Decision for dispute CAC-UDRP-102813

Case number	CAC-UDRP-102813
Time of filing	2019-12-12 13:01:34
Domain names	novartisformulary.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Organization	xi xuan yong

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings pending or decided which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant has to the Panel's satisfaction documented its international trade mark "NOVARTIS" No. 663765 in Nice Classification classes 5, 9, 10 and several other classes and has further produced an extensive listing of this brand from the World Intellectual Property Organization's Global Brand Database as well as Whois records for its novartis.com and novartis.net domain name registrations, together with indications of hosting and website use.

The Respondent registered the disputed domain name <novartisformulary.com> on 21 October 2019.

FACTUAL BACKGROUND

The Complainant is a long-established global healthcare company based in Switzerland which operates in 155 countries and, among other things, manufactures drugs that include clozapine (Clozail), diclofenac (Voltaren), carbamazepine (Tegretol) and valsartan (Diovan). Its products reached around 800 million people globally in 2018. The Complainant also states that its workforce numbers some 125,000 comprised of some 145 nationalities. Its international trade mark 663765 is registered in China.

The Complainant avers that its business language is English. It also states that it has a “strong presence” in China and has a local corporate website there. This site is in Chinese.

No details of the Respondent were visible to the Complainant from the Whois information publicly available for the disputed domain name.

The CAC Case Administrator requested the registrar of the disputed domain name, XinNet.com, to provide the registrant’s identity during the Registrar Verification step in this proceeding. The registrar revealed that the name registered for the registrant is Xi Xuan Yong and stated that the registration agreement is in Chinese.

The registrar provided the Respondent’s contact details as well as its own in Chinese.

These Respondent’s contact details included a (mobile) telephone number, a postal address in Beijing and an email address (hosted by a Chinese provider). However, as is common knowledge in international business, Beijing’s postal code range commences with the digits 10, whereas the postal code given for the Respondent via the registrar, 331400, is in Xiajiang County, Ji'an, Jiangxi province – i.e. in a completely different part of China.

No response was received from the Respondent to the Case Administrator’s communications in respect of the present proceeding, sent by e-mail and by post. These were composed in English, in line with the Complaint.

For its part, the Complainant’s authorized representative sought to contact the Respondent through the Chinese registrar, again in English, but was met with a system error message to online forms and no response to emails.

The documentation submitted by the Complainant reveals no attempt by it to communicate with either the Respondent or the registrar of the disputed domain name in Chinese.

The Complainant used a commonly available online languages translator to determine from the content of the website employing the disputed domain name that it linked to a gambling site.

The Complainant provided screenshots showing that the website employing the disputed domain name -- which is at the time of preparing the present Decision the Panel, in exercise of its general powers, observes is now no longer operational -- contained limited translations into English of some of its internal site links, namely, for “technical support”, “service experience” and “recharge method” as well as the translation into English of “Copyright Reserved”.

The Complainant adduced a listing of 53 reverse Whois lookup results for domain names registered under the Respondent’s email address as confirmed during the Registrar Verification. The status of the list is date-stamped as 17 December 2019. The latest registrations in this listing were seven made on one day, 12 December 2019. A further three had been made the previous day. Among the domain names registered on those two days were the name of an association in France that supports small and medium sized enterprises and of an Indian software outsourcing company, as well as such names as the name of a book of a German philosopher and an area of legal practice in a US state. Earlier ones include the full name of a US construction company, a reformulation including the elements of the name of a major English-speaking social media

platform, and a word in German connoting heart disease. All of the domain names listed in this item of evidence were created in 2019. The only ICANN registrar listed which is Chinese is based in Hong Kong. The others are nearly all US-based.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

I. LANGUAGE OF PROCEEDINGS

The Complainant asked the Panel to rule that the language of the proceeding should be changed from Chinese to English, invoking the following arguments:

- Use of English terms on the website employing the disputed domain name;
- The Respondent's registration of domain names containing English terms;
- The disputed domain name's inclusion of the Complainant’s trademark NOVARTIS in its entirety combined with a generic term “formulary”, which is closely related to the Complainant’s business activities in the context that the terms are used together;
- The Complainant's being a global company whose business language is English;
- The main website operated by the Complainant is in English.

