

Decision for dispute CAC-UDRP-106829

Case number	CAC-UDRP-106829
Time of filing	2024-09-02 09:20:02
Domain names	novartis-ios.app, novartiscn.com, novartiscn.pro

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

Organization	Aians Pnesesei (Hornsby)
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OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that are pending or decided and that relate to the Disputed Domain Names.

IDENTIFICATION OF RIGHTS

Complainant states, and provides evidence to support, that it “is the owner of the registered well-known trademark NOVARTIS in numerous jurisdictions all over the world, including in Australia, a country where it has an active presence through its subsidiaries and associated companies and where it has been playing an active role on the local markets and societies.” These registrations include Int’l Reg. Nos. 1,544,148 for NOVARTIS (registered June 29, 2020) and 1,349,878 for NOVARTIS (registered November 29, 2016); and Australia Reg. Nos. 2,237,137 (registered December 16, 2021) and 2,239,987 (registered November 26, 2021). These registrations are referred to herein as the “NOVARTIS Trademark.”

FACTUAL BACKGROUND

Complainant states that it was created in 1996 and “is one of the biggest global pharmaceutical and healthcare groups”; that it “provides solutions to address the evolving needs of patients worldwide by developing and delivering innovative medical treatments and drugs”; and that it “achieved net sales of USD 45.4 billion, and total net income amounted to USD 14.9 billion and employed approximately 76 000 full-time equivalent employees as of December 31, 2023.”

The Disputed Domain Names were created on July 19, 2024.

Complainant states that the Disputed Domain Names “have “been passively held.” Printouts of the home pages of the website

associated with each of the Disputed Domain Names show inactive websites.

PARTIES CONTENTIONS

Complainant contends, in relevant part, as follows:

Paragraph 4(a)(i): Complainant argues that it has rights in the NOVARTIS Trademark as a result of the registrations cited above. Complainant further states that each of the Disputed Domain Names is confusingly similar to the NOVARTIS Trademark because they incorporate the NOVARTIS Trademark in its entirety plus (in the case of <novartiscn.com> and <novartiscn.pro>) “the term ‘cn’, most likely a reference to the 2-letter country code for China, a country where the Complainant has an active business presence”; and (in the case of <novartis-ios.app>) “the relevant term ‘ios’ separated by a hyphen,” which “is most likely a reference for the operating system (OS) software that runs on mobile Apple devices.”

Paragraph 4(a)(ii): Complainant argues that Respondent has no rights or legitimate interests in respect of the Disputed Domain Names because, inter alia, “[t]he 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 names”; “[t]he Complainant has not found that the Respondent is known by the disputed domain names”; “[t]he disputed domain names are not being used in connection with bona fide offering of goods or services” because they “have indeed been passively held”; Respondent has not replied to a demand letter sent by Complainant; and “[t]he use of the Complainant’s well-known trademark in the second level portion of the disputed domain names is a deliberate attempt by the Respondent to create a false association and confuse consumers.”

Paragraph 4(a)(iii): Complainant argues that the Disputed Domain Names were registered and are being used in bad faith because, inter alia, given that “previous UDRP panels have stated that the NOVARTIS trademark is well-known... [i]t is therefore inconceivable that the Respondent was unaware of the existence of the Complainant when it registered the disputed domain names”; and “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”; and the passive holding doctrine applies since “the NOVARTIS trademark is well-known” and Respondent did not reply to Complainant’s demand letter.

No administratively compliant response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Disputed Domain Names are 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 UDRP).

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 Names (within the meaning of paragraph 4(a)(ii) of the UDRP).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Disputed Domain Names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the UDRP).

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

Identical or Confusingly Similar: Paragraph 4(a)(i):

Based upon the trademark registrations cited by Complainant, it is apparent that Complainant has rights in and to the NOVARTIS

Trademark.

As to whether the Disputed Domain Names are identical or confusingly similar to the NOVARTIS Trademark, the relevant comparison to be made is with the second-level portion of the Disputed Domain Name only (i.e., “novartiscn” and “novartis-ios”) because “[t]he 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.” WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”), section 1.11.1.

As set forth in section 1.7 of WIPO Overview 3.0, “in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.” Further, “[w]here the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.” WIPO Overview 3.0, section 1.8. Here, each of the Disputed Domain Names incorporates the entirety of the NOVARTIS Trademark, which is recognizable within the Disputed Domain Names despite the addition of the terms “cn” and “-ios”.

Accordingly, the Panel finds that Complainant has proven the first element of the Policy.

Rights or Legitimate Interests: Paragraph 4(a)(ii)

Complainant states that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name for the reasons set forth above.

WIPO Overview 3.0, section 2.1, states: “While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of ‘proving a negative’, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.”

The Panel finds that Complainant has established its prima facie case and, without any evidence from Respondent to the contrary, the Panel is satisfied that Complainant has satisfied the second element of the UDRP.

Registered and Used in Bad Faith: Paragraph 4(a)(iii)

Whether a domain name is registered and used in bad faith for purposes of the UDRP may be determined by evaluating four (non-exhaustive) factors set forth in paragraph 4(b) of the UDRP: (i) circumstances indicating that the registrant has registered or the registrant has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the registrant’s documented out-of-pocket costs directly related to the domain name; or (ii) the registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the registrant has engaged in a pattern of such conduct; or (iii) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant’s website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the registrant’s website or location or of a product or service on the registrant’s website or location.

As set forth in section 3.1.4 of WIPO Overview 3.0: “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.” That is precisely the case here.

Accordingly, the Panel finds that Complainant has proven 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. **novartis-ios.app**: Transferred
2. **novartiscn.com**: Transferred
3. **novartiscn.pro**: Transferred

PANELLISTS

Name **Douglas Isenberg**

DATE OF PANEL DECISION 2024-10-10

Publish the Decision
