

Decision for dispute CAC-UDRP-106834

Case number	CAC-UDRP-106834
Time of filing	2024-09-03 15:10:06
Domain names	novartisimmunologyprizes.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	Abion GmbH
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Respondent

Name	Andrew Tanoto
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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 submitted evidence that it is the owner of the following trademarks:

- The Swiss wordmark “NOVARTIS”, registration number 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 wordmark “NOVARTIS”, registration number 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 Cambodian wordmark “NOVARTIS”, registration number KH/1997/9225, registered on **June 23, 1997**, in class 5;
- The US wordmark “NOVARTIS”, registration number 4986124, registered on **June 28, 2016**, in classes 5, 6, 18, 44, 46, 51 and 52;

- The international wordmark “NOVARTIS”, registration number 1349878, registered on **November 29, 2016**, in classes 9, 10, 41, 42, 44 and 45;
- The US combined trademark “NOVARTIS”, registration number 6990442, registered on **February 28, 2023**, in class 5.

Hereinafter the “**Trademarks**”.

FACTUAL BACKGROUND

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

The Complainant claims to be one of the biggest pharmaceutical and healthcare groups of the world. The Complainant states its products are manufactured and sold in many countries worldwide. The Complainant also states it has an active presence in several countries around the globe through its Novartis Access program. The Complainant specifies that it offers patient access programs in Cambodia, where the Respondent is located.

Every three years the Complainant awards The Novartis Prizes for Immunology for breakthrough contributions to the field of basic and clinical immunology.

The Complainant provided evidence that it is the registered owner of the Trademarks and several domain names that include the term “NOVARTIS” such as <novartis.com> since April 2, 1996, and <novartispharma.com> since October 27, 1999.

The Complainant also provided evidence it has a strong presence online via its social media platforms (Facebook, Twitter, Instagram).

The disputed domain name <novartisimmunologyprizes.com> was registered on June 30, 2024 (hereafter the “**Disputed Domain Name**”).

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the Disputed Domain Name should be transferred to it.

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.

Confusing similarity

The Disputed Domain Name <novartisimmunologyprizes.com> consists of the word element of the Complainant's Trademarks "NOVARTIS" with the addition of the English terms "IMMUNOLOGY" and "PRIZES".

According to the Complainant, the addition of a hyphen and the English terms "IMMUNOLOGY" and "PRIZES" is not sufficient to avoid a likelihood of confusion with the Trademarks. The Complainant argues that the mere addition of descriptive terms does not prevent a finding of confusing similarity to the Trademarks. Furthermore, the Complainant argues that the gTLD ".com" may be disregarded when assessing whether the Disputed Domain Name is confusingly similar to the Trademarks.

The Panel notes that the Disputed Domain Name incorporates the entirety of the Complainant's "NOVARTIS" Trademarks (at least the word element of the Trademarks, which is the dominant element of the Trademarks), with the addition of the English terms "IMMUNOLOGY" and "PRIZES".

The Panel remarks that Section 1.7 of WIPO Overview 3.0, clearly states that, *"in cases where a domain name contains the whole of a trademark, or where at least one dominant feature of the relevant trademark is recognisable in the domain name, the domain name shall normally be considered confusingly similar to that trademark for the purposes of UDRP status"*.

The Panel finds that the addition of the English terms "IMMUNOLOGY" and "PRIZES" does not prevent a finding of confusing similarity under the first element of paragraph 4(a) of the Policy, since these are pure descriptive terms. On the contrary, the addition of these terms increases the confusing similarity due to the fact that the Complainant awards every three years so called "Novartis Prizes for Immunology" for contributions to the field of immunology.

This is supported by section 1.8 of WIPO Overview 3.0, which clearly states: *"Where the relevant mark is recognisable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless or otherwise) would not preclude a finding of confusing similarity under the first element"*.

It is well-established that the gTLD ".com" may be disregarded when it comes to considering whether a domain name is confusingly similar to a trademark in which a complainant has rights. Moreover, section 1.11.1 of WIPO Overview 3.0 clearly states: *"The applicable Top Level Domain ("TLD") in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test."*

For these reasons, the Panel concludes that the Disputed Domain Name is confusingly similar to a trademark in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

Rights or legitimate interests

As regards paragraph 4(a)(ii) of the Policy, while the overall burden of proof rests with the Complainant, it is commonly accepted that this should not result in an often-impossible task of proving a negative. Therefore, numerous previous panels have found that the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the Disputed Domain Name. If the Respondent fails to come forward with such appropriate allegations or evidence, the Complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy. If the Respondent does come forward with some allegations or evidence of relevant rights or legitimate interests, the Panel then must weigh all the evidence, with the burden of proof always remaining on the Complainant.

The Complainant argues that:

- The Respondent was not authorized to use the Trademarks in the Disputed Domain Name or in any other form;
- The Respondent is not commonly known by the Disputed Domain Name. On the contrary, when conducting a search in open trademark databases, no trademarks are found corresponding to the terms "NOVARTISIMMUNOLOGYPRIZES.COM", "NOVARTISIMMUNOLOGYPRIZES" or "NOVARTIS IMMUNOLOGY". Moreover, when conducting a search on Google with the terms "NOVARTIS" alone or in combination with the terms "IMMUNOLOGY" and "PRIZES", the majority of the search results lead to the Complainant.
- The Disputed Domain Name refers to The Novartis Prizes for Immunology granted by the Complainant. The Disputed Domain Name is also very close to the domain name <Novartis.com> of the Complainant. Both may lead internet users to believe the Disputed Domain Name to be linked to the Complainant.
- The Respondent has used the Disputed Domain Name to show Indonesian content related to gambling. Taking this into account, the Complainant argues that the Disputed Domain Name was chosen to attract, confuse and profit from internet users by creating a false association with the Complainant and with that profiting from its reputation and goodwill.
- The Disputed Domain Name is not actively used anymore by the Respondent; therefore, it is not being used in connection with bona fide offering of goods and services.

