Decision for dispute CAC-UDRP-106184

Case number	CAC-UDRP-106184
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Domain names	novartisvip.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Organization	xudao

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 registered trademark NOVARTIS in numerous jurisdictions all over the world, including Hong Kong, a country where it has an active presence through its subsidiaries and associated companies. Namely, the Complainant's trademark registrations applying to the present proceedings include the following earlier rights:

EU trademark registration for NOVARTIS (EUIPO)

Reg. No.: 013393641

Reg. date: March 17, 2015

US trademark registration for NOVARTIS (HK)

Reg. No.: HK IPD 303941794

Reg. date: October 26, 2017

International Registration for NOVARTIS

Reg. No.: 663765

Reg. date: July 1, 1996

Hong Kong trademark registration for NOVARTIS

Reg. No.: **303941794**

Reg. Date: October 26, 2017

The Complainant also owns numerous domain names composed of either its trademark NOVARTIS alone, including <**novartis.com**> (created on 2 April 1996) and <**novartis.us**> (created on 19 April 2002) or in combination with other terms, such as <**novartispharma.com**> (created on 27 October 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. Novartis AG (the "Complainant"), with headquarter in Switzerland, created in 1996 through a merger of two other companies Ciba-Geigy and Sandoz, is the holding company of the Novartis Group. In 2022, Novartis achieved net sales from continuing operations of USD 50.5 billion, and total net income amounted to USD 7.0 billion and employed approximately 102 000 full-time equivalent employees as of December 31, 2022. Novartis

The Complainant is the owner of the registered trademark NOVARTIS in numerous jurisdictions all over the world and several domain names containing the trademark NOVARTIS. The Complainant enjoys a local presence in Hong Kong, where the Respondent is allegedly located.

The Complainant's trademark registrations significantly predate the registration of the Disputed Domain Name, which was registered on December 12, 2023. Namely, the Complainant's trademark registrations applying to the present proceedings.

The Complainant states that the Disputed Domain Name < novartisvip.com > incorporates the NOVARTIS trademark in its entirety, followed by the term "vip", typically used as an acronym for the English term "very important people".

The NOVARTIS trademark is clearly recognizable within the Disputed Domain Name. 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 Disputed Domain Name should in the view of Complainant be considered as confusingly similar to the Complainant's trademark NOVARTIS.

The Complainant furthermore states that 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, including in the Disputed Domain Name.

The Complainant has not found that the Respondent is known by the Disputed Domain Name. Indeed, when searching for the Disputed Domain Name term "novartisvip" in the Google search engine, all of the returned results point to the Complainant. Moreover, when searching for the Disputed Domain Name term "novartisvip" in connection with the name of the Respondent's organization as disclosed by the Registrar Verification, namely "xudao", the returned results do not show a connection between the two. Furthermore, when searching for any trademarks incorporating the Disputed Domain Name term "novartisvip" on online trademark search platforms, no registered trademarks are to be found.

The Complainant states that the Respondent could have easily performed a similar search before registering the Disputed Domain Name and would have quickly learned that the trademark is owned by the Complainant and that the Complainant has been using the trademark for its business activities. However, the Respondent still registered the Disputed Domain Name as such.

In addition, the Complainant states that the Respondent is using a Privacy Shield service to mask its identity on the publicly available WhoIs records. It therefore appears that the Respondent does not wish to be known in connection with the Disputed Domain Name and aims at hiding its true identity rather than being known by the Disputed Domain Name.

At the time the Complainant found out about the Disputed Domain Name, the latter resolved to a website mentioning a sign confusingly similar to the NOVARTIS figurative trademark " " (i.e., incorporating the visual elements of the same), and providing an interface allegedly asking internet users to "recharge" their account, along with performing other activities associated with investment platforms. As previously mentioned, the Complainant never granted the Respondent with any rights to use the NOVARTIS trademarks, or any sign confusingly similar to the same, including in the Disputed Domain Name and corresponding website.

Such activity cannot give the Respondent any rights or legitimate interests in the Disputed Domain Name.

