

Decision for dispute CAC-UDRP-105805

Case number	CAC-UDRP-105805
Time of filing	2023-09-26 09:43:31
Domain names	novartisonboarding.com

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	huangju nqi
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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 a provider of pharmaceutical and healthcare products and is the owner of an international portfolio of trademark registrations for the NOVARTIS mark including the following for which it has provided evidence of registration, ownership and extensive International use: International Trademark Registration for NOVARTIS (also designating China), registration number 666218, registered on July 1, 1996 for services in iclasses 41 and 42; PRC trademark registration NOVARTIS registration number 42520145, registered on September 7, 2020 for goods in class 5; PRC trademark registration NOVARTIS, registration number 12128356, registered on July 28, 2014 for services in class 35.

The Complainant has an established goodwill in the NOVARTIS mark, and has an Internet presence maintaining a website at <www.novartis.com>.

FACTUAL BACKGROUND

The Complainant is a provider of pharmaceutical and healthcare products and is the owner of an international portfolio of trademark registrations for the NOVARTIS mark.

The Disputed Domain Name <novartisonboarding.com> was registered on June 22, 2023 and was inactive on the date of filing of the Complaint. There is no information available about the Respondent, which has elected to have its identity redacted on the

published Whois, except for that provided in the Complaint, the Registrar's Whois and the information provided by the Registrar in response to the request by the Center for details of the registration of the disputed domain name for the purposes of this proceeding.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant claims rights in the NOVARTIS trademark established by its ownership of an international portfolio of registrations described above and extensive use of the mark in its pharmaceutical and healthcare business.

The Complainant submits that the NOVARTIS mark has an international goodwill and reputation, and in 2022, the Complainant's group achieved net sales from continuing operations of USD \$50.5 billion, and total net income amounted to USD \$7.0 billion. As of December 31, 2022, the Complainant's group employed approximately 102 000 full-time equivalent employees and its Annual Reports with detailed information about the group activities can be found on its website at https://www.novartis.com/sites/novartis_com/files/novartis-annual-report-2022.pdf

The Complainant submits that it has active presence in China, where the Respondent is allegedly located according to the publicly available Whois records and its NOVARTIS mark has become well known in that jurisdiction and other jurisdictions across the world, through its activities and those of its subsidiaries and associated companies. Furthermore, the Complainant submits that it also enjoys a strong presence online via its official website and social media platforms.

The Complainant alleges that the Disputed Domain Name <novartisonboarding.com> is identical or confusingly similar to its NOVARTIS mark, as it incorporates the mark in its entirety in its second level, followed by the term "onboarding". It is argued that the NOVARTIS trademark is clearly recognizable within the Disputed Domain Name. The Complainant adds that the presence of the generic Top-Level Domain ("gTLD") extension ".com" in the first level portion of the Disputed Domain Name 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.

The Complainant next alleges that the Respondent has no rights or legitimate interests in the Disputed Domain Name, within the meaning of the Paragraphs 4(a)(ii) and (4)(c) of the Policy, arguing that the Respondent has never had any previous relationship with Complainant, nor has the Complainant ever granted the Respondent any rights to use the NOVARTIS trademark, including in the Disputed Domain Name. The Complainant avers that its searches have not found that the Respondent is known by the Disputed Domain Name, and as shown in a screen capture exhibited in an annex to the Complaint, when searching for the terms "Novartis onboarding" and "novartisonboarding.com" in the Google search engine, the vast majority of the returned results point to the Complainant. Moreover, when searching for those terms in the Google search engine in combination with the name of the Respondent's organization as available in the Whois records, and namely "huangjunqi", the vast majority of the returned results again point to the Complainant; and furthermore when searching for those terms in the Google search engine in combination with the first and last name of the Respondent as revealed by the Registrar Verification, namely "junqi huan g", the returned results either point to the Complainant or there are no returned results. Furthermore, when searching for any trademarks incorporating the terms "Novartis onboarding" and "novartisonboarding.com" on trademark search platforms online, no registered trademarks are to be found. Moreover, when searching for any trademarks registered in the name of the Respondent's organization as stated in the Whois record for the Disputed Domain Name, and namely "huangjunqi", there are no returned results.

