

Decision for dispute CAC-UDRP-105186

Case number	CAC-UDRP-105186
Time of filing	2023-02-08 08:51:26
Domain names	novartisbio.net, check-novartisbio.com

Case administrator

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

Organization	Novartis AG
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Complainant representative

Organization	BRANDIT GmbH
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Respondent

Name	Pierre Marione
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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 names.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the well-known trademark "NOVARTIS" registered as both a word and device mark in several classes worldwide, including Cyprus. The Complainant has adduced evidence of its extensively portfolio of registered trademarks, most of them predates the registrations of the disputed domain names.

Specifically, the Complainant's trademark registration applying to this proceeding include the following trademark registrations:

- **EU Trademark: NOVARTIS.** no: 013393641. Reg. date: March 13, 2018;
- **EU Trademark: NOVARTIS.** no: 000304857. Reg. date: June 28, 2018;
- **Cyprus Trademark: NOVARTIS.** no: 45686. Reg. date: November 10, 2000;

The Complainant also owns numerous domain names composed of either its "NOVARTIS" mark alone or in combination with other terms. For example,

- <novartis.us> created on April 19, 2002;
- <novartis.com> created on April 2, 1996;
- <novartispharma.com> created on October 27, 1999.

The Complainant uses these domain names to resolve to its official websites through which it informs Internet users and potential

consumers about its “NOVARTIS” mark and its related products and services.

FACTUAL BACKGROUND

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.

The Complainant was created in 1996 through a merger of two other companies Ciba-Geigy and Sandoz, and is the holding company of the Novartis Group. Its headquarter is in Switzerland.

The Complainant’s products are manufactured and sold in many countries worldwide, including in Cyprus. The Complainant has especially an active presence in Cyprus where the Respondent is located. It operates via its office in Nicosia as well as taking active part in different projects in Cyprus.

The Complainant uses its domain names to promote the NOVARTIS mark with related products and services. It also enjoys a strong presence online via its social media platforms.

The disputed domain name <check-novartisbio.com> was registered on January 3, 2023, and the disputed domain name <novartisbio.net> was registered on January 3, 2023.

PARTIES CONTENTIONS

Complainant's contentions are summarised below.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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).

The Complainant contends that the disputed domain names are confusingly similar to the Complainant’s trademark “NOVARTIS” as follows:

- The disputed domain name <check-novartisbio.com> incorporates the Complainant’s registered trademark “NOVARTIS” entirely along with the relevant term “bio” directly referring to the business of the Complainant preceded by the term “check” and gTLD “.com”;
- The disputed domain name <novartisbio.net> incorporates the Complainant’s registered trademark “NOVARTIS” entirely along with the relevant term “bio” directly referring to the Complainant and their business along with gTLD “.net”.

The term “bio” is a known abbreviation of “biology/biological” and the Complainant contends that it is descriptive of its activities being the leading pharmaceutical and biotechnology innovation organization committed to discovering innovative medicines and solutions.

The Panel accepts that the “NOVARTIS” trademark is well-known. In the present case, the “NOVARTIS” trademark is clearly recognizable within the disputed domain names. The mere addition of descriptive terms “check” and “bio” in the respective disputed domain names would not prevent a finding of confusing similarity to the trademark “NOVARTIS”. See *Novartis AG v. Black Roses*, CAC Case No. 102137; Paragraph 1.8 WIPO Jurisprudential Overview 3.0.

It is also trite to state that the addition of the gTLD “.COM” does not add any distinctiveness to the disputed domain names and will be disregarded for the purposes of considering this ground.

The Panel considers that the disputed domain names are confusingly similar to the Complainant’s trademark “NOVARTIS” and this ground is made out.

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 names (within the meaning of paragraph 4(a)(ii) of the Policy).

A complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such a prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name.

If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. See WIPO Case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.

The Complainant contends that the Respondent has no rights in the disputed domain names, and that they have never had any previous relationship, nor has the Complainant ever granted the Respondent with any rights to use the "NOVARTIS" trademark in any form, including the disputed domain names.

In support of its contentions, the Complainant asserts the following matters:

- It has not found that the Respondent is commonly known by the disputed domain names, nor that Respondent has legitimate interest over the disputed domain names.
- When searching for the terms <check-novartisbio.com> and <novartisbio.net> in the Google search engine, the search results point to the Complainant and its business activities.
- When searching for the name of the Respondent "Pierre Marione" along with the terms of the disputed domain names there are no returned results showing that the Respondent is known by the disputed domain names. The only mention that points the Respondent to the trademark Novartis is another domain name dispute proceeding regarding the domain name <novartis-bio.eu> that the Complainant raised in 2021 before Czech Arbitration Court.

