

Decision for dispute CAC-UDRP-105807

Case number	CAC-UDRP-105807
Time of filing	2023-09-26 08:24:15
Domain names	novartisstaffingonline.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

Organization	Will Adams (Lead Recruiting.)
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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 Owner of trademarks in U.S. and all over the world. E.g. he has following valid trademarks with the name NOVARTIS:

Trademark: NOVARTIS

Swiss Reg. No: 2P-427370

Reg. Date: July 1, 1996, in classes 1, 2, 3, 4, 5, 7, 8, 9, 10, 14, 16, 17, 20, 28, 29, 30, 31, 32, 40 and 42

International trademark registration for NOVARTIS

Reg. No. 663765

Reg. date: July 1, 1996 in classes 1, 2, 3, 4, 5, 7, 8, 9, 10, 14, 16, 17, 20, 22, 28, 29, 30, 31, 32, 40 and 42

Reg. No.: 1249666

US trademark registration for NOVARTIS (USPTO)

Reg. No.: 2336960

Reg. date: April 4, 2000

The Complainant also provided evidence that it owns a domain name containing the name <novartis.com>, registered on April 2, 1996, or in combination with other terms, such as <novartispharma.com> (registered in 1999) well before the Respondent registered the Disputed Domain Name, which was registered on August 31, 2023.

FACTUAL BACKGROUND

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

ABOUT COMPLAINANT:

The Complainant is a pharmaceutical company based in Basel, Switzerland. The Complainant is active in the pharmaceutical business for many decades and has as group about 126 000 people of 145 nationalities work at Novartis around the world. The complainant is represented by BrandIT GmbH, Zürich, Switzerland.

The Complainant is the owner of the registered well-known trademark NOVARTIS as a word and figure mark in several classes in numerous of countries all over the world including in USA. The Complainant showed evidence that he has a presence in U.S., through its subsidiaries and associated companies.

The Complainant owns numerous domain names composed of either its trademark NOVARTIS alone, including <novartis.com> (created on April 2, 1996) or in combination with other terms, e.g. <novartispharma.com> (created on October 27, 1999) and many others. The Complainant uses these domain names to promote the NOVARTIS mark with related products and services, here job offers. The Complainant enjoys a strong presence online also via its official social media platforms.

ABOUT RESPONDENT:

The Respondent is an U.S. citizen, using a hidden domain holder name. On August 31, 2023 the Respondent registered Disputed Domain Name. He uses the Disputed Domain Name for staffing purposes and gaining personal data as the Complainant showed by evidence.

SUMMARY:

- NOVARTIS is a well-known, distinctive trademark worldwide.
- Complainant's trademarks registration predates the registration of the Disputed Domain Name.
- Respondent has no rights in the mark NOVARTIS, bears no relationship to the Complainant, and is not commonly known by the Disputed Domain Name - accordingly it has no legitimate interest in the Disputed Domain Name.
- It is highly unlikely that Respondent was not aware of Complainant's prior rights in the trademark NOVARTIS at the time of registering the Disputed Domain Name, given the Complainant's worldwide renown.
- Respondent has used the Disputed Domain Name for a website which looks a like if it was the Complainants project.
- Respondent failed in responding to cease-and-desist letter sent by the Complainant.
- Respondent has been using privacy shield to conceal its identity.

Consequently, the Complainant argues that Respondent should be considered to have registered the Disputed Domain Name confusingly similar to the Complainant's well-known, distinctive trademark NOVARTIS. Especially the generic terms "staffingonline" in the Disputed Domain Name in combination with the well-known word part "Novartis" make obvious that the Respondent was aware what he has done. The Complainant has not found that the Respondent is of any legitimate right or interest in using the Disputed Domain Name, but rather registered and has been using the Disputed Domain Name in bad faith.

From the Complainant's perspective, the Respondent deliberately chose to incorporate a sign that is confusingly similar to the well-known, distinctive trademark NOVARTIS in the Disputed Domain Name, very likely with the intention to attract U.S. and other job seekers by benefiting from the Complainant's worldwide renown.