The Complainant submits that the structure of the Disputed Domain Name, which incorporates the NOVARTIS trademark in its entirety in its second level, followed by the term "onboarding", is clearly referring to the Complainant. Moreover, the additional term "onboarding" present on the second level portion of the Disputed Domain Name is very likely to be a reference to the onboarding process of new staff members, suppliers and alike at Novartis or their subsidiaries. As shown in a screen capture of the website to which the Disputed Domain Name resolves, when the Complainant first found out about the Disputed Domain Name, it resolved to a website in Chinese language; and according to an automated translation, purports to be maintained by a manufacturer of wire rolling machine and rebar sleeve products based in Hengshui City. The exhibited screen capture of the website presents several images of steel products and machinery. The Complainant submits that by using the Disputed Domain Name in such manner, the Respondent was attempting to divert traffic to a website unrelated to the Complainant and abuse the Complainant's goodwill and reputation, and/or possibly to give a false appearance of rights or legitimate interests in the Disputed Domain Name by connecting it with a placeholder website. In similar cases, Panels have held that the use of a domain name at issue in these circumstances to direct visitors to a website unconnected with the Complainant does not constitute use in connection with a bona fide offering of goods and services, nor can it be considered a legitimate use of the disputed domain name. See General Motors LLC v. Jeff Shenk, MediaTrac LLC, WIPO Case No. D2017-1817, and that passively holding a domain name, including with a placeholder or draft website, in and of itself does not constitute a bona fide offering of goods or services. See Philip Morris USA Inc. v. Gabriel Hall, WIPO Case No. D2015-1779. The Complainant submits that at the time of filing of this Complaint, the Disputed Domain Name did not resolve to any active page/content, as also shown in a screen capture annexed to the Complaint.

The Complainant argues that therefore, the Disputed Domain Name is not currently being used in connection with bona fide offering of goods or services, i.e., there is no available evidence that the Respondent engages in, or has engaged in any activity or work. Moreover, the Complainant submits that when it found out about the registration of the Disputed Domain Name, it caused a Cease and Desist letter to be sent to the Respondent on July 11, 2023, initiated a contact request via the service provided by the Registrar,

and sent a reminder letter via the service provided by the Registrar on August 2, 2023. No response was received from the Respondent. The Complainant adds that notwithstanding that the Respondent has been granted an opportunity to present some compelling arguments that it has rights or legitimate interests in the Disputed Domain Name, it has failed so to do.

The Complainant next alleges that the disputed domain name was registered in bad faith, arguing that the Complainant's trademark registrations for the NOVARTIS mark significantly predate the registration of the Disputed Domain Name, and the Respondent has never been authorized by the Complainant to register the Disputed Domain Name. The Complainant also enjoys a strong online presence, and by conducting a simple online search for the Disputed Domain Name terms on popular search engines, the Respondent would have inevitably learnt about the Complainant, its trademark and business. Furthermore, the structure of the Disputed Domain Name, incorporating as it does, in its second level the Complainant's well-known trademark NOVARTIS alongside the relevant term "onboarding" - shows that the Respondent registered it with the Complainant and its NOVARTIS trademark in mind. The Complainant submits that this 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. Considering that the NOVARTIS trademark is well known and the Complainant is a globally renowned pharmaceutical company, with a strong business presence worldwide, including in China where the Respondent purports to be based, it is inconceivable that the Respondent was unaware of the existence of the Complainant when it registered the Disputed Domain Name.

On the contrary, it appears that the Respondent was fully aware of the Complainant and its business and was most likely intentionally trying to confuse consumers and other Internet users by creating a similarity between the Disputed Domain name and the Complainant. By doing so, the Respondent is seeking to benefit from the Complainant's established reputation.

The Complainant finally argues that the Disputed Domain Name is being used in bad faith. The Complainant submits that among the circumstances which are indicative of use in bad faith are those described in Policy Paragraph 4(b)(iv) which 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." By reading the Disputed Domain Name, Internet users may believe that it is directly connected to or authorized by the Complainant.