The Complainant contends that the Respondent should have already performed similar searches before registering the disputed domain names and it would have quickly learnt that the trademark "NOVARTIS" is owned by the Complainant and that the Complainant has been using its trademark in many countries worldwide.

The evidence also shows that at the time of filing of this Complaint the disputed domain names do not resolve to any active content. The Panel accepts that this indicates, at first instance, the disputed domain names have not been used in connection with bona fide offering of goods or services. There is also no "evidence that the Respondent engages in, or has engaged in any activity or work, i.e., legitimate or fair use of the disputed domain names, that demonstrates a legitimate interest in the disputed domain name". See *Bollore v. Tywonnia W Hill*, WIPO Case No. DCO2017-0012.

No challenge has been made by the Respondent to the Complainant's contentions and assertions as it has not filed any administrative compliant response.

Given the evidence adduced by the Complainant of its extensive portfolio of trademarks and wide business networks which the Panel accepts as evidencing the strength of its reputation, the Panel accepts and finds that the Respondent has no rights or legitimate interests to the disputed domain names.

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

There are two elements that must be satisfied – registration and use in bad faith.

Registration in bad faith

The evidence shows, and the Panel accepts, that the Complainant's trademark "NOVARTIS" is well-known all around the world. The Complainant's trademark was clearly registered prior to the registration of the disputed domain names. In addition, the Complainant has never authorized the Respondent to use the "NOVARTIS" trademark nor to register the disputed domain names.

Given the Complainant's world-wide reputation, it is highly unlikely that the Respondent did not know of the Complainant's trademark "NOVARTIS" and its business when it registered the disputed domain names. On the contrary, the Panel accepts that the Respondent would have inevitably learnt about the Complainant, its trademark, and its business even by conducting a simple online search. See *Teamreager AB v. Muhsin E.Thiebaut, Walid Victor*, WIPO Case No. D2013-0835, *Amundi Asset Management v. tang xiao ming*, WIPO Case No. D2019-2744.

The Panel accepts that the inclusion of the terms "check" and "bio" relates to the Complainant's business along with incorporating the trademark "NOVARTIS" within the disputed domain names are strong indicators of bad faith registration.

The Panel draws the adverse inference that the Respondent is most likely intentionally trying to confuse consumers by creating a similarity between the disputed domain names and the Complainant. By doing so, the Respondent is seeking to benefit from the Complainant's established reputation and potentially harm their business by diverting traffic to a different website. This conduct not only violates the Complainant's trademark rights, but also demonstrates a lack of good faith in the registration of the disputed domain names. Thus, the addition of terms relating to the Complainant's business to the trademark "NOVARTIS" in the disputed domain names is a clear sign of registration in bad faith.

The Complainant also refers to the history of the Respondent targeting the Complainant before the registration of the disputed domain names, which the Complainant contends, shows that the Respondent was well aware of the Complainant and its trademark.

The Panel considers that prior proceedings between a complainant and respondent in respect of similar allegations while not strictly relevant to the issues in dispute are highly probative in determining the motivation of a respondent in registering a disputed domain

name that incorporates a complainant's trademark.

Here, Complainant raised three other complaints against the Respondent. Namely,

- On November 3, 2022 the Complainant filed UDRP complaint against Respondent regarding the domain name <novartis-bio.info> CAC Case No. CAC-UDRP-104971. In the mentioned case the Respondent was actively using the domain name displaying Complainant's trademark, mentioning contact information as Novartis – Bio, Switzerland EU, impersonating the Complainant. The Complainant was successful in the proceedings and the domain name was transferred to the Complainant;
- On June 2, 2022 the Complainant filed .eu ADR complaint against Respondent regarding the domain name <novartis-bio.eu> CAC Case. No. CAC-ADREU-008361. In the mentioned case the disputed domain name was resolving to an active page offering for sale unauthorized pharmaceutical products bearing Complainant's trademarks Novartis® and offering to "validate" the authenticity of the products. Following takedown complaint by the Complainant the content was removed. The Complainant was successful in the proceedings and the domain name was transferred to the Complainant;
- Lastly, the Complainant also filed ADR complaint against Respondent regarding the domain name <novartisbio.eu>, CAC Case No. CAC-ADREU-008480. The Registrar verified that that the Respondent is the same.

The Panel draws the adverse inference that the Respondent registered the disputed domain names incorporating the trademark "NOVARTIS" and with the addition of terms directly relating to the Complainant's business intentionally, in order to take advantage of reputation of the trademark "NOVARTIS" and the Complainant's goodwill.

