

Decision for dispute CAC-UDRP-105123

Case number CAC-UDRP-105123

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Domain names novatismed.com

Case administrator

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

Complainant

Organization Novartis AG

Complainant representative

Organization BRANDIT GmbH

Respondent

Name Xiuzhi Gao

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 owner of numerous trademarks worldwide, including but not limited to the following:

- International Trademark Registration No. 666218 for NOVARTIS, registered on October 31, 1996;
- International Trademark Registration No. 663765 for NOVARTIS, registered on July 1, 1996;
- International Trademark Registration No. 1349878 for NOVARTIS, registered on November 29, 2016.

FACTUAL BACKGROUND

The Complainant, Novartis AG, is the holding company of the Novartis Group, which is one of the biggest global pharmaceutical and healthcare groups in the world. It focuses on developing and delivering innovative medical treatments and drugs. The Complainant's products are manufactured and sold in many regions around the world, including China. The Complainant has numerous offices in China and maintains a strong presence in China.

The Complainant states that it owns multiple domain names, consisting, inter alia, the NOVARTIS mark, such as <novartis.com> (created on April 2, 1996), <novartispharma.com> (created on October 27, 1999) and <novartis.us> (created on April 19, 2002).

The disputed domain name was registered by the Respondent on May 2, 2022 and resolves to an active page which has its name as "Novatis" displayed in a prominent position and appears to offer pharmaceutical goods and services.

The Complainant states that it sent the Respondent a cease-and-desist letter on December 14, 2022, as well as a reminder on January 14, 2022. However, to date, the Respondent has not responded.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

COMPLAINANT:

The Complainant contends that the disputed domain name is confusingly similar to the NOVARTIS mark on the basis that the disputed domain name which consists of a typo of the Complainant's mark by and adds a generic suffix which are insufficient to avoid the finding that the disputed domain name is confusingly similar to its NOVARTIS mark.

The Complainant also argues that the Respondent does not have any rights or legitimate interests in the disputed domain name. The Respondent has not acquired any rights in a trademark or trade name corresponding to the disputed domain name. In addition, the Respondent is not affiliated with the Complainant nor did the Complainant license or authorize the Respondent to use the NOVARTIS mark.

The Complainant further asserts that the disputed domain name has been registered and is being used in bad faith as the Respondent knew of the Complainant's NOVARTIS mark at the time of registration of the disputed domain name and registered the domain with the intent to target the trademark. The Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant and its mark.

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.

Preliminary Issue: Language of Proceedings

Paragraph 11 of the Rules provides that:

"(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."

The language of the Registration Agreement for the disputed domain name is Chinese.

The Complainant requested that the language of the proceeding be English for the following reasons:

- neither the Complainant nor its representatives understand Chinese;
- the disputed domain name is in Latin characters and include the English term, "med", a common abbreviation of 'medical' or

'medicine';

- the disputed domain name resolves to an active page in the English language;
- requiring the Complainant to translate the Complaint would incur additional costs and cause unnecessary delays.

The Respondent did not comment on the language of the proceeding.

The Panel cites the following with approval: "Thus, the general rule is that the parties may agree on the language of the administrative proceeding. In the absence of this agreement, the language of the Registration Agreement shall dictate the language of the proceeding. However, the Panel has the discretion to decide otherwise having regard to the circumstances of the case. The Panel's discretion must be exercised judicially in the spirit of fairness and justice to both parties taking into consideration matters such as command of the language, time and costs. It is important that the language finally decided by the Panel for the proceeding is not prejudicial to either one of the parties in his or her abilities to articulate the arguments for the case." (See *Groupe Auchan v. xmxzl*, WIPO Case No. DCC2006-0004).

Having considered the above factors, the Panel determines that English be the language of the proceeding. The Panel agrees that the Respondent appear to be familiar with the English language, taking into account the Respondent's selection of the English-language trademark and the domain name in dispute. In the absence of an objection by the Respondent, the Panel does not find it procedurally efficient to have the Complainant translate the Complaint and evidence into Chinese.

PRINCIPAL REASONS FOR THE DECISION

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a complainant to show that a domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. The Complainant has provided evidence that it owns numerous trademark registrations of the NOVARTIS mark.

The differences between the disputed domain name and the Complainant's NOVARTIS trademark are omission of the letter 'r', the addition of the term "med" and the TLDs ".com", which in the Panel's view does not avoid confusing similarity with the Complainant's trademark.

It is established that where a trademark is recognizable within the disputed domain name, the addition of a descriptive term would not prevent a finding of confusing similarity under the first element. (See WIPO Overview 3.0, section 1.8).