Moreover, the exhibited screen capture shows that the Disputed Domain Name has resolved to a website which referred to a manufacturer of wire rolling machine and rebar sleeve products based in Hengshui City, with content that included several images of steel products and machinery. It therefore appears that the website previously connected to the Disputed Domain Name was an attempt on the side of the Respondent to divert traffic to a website unrelated to the Complainant and abuse its goodwill and reputation, and/or possibly give a false appearance of rights or legitimate interests in the Disputed Domain Name, both of which are activities that could be characterized as being in bad faith. In similar circumstances, panels established under the Policy have held that to establish a website by use of a domain name that incorporates a generally recognized and well regarded mark, simply for the sake of catching consumers' attention, then to syphon off their trade by offering unrelated goods via that website, is an activity which can only be characterized as being in bad faith. See LEGO Juris A/S v. Torsten Kruger WIPO Case No. D2017-2187.

Moreover, the Complainant submits that at the time of filing of this Complaint, the Disputed Domain Name did not resolve to any active content as shown in an exhibited screen capture and is currently passively held.

In the present case, the following circumstances have to be taken into account:

- the NOVARTIS trademark is well-known and has been so held in previous decisions under the Policy, see Novartis AG v. Amartya Sinha, Global Webs Link, Novartis RO, WIPO Case No. D2020-3203;
- the aforementioned Cease and Desist letter on July 11, 2023, contact request via the service provided by the Registrar, and reminder on August 2, 2023 advised the Respondent that the unauthorized use of their trademarks within the Disputed Domain Name violates the Complainant's trademark rights and requested a voluntary transfer of the Disputed Domain Name. the Respondents chose not to reply to the Complainant's communications which infers bad faith.
- a reverse WHOIS search carried out using the Respondent's email address reveals over 430 results, some of which appear to be infringing registered trademarks. The evidence suggests that the individuals behind the Respondent are professional cybersquatters on an industrial scale, this constituting a pattern of conduct for the purposes of paragraph 4(b)(ii) of the Policy." See Vierol AG v. Whois Protection WIPO Case No. D2007-1078. RESPONDENT 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

The Complainant's Rights:

The Complainant has provided convincing, uncontested evidence that it has rights in the NOVARTIS mark, established by the ownership of the portfolio of trademark and service mark registrations described above and the reputation and goodwill that it has established in the mark by extensive use on its human and animal food supplement business.

Confusing Similarity:

The disputed domain name <Novartisonboarding.com> consists of the Complainant's NOVARTIS mark in its entirety, in combination with the term "onboarding" and the gTLD extension <.com>.

The Complainant's NOVARTIS mark is clearly recognizable as being the initial, dominant and only distinctive element in the disputed domain name. The term "onboarding" could be considered a reference to bringing employees into an organisation, but in the circumstances of this case it has no distinctive character and does not prevent a finding that the Disputed Domain Name is confusingly similar to the NOVARTIS mark. Similarly, the gTLD extension <.com> does not prevent a finding of confusing similarity, because in the circumstances of this proceeding, it would be considered to be a necessary technical requirement for a domain name registration, this Panel finds therefore that the Disputed Domain Name is confusingly similar to the NOVARTIS mark in which the Complainant has rights, and the Complainant has therefore succeeded in the first element of the test in Policy Paragraph 4(a)(i).

Rights and Legitimate Interests:

