Decision for dispute CAC-UDRP-106183

Case number	CAC-UDRP-106183
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Domain names	novartis-eu.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Name	Thomas Tay

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's trademark registrations include the following earlier rights:

EU trademark registration for NOVARTIS (EUIPO), Reg. No.: 013393641, Reg. date: March 17, 2015;

US trademark registration for NOVARTIS (USPTO), Reg. No.: 2336960, Reg. date: April 4, 2000;

International Registration for NOVARTIS, Reg. No.: 663765, Reg. date: July 1, 1996.

FACTUAL BACKGROUND

The Complainant is one of the biggest global pharmaceutical and healthcare groups. It provides solutions worldwide by developing and delivering 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.

The Complainant is the owner of the registered well-known trademark NOVARTIS in numerous jurisdictions all over the world,

including in Singapore, a country where it has an active presence through its subsidiaries and associated companies. The Complainant enjoys a local presence in Singapore, 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 4, 2023. Previous UDRP panels have stated that the NOVARTIS trademark is well-known (see Novartis AG v. Amartya Sinha, Global Webs Link, Novartis RO, WIPO Case No. D2020-3203).

The Complainant 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.

The Complainant also enjoys a strong presence online via its official social media platforms.

PARTIES CONTENTIONS

The Complainant submits that the requirements of the Policy have been met and that the disputed domain name should be transferred to it. The Complainant makes a number of legal arguments (referenced below) and also supplies a set of annexes providing evidence of its activities and of the Respondent's use of the disputed domain names.

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

According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that the disputed domain name should be transferred or cancelled:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

The Panel has examined the evidence available to it and has come to the following conclusion concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

RIGHTS

The Complainant has established rights in the name NOVARTIS. The disputed domain name <NOVARTIS-EU.COM> is found to be confusingly similar to the Complainant's trademark and company name. This finding is based on the settled practice in evaluating the existence of a likelihood of confusion of:

a) disregarding the top-level suffix in the domain names (i.e. ".com") in the comparison; and

b) finding that the simple combination of a trademark and a generic term such as a geographic indicator referring to a country or region in which the Complainant is conducting business (in this case "EU") would by no means be considered sufficient to distinguish a domain name from a trademark.

The disputed domain name is therefore found to be confusingly similar to the earlier rights in the name NOVARTIS and the Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The onus to make out a prima facie case that the Respondent lacks rights or legitimate interests is placed on the Complainant. However, once such a prima facie case is made, the Respondent carries the burden of demonstrating 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.

The Respondent has no rights or legitimate interests in the disputed domain name. The Complainant and the Respondent have never had any previous relationship, 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 disputed domain name did not resolve to any active page/content. Therefore, the disputed domain name cannot be in use in connection with a bona fide offering of goods or services. 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, so that there is nothing that could be interpreted as rights or legitimate interests of the Respondent. Since the Respondent has not filed a response, the Respondent has also failed to put forward any arguments at all which could change this finding.

Additionally, a Cease-and-Desist letter sent to the e-mail address of the Registrar provided on the WhoIs records, asking the latter to forward the communication to the Respondent on December 13, 2023, remained unanswered, as did the contact request through the service provided by the Registrar.

The Respondent was given an opportunity to present arguments relating to 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 name in connection with a bona fide offering of goods and services, demonstrates the Respondents' absence of rights or legitimate interests in respect of the disputed domain name.

The Panel therefore concludes that the Respondent did not refute the Complainant's prima facie case and has not established any rights or legitimate interest in the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy). The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Panel finds that the Complainant has established that the disputed domain name was registered by the Respondent and is being used by the Respondent in bad faith.

The well-known nature of the NOVARTIS trademark has been confirmed in earlier decisions. The name is distinctive and well known in numerous countries including the United Kingdom for the products manufactured and sold by the Complainant.

The Respondent has copied the Complainant's trademark "NOVARTIS" and has combined it with a generic term referring to a location in which the Complainant has an active business presence. Therefore, this registration can only be viewed as an attempt to exploit the goodwill vested in the trademark by attracting Internet users and confusing them to the extent that they would believe that a website connected to the disputed domain name offers the services of an entity that is affiliated to the Complainant.

No other reason for registering a combination of the trademark of the Complainant together with generic terms as a domain name appears even remotely feasible. Any, even the most basic Google search in respect of the letter combination NOVARTIS would have yielded obvious references to the Complainant.

The disputed domain name is passively held. There is no evidence of any actual or contemplated good-faith use of the disputed domain name, as previous UDRP panels held. Instead, previous UDRP panels have held, under the doctrine of passive holding, that the non-use of a domain would not prevent a finding of bad faith and that it is possible, in certain circumstances, for inactivity by the Respondent to amount to the domain name being used in bad faith. This has also been held for Respondents concealing their identity behind privacy shields as was the case here.

The Panel therefore concludes that the Respondent has registered and is using the disputed domain name in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy). The Complainant has therefore also satisfied the requirement under 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-eu.com**: Transferred

PANELLISTS

Name	**Udo Pfleghar B.A. (Melb.)**

DATE OF PANEL DECISION 2024-03-13

Publish the Decision