It should be highlighted that most of Complainant's trademark registrations predate the registration of the Disputed Domain Name and the Respondent has never been authorized by the Complainant to register the Disputed Domain Name. Considering the renown of the Complainant and its trademark NOVARTIS, and the overall composition of the Disputed Domain Name, i.e. incorporates the Complainant's well-known, distinctive trademark NOVARTIS in its entirety along with the terms "pharma" and "services", which are closely related to the Complainant and its business activities, it follows that incorporating the well-known trademark NOVARTIS in the

Disputed Domain Name is a deliberate and calculated attempt to improperly benefit from the Complainant's rights and reputation.

PARTIES CONTENTIONS

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

It is necessary for the Complainant, if it is to succeed in this administrative proceeding, to prove each of the three elements referred to in paragraph 4(a) of the Policy, namely that:

- (A) the disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights; and
- (B) the Respondent has no rights or legitimate interest in respect of the disputed domain name; and
- (C) the disputed domain name has been registered and is being used in bad faith.

to (A):

The Panel finds that the Disputed Domain Name <NOVARTISSTAFFINGONLINE.COM> (hereinafter referred to as the "Disputed Domain Name") is confusingly similar to the trademarks of the Complainant. The Disputed Domain Name, which was registered on August 31, 2023 (according to the Registrar Verification), incorporates entirely the Complainant's well-known, registered trademark NOVARTIS with generic indications "staffing" and "online". The Disputed Domain Name in its structure directly refers to the Complainant, its trademark and business, here the hiring department. Moreover, previous UDRP panels have stated that the NOVARTIS trademark is well-known, especially for the pharmaceutical business (inter alia, Novartis AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org./ Sergei Lir, WIPO Case No. D2016-1688).

The addition of the Gtld ".com" does not add any distinctiveness to the Disputed Domain Name. See as an example the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), paragraph 1.11. as well as the International Business Machines Corporation v. Sledge, Inc. / Frank Sledge WIPO Case No. D2014-0581 where the Panel stated the following: "In addition, it is generally accepted that the addition of the top-level suffix in the domain name (e.g., ".com") is to be disregarded under the confusing similarity test". The same reasoning should apply in the current case.

to (B):

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. The Complainant has not granted the Respondent any right to use the NOVARTIS trademarks within the Disputed Domain Name, nor is the Respondent affiliated to the Complainant.

Moreover, the Complainant contends and provides evidence that the Respondent has not developed a legitimate use in respect of the Disputed Domain Name. The Complainant contends that the Respondent was seeking to use the Disputed Domain Name only to divert consumers to its own business and that the Respondent has no legitimate interests in respect of the Disputed Domain Name. Indeed, in a similar case, the Panel has concluded that: "the Respondent's recorded attempts at collecting personal data from the Complainant's clients and potential clients through form filling cannot be described as a legitimate noncommercial or fair use of the Disputed Domain Name." See WIPO Case No. DCO2015-0032, AB Electrolux vs. Registration Private, Domains By Proxy, LLC / Mohamed Samir.

The Complainant has not found that the Respondent is commonly known by the Disputed Domain Name or that it has legitimate interest over the Disputed Domain Name. When searched for it in the Google search engine, the search engine returned numerous results about the Complainant and its business activities.

The Respondent could have easily performed a similar search before registering the Disputed Domain Name and would have quickly learnt that the trademarks are owned by the Complainant. However, the Respondent still chose to register the Disputed Domain Name as such.

In addition, according to the Registrar Verification, the Respondent's name is not related to the Complainant nor to the term "Novartis" in any way. The Respondent has not been using the Disputed Domain Name for any bona fide offering of goods or services.

When Job seekers and internet users, who search for job information about the Complainant and the brand "Novartis", see the Disputed Domain Name and the active website, would very likely be confused and be led to believe that the Disputed Domain Name is somehow related to the Complainant and be disappointed as they would not find the information as expected – which will lead to trademark tarnishment for the Complainant.

