

Decision for dispute CAC-UDRP-104655

Case number	CAC-UDRP-104655
Time of filing	2022-06-17 09:16:39
Domain names	corporacionnovartis.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	Novartis AG
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Complainant representative

Organization	BRANDIT GmbH
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Respondent

Organization	NOVARTIS CORP WEBSITE
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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 is the registered owner of several trademark registrations for NOVARTIS, e.g. International trademark no. 663765 "NOVARTIS", registered on July 1, 1996 and designating several countries worldwide; Peruvian trademark no. P00278838 "NOVARTIS", registered on May 8, 2019.

FACTUAL BACKGROUND

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

It results from the Complainant's undisputed allegations that it belongs to one of the biggest global pharmaceutical and healthcare groups, providing solutions to address the evolving needs of patients worldwide by developing and delivering innovative medical treatments and drugs. Its products are manufactured and sold in many regions worldwide including in Peru. The Complainant has an active presence in Peru where the Respondent is located, it owns subsidiary in Lima (Peru) and has been actively involved in development of innovative drugs for the local market.

The Complainant further contends its trademark NOVARTIS be distinctive and well-known all around the world.

The Complainant registered many domain names containing the term “NOVARTIS” or in combination with other terms, for example <novartis.com> (created on April 2, 1996) and <novartispharma.com> (created on October 27, 1999). The Complainant uses these domain names to connect to a website through which it informs about its NOVARTIS mark with related products and services.

The disputed domain name <corporacionnovartis.com> was created on April 28, 2022 and resolves to an inactive webpage.

Finally, the Complainant sent a cease and desist letter to the Respondent on May 6, 2022, requesting the transfer of the disputed domain name. The Respondent did not reply to it.

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.

Paragraph 11(a) of the Rules provides that “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”.

However, as noted by previous UDRP panels, paragraph 11 of the Rules must be applied in accordance with the overriding requirements of paragraphs 10(b) and 10(c) of the Rules that the parties are treated equally, that each party is given a fair opportunity to present its case and that the proceeding takes place with due expedition, see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Jurisprudential Overview 3.0”) at point 4.5.1. Accordingly, account should be taken of the risk that a strict and unbending application of paragraph 11 of the Rules may result in delay, and considerable and unnecessary expenses of translating documents.

The Center notified both parties of the potential language issue, inviting the Complainant to 1) either translate the complaint in Spanish; or 2) submit a supported request for English to be the language of the administrative proceedings.

On September 22, 2020, the Complainant submitted an Amended Complaint requesting that English be the language of the proceedings.

In the light of the above, the Center provided the Respondent in both English and Spanish with the Notification of Complaint and Commencement of Administrative Proceeding.

In deciding whether to allow the proceedings to be conducted in a language other than the language of the Registration

Agreement, the Panel must have regard to all “the relevant circumstances”. The factors that the Panel should take into consideration include whether the Respondent is able to understand in the language in which the Complaint has been made and would suffer no real prejudice, and whether the expenses of requiring translation and the delay in the proceedings can be avoided without at the same time causing injustice to the parties (see e.g. Carrefour SA v. Matias Barro Mares WIPO Case No. D2020-3088; Volkswagen AG v. Nowack Auto und Sport - Oliver Nowack, WIPO Case No. D2015-0070; SWX Swiss Exchange v. SWX Financial LTD, WIPO Case No. D2008-0400).

In the case at issue, this Panel considers that conducting the proceedings in English would not be disadvantageous to the Respondent, since it results from the Complainant’s undisputed allegations that the Respondent has demonstrated an ability to understand English, since the English terms “corp” – an abbreviation of the term “corporation” – and “website” are incorporated in the Respondent’s name (i.e. NOVARTIS CORP WEBSITE) and email address (i.e. novartiscorpwebsite@outlook.es). Moreover, the Respondent registered the disputed domain name under the generic Top-Level Domain “.com”. By choosing such very popular gTLD extension, the Respondent has aimed at targeting a global and broad audience of Internet users rather than Spanish speakers only. The Panel is therefore prepared to infer that the Respondent is able to understand English.

Furthermore, the Panel finds that substantial additional expense and delay would likely be incurred if the Complaint had to be translated into Spanish. The Panel is of the view that the language requirement should not cause any undue burden on the parties or undue delay.

Finally, the Panel notes that the Respondent did not object to the Complaint being in English, nor to the request made that the proceedings be conducted in English. The Respondent was given a fair opportunity to present his case, to raise objections as to the request for English to be the language of proceedings or to inform the Center on his language preference. He has however chosen not to comment on any of these issues, (e.g. Carrefour SA v. Matias Barro Mares WIPO Case No. D2020-3088; Volkswagen AG v. Nowack Auto und Sport - Oliver Nowack, WIPO Case No. D2015-0070; Volkswagen AG v. Song Hai Tao, WIPO Case No. D2015-0006).

