

Decision for dispute CAC-UDRP-105120

Case number	CAC-UDRP-105120
Time of filing	2023-03-15 09:54:50
Domain names	novartis-pharmaceutical.org

Case administrator

Name	Olga Dvořáková (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	Chartrand!NOVARTIS
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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 submitted evidence that it is the owner of the following trademarks:

- The US combined trademark "NOVARTIS", application number 97236683, registration number 6990442, filed on 25 January 2022, registered on 28 February 2023, valid in the US for a list of goods and services in class 5.
- The US combined trademark "NOVARTIS", application number 86063136, registration number 4986124, filed on 12 September 2013, registered on 28 June 2016, valid in the US for a list of goods and services in classes 5, 9, 10, 41, 42 and 44.
- The US combined trademark "NOVARTIS", application number 75131409, registration number 2336960, filed on 9 July 1996, registered on 4 April 2000, valid in the US for a list of goods and services in class 5.
- The US combined trademark "NOVARTIS", application number 79209927, registration number 5420538, filed on 29 November 2016, registered on 13 March 2018, valid in the US for a list of goods and services in classes 9, 10, 41, 42, 44.

Hereinafter the "Trademarks".

FACTUAL BACKGROUND

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

The Complainant claims to be an international pharmaceutical and healthcare group. The Complainant states its products are manufactured and sold in many countries worldwide. The Complainant also states it has an active presence in several countries around the globe through its subsidiaries and associated companies. The Complainant specifies that it has a local presence in the U.S., where the Respondent is located.

The Complainant provided evidence that it is the registered owner of the Trademarks and several domain names including the term "Novartis" such as <novartis.com> since 2 April 1996 and <novartispharma.com> since 27 October 1999.

The Complainant also provided evidence that it has a strong presence online via its social media platforms (Facebook, Twitter, Instagram).

The disputed domain name <novartis-pharmaceutical.org> was registered on 15 November 2022.

PARTIES CONTENTIONS

Complainant's contentions are summarised in the PRINCIPAL REASONS FOR THE DECISION section.

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

Confusing similarity

The disputed domain name <novartis-pharmaceutical.org> consists of the word element of the Complainant's Trademarks "NOVARTIS" with the addition of a hyphen and the English term "PHARMACEUTICAL".

According to the Complainant, the addition of a hyphen and the word "PHARMACEUTICAL" is not sufficient to avoid a likelihood of confusion with the Complainant's registered Trademark. The Complainant argues that the mere addition of a descriptive or generic term does not prevent a finding of confusing similarity to a trademark. Moreover, the Complainant stresses that the term "pharmaceutical" refers to the Complainant and its business. Furthermore, the Complainant argues that the gTLD ".com" may be disregarded when assessing whether the disputed domain name is confusingly similar to the Trademarks.

The Panel notes that the disputed domain name <novartis-pharmaceutical.org> incorporates the entirety of the Complainant's "NOVARTIS" Trademark (at least the word element of the Trademark), with the addition of a hyphen and the English term "PHARMACEUTICAL".

The Panel remarks that Section 1.7 of WIPO Overview 3.0, clearly states that, "in cases where a domain name contains the whole of

a trademark, or where at least one dominant feature of the relevant trademark is recognisable in the domain name, the domain name shall normally be considered confusingly similar to that trademark for the purposes of UDRP status".

The Panel finds that the addition of the term "PHARMACEUTICAL" does not prevent a finding of confusing similarity under the first element of paragraph 4(a) of the Policy, since it is a pure descriptive term. The addition of the hyphen is purely for readability and does not affect this finding.

This is supported by section 1.8 of WIPO Overview 3.0, which clearly states: "Where the relevant mark is recognisable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless or otherwise) would not preclude a finding of confusing similarity under the first element".

It is well-established that the gTLD ".com" may be disregarded when it comes to considering whether a domain name is confusingly similar to a trademark in which the Complainant has rights. Moreover, section 1.11.1 of WIPO Overview 3.0 clearly states: "The applicable Top Level Domain ("TLD") in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test."

For these reasons, the Panel concludes that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

Rights or legitimate interests

As regards paragraph 4(a)(ii) of the Policy, while the overall burden of proof rests with the Complainant, it is commonly accepted that this should not result in an often-impossible task of proving a negative. Therefore, numerous previous panels have found that the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to come forward with such appropriate allegations or evidence, the Complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy. If the Respondent does come forward with some allegations or evidence of relevant rights or legitimate interests, the Panel then must weigh all the evidence, with the burden of proof always remaining on the Complainant.

