainant's Reverse WHOIS search showed that the Respondent has registered numerous other domain names composed by English terms, such as acpcapetinsurance.com, facebookn.com, spectrumhealth.org, etc. which demonstrates that the Respondent understands English; 4)-Moreover, a translation of the Complaint to Chinese would entail significant additional costs for the Complainant and delay in the proceedings. Relevant decisions have been cited to support the Complainant's positions.

In light of the scenarios and equity, the Panel is of the view that conducting the proceeding in English is unlikely to heavily burden the Respondent, and it is likely that the Respondent can understand the English language based on a preponderance of evidence test. Without further objection from the Respondent on the issue, the Panel will proceed to issue the decision in English.

PRINCIPAL REASONS FOR THE DECISION

1. Identical or confusingly similar

The Complainant contends that the Disputed Domain Name <novartisphara.com> is confusingly similar to the Complainant's trademark "Novartis". The Complainant, Novartis Group is one of the biggest global pharmaceutical and healthcare groups in the world. Novartis AG has its headquarter in Switzerland, was created in 1996. The Complainant is the owner of the well-known trademark NOVARTIS registered as both a word and device mark in several classes worldwide, including China. The Complainant owns numerous domain names composed of either its trademark NOVARTIS alone, 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 disputed domain name <novartisphara.com> (hereinafter referred to as the "Disputed Domain Name"), which was registered on 25 March 2022 according to the WHOIS. It incorporates the Complainant's trademark NOVARTIS completely, in combination with "phara" which is a typed version of "pharma", 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.

The Panel therefore concludes that the Disputed Domain Name is confusingly similar to a trademark in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

2. No rights or legitimate interests

Although the Respondent did not file an administratively compliant (or any) response, the Complainant is still required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Complainant in the present case has not licensed or authorized the Respondent to register or use the trademark or the Disputed Domain Name. There is no evidence that the Respondent is known by the Disputed Domain Name or owns any corresponding registered trademarks including the terms "novartis" and/or "novartisphara".

The organization of the Respondent, "YangZhiChao", also has no connection with the Complainant's brand. The Complainant contends that no evidence suggests that the Respondent has been known in any way by the Disputed Domain Name. The Complainant did not grant any license or authorization to the Respondent to register or use the Disputed Domain Name, nor the use of the Complainant's trademark on pages of the disputed website.

In addition, The Respondent does not appear to have used the disputed Domain Name in connection with active websites at any time since the registrations. Currently, the Domain Name resolves to Pay-Per-Click pages. The Respondent has not been using the Disputed Domain Name for any bona fide offering of goods or services. Therefore, the Respondent has not used the Disputed Domain Name or a name corresponding to the Disputed Domain Name in connection with a bona fide offering of goods or services.

On the basis of preponderance of evidence, and in the absence of any evidence to the contrary or any administratively compliant response being put forward by the Respondent, the Panel finds that the Respondent does not have rights or legitimate interests in the Disputed Domain Name within the meaning of paragraph 4(a)(ii) of the Policy.

3. Bad faith

By trying to establish the bad faith element of paragraph 4(a) of the Policy, the Complainant has primarily attempted to rely on paragraph 4(b)(i) and 4(b)(iv) of the Policy.

Registration of the disputed domain name in bad faith – As far as registration goes, UDRP panels have consistently held that the mere registration of a domain name that is confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. Complainant's trademark registrations predate the registration of the Disputed Domain Name. The fact that the Complainant's trademark is a well-known and that The Respondent has failed in presenting a credible evidence-backed rationale for registering the Disputed Domain Name implied that the Respondent may have had knowledge of the Complainant's trademark at the time of registration of the Disputed Domain Name. It is reasonable to infer that the registrant registered the disputed domain name with the knowledge of the complainant's trademark and/or brand influence.

Use of the Disputed Domain Name in Bad Faith – Currently, the Disputed Domain Names resolve to pay-per-click pages. "Applying UDRP paragraph 4(c), panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users." (WIPO Jurisprudential Overview 3.0 2.9). This this conduct constitutes bad faith as it has been confirmed in previous cases (WIPO Case No. D2016-0245, Heraeus Kulzer GmbH. v. Whois Privacy Services Pty Ltd / Stanley Pace). The Respondent is not making any active use of the Disputed Domain Name. At the same time, the Respondent could have registered the Disputed Domain Names to divert internet users to its own websites. According to paragraph 4(b)(iv) of the Policy, "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", if found by the Panel, shall be considered evidence of registration and use of the domain name in bad faith.

Moreover, a cease-and-desist letter was sent to the Respondent on 19 April 2022 and the Respondent never responded. Prior panels have also held that a failure to respond to a cease-and-desist letter can be evidence of bad faith (see e.g., HSBC Finance Corporation v. Clear Blue Sky Inc. and Domain Manager, WIPO Case No. D2007-0062).

Therefore, in the absence of any evidence to the contrary (or any administratively compliant response) being put forward by the Respondent, the Panel determines that the Complainants have failed to provide that the Disputed Domain Name was registered and is being used in bad faith within the meaning of paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. NOVARTISPHARA.COM: Transferred

PANELLISTS

Name	Carrie Shang
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DATE OF PANEL DECISION 2022-07-10

Publish the Decision