Thus, the Respondent obviously understands English. To avoid any potential unfairness or unwarranted delay in ordering the Complainant to translate the Complaint, the Complainant requests that the proceeding language should be in English.

II. LEGAL GROUNDS

A. THE DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR

The disputed domain name <novartisformulary.com> incorporates the Complainant’s well-known, distinctive trademark NOVARTIS in its entirety combined with a generic term “formulary”, which is closely related to the Complainant’s business activities. The term “NOVARTIS” being distinctively recognizable in the disputed domain name, it is confusingly similar to the Complainant's trademark. The addition of the gTLD “.com” does not add any distinctiveness to the disputed domain name.

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

The Complainant has never granted the Respondent any right to use the NOVARTIS trademark, nor is the Respondent affiliated to the Complainant in any way.

The Complainant has not found that the Respondent is commonly known by the disputed domain name or that it has an interest over it or the major part of it. When entering the terms “Novartis” and “formulary” in the Google and Baidu (the leading search engine in China) search engines, the search results all point to the Complainant and its business activities. A similar search before registering the disputed domain name would have revealed the same to the Respondent.

The disputed domain name resolved to an active website displaying gambling information.

The Respondent deliberately chose to use the Complainant's well-known, distinctive trademark NOVARTIS in the disputed domain name in order to confuse internet users and attract them by benefitting from the Complainant’s global renown.

The Respondent therefore has not been using the disputed domain name for any bona fide offering of goods or services.

The Respondent has hence no right nor legitimate interest in respect of the disputed domain name.

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

i. THE DOMAIN NAME WAS REGISTERED IN BAD FAITH

The registration of the Complainant's trademarks predates the registration of the disputed domain name and the Respondent was not authorized by the Complainant to register it.

Due to the Complainant's strong presence in China and the background introduced above, it is inconceivable that registration of the combination of the well-known, distinctive trademark NOVARTIS and the generic term "formulary" in the disputed domain name was not a deliberate and calculated attempt to improperly benefit from the Complainant's rights.

ii. THE DOMAIN NAME IS BEING USED IN BAD FAITH

The disputed domain name has been actively used in conjunction with a website displaying gambling information and linking to a gambling website. Taking into account the Complainant's renown, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other location by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or other location or of a product or service.

The Complainant has sought to contact the Respondent to induce the Respondent to cease this conduct, to no avail, from which an inference of bad faith may, in addition, be drawn, as previous Panels have found. The Respondent moreover sought to conceal its identity in its registration details.

RESPONDENT:

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 that 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 not satisfied that all procedural requirements under the UDRP were met by the Complainant in this case as concerns the language of the proceeding, as explained under the Principal Reasons for the Decision below.

However, on a balance of the factors in the circumstances of the case related to the Respondent, the Panel considers that it would nevertheless be inappropriate not to provide a Decision, again as explained below.

PRINCIPAL REASONS FOR THE DECISION

1. Procedural request for this proceeding to be conducted in another language than that of the registration agreement

Para. 11 of the UDRP Rules lays down that the language of the proceeding must be the language of the registration agreement, unless the Panel exercises its authority to change the language, having regard to the circumstances of the case.

The Complainant in this respect cites potential unfairness or delay to it if Chinese is used as the language of this proceeding.

Yet the Complainant – one of the largest pharmaceutical companies in the world – has a “strong presence” in China, a website in Chinese and 145 nationalities working for it, among whom a number will be Chinese-speaking. The Complainant can thus be presumed to be in a position to initiate this proceeding in the language of the registration agreement, Chinese. The Complainant was also aware that the website associated with the disputed domain name and the site(s) it linked to were in Chinese. So the Complainant should have been aware that, in a proceeding initiated in English, the Panel will not usually be able to scrutinize items of evidence in Chinese submitted by the Complainant, unless they are first reliably translated.

