Decision for dispute CAC-UDRP-106993

Case number	CAC-UDRP-106993
Time of filing	2024-10-25 08:58:10
Domain names	novartis-offer.com

Case administrator

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

Complainant

Organization	Novartis AG

Complainant representative

Organization	Abion GmbH

Respondent

Name	sandy royal NANIT

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

For the Complainant

The Complainants Enjoys Registered Trademark Rights

The Complainant has acquired and enjoys registered trademark rights in respect of its trademark “NOVARTIS” in many jurisdictions worldwide, including the following jurisdictions:

Swiss trademark: NOVARTIS

Reg. No. 2P-427370

Registration Date: July 1, 1996

International trademark: NOVARTIS

Reg. No. 663765

Registration Date: July 1, 1996

International Trademark: NOVARTIS

Reg. no: 1349878

Reg. date: November 29, 2016

US trademark: NOVARTIS

Reg No. 4986124

Registration Date: June 28, 2016

US trademark: NOVARTIS

Reg. No. 6990442

Registration Date: February 28, 2023

EU trademark: NOVARTIS

Reg. No. 304857

Registration Date: June 25, 1999

The Complainant’s acquisition of registered trademark rights predates the date of the registration of the disputed domain name which is 26 August 2024.

The Complainant’s Use of Trademark Reinforces its Trademark Rights

The evidence submitted to this Panel has unequivocally demonstrated the Complainant's extensive and continuous use of its trademark "NOVARTIS". The Complainant has also incorporated its trademark into domain name registrations under numerous Top-Level-Domains, including <novartis.com>, <novartis.us> and other domain names which have served as online portals for the Complainant's official website since 1996. The Complainant's use of its trademark in social media platforms and other online environments further strengthens its trademark rights. This use of trademark, both offline and online, has not only reinforced the Complainant's trademark rights but has also made the trademark a distinctive identifier of the Complainant's goods and services.

For the Respondent

There is no evidence submitted to this Panel with regards to whether the Respondent has trademark rights.

FACTUAL BACKGROUND

For the Complainant

The Complainant, a leading global pharmaceutical and healthcare group established in 1996, is dedicated to meeting the evolving needs of patients worldwide. It achieves this by developing and delivering innovative medical treatments and drugs. The Complainant, with its headquarters in Switzerland, is the holding company of the Novartis Group, formed through the merger of Ciba-Geigy and Sandoz.

For the Respondent

The Respondent registered the disputed domain name on 26 August 2024.

PARTIES CONTENTIONS

The Complainant

The Complainant, as the owner of the well-known trademark “NOVARTIS,” asserts that the disputed domain name, which incorporates the Complainant’s mark in its entirety and followed by the term “offer,” separated by a hyphen, is causing confusion among internet users.

The Complainant also refers to Third Edition (“WIPO Jurisprudential Overview 3.0”) para. 1.8 and Rollerblade, Inc. v. Chris McCrady, WIPO Case No. D2000-0429; Can Pro Pet Products LTD. v. Matthew Dweck, WIPO Case No. D2020-0615; Sanofi v. Aamir Hitawala, WIPO Case No. D2021-1781 to substantiate his assertion in this regard.

The Complainant also alleges that Respondent has no rights or legitimate interests in respect of the disputed domain name mainly for the following facts:

- The Complainant has never granted the Respondent with any rights to use the NOVARTIS trademark in any form, including in the disputed domain name;
- No evidence is found that Respondent is not known by “novartis-offer” or “novartis offer”;
- Respondent is not in any way connected, associated, or affiliated with Complainant;
- The disputed domain name points to a parking site with “pay per click” links;
- The Complainant receives no response from the Respondent to the Cease-and-Desist Letter (C&D Letter) sent by the Complainant via a publicly available WhoIs records and the registrar.

  The disputed domain name is not used in connection with a bona fide offering of goods and services.

The Complainant further contends that the disputed domain name was registered in bad faith and is being used in bad faith. The Complainant asserts its trademark is well-known globally, and the Respondent’s intention to create an association, and a subsequent likelihood of confusion, with the Complainant, its NOVARTIS trademark, and the Novartis group in Internet users’ minds. The Respondent likely obtained a financial benefit when Internet users clicked on the links above. Such use of the disputed domain name aims at attracting Internet users for commercial gain by creating a likelihood of confusion with the Complainant’s NOVARTIS trademark as to the sources, sponsorship, affiliation, or endorsement of the aforementioned PPC page. Moreover, the Respondent has not responded to the Complainant’s C&D Letter infers bad faith.

The Complainant also asserts that the Respondent is trying to conceal its identity regarding the ownership of the disputed domain name – as its name and most of its contact details are covered by a privacy shield in the corresponding WHOIS records, which also infers further evidence of bad faith.

The Respondent

The Respondent did not submit a Response in respect of the Complaint within the required period of time.