When the Complainant sent a C&D letter to the Respondent, the Disputed Domain Name had stopped resolving to the previous

website and did not resolve to any active page/content. Around the time of filing this Complaint, the Disputed Domain Name does not resolve to any active page/content. Therefore, the Disputed Domain Name is in the view of Complainant not 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, i.e., legitimate or fair use of the disputed domain name, that demonstrates a legitimate interest in the disputed domain name”.

The Respondent has been granted an opportunity to present some compelling arguments that they have rights or legitimate interests in the Disputed Domain Name but have failed to do so. This behavior, coupled with the absence of use of the Disputed Domain Names in connection with a bona fide offering of goods and services, further demonstrates in the view of the Complainant the Respondents’ absence of rights or legitimate interests in respect of the Disputed Domain Name.

As mentioned above, the Complainant’s trademark registrations 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. The Complainant is very active on social media to promote its mark, products and services. By conducting a simple online search regarding the Disputed Domain Name terms on popular search engines, the Respondent would have inevitably learned about the Complainant, its trademark, and its business.

Complainant states that it is therefore inconceivable that the Respondent was unaware of the existence of the Complainant when it registered the Disputed Domain Name.

Furthermore, the structure of the Disputed Domain Name – incorporating the Complainant’s well-known trademark NOVARTIS followed by the relevant term “VIP” - shows in the view of the Complainant that the Respondent registered it having the Complainant and its NOVARTIS trademark in mind. 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’ minds. Indeed, by reading the Disputed Domain Name, Internet users may believe it is directly connected to or authorized by the Complainant.

Furthermore, at the time the Complainant found out about the Disputed Domain Name, the latter resolved to a website mentioning a sign confusingly similar to the NOVARTIS figurative trademark “ ” (i.e., incorporating the visual elements of the same), and providing an interface allegedly asking internet users to “recharge” their account, along with performing other activities associated with investment platforms. Such activity clearly leads to the conclusion that the Respondent knew about the Complainant and registered the Disputed Domain Name with the Complainant in mind.

Complainant states that when considering that the NOVARTIS trademark is well known and that the Complainant is a globally renowned pharmaceutical company, it clearly appears that the Respondent knew the Complainant and the NOVARTIS trademark at the time it registered the Disputed Domain Name.

The structure of the Disputed Domain Name in and of itself – incorporating the Complainant’s well-known trademark NOVARTIS followed by the relevant term “VIP” - reflects in the view of the Complainant the Respondent’s intention to create an association, and a subsequent likelihood of confusion, with the Complainant, its NOVARTIS trademark and the Novartis group in Internet users’ mind, as by reading the Disputed Domain Name, Internet users may believe that it is directly connected to or authorized by the Complainant. In this regard, previous UDRP panels have consistently found that the mere registration of a domain name that is confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith.

In addition, at the time the Complainant found out about the Disputed Domain Name, it did not resolve to any active page/content. Similarly, around the time of filing of this complaint, the Disputed Domain Name does not resolve to any active content, therefore the Disputed Domain Name is passively held.

The Complainant tried to contact the Respondent through a Cease and Desist Letter. In the Cease-and-Desist letter, the Complainant advised the Respondent that the unauthorized use of their trademarks within the Disputed Domain Name violates their trademark rights and requested a voluntary transfer of the Disputed Domain Name. The Respondents chose not to reply to the Cease and Desist letter sent by the Complainant, which infers bad faith.

Furthermore, it is likely that the Respondent is trying to conceal its identity regarding the ownership of the Disputed Domain Name – as its name and contact details are covered by a privacy shield in the publicly available WhoIs records – which is further evidence of bad faith.

PARTIES CONTENTIONS

The Complainant´s contentions are summarised above.

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

1. The Disputed Domain Name is confusingly similar to a trademark in which the Complainant has rights.

The Panel agrees that the Disputed Domain Name is confusingly similar to the NOVARTIS trademark.

