Decision for dispute CAC-UDRP-102819

Case number	CAC-UDRP-102819
Time of filing	2019-12-23 09:14:03
Domain names	novartis-live.com

Case administrator

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

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Organization	sicbon infotech inc.

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 several trademarks consisting either of the word element “NOVARTIS” alone or of composed trademarks in which “NOVARTIS” represents the main distinctive feature.

Some of the most relevant trademarks registered by the Complainant are as follows:

• Word EU trademark “NOVARTIS”, No. 000304857, registered in Classes 1,5,9,10,29,30,31,32 with priority date from July 5, 1996;

• Word EU trademark “NOVARTIS”, No. 013393641, registered in Classes 9,10 with priority date from October 22, 2014;

• International Registration of a word trademark “NOVARTIS”, No. 663765 in Classes 1;2;3;4;5;7; 8; 9; 10; 14; 16; 17; 20; 22; 28; 29; 30; 31; 32; 40 and 42, where China is one of the designated territories.

Moreover, the Complainant owns an important domain names portfolio containing the wording NOVARTIS, such as:

• <novartis.com> (registered in 1996);

• <novartis.net> (registered in 1998).

FACTUAL BACKGROUND

The Complainant is a multinational healthcare company based in Switzerland. Novartis was founded in 1996 and nowadays manufactures several well-known drugs which are commercialized worldwide. Its operations overs most of the important jurisdictions, including the EU, US and China.

No information is known about the Respondent who registered the disputed domain name <novartis-live.com> on November 11, 2019 under a privacy statement. The disputed domain name is not currently used in connection with any goods or services and resolves in error page.

In view of the above-mentioned, on November 18, 2019, the Complainant sent a cease and desist letter to the Respondent, via the Registrar's online contact form, and two subsequent reminders on December 2, 2019 and December 10, 2019. The Complainant has not received any response.

PARTIES CONTENTIONS

COMPLAINANT' CONTENTIONS:

Identical or confusingly similar

The Complainant argues that the disputed domain name <novartis-live.com> and the Complainant's registered trademarks NOVARTIS are confusingly similar.

The Complainant argues that its trademarks are fully contained within the disputed domain name and points out that the elements in which the signs vary, are generics and thus do not alter the overall confusion between the signs.

No rights or legitimate interests

The Complainant argues that there is no evidence at all that the Respondent is commonly known by the disputed domain name or a name corresponding to the disputed domain name, nor that the Respondent is making a bona fide offering of goods or services.

Moreover, the Complainant states that the Respondents have not been licensed or otherwise authorized to use any of the Complainant's trademarks nor to apply for or use any domain name incorporating such trademarks.

Registered and used in bad faith

As far as bad faith registration is concerned, the Complainant states due to its worldwide presence and considering that the Complainant's trademark are well known mark, the Respondents could not be unaware of the Complainant rights over the name NOVARTIS at the time of the disputed domain name registration.

Finally, the website at the disputed domain name is currently inactive and there is no evidence of it having ever been associated with any goods or services. The Complainant underlines that, although the domain name is not being actively used by the Respondent, passive holding may amount to bad faith use under certain circumstances, as in this case.

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 15 of the Rules states that the Panel shall decide a Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law deemed applicable.

In the case of default by a Party, Rule 14 states that if a Party, in the absence of exceptional circumstances, does not comply with a provision of, or requirement under the Rules, the Panel shall draw such inferences therefrom as appropriate.

In the present case, the Respondent has not submitted any Response and consequently has not contested any of the contentions made by the Complainant.

The Panel proceeds therefore to decide only on the basis of the Complainant's factual statements and the documentary evidences provided in support of them.

1. The first issue in this case concerns the language in which the UDRP proceeding can be conducted.

The Complainant argues that the Respondent understands English and that conducting the proceeding in English would avoid unwarranted delay. More specifically, the Complainant points out on the following circumstances:

- The disputed domain name includes a generic English term "live", which is closely related to the Complainant's business activities and is correctly spelt;

- The Respondent has put its organization's name in English as "sicbon infotech inc.";

- The Respondent has registered other domain names, among which the domain name "ihkcc.com" resolves to an active website which displays English terms such as "HOME" "ABOUT US" "SERVICE", etc.;

- The Complainant is a global company whose business language is English, and the main website operated by the Complainant is in English (see www.novartis.com).

