Decision for dispute CAC-UDRP-106488

Case number	CAC-UDRP-106488
Time of filing	2024-05-03 16:36:06
Domain names	novartislimited.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Name	Timothy Neaves

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 proved to own the following trademark registrations which predate the registration of the disputed domain name:

- South Africa trademark NOVARTIS No. 1996/09136 as of July 9, 1996 in class 5;
- Swiss trademark NOVARTIS No. 2P-427370, registered on 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;

- The International trademark NOVARTIS No. 663765, registered on 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;
- The United States trademark NOVARTIS No. 4986124, registered on June 28, 2016, in classes 5, 9, 10, 41, 42 and 44; and
- The United States trademark NOVARTIS No. 6990442, registered on February 28, 2023, in class 5.

The Complainant also owns the domain names <**novartis.com**> (created on 2 April 1996), <**novartis.us**> (created on 19 April 2002) and <**novartispharma.com**> (created on 27 October 1999).

FACTUAL BACKGROUND

I. Complainant

The Complainant is one of the biggest global pharmaceutical and healthcare groups. Novartis AG (the “Complainant”), created in 1996 through a merger of two other companies Ciba-Geigy and Sandoz, is the holding company of the Novartis Group.

According to the Complainant's submissions, the NOVARTIS trademark has a strong presence in South Africa through its local subsidiary.

Moreover, 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 is also very active via its official social media platforms.

II. The disputed domain name and the Respondent

<Novartislimited.com> was registered on March 4, 2024 and currently links to an inactive website. According to the information provided by the Registrar, the Respondent is Timothy Neaves domiciled in South Africa.

PARTIES CONTENTIONS

COMPLAINANT

The Complainant supports that the disputed domain name is confusingly similar to its trademarks as it entirely incorporates the NOVARTIS trademark, in combination with the term “LIMITED”, which could be easily associated to a company form. The addition of the gTLD “.com” does not add any distinctiveness to the disputed domain name.

The Complainant denies that the Respondent has rights or legitimate interests in respect of the disputed domain name and Novartis AG has never had any business relationship with the Respondent. Moreover, the Complainant excludes that the Respondent is known with the disputed domain name.

The Complainant supports that the disputed domain name is registered and used in bad faith, given the high reputation of the NOVARTIS trademark and the fact that <novartislimited.com> is not actively used.

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

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

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 addition of the element "limited" increases rather then excludes the likelihood of confusion since it could be associated to a specific company form.

The Complainant agrees that the ".com" extension has no impact in the confusing similarity assessment due to its technical function.

As a consequence, 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 is required to make out a prima facie case that a respondent lacks rights or legitimate interests in the disputed domain name. Once such 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 that the Respondent's lack of rights and legitimate interests in the disputed domain name.

According to the information provided by the Complainant and not contested, the Respondent is not commonly known by the disputed domain name nor he is authorized to use the Complainant's trademark "NOVARTIS". Moreover the Whois record does not provide any right or legitimate interest in the registration of <novartislimited.com> by the Respondent.

<novartislimited.com> 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 purposes of the Policy.

3. The disputed domain name was registered and is used in bad faith.

The Panel finds the following circumstances as material in order 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. The reputation of the trademark NOVARTIS, including in South Africa, 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 structure of the disputed domain name (trademark + generic term - NOVARTIS + LIMITED) is an index of the Respondent's intention to create an association, and consequently a likelihood of confusion, with the Complainant's trademark.

As concerns the use in bad faith requirement, the Panel points out that <novartislimited.com> 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, as said above, the NOVARTIS trademark enjoys a high degree of reputation all over the world. The high reputation of the Complainant's trademark excludes any plausible use in good faith of the disputed domain name. Furthermore, the Respondent did not file any response nor in the UDRP nor before (in response to the c&d) providing information on a possible good faith use of the disputed domain name. Moreover the Respondent's contact details were previously shielded by a privacy protection service which is, combined with the other factors, an additional index of use in 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. **novartislimited.com**: Transferred

PANELLISTS

Name	**Andrea Mascetti**

DATE OF PANEL DECISION 2024-06-16

Publish the Decision