As a matter of fact, the Disputed Domain Name entirely incorporates the NOVARTIS trademark and this is sufficient to meet the threshold of the First Element of the UDRP policy. Moreover, the combination of the element "VIP" has no significant impact on the confusing similarity assessment as this element could be associated with possible descriptive meanings ("VIP" is short for VERY IMPORTANT PERSON), and in any case, the NOVARTIS element is the dominant part of the Disputed Domain Name.

The Panel agrees that the ".com" extension does not impact the confusing similarity assessment due to its technical function.

Consequently, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant’s trademark, for the purposes of the First Element of the Policy.

2. The Respondent lacks rights or legitimate interests in the Disputed Domain Name.

Pursuant to paragraph 4(a)(ii) of the Policy, a complainant must make out a prima facie case that a respondent lacks rights or legitimate interests in the Disputed Domain Name. Once such a prima facie case is made, the respondent carries the burden of demonstrating its 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.

In this case, the Panel finds that the Complainant’s submitted evidence and allegations are sufficient to establish a prima facie case of the Respondent’s lack of rights and legitimate interests in the Disputed Domain Name, also considering the fact that the Respondent had the chance to justify the registration and use of the Disputed Domain Name, but failed to do so.

According to the information provided by the Complainant and not contested, the Respondent is not commonly known by the Disputed Domain Name nor authorized to use the Complainant’s trademark “NOVARTIS”. The Disputed Domain Name is not used; as a consequence, there is no evidence of a bona fide or legitimate non commercial use of the domain name as required by the UDRP.

For these reasons, the Panel takes the view that the Respondent lacks rights or legitimate interests in the Disputed Domain Name for the purpose of the Policy.

3. The Disputed Domain Name was registered and is used in bad faith.

The Panel finds the following circumstances as material to establish the Respondent's bad faith in the registration of the Disputed Domain Name:

(i) the Disputed Domain Name was registered well after the Complainant acquired rights on the trademark NOVARTIS;

(ii) the Complainant's trademark is widely known as confirmed by previous Panels (see Novartis AG v. Amartya Sinha, Global Webs Link, Novartis RO, WIPO Case No. D2020-3203). The reputation of the trademark NOVARTIS, including in Hong Kong, makes it very improbable that the Respondent was not aware of the Complainant's exclusive rights on such trademark at the time of the registration of the Disputed Domain Name;

(iii) the Respondent did not react to a Cease and Desist Letter. This fact is considered by the Panel as a further index of registration in bad faith;

(iv) furthermore, the Respondent is trying to conceal its identity regarding the ownership of the Disputed Domain Name – as its name and contact details are covered by a privacy shield in the publicly available WhoIs records – which is further evidence of bad faith (See Instagram, LLC v. Registration Private, Domains By Proxy, LLC / Murat Sander, WIPO Case No. D2021-0526).

Regarding the use in bad faith requirement, the Panel points out that the Disputed Domain Name is not used in connection with an active website. Previous panels have found that the non-use of a domain name (including a blank or “coming soon” page) does not prevent a finding of bad faith under the doctrine of passive holding.

Factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.

In this case, these factors suggest that the actual use of the Disputed Domain Name could be qualified as a use in bad faith. As said before, the NOVARTIS trademark enjoys a high degree of reputation worldwide which also excludes a possible use in good faith of the Disputed Domain Name. Furthermore, the Respondent did not file any response providing information on a possible good faith use of the Disputed Domain Name. Last, the Complainant tried to contact the Respondent through a Cease and Desist Letter. In the Cease-and-Desist letter, the Complainant advised the Respondent that the unauthorized use of their trademarks within the Disputed Domain Name violates their trademark rights and requested a voluntary transfer of the Disputed Domain Name. The Respondents chose not to reply to the Cease and Desist letter sent by the Complainant, which infers bad faith.

For these reasons, the Panel takes the view that the Disputed Domain Name is registered and 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. **novartisvip.com**: Transferred

PANELLISTS

Name	Jan Schnedler

DATE OF PANEL DECISION 2024-02-27

Publish the Decision