Taking all these circumstances into account, this Panel finds that it is appropriate to exercise its discretion, according to paragraph 11(a) of the Rules and allow the proceedings to be conducted in English.

PRINCIPAL REASONS FOR THE DECISION

1. Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

It results from the evidence provided that the Complainant is the registered owner of several trademark registrations for NOVARTIS.

Prior UDRP panels have found that a disputed domain name is confusingly similar to a complainant’s trademark where the disputed domain name incorporates the complainant’s trademark in its entirety (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”) at section 1.7).

This Panel shares this view and notes that the Complainant’s registered trademark NOVARTIS is fully included in the disputed domain name, preceded by the generic and descriptive term “corporacion”, meaning “corporation” in Spanish). Furthermore, it is the view of this Panel that the addition of the term “corporacion” in the disputed domain name cannot prevent a finding of confusing similarity between the disputed domain name and the Complainant’s trademark since the Complainant’s trademark is clearly recognizable in the disputed domain name (see WIPO Overview 3.0 at section 1.8).

Finally, the generic Top-Level Domain (“gTLD”) “.com” of the disputed domain name may be disregarded under the first element confusing similarity test (see WIPO Overview 3.0 at section 1.11.1).

In the light of the above, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

2. Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent's rights or legitimate interests to the disputed domain name. In the Panel's view, based on the undisputed allegations stated above, the Complainant has made a prima facie case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

According to the Complaint, which has remained unchallenged, the Complainant has no relationship in any way with the Respondent and did, in particular, not authorize the Respondent's use of the trademark NOVARTIS, e.g. by registering the disputed domain name comprising the said trademark entirely.

Furthermore, the Panel notes that there is no evidence showing that the Respondent might be commonly known by the disputed domain name in the sense of paragraph 4(c)(ii) of the Policy.

Moreover, the Panel notes that the disputed domain name contains the Complainant's registered and well-known trademark NOVARTIS and that the trademark NOVARTIS is not a trademark that one would legitimately adopt as a domain name unless to suggest an affiliation with the Complainant. The Panel finds it most likely that the Respondent selected the disputed domain name with the intention to take advantage of the Complainant's reputation by registering a domain name fully containing the Complainant's trademark with the intent to attract Internet users for commercial gain (e.g., Bayer AG v. Privacy service provided by Withheld for Privacy ehf / farm construction, BAYERCROP POLAND, WIPO Case No. D2022-1043 Carrefour SA v. Matias Barro Mares, WIPO Case No. D2020-3088; Koc Holding A.S. v. VistaPrint Technologies Ltd, WIPO Case No. D2015-0886).

It is acknowledged that once the Panel finds a prima facie case is made by a complainant, the burden of production under the second element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name, see WIPO Overview 3.0 at section 2.1. Since the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds, in the circumstances of this case, that the Respondent has no rights or legitimate interests in the disputed domain name.

The Panel finds that the Complainant has therefore satisfied paragraph 4(a)(ii) of the Policy.

3. According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith.

Based on the evidence submitted by the Complainant, the Panel shares the view of other UDRP panels and finds that the Complainant's trademark NOVARTIS is widely known, e.g. Novartis AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org, / Sergei Lir, WIPO Case No. D2016-1688. Therefore, this Panel has no doubt that the Respondent positively knew or should have known that the disputed domain name consisted of the Complainant's trademark when registered the disputed domain name. Registration of the disputed domain name in awareness of the reputed NOVARTIS mark and in the absence of rights or legitimate interests in this case amounts to registration in bad faith (see e.g., Carrefour SA v. Matias Barro Mares, WIPO Case No. D2020-3088; Banca Mediolanum S.p.A. v. Domains By Proxy, LLC / Marzia Chiarello, WIPO Case No. D2020-1955).

The disputed domain name does not resolve to an active website. In this regard, the Panel notes that the passive holding does not preclude a finding of bad faith (see Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003). In fact, the further circumstances surrounding the disputed domain name's registration and use confirm the findings that the Respondent has registered and is using the disputed domain name in bad faith (see WIPO Overview 3.0 at section 3.3):

- (1) the Complainant's trademark NOVARTIS is widely known;
- (2) the Respondent's failure to reply to the cease and desist letter sent by the Complainant which made him aware of the NOVARTIS marks;

(3) the Respondent failed to submit a formal response or to provide any evidence of actual or contemplated good-faith use; and
(4) the implausibility of any good faith use to which the disputed domain name may be put.

In the light of the above, the Panel finds that the disputed domain name has been registered and is being used in bad faith pursuant to 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. **CORPORACIONNOVARTIS.COM**: Transferred

PANELLISTS

Name	Dr. Federica Togo
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DATE OF PANEL DECISION	2022-10-27
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Publish the Decision