In lack of any Response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and has not been using the Disputed Domain Name for any bona fide offering of goods or services.

to (C):

1. THE DISPUTED DOMAIN NAME WAS REGISTERED IN BAD FAITH

The Complainant also referred to the distinctiveness and reputation of its NOVARTIS trademarks. This makes it highly unlikely that the Respondent had no knowledge of the Complainant's prior trademark rights at the time of registration of the Disputed Domain Name. Especially the generic terms "staffing" and "online", the Respondent, who is allegedly based in the United States, clearly aimed at referring to the Novartis group as a part of the Disputed Domain Name makes obvious that the Respondent was aware what the combination of the words with NOVARTIS will mean. The Complainant rightfully contended that the Respondent has used the Disputed Domain Name intentionally to attract job seeking visitors for commercial gain by creating confusion with the Complainant's trademarks, and that the Respondent has used the Disputed Domain Name with that intention, namely in bad faith. See e.g., Accor v. Shangheo Heo / Contact Privacy Inc., WIPO Case No. D2014-1471 where the Panel stated that: "The unopposed allegation of phishing, and the evidence submitted in support of phishing, combined with the likelihood of confusion, is sufficient evidence of bad faith. ...It seems likely, as Complainant alleges, that Respondent intentionally attempted to deceive consumers into providing personal and financial information, believing that Respondent was associated with the bona fide services offered by Complainant."

Reference is made also to: CAC case N° 101036, Boehringer Ingelheim Pharma GmbH & Co. KG vs. SKYRXSHOP - dulcolax.xyz and WIPO Case no. D2014-0306 Boehringer Ingelheim Pharma GmbH & Co. KG v. Klinik Sari Padma, BAKTI HUSADA.

In detail considering the facts that:

- the Respondent very likely knew about the Complainant and its trademark;
- the Complainant's trademark NOVARTIS is a distinctive, well-known trademark worldwide and in Indonesia where the Respondent resides;
- the Respondent has failed in presenting a credible evidence-backed rationale for registering the Disputed Domain Name; and
- the Disputed Domain Name shall be deemed as registered in bad faith, which is supported by WIPO Overview 3.0, para. 3.1.1.: "If on the other hand circumstances indicate that the respondent's intent in registering the disputed domain name was in fact to profit in some fashion from or otherwise exploit the complainant's trademark, panels will find bad faith on the part of the respondent. While panel assessment remains fact-specific, generally speaking such circumstances, alone or together, include: (i) the respondent's likely knowledge of the complainant's rights, (ii) the distinctiveness of the complainant's mark, ... (vii) failure of a respondent to present a credible evidence-backed rationale for registering the domain name, ..." and para.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."

2. THE DISPUTED DOMAIN NAME IS BEING USED IN BAD FAITH

Firstly, the Disputed Domain Name resolves to an active page displaying the trademarks of the Complainant, along with developed sections titled “About Novartisstaffingonline”, “Find your next opportunity with Novartisstaffingonline”, and “We're Hiring! Join us today! If you're interested in one of our open positions, start by applying here and attaching your resume.”, the latter being immediately above an open form where internet users are prompted to “Apply Now” by inserting their personal details, such as Name, Phone and Email address, as well as attaching a resume, as the Complainant showed by evidence.

Additionally, the Complainant tried to reach the Respondent by a cease-and-desist letter the Registrar as the Respondent’s contact details were under privacy shield in the publicly available WHOIS. However, until the time the Complainant prepared this Complaint, it has not received response from the Respondent.

In terms of paragraph 4(b)(iv) of the Policy, the above facts demonstrate the Respondent’s use of the Disputed Domain Name in bad faith. In a case with similar factual and legal background, the Panel has found that: “Respondent on the website at the disputed domain name nearly is impersonating Complainant, while trying to elicit personal information from Internet users presumably looking for Complainant and its STEVE MADDEN mark. Presumably, such users would not provide this information unless they believe they were dealing with Complainant.” and consequently found that “by using the disputed domain name in this manner, Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on Respondent’s website or location.” See WIPO Case No. D2015-1024, Steven Madden, Ltd. v. Daniel Monroy.

Furthermore, the Respondent was using a hidden identity. But this argument is not to be discussed further because bad faith is evident, whatsoever.

Accordingly, the Panel finds that the Disputed Domain Name was both registered and used in bad faith and that the Complaint succeeds under the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **novartisstaffingonline.com**: Transferred

PANELLISTS

Name	Harald von Herget
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DATE OF PANEL DECISION	2023-11-04
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Publish the Decision