The Complainant has made out a prima facie case that the Respondent has no rights legitimate interests in the Disputed Domain Name arguing that the Respondent has never had any previous relationship with the Complainant; the Complainant has never granted the Respondent any rights to use the NOVARTIS trademark, including in the Disputed Domain Name; the Complainant avers that it has not found that the Respondent is known by the Disputed Domain Name; a screen capture of search results exhibited in an annex to the Complaint, shows that when searching for the terms "Novartis onboarding" and "novartisonboarding.com" in the Google search engine, the vast majority of the returned results point to the Complainant; additionally, exhibited results of searches against the terms "Novartis onboarding" and "novartisonboarding.com" in the Google search engine in combination with the name "huangjunqi" which is the Respondent's organization according to available in the Whois records, reveal that the vast majority of the returned results again point to the Complainant; exhibited results of searches against the terms "Novartis onboarding" and "novartisonboarding.com" in the Google search engine in combination with the first and last name of the Respondent as revealed by the Registrar Verification, namely "Junqi huan g", the returned results either point to the Complainant or there are no returned results; exhibited results of searches against the terms "Novartis onboarding" and "novartisonboarding.com" in on online trademark search platforms, show that no registered trademarks are to be found; when searching for any trademarks registered in the name of the Respondent's organization as available in the Whois records, and namely "huangjunqi", there are no returned results; the structure of the Disputed Domain Name – which incorporates, in its second level portion, the NOVARTIS trademark in its entirety, followed by the term "onboarding" – clearly refers to the Complainant; the additional term "onboarding" present on the second level portion of the Disputed Domain Name is very likely to be a reference to the onboarding process of new staff members, suppliers and alike at Novartis or their subsidiaries; a screen capture of the website to which the disputed domain name resolves, which is also exhibited in an annex to the Complaint, when the Complainant first found out about the Disputed Domain Name, it resolved to a website in Chinese language; and according to an automated translation, purports to be maintained by a manufacturer of wire rolling machine and Rebar Sleeve based in Hengshui City presented several images of steel products and machinery; at the time of filing of this Complaint, the Disputed Domain Name did not resolve to any active page/content, as also shown in a screen capture annexed to the Complaint. The Disputed Domain Name is not currently being used in connection with bona fide offering of goods or services; when it found out about the registration of the Disputed Domain Name, it caused a Cease and Desist letter to be sent to the Respondent on July 11, 2023, and initiated a contact request via the service provided by the Registrar; a reminder was also sent to the Respondent via the service provided by the Registrar on August 2, 2023; and no response was received from the Respondent; notwithstanding that the Respondent has been granted an opportunity to present some compelling arguments that it has rights or legitimate interests in the Disputed Domain Name, it has failed so to do.

It is well established that once a complainant makes out a prima facie case that a respondent has no rights or legitimate interests in

the domain name at issue, the burden of production shifts to the respondent to prove its rights or legitimate interests. Respondent has failed to discharge that burden and therefore this Panel must find that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The Complainant has therefore succeeded in the second element of the test in Policy Paragraph 4(a)(ii).

Registration and Use in Bad Faith:

The Complainant has adduced clear and convincing, uncontested evidence that it has registered trademark rights in the NOVARTIS mark dating back to July 1, 1996 which long predate the registration and first use of the Disputed Domain Name <novartisonboarding.com> which was registered on June 22, 2023.

NOVARTIS is a distinctive mark it is most improbable that the Disputed Domain Name which has as its initial, dominant and only distinctive element the NOVARTIS trademark, was chosen for any reason other than its similarity to the Complainant's mark.

Therefore on the balance of probabilities it was registered to infer a reference to the Complainant and its NOVARTIS mark. This Panel finds therefore that on the balance of probabilities the disputed domain name was registered in bad faith with the Complainant and its mark in mind to take predatory advantage of the Complainant's goodwill and reputation in the NOVARTIS mark. The Complainant has adduced uncontested evidence that the disputed domain name is inactive. Because the Complainant has shown that the NOVARTIS mark has an extensive international reputation and goodwill and is both registered and is being used in China, where the Respondent purports to be established, and because NOVARTIS is a very distinctive mark, and clearly recognisable within the Disputed Domain Name, and there is no plausible reason as to why the Respondent might register and use the Disputed Domain Name, and the Respondent has failed to respond to the communications from the Complainant prior to the issue of this Complaint and no timely Response has been filed, this Panel finds that the passive holding of the Disputed Domain Name constitutes use in bad faith for the purposes of the Policy.

The Complainant has additionally argued that disputed domain name has in the past resolved to a website of an enterprise in China and has exhibited a screen capture of the website in the Chinese language in an annex to the Complaint. The Complainant refers to an automated translation of the website, but does not exhibit the translation. In other circumstances this Panel would have considered requesting a certified translation of the website as might be expected from a complainant with extensive resources, because the language of the proceedings is in the English language.

However because the uncontested evidence of the Complainant is that the disputed domain name is inactive, it is not necessary to make that request. As this Panel has found that the disputed domain name was registered and is being used in bad faith, the Complainant has succeeded in the third element of the test in Policy paragraph 4(a)(iii).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **novartisonboarding.com**: Transferred

PANELLISTS

Name	James Bridgeman
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DATE OF PANEL DECISION **2023-11-02**

Publish the Decision
