Decision for dispute CAC-UDRP-106907

Case number	CAC-UDRP-106907
Time of filing	2024-10-02 09:23:20
Domain names	novartisca.com

Case administrator

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

Complainant

Organization	Novartis AG

Complainant representative

Organization	Abion GmbH

Respondent

Organization	Registrant of novartisca.com

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 inter alia the owner of the Australian trademark registration no. 663765 "NOVARTIS", registered on July 1, 1996, for various goods and services in classes 1, 2, 3, 4, 5, 7, 8, 9, 10, 14, 16, 17, 20, 22, 28, 29, 30, 31, 32, 40, and 42 (hereinafter referred to as the "Trademark").

FACTUAL BACKGROUND

The Complainant is the holding company of the Novartis Group, one of the biggest global pharmaceutical and healthcare groups, which was established in 1996 through a merger of two other companies Ciba-Geigy and Sandoz. The Complainant's products are manufactured and sold in many regions worldwide. The Complainant has a strong presence and several subsidiaries and associated companies in Australia, where the Respondent is located. The Complainant is the registered owner of numerous domain names, including <novartis.com> and <novartis.ca>.

The disputed domain name was registered on May 22, 2024, and is not actively used.

The Complainant sent a cease and desist letter to the Respondent on June 4, 2024, to which the Respondent did not reply.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant contends that the disputed domain name is confusingly similar to the Trademark as the Trademark is clearly recognizable within the disputed domain name, as the term “ca” refers to the country code for Canada and is generic, and as the gTLD extension ".com" may be disregarded when assessing whether the disputed domain name is confusingly similar to the Trademark.

The Complainant also states that the Respondent does not have any rights or legitimate interest with regard to the disputed domain name. The Complainant argues that it has never granted the Respondent any right to use the Trademark in the disputed domain name, that the Respondent is not affiliated to the Complainant in any form, that the Respondent is not known by the disputed domain name, that the Respondent has no trademark rights in the terms “novartisca” or “novartis ca”, and that the disputed domain name is being passively held and not used in connection with a bona fide offering of goods and services or in connection with a legitimate noncommercial or fair use. The Complainant argues that 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.

With respect to bad faith, the Complainant alleges that the disputed domain name was registered and is being used in bad faith. With respect to bad faith registration, the Complainant argues that the Respondent was aware of the Complainant and the Trademark because the Trademark is well-known (as confirmed in prior UDRP decisions) and because the Complainant has a strong online presence and is very active in social media to promote its mark, products and services. The Complainant further alleges that the disputed domain name directly targets the Complainant's Canadian online presence at <novartis.ca>. With respect to bad faith use, the Complainant relies on the passive holding doctrine and contends that the Respondent has not demonstrated any activity with respect to the disputed domain name and that it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be unlawful, such as passing off, infringement of consumer protection laws, or an infringement of the Complainant’s trademark rights.

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

Paragraph 4(a) of the Policy requires the Complainant to establish each of the following three elements:

(i) the disputed domain name is identical or confusingly similar to the Complainant's trademark; 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.

1. The Panel accepts that the disputed domain name is confusingly similar to the Trademark because the Trademark is recognizable in the disputed domain name. It is well established that a domain name that fully incorporates a trademark may be confusingly similar to such a trademark within the meaning of the Policy despite the addition of generic terms such as "CA".

2. The Complainant has substantiated that the Respondent has no rights or legitimate interests in the disputed domain name. The Panel finds that the Complainant has fulfilled its obligations under paragraph 4(a)(ii) of the Policy. The Respondent has not denied these allegations and has therefore failed to establish any rights or legitimate interests in the disputed domain name.

Based on the evidence on file, the Panel cannot find any rights or legitimate interests of the Respondent either. In particular, the disputed domain name is inactive and the Respondent has not provided any evidence of use or demonstrable preparations for use of the disputed domain name. Accordingly, the Panel finds that the Complainant has established that the Respondent has no rights or legitimate interests in respect of the disputed domain name under paragraphs 4(a)(ii) and 4(c) of the Policy.

3. The Panel is satisfied that the Respondent registered the disputed domain name with full knowledge of the Complainant and its rights in the Trademark as the Trademark is highly distinctive and very well established.

Furthermore, the Panel accepts the Complainant's contentions that the disputed domain name has been used in bad faith under the principles of passive holding. It is consensus view that the lack of an active use of a domain name does not as such prevent a finding of bad faith under the Policy. In such cases, the panel must examine all the circumstances of the case to determine whether a respondent is acting in bad faith. Examples of circumstances that may indicate bad faith include a complainant having a well-known trademark, no response to the complaint, the respondent’s concealment of identity, and the impossibility of conceiving a good faith use of the domain name (cf Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003; Jupiters Limited v. Aaron Hall, WIPO Case No. D2000-0574; Ladbroke Group Plc v. Sonoma International LDC, WIPO Case No. D2002-0131).

The Panel is convinced that the Trademark is highly distinctive and well-established. Furthermore, the Respondent failed to file a Response or to the Complainant's cease and desist letter and therefore did not provide evidence of any actual or contemplated good faith use of the disputed domain name. In the view of the Panel, the facts of this case do not allow for any plausible actual or contemplated active use of the disputed domain name by the Respondent in good faith. The Panel is therefore convinced that, even though the disputed domain name has not yet been actively used, the Respondent’s non-use of the disputed domain name equals to use in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **novartisca.com**: Transferred

PANELLISTS

Name	**Peter Müller**

DATE OF PANEL DECISION 2024-11-09

Publish the Decision