Use in bad faith

The non-use of a domain would not prevent a finding of bad faith. See section 3.3 of WIPO Jurisprudential Overview 3.0. It is also open for a panel, in certain circumstances, to find that inactivity by a respondent to amount to the domain name being used in bad faith. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003.

Here, the evidence also shows that the disputed domain names are passively held. They do not resolve to active websites. The Respondent has not filed an administratively compliant response to the Amended Complaint.

Accordingly, the Panel draws the inference that there is no evidence of any actual or contemplated use of the disputed domain names in good faith. See *British Airways Plc. v. David Moor*, WIPO Case No. D2006-1224; *Boehringer Ingelheim Pharma GmbH & Co.KG v. Raju Khan*, CAC Case No. 101517.

Further, the evidence that the trademark "NOVARTIS" is incorporated within the disputed domain names along with the terms "bio" and "check" is irrefragable proof of use in bad faith by the Respondent.

The Complainant also asserts that the Respondent has a pattern of abusive domain name registrations incorporating trademarks of the Complainant and contends that the Respondent is intentionally targeting the Complainant and disrupting its business. While these assertions are made, there is no evidence adduced that the Complainant's business is being disrupted. As the Panel has found that the element of use in bad faith is satisfied in respect of each of the disputed domain names, it is unnecessary for the Panel to express any further views on this contention.

Accordingly, the Panel accepts that the disputed domain names were registered by the Respondent and used in bad faith.

PROCEDURAL FACTORS

Language of proceedings request

The Complainant requests that the English language should be the language of the proceeding. While the Respondent's seat or residence appears to be in Tochn, Cyprus, the language of the Registration Agreement of the disputed domain names is English.

Rule 11(a) of the UDRP rules states:

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.

In conducting the administrative proceeding, the Panel is required to ensure under Rule 10 of the UDRP rules that the Parties are treated with equality and be given a fair opportunity to present its case.

The Respondent has not filed any administratively compliant response to the Complainant's Amended Complaint.

In the circumstances, the Panel accepts the Complainant's request and considers that it is appropriate to proceed to determine the proceeding in the English language.

Notification of proceedings to the Respondent

When forwarding a Complaint, including any annexes, electronically to the Respondent, paragraph 2 of the Rules states that CAC shall employ reasonably available means calculated to achieve actual notice to the Respondent.

Paragraphs 2(a)(i) to (iii) set out the sort of measures to be employed to discharge CAC's responsibility to achieve actual notice to the Respondent.

On March 14, 2023 the CAC by its non-standard communication stated as follows (omitting irrelevant parts):

- That neither the written notice of the Complaint nor the advice of delivery thereof was returned to the Czech Arbitration Court.
- As far as the e-mail notice is concerned, CAC received a notification that the e-mail notices sent to postmaster@novartisbio.net and to postmaster@check-novartisbio.com was returned back as undelivered. The e-mail notice was also sent to novartisbio@safe-mail.net, but the CAC never received any proof of delivery or notification of undelivery.
- No further e-mail address could be found on the disputed site.
- The Respondent never accessed the online platform.

Given the reasonable measures employed by CAC as set out in the above non-standard communication, 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

The Complainant owns the international trademark "NOVARTIS" and the domain name <novartis.com> and others which are used in connection with its goods or services.

The Respondent registered the disputed domain name <check-novartisbio.com> on January 3, 2023 and the disputed domain name <novartisbio.net> on January 3, 2023. The disputed domain names are passively held and are not resolving to any active websites.

The Complainant challenges the Respondent's registration of the disputed domain name under paragraph 4(a)(i) of the Uniform Dispute Resolution Policy ("Policy") and seeks relief that the disputed domain name be transferred to the Complainant.

The Respondent failed to file any administratively compliant response.

The Respondent also has a history of registering domain names that incorporate the Complainant's trademark "NOVARTIS" that prompted several proceedings to be taken against the Respondent. While evidence of previous proceedings brought against the same respondent are not strictly relevant to the issues in dispute, such evidence is highly probative in determining the motivation of a respondent in registering a disputed domain name that incorporates a complainant's trademark.

For the reasons articulated in the Panel's reasons above, the Complainant has satisfied the Panel of the following:

- (a) The disputed domain names are confusingly similar to the Complainant's well-known trademark "NOVARTIS";
- (b) The Respondent has no rights or legitimate interests in respect of the disputed domain names;
- (c) The disputed domain names have been registered and are 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. **novartisbio.net**: Transferred
2. **check-novartisbio.com**: Transferred

PANELLISTS

Name	William Lye OAM KC
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DATE OF PANEL DECISION 2023-03-15

Publish the Decision