The Respondent did not file an administratively compliant (or any) response. The Respondent did not provide evidence that he has rights or legitimate interests in the Disputed Domain Name.

The Panel finds that the Respondent does not appear to have any rights or legitimate interests in the Disputed Domain Name from the following facts:

- There is no evidence that the Respondent is or has been commonly known by the Disputed Domain Name or by the term “NOVARTIS” (alone or in combination with the terms “IMMUNOLOGY” and “PRIZES”). The Respondent did not show to have any trademark rights or other rights regarding the term “NOVARTIS” (alone or in combination with the terms “IMMUNOLOGY” and “PRIZES”).
- The Complainant’s Trademarks were registered and have been used well before the registration date of the Disputed Domain Name. The Disputed Domain Name was registered on June 30, 2024, whereas all of the Trademarks of the Complainant were registered well before this date.
- There is no evidence that shows that the Respondent is making a legitimate non-commercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers.
- The Respondent does not seem to have any consent or authorisation to use the Trademarks of the Complainant and does not seem to be related in any way to the Complainant.

In sum, on the balance of probabilities, and in the absence of any evidence to the contrary or any administratively compliant response being put forward by the Respondent, the Panel finds that the Complainant has made a prima facie case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name.

The Panel concludes that the Respondent does not have rights or legitimate interests in the Disputed Domain Name.

Bad faith

The Complainant argues that:

- The registration of the Trademarks pre-date the registration of the Disputed Domain Name.
- The Respondent had knowledge of the Complainant and the Trademarks since the Complainant has a strong online presence and has a presence in Cambodia through the Novartis Access program. Moreover, the Complainant awards the Novartis Prizes for Immunology, for breakthrough contributions to the fields of basic and clinical immunology. This all results in the fact that when a search on Google is conducted with the terms “NOVARTIS” alone or in combination with the terms “IMMUNOLOGY” and “PRIZES”, the majority of the search results lead to the Complainant.
- The Disputed Domain Name resolved to a website with content in Indonesian related to gambling. Taking this into account, the Complainant argues that the Disputed Domain Name was chosen to attract, confuse and profit from internet users by creating a false association with the Complainant and with that profiting from its reputation and goodwill.
- Currently, the Disputed Domain Name is passively held. Therefore, according to the Complainant, there is no evidence of any actual or contemplated good-faith use of the Disputed Domain Name.
- The combination of the term “NOVARTIS” and the terms “IMMUNOLOGY” and “PRIZES”, creates a direct association with the Complainant and its business since the Complainant develops and delivers pharmaceuticals worldwide. The Complainant claims that the Respondent has used the Disputed Domain Name to intentionally confuse consumers by creating a similarity between the Disputed Domain Name and the Complainant.
- The Respondent is trying to conceal its identity regarding the ownership of the Disputed Domain Name by using a privacy service shield.
- The Respondent chose not to reply to the cease-and-desist letter of the Complainant. The Complainant states that this infers bad faith.
- Active MX records are associated to the Disputed Domain Name. Therefore, there is a risk that corresponding fraudulent e-mail addresses are associated with the Disputed Domain Name.

The Panel weighs these arguments and facts as follows:

- As mentioned already, the Disputed Domain Name reproduces the word element (i.e., the dominant element) of the Complainant's Trademarks "NOVARTIS" entirely, with the addition of the descriptive words "IMMUNOLOGY" and "PRIZES". These combined terms clearly refer to the Complainant, its business, and its Novartis Immunology Prizes, and thereby causes (or risks to cause) confusion among the public.
- The Complainant’s Trademarks and domain names predate the registration of the Disputed Domain Name with several years.
- It is inconceivable that the Respondent would have come up with a domain name consisting of the term “NOVARTIS” in combination with the term “IMMUNOLOGY” and “PRIZES” without having prior knowledge of the Complainant, its Trademarks and its activities. On the balance of probabilities, it seems evident that the Respondent had actual knowledge of the existence of the Complainant and its activities, and of the Complainant's Trademarks and the scope of the Trademarks at the time of registration and use of the Disputed Domain Name. The Panel is convinced that the Respondent had the Trademark(s) of the Complainant in mind when registering and using the Disputed Domain Name.
- The Respondent intends to create an association with the Complainant through the Disputed Domain Name and has shown gambling content on the webpage resolving to the Disputed Domain Name. This shows the Respondent clearly had a commercial gain. This cannot be seen as a bona fide offering of goods.
- The Respondent did not contest any of the Complainant’s arguments and did not provide any explanation concerning its choice for registering and/or using a domain name that includes the word element (i.e., the dominant element) of the Complainant’s registered Trademarks in combination with the descriptive words “IMMUNOLOGY” and “PRIZES”.
- The Respondent did not answer to the cease-and-desist letter of the Complainant.

Given the above elements, the Panel concludes that the Disputed Domain Name is being used for the purpose of misleading internet users. There is no evidence whatsoever of any bona fide offering of goods or services. The Disputed Domain Name was registered and is being used in bad faith within the meaning of 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. **novartisimmunologyprizes.com**: Transferred
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PANELLISTS

Name	Bart Van Besien (Presiding Panelist)
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DATE OF PANEL DECISION 2024-10-03

Publish the Decision