The Complainant argues that:

- The Respondent has no rights or legitimate interests in respect of the domain name and is not related in any way to the Complainant's business.
- The Respondent is not commonly known by the disputed domain name. On the contrary, when conducting a search on Google with the terms "novartis-pharmaceutical", the search results all lead to the Complainant. Moreover, when conducting a search in open trademark databases, the Respondent does not seem to have any trademarks, let alone trademarks containing the terms "NOVARTIS" or "PHARMACEUTICAL".
- The disputed domain name is not actively used by the Respondent, therefore there it is not being used in connection with bona fide offering of goods and services.

The Respondent did not file an administratively compliant (or any) response. The Respondent did not provide evidence that it has rights or legitimate interests in the disputed domain name.

The Panel finds that the Respondent does not appear to have any rights or legitimate interests in the disputed domain name from the following facts:

- There is no evidence that the Respondent is or has been commonly known, by the disputed domain name or by the term "NOVARTIS". The Respondent did not show to have any trademark rights or other rights regarding the term "NOVARTIS".
- The Complainant's Trademarks were registered and have been used well before the registration date of the disputed domain name. The disputed domain name was registered on 15 November 2022, whereas most of the Trademarks of the Complainant were registered well before.
- There is no evidence that shows that the Respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers.
- The Respondent does not seem to have any consent or authorisation to use the Trademarks and does not seem to be related in any way to the Complainant.

In sum, on the balance of probabilities, and in the absence of any evidence to the contrary or any administratively compliant response being put forward by the Respondent, the Panel finds that the Complainant has made a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Panel concludes that the Respondent does not have rights or legitimate interests in the disputed domain name.

Bad faith

The Complainant argues that:

- The registration of the Trademarks pre-date the registration of the disputed domain name. The Complainant repeats that the Respondent has never been authorized by the Complainant to use its Trademarks. The Complainant is of the opinion that the

Respondent can be assumed to know the Complainant, its business, and its Trademarks.

- The combination of the Trademarks "NOVARTIS" and the term "PHARMACEUTICAL" creates a direct association with the Complainant and its business since the Complainant develops and delivers pharmaceuticals worldwide. The Complainant claims that the Respondent has used the disputed domain name <novartis-pharmaceutical.org> to intentionally confuse consumers by creating a similarity between the disputed domain name and the Complainant.
- Since the disputed domain name is passively held, there is no evidence of any actual or contemplated good-faith use of the disputed domain name.
- The Respondent chose not to reply to the cease-and-desist letter of the Complainant. The Complainant states that this infers bad faith.

The Panel weighs these arguments and facts as follows:

- As mentioned already, the disputed domain name reproduces the word element (i.e., the dominant element) of the Complainant's Trademarks "NOVARTIS" entirely, with the addition of the generic word "PHARMACEUTICAL". These combined terms clearly refer to the Complainant and its business, and thereby causes confusion among the public.
- (Most of) the Complainant's Trademarks predate the registration of the disputed domain name.
- It is inconceivable that the Respondent would have come up with a domain name consisting of the term "NOVARTIS" in combination with the term "PHARMACEUTICAL" without having prior knowledge of the Complainant and its Trademarks and activities. On the balance of probabilities, it seems evident that the Respondent had knowledge of the existence of the Complainant and its activities, and of the existence of the Complainant's Trademarks and the scope of the Trademarks at the time of registration and use of the disputed domain name. The Panel is convinced that the Respondent had the Trademark(s) of the Complainant in mind when registering the disputed domain name.
- The Respondent did not contest any of the Complainant's arguments and did not provide any explanation concerning its choice for registering and/or using a domain name that includes the word element (dominant element) of the Complainant's registered Trademarks in combination with the generic word "PHARMACEUTICAL". The Respondent did not answer to the cease-and-desist letter of the Complainant.

Given the above elements, the Panel concludes that the disputed domain name is being used for the purpose of misleading internet users. There is no evidence whatsoever of any bona fide offering of goods or services. The disputed domain name was registered and is being used in bad faith within the meaning of 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-pharmaceutical.org** : Transferred

PANELLISTS

Name	Bart Van Besien
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DATE OF PANEL DECISION **2023-04-19**

Publish the Decision