Further, in this case, the addition of the descriptive term "med", which is a common abbreviation of the term 'medical' or 'medicine' is related to and descriptive of the Complainant's business activities which increases the likelihood of confusion.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the NOVARTIS mark and the element under paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires the complainant to show that the respondent has no rights or interests in respect of the domain name. Once the complainant establishes a prima facie case that the respondent lacks rights or legitimate interests in the domain name, the burden of production shifts to the respondent to show that it has rights or legitimate interests in respect to the domain name (see WIPO Overview 3.0, section 2.1).

In the present case, the Complainant has demonstrated prima facie that the Respondent lacks rights or legitimate interests in respect of the disputed domain name and the Respondent has failed to assert any such rights or legitimate interests.

The Complainant submitted evidence that it did not authorize or license the Respondent to use the NOVARTIS mark (see *OSRAM GmbH. v. Mohammed Rafi/Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org*, WIPO Case No. D2015-1149; *Sanofi-Aventis v. Abigail Wallace*, WIPO Case No. D2009-0735). The Complainant also submitted evidence that its registrations and use of the trademarks predate the registration of the disputed domain name by at least 26 years.

In addition, the evidence submitted by the Complainant shows that the Respondent is not commonly known by the disputed domain name.

The Complainant provided evidence that the disputed domain name resolves to a webpage which displays the "NOVATIS" mark prominently and offers what appear to be goods and services which compete with those of the Complainant's. A respondent's use of a complainant's mark to redirect users (e.g., to a competing site) would not support a claim to rights or legitimate interests (see WIPO Overview 3.0 section 2.5.3).

The Panel also notes that in the present case, the addition of the term “med” is within the Complainant’s field of commerce or indicating goods and services related to the brand, as the Complainant is well-known in the pharmaceutical industry, which may trigger an inference of affiliation with the Complainant even though the Respondent is in no way affiliated with the Complainant (see WIPO Overview 3.0, section 2.5.1).

The Respondent did not submit a response in the present case and did not provide any explanation or evidence to show rights or legitimate interests in the disputed domain name which is sufficient to rebut the Complainant’s prima facie case.

The Panel is therefore of the view that the Respondent has no rights or legitimate interests in respect of the disputed domain name and accordingly, paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

The complainant must show that the respondent registered and is using the disputed domain name in bad faith (Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy provides circumstances that may evidence bad faith under paragraph 4(a)(iii) of the Policy.

In this case, the evidence shows that the Complainant’s mark has attained such goodwill and reputation such that the Respondent is unlikely to have registered the disputed domain name without sight and knowledge of the Complainant’s mark and it is implausible that there is any good faith use to which the disputed domain name may be put to. It is also the Complainant’s evidence that the Respondent could not have registered the disputed domain name without prior knowledge of the Complainant’s mark as the Respondent’s name has no connection with the Complainant’s NOVARTIS mark which was registered long ago.

Further, the disputed domain name incorporates a typosquatting variations of the Complainant’s NOVARTIS mark which the Panel finds is an attempt by the Respondent to confuse and/or mislead Internet users seeking or expecting the Complainant. This involves a single letter typo or add a single letter typo in the Complainant’s mark. Previous UDRP panels ruled that in such circumstances “a likelihood of confusion is presumed, and such confusion will inevitably result in the diversion of Internet traffic from the Complainant’s site to the Respondent’s site” (see *Edmunds.com, Inc v. Triple E Holdings Limited*, WIPO Case No. D2006-1095). To this end, prior UDRP panels have established that attracting Internet traffic by using a domain name that is identical or confusingly similar to create a likelihood of confusion with a registered trademark may be evidence of bad faith under paragraph 4(b)(iv) of the Policy. Further, the Complainant has submitted evidence which shows that the Respondent registered the disputed domain name long after the Complainant registered the NOVARTIS trademark. Given the evidence presented to the Panel, the Panel finds that it is highly likely that the Respondent was aware of the Complainant and its NOVARTIS trademark at the time of registering the disputed domain name and specifically targeted the Complainant and its goodwill.

Having regard to the above factors in the particular circumstances of the present case whereby the Complainant’s NOVARTIS mark is sufficiently distinctive, the Respondent has failed to submit a Response, it is implausible to put any good faith use to the disputed domain name.

Based on the evidence presented to the Panel, as presented and discussed above, the Panel draws the inference that the disputed domain name was registered and is being 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. **novatismed.com**: Transferred

PANELLISTS

Name	Jonathan Agmon
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DATE OF PANEL DECISION **2023-03-08**

Publish the Decision