The Rules for the Uniform Domain Name Dispute Resolution Policy (UDRP) dictate in the article 11 that the language for a

dispute proceeding:

(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.

(b) The Panel may order that any documents submitted in languages other than the language of the administrative proceeding be accompanied by a translation in whole or in part into the language of the administrative proceeding.

In deciding the appropriate language of the proceeding, the Panelists considers that the disputed domain name includes an English word element “LIVE” jointly with the Complainants business name and trademark “Novartis”; the Complainant operates worldwide and uses English as a principal language in its business; the Respondent’s business uses a corporate identifier “inc.” which is associated with English language and refers to “incorporation”.

Therefore, the Panel finds that all the above-mentioned factors in their conjunction are sufficient to establish that the Respondent understand English and considers reasonable to conduct the proceeding in English.

2. The Complainant is owner of a considerable number of trademarks whose common distinctive element is a particle “NOVARTIS”, which does not have any known meaning. Besides the EU protection, the trademark “NOVARTIS” have been registered by the Complainant in various non-EU countries, including the Respondent’s country of origin, China.

The disputed domain name <novartis-live.com> comprises of the distinctive element “NOVARTIS” which is followed by English word “LIVE", with lower distinctive character and the Top-Level domain “.com”.

Since the Complainant’s trademark is fully comprised within the disputed domain name and the additional elements have lower degree of distinctiveness, the Panel considers that the disputed domain name is confusingly similar to Complainant’s previously registered trademark.

The Panel accordingly concludes that paragraph 4(a)(i) of the Policy is satisfied.

3. The Respondent is not in any way related to the Complainant's business, and is not the agents of the Complainant. The Respondent is not currently known and has never been known as “NOVARTIS”, or any combination of this trademark.

The domain name <novartis-live.com> is not associated with any webpage. Therefore, the Respondent does not appear to have a legitimate interest in the disputed domain name.

Consequently, and in the absence of a Response, the Panelist finds that the Respondents have no rights or legitimate interests in the disputed domain name, so that the requirements of paragraph 4(a)(ii) of the Policy are met.

4. As to the bad faith at the time of the registration, the Panel finds that, in light of the distinctiveness of the Complainant’s trademark with which the disputed domain name is confusingly similar, and due to the worldwide presence of the Complainant’s business known under the name “NOVARTIS”, the Respondent was more likely be aware of the Complainant’s trademark at the time of the registration of the disputed domain name.

Furthermore, the Complainant notes that the disputed domain name does not resolve to any web site or other on-line presence, nor appears to have been used so far. In this regard, prior panels have discussed the passive holding of a Domain Names (e.g. in Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003) and found that the passive holding itself can constitute bad faith use.

The Panelist recalls that „the relevant issue is not whether the Respondent is undertaking a positive action in bad faith in relation to the domain name, but instead whether, in all the circumstances of the case, it can be said that the Respondent is acting in bad faith" (see Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003).

The particular circumstances of this case, allow the Panelist to infer that this is the case when the inactivity of the domain name holder could be considered as a bad faith use, given that:

(i) The Complainant's business name and trademark "NOVARTIS" has a strong reputation and is widely known, as evidenced by its substantial use in several countries including China;

(ii) The disputed domain name includes (as the only element which is different form the Complainant's trademark), the word "LIVE" which can be perceived as allusive to the healthcare and pharmaceutical industry;

(iii) The Respondent has taken active steps to hide its identity and has not reply to any of the Complainant's attempt of settlements;

(iv) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the disputed domain name.

Bearing in mind these circumstances, the Respondent can be deemed to have registered the disputed domain name for blocking purposes.

Under such circumstances, the Panel finds that the disputed domain name was registered in bad faith.

Accordingly, the Panel finds that the Complainant has satisfied 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. **NOVARTIS-LIVE.COM**: Transferred

PANELLISTS

Name	**JUDr. Hana Císlerová, LL.M.**

DATE OF PANEL DECISION 2020-02-07

Publish the Decision