

Decision for dispute CAC-UDRP-105429

Case number	CAC-UDRP-105429
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Time of filing	2023-05-10 10:11:56
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Domain names	novartis-shop.com
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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

Name	Xue Chun
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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 owner of the well-known trademark NOVARTIS registered as both a word and device mark in several classes worldwide, including China. The vast majority of the Complainant's trademark registrations significantly predates the registration of the Disputed Domain Name. Namely, the Complainant's trademark registrations in China applying to the present proceedings include the following earlier rights:

Overview of trademark registrations:

Trademark: NOVARTIS

Reg. No: IR 666218

Class: 41; 42

Date of Registration: 31.10.1996 (designating China)

Trademark: NOVARTIS

Reg. No: IR 663765

Class: 01; 02; 03; 04; 05; 07; 08; 09; 10; 14; 16; 17; 20; 22; 28; 29; 30; 31; 32; 40; 42

Date of Registration: 01.07.1996 (designating China)

Trademark: NOVARTIS

Reg. No: IR 1349878

Class: 09; 10; 41; 42; 44; 45

Date of Registration: 29.11.2016 (designating China)

FACTUAL BACKGROUND

The Complainant owns numerous trademarks NOVARTIS which were registered many years before the registration of the Disputed Domain Name, which, according to the publicly available WHOIS records, was registered on March 11, 2023.

The Complainant found out about the registration of the Disputed Domain Name and sent a Cease and Desist Letter on March 20, 2023. The Cease and Desist Letter has been sent via on-line form as provided by the Registrar – Gname 009 inc as well as via the abuse contact of the Registrar. There was no response from the Respondent.

The Disputed Domain Name resolves to an active website apparently related to betting and gaming which is likely to generate commercial gain when Internet users click on the links displayed therein.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.

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).

The Disputed Domain Name, in its second level portion, incorporates the trademark NOVARTIS in its entirety and, separated by the hyphen, the term “shop”.

The NOVARTIS trademark is clearly recognizable within the Disputed Domain Name. Previous UDRP Panels have constantly held that the mere addition of a descriptive or generic term would not prevent a finding of confusing similarity to a trademark (see *Novartis AG v. Black Roses*, CAC Case No. 102137 and *Accenture Global Services Limited v. Mark Henry*, WIPO Case No. D2020-1691).

WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Jurisprudential Overview 3.0”) 3.0 para. 1.8 states: “Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements”.

The incorporation of a Complainant's well-known trademark in the registered domain name is considered sufficient to find the domain name confusingly similar to the Complainant's trademark (see *Quixtar Investments, Inc. v. Smithberger and QUIXTAR-IBO*, WIPO Case No. D2000-0138 and *Ansell Healthcare Products Inc. v Australian Therapeutics Supplies Pty, Ltd.*, WIPO Case No. D2001-0110).

The presence of the generic Top-Level Domain (“gTLD”) extension “.com” in the first level portion of the Disputed Domain Names is a standard registration requirement and may be disregarded when assessing whether the disputed domain name is confusingly similar to the trademark in which the Complainant has rights (see *Rollerblade, Inc. v. Chris McCrady*, WIPO Case No. D2000-0429; *Can Pro Pet Products LTD. v. Matthew Dweck*, WIPO Case No. D2020-0615; *Sanofi v. Aamir Hitawala*, WIPO Case No. D2021-1781).

The Disputed Domain Name is therefore confusingly similar to the Complainant’s NOVARTIS trademark.

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).

The Complainant and the Respondent have never had any previous relationships, nor has the Complainant ever granted the Respondent with any rights to use the NOVARTIS trademark in any form, including in the Disputed Domain Name.

The Complainant has not found that the Respondent is commonly known by the Disputed Domain Name or that it has a legitimate interest over the Disputed Domain Name. When searched for “**novartis-shop**” or “**novartis-shop.com**” in the Google search engine, the search results are pointed to the Complainant, their business activities.

When searched for the name of the Respondent “Xue Chun” along with the terms of the Disputed Domain Name <novartis-shop.com> or <novartis shop> there are no returned results showing that the Respondent is known by the Disputed Domain Name.

When searching for any trademarks incorporating the terms “novartis-shop.com” in the open Global Brand Database of WIPO there are no relevant results. In return, all the return results are pointed at numerous trademark registrations of the Complainant. When searching for any trademarks owned by the Respondent “Xue Chun” in WIPO’s Madrid Monitor system there are not returned results

The Respondent should have already performed a similar search before registering the Disputed Domain Name and should have quickly learnt that the trademarks are owned by the Complainant and that the Complainant has been using its trademarks in many countries worldwide.

At the time the Complainant found out about the Disputed Domain Name (March 14, 2023) it did not resolve to any active page/content .

At the time of filing the complaint, the Disputed Domain Name resolved to an active website in Chinese apparently related to betting and gaming, where the Internet user is allegedly offered discounts and gift coupons providing they enter an alleged “official website”, become “member” and open an “account”.