RIGHTS

A) Identical or Confusing Similarity

The Panel finds that the Complainant has produced sufficient evidence to establish it enjoys registered trademark rights concerning the name "NOVARTIS" and that the Complainant's trademark is well-known worldwide and has a strong business presence on the Internet. This finding concurs with a recent UDRP decision involving the Complainant and the same trademark, where the Panel finds the Complainant's registered word mark to be well-known. (aboratoires M&L v. Zhaoxingming, CAC Case No. 102277).

The Panel's meticulous examination concludes that the disputed domain name is indeed confusingly similar to the Complainant's trademark. Including the entire trademark and adding a hyphen and the term 'offer' does not diminish this similarity.

The Panel acknowledges the Complainant's extensive and continuous use of the trademark in its business. This recognition, coupled with the trademark's high distinctiveness, reinforces the Panel's finding of confusing similarity between the Complainant's trademark and the disputed domain name.

Based on the evidence presented, the Panel finds that the Complainant has established the first element of the UDRP. The disputed domain name is either identical or confusingly similar to the Complainant's "NOVARTIS" mark, as per the Panel's finding.

NO RIGHTS OR LEGITIMATE INTERESTS

B) Rights or Legitimate Interests of the Respondent

While the Complainant bears the overall burden of proof in UDRP proceedings, various UDRP panels have recognized that if a complainant makes out a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name, then the burden of proof of this element shifts to the Respondent to produce relevant evidence demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to provide such relevant evidence, the Complainant is deemed to have satisfied the second element.

Having considered the totality of the evidence in the present case, the Panel accepts that the Complainant has made out a prima facie case that the Respondent lacks rights or legitimate interests in respect of the disputed domain name. On the other hand, the Respondent has provided no evidence that it has rights or legitimate interests in the disputed domain name.

BAD FAITH

C) Bad Faith

Paragraph 4(a) of the Policy requires the Complainant to prove both registration and use in bad faith. Nonetheless, Paragraph 4(b) of the Policy sets out particular scenarios, which shall be evidence of the registration and use of a domain name in bad faith. They are:

(i) circumstances indicating that the Respondent has registered or the Respondent 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 Respondent's documented out of pocket costs directly related to the domain name; or

(ii) the Respondent 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 Respondent has engaged in a pattern of such conduct; or

(iii) the Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location.

The Panel finds that the Complainant's mark "NOVARTIS" is well-known and enjoys a high and longstanding reputation in many countries worldwide. As such, the Panel infers that the Respondent must have been fully aware of the Complainant's trademark and its goodwill before registering the disputed domain name, which suggests that the registration of the disputed domain name is likely to target the Complainant's Trademark.

Having established that the Respondent has no rights or legitimate interests in the disputed domain name, the Panel's conclusion is unequivocal: the Respondent's registration and use of the disputed domain name was not a coincidence, but a deliberate act of bad faith under paragraph 4b(iv) of the Policy.

The Complainant also produces evidence to show that the disputed domain name also resolves to a Parking Page with "pay per click" links, that the Respondent has failed to respond to the Complainant's C&D Letter, and that an MX record is set up in association with the disputed domain name. The Complainant's above assertions are persuasive in proving the registration and use of disputed domain name are likely to obtain a financial benefit attracting Internet users for commercial gain by creating a likelihood of confusion with the Complainant's "NOVARTIS" trademark as to the sources, sponsorship, affiliation, or endorsement.

PROCEDURAL FACTORS

Procedural Issue - Language of the Proceedings

The Complainant asserts that the language of the proceedings should be English. The Complainant refers to Paragraph 11 of the UDRP Rules which provides that unless otherwise agreed by the parties, the language of the proceeding is the language of the registration agreement. The Complainant also produces a registration agreement of the Registrar of the disputed domain name, which is in English, further supporting their request for English as the language of the proceedings.

The Complainant also refers to Carrefour v. Contact Privacy Inc. Customer 1242379769 / Le Berre, WIPO Case No. D2018-1552, which emphasises that UDRP panelists should exercise their discretion on language issue in the spirit of fairness to both parties.

This is in line with paragraph 10(b) of the Rules, which mandates that all parties be treated with equality. The panelists should take into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs, to ensure a fair and equal process for all.

In the present case, the Complaint is filed in English, the disputed domain name is in English, the Registration Agreement is in English, the Respondent's name is in English and its location is in India (where English is one of the official languages) according to the registration information provided by the Registrar. This prevalence of English in the case underscores its suitability as the language of the proceedings.

Based on the above, the Panel finds that the Language of the Proceedings is English, taking into account the Complainant's assertions, the UDRP Rules, and the circumstances of the case. This decision is made to ensure a fair and equal process for all parties involved.

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

Substantive Issues

Paragraph 4(a) of the Policy directs that the Complainant must prove **each of** the following:

1) that the disputed domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

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

3) that the disputed domain name has been registered and is being 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. **novartis-offer.com**: Transferred

PANELLISTS

Name	**Dennis Weiping CAI**

DATE OF PANEL DECISION 2024-12-08

Publish the Decision