These considerations tend to militate against the Complainant’s request, although the Panel was in fact able to confirm visually from the evidence that the character of the websites referred to was as contended, namely, they clearly involved gambling.

As to the rest of the Complainant's argumentation:

- the inclusion of incidental English terms on the website associated with the disputed domain name.

Such snippets as the Complainant refers to are so widely copied and pasted that they can hardly be claimed to evidence of something as substantial as knowledge of any foreign language, and still less so when the elements of speech and writing vary so widely as between English and Chinese;

- reference to the facts of the Complainant being a “global company whose business language is English” and that the Novartis website is in English.

This contention appears to overlook the purpose of the language rule. For para. 11 of the Rules balances what is in effect the UDRP's extension of essentially national rights worldwide by providing an essential procedural protection to any domain name registrant who has chosen to enter obligations written in their own language.

- proof of the Respondent’s frequent and dubious registration of domain names of different kinds containing English words or names from mainly English-speaking contexts via a variety of registrars employing registration agreements in English.

. the connection between its pharmaceutical business and the generic word “formulary”.

The Panel thus discounts the first two of these arguments, but finds the latter two sufficiently compelling, together, in light of the following considerations:
- the provision by the Respondent of what appears to be contradictory postal address elements, so casting doubt on the Respondent’s compliance with the basic requirement of any registration agreement based on ICANN requirements to provide valid identification details;
- the registration by the Respondent of a large number of domain names governed mostly by registration agreements in English;
- the fact that the website associated with the disputed domain name has been taken down after the communications to the Respondent in respect of this proceeding were sent by the Case Administrator;
- as a subsidiary factor, the fact that formularies around the world are concerned with prescription drugs that will include some produced by the Complainant, thereby opening up the possibility that misuse of the disputed domain name, notably through e-mail advertising in at least the language used in that name, English, might be posing a risk to public health.

The Panel therefore decides that strong justification exists to change the language of this proceeding to English. It, however, underlines the importance of the language rule in para. 11 of the Rules as an essential procedural protection for registrants, which requires both the Complainant and an ADR provider normally to use the correct language, i.e. that of the registration agreement.

2. Application of the UDRP three-part cumulative test

The Panel finds that the Complainant has amply made out its case, to which the Respondent has not entered a Response.

In particular,

(1) the Complainant has evidenced its rights on the basis of its international trade mark, which is also registered in China, and through its documentation of the global nature of its pharmaceutical business and of the well-known nature of its brand, including in China;

(2) the disputed domain name is confusingly similar to the Complainant's trademark by reason of incorporation of the trademark in a <.com> registration as the dominant cognitive element, with the generic word “formulary” serving to suggest a medical source for the Complainant’s pharmaceutical products, especially prescription drugs;

(3) accepts the Complainant's contentions that the Respondent has no relation to the Complainant and that no legitimate basis exists otherwise for forming an association with the Complainant’s trade mark in the disputed domain name or with the word “novartis”;

(4) finds that the disputed domain name was registered in bad faith in order to exploit the Complainant’s well-known brand and that it was also used in bad faith in order to attract internet traffic for commercial gain, while the use of the domain name in email communication, though not asserted by the Complainant, poses a potential separate risk, produced in bad faith. This is evident to the Panel from comparison of the disputed domain with the type of domain names being amassed by the Respondent, as shown by the listing of domain names registered by the Respondent that was adduced by the

Complainant.

The Panel attaches no specific importance regarding the element of bad faith to either the lack of a response to the Complainant's attempts to communicate with the Respondent or the Respondent not having entered a Response, but considers neither circumstance to be due to merely linguistic factors.

On the basis of the above reasons, the Panel therefore upholds the Complaint and transfers the disputed domain name to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTISFORMULARY.COM**: Transferred

PANELLISTS

Name	**Kevin J. Madders**

DATE OF PANEL DECISION 2020-02-07

Publish the Decision