The website associated with the Disputed Domain Name is being also used to encourage the Internet users to download apps – that might be unwanted and malicious – as well as linking to external web pages related to online betting and gaming, including some where the Internet user is prompted to download and install apps and also to disclose personal and confidential information, such as mobile phone number and e-mail address.

Such use of the disputed domain name aims at attracting Internet users for commercial gain by creating a likelihood of confusion with the Complainant’s NOVARTIS trademark as to the source, sponsorship, affiliation, or endorsement of the aforementioned website.

Moreover, the structure of the disputed domain name – incorporating in its second level portion the NOVARTIS trademark entirely along with the term “shop” – reflects the Respondent’s intention to create an association, and a subsequent likelihood of confusion, with the Complainant and its NOVARTIS trademark in Internet users’ mind. The disputed domain name in its structure directly refers to the Complaint, its trademark and business.

By reading the disputed domain name, Internet users may believe that it is directly connected or authorized by the Complainant and that the disputed domain name will resolve to the Complainant’s official website, which is not the case. In accordance with previous UDRP Panel decisions and as indicated in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Jurisprudential Overview 3.0”), section 2.5, “a respondent’s use of a domain name will not be considered ‘fair’ if it falsely suggests

affiliation with the trademark owner". In the present case, the Respondent has aimed at making Internet users believe that the disputed domain name is directly linked to, or operated by, the Complainant. In similar circumstances, it has been held that "the nature of the disputed domain name carries a risk of implied affiliation" (see *Instagram, LLC v. Registration Private, Domains By Proxy, LLC / Murat Sander*, WIPO Case No. D2021-0526).

It therefore appears that the Respondent deliberately chose to use the well-known trademark NOVARTIS in the disputed domain name to benefit from the Complainant's worldwide renown trademark and to confuse Internet users as to the source of the disputed domain name and the associated web page. Such use of the disputed domain name cannot therefore be considered as a *bona fide* offering of goods or services nor as legitimate noncommercial or fair.

Panels have also previously asserted that "the use of the disputed domain name to encourage users to download malicious content does not confer a *bona fide* legitimate interest upon Respondent." (see *Arnold Clark Automobiles Limited v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. D2019-1034).

The Complainant found out about the registration of the Disputed Domain Name and sent a Cease and Desist Letter on March 20, 2023. The Cease and Desist Letter has been sent via on-line form as provided by the Registrar – Gname 009 inc as well as via the abuse contact of the Registrar. There was no response from the Respondent. The Respondent has been granted an opportunity to present some compelling arguments that it has rights or legitimate interests in the Disputed Domain Name but has failed to do so. This behavior coupled with the absence of use of the Domain Name in connection with a *bona fide* offering of goods and services further demonstrate the Respondent's absence of rights or legitimate interests in respect of the Disputed Domain Names.

For the foregoing reasons, the Respondent has no rights or legitimate interests in respect of the disputed domain name, within the meaning of the Paragraphs 4(a)(ii) and (4)(c) 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).

It has to be highlighted that the registration of the Complainant's trademarks pre-dates the registration of the Disputed Domain Name and the Respondent has never been authorized by the Complainant to use the NOVARTIS trademark nor to register the Disputed Domain Name. The Respondent has chosen to incorporate the distinctive well-known trademark NOVARTIS in the Disputed Domain Name in its entirety.

As mentioned earlier, the Complainant enjoys a strong online presence. By conducting a simple online search regarding for "**novartis-shop**" or "**novartis-shop.com**" in the Google search engine, the Respondent would have inevitably learnt about the Complainant, its trademark and business (see *Teamreager AB v. Muhsin E. Thiebaut, Walid Victor*, WIPO Case No. D2013-0835 and *Amundi Asset Management v. tang xiao ming*, WIPO Case No. D2019-2744).

Considering the structure of the Disputed Domain Name incorporating in its second level portion the NOVARTIS trademark entirely along with the term "shop", separated by the hyphen - it is therefore inconceivable that the Respondent was unaware of the existence of the Complainant when it registered the Disputed Domain Names. It reflects the Respondent's clear intention to create an association, and a subsequent likelihood of confusion, with the Complainant's trademark in Internet users' mind. By reading the disputed domain name, the Internet users may believe that it is directly connected to or authorized by the Complainant.

Furthermore, as stated in the WIPO Overview 3.0, Paragraph 3.1.4, "Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith."

Therefore, the Respondent had knowledge of the Complainant and the NOVARTIS trademark at the time of the registration of the disputed domain name.

Paragraph 4(b) of the Policy identifies, in particular but without limitation, four circumstances which shall be evidence of the registration and use of a domain name in bad faith. Among those circumstances Paragraph 4(b)(iv) of the Policy reads: “by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.”

Firstly, as previously mentioned, the Disputed Domain Name, in its second level portion, incorporates the trademark NOVARTIS in its entirety, along with the term “shop”, separated by the hyphen. The NOVARTIS trademark can be easily identified within the Disputed Domain Name.

The Disputed Domain Name resolves to an active website apparently related to betting and gaming which is likely to generate commercial gain when Internet users click on the links displayed therein. by creating a likelihood of confusion with the Complainant’s NOVARTIS trademark as to the sources, sponsorship, affiliation, or endorsement of the aforementioned website.

In a previous case involving the owner of the well-known trademark “Ferrari”, the domain name at issue resolved to a website offering totally unconnected services and Panel stated that “In accordance with Paragraph 4(b)(iv) of the Policy, the Respondent has therefore intentionally created confusion amongst consumers, so as to direct them to an on-line location, no doubt with an eye to commercial gain of some description. This also amounts to use in bad faith.” (see *Ferrari S.p.A. v. ASDAQ.com*, WIPO Case No. D2004-0342).

Moreover, the Complainant sent a cease-and-desist letter to the Respondent informing of the Complainant’s rights regarding the NOVARTIS trademark, to which the Respondent did not reply. Such behaviour may infer bad faith (see *Altarea v. Loretta Zayas*, WIPO Case No. D2020-2337).

Furthermore, it is likely that the Respondent is trying to conceal its identity regarding the ownership of the disputed domain name – as, at the time of the filing of the Complaint on March 23, 2023, their name and contact details were covered by a privacy shield in the corresponding Whois record – which is further evidence of bad faith (see *Instagram, LLC v. Registration Private, Domains By Proxy, LLC / Murat Sander*, WIPO Case No. D2021-0526).

In addition, by conducting Reverse WHOIS search by the e-mail of the Respondent <duan**dabner@gmail.com**> it appears that the Respondent owns 2,412 domain names, including those incorporating well-known trademarks or their typos, e.g. <amazonshopy.com> or <amazonw0rkforce.com> (Amazon®). It therefore seems that the Respondent is engaged in pattern of abusive domain name registration which is another indication of bad-faith.

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.

According to the Registrar Verification the language of the Registration Agreement is Chinese.

In accordance with Paragraph 11 of the UDRP Rules, unless otherwise agreed by the parties, the language of the proceedings is the language of the registration agreement, subject to the authority of the panel to determine otherwise, exercising its “discretion in the spirit of fairness to both parties, which pursuant to paragraph 10(b) of the Rules have to be treated with equality, taking into account all relevant circumstances of the case, including matters such as the parties’ ability to understand and use the proposed language, time and costs” (see *Carrefour v. Contact Privacy Inc. Customer 1242379769 / Le Berre*, WIPO Case No. D2018-1552).

The Panel holds that the language of the present administrative proceeding be English based on the following reasons:

- the Disputed Domain Name incorporates, in its second level portion, the Complainant’s well-known trademark Novartis® in its entirety along with the generic word “shop” separated by hyphen. The term “shop” is common noun/verb in daily English language. Using such terms in the second level portion of the domain names shows that the Respondent understands English and has intended, by registering such domain names, to target English speaking Internet users. The Respondent could have chosen to incorporate Chinese characters or terms but yet decided to use English language;

- By conducting reverse WHOIS search by e-mail as disclosed by the Registrar Verification it appears that the Respondent owns 2,412 domain names, including those incorporating well-known trademarks or their typos, e.g. <amazonshopy.com> or <amazonw0rkforce.com>. Vast majority of the Respondent's domain names are incorporated with English language terms <apartmentaudio.com>, <apartmentschannel.com>, <bankresearch.com>, <bad-choices.com> and numerous others . Clearly, the Respondent has good knowledge of English language and intends to target English speaking users;
- The Complainant is a global company, originally founded in Switzerland, having its website at "novartis.com" displayed in the English language, and it appears that the Respondent is located in China. The English language, being commonly used internationally, would be considered as neutral for both parties in the present case. It would therefore be fair to the Parties that the language of the present proceeding be English (See Intesa Sanpaolo S.p.A. v. Ida Ekkert, CAC Case No. 102263).
- Moreover, should the language of the Registration Agreement be different from English, a translation of the Complaint in such a language would entail significant additional costs for the Complainant and delay in the proceedings.

PRINCIPAL REASONS FOR THE DECISION

The Disputed Domain Name resolves to an active website apparently related to betting and gaming which is likely to generate commercial gain when Internet users click on the links displayed therein. by creating a likelihood of confusion with the Complainant's NOVARTIS trademark as to the sources, sponsorship, affiliation, or endorsement of the aforementioned website. Moreover, the Complainant sent a cease-and-desist letter to the Respondent informing of the Complainant's rights regarding the NOVARTIS trademark, to which the Respondent did not reply. Such behaviour may infer bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **novartis-shop.com**: Transferred

PANELLISTS

Name	Thomas Hoeren
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DATE OF PANEL DECISION	2023-06-09
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Publish the Decision
