

Decision for dispute CAC-UDRP-103559

Case number	CAC-UDRP-103559
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Time of filing	2021-02-04 10:23:40
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Domain names	Novartisusa.info
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Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	Novartis AG
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Complainant representative

Organization	BRANDIT GmbH
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Respondent

Name	Viktor Iobak
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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 <novartisusa.info>.

IDENTIFICATION OF RIGHTS

According to the Complainant, Novartis AG is "one of the biggest global pharmaceutical and healthcare groups. It provides solutions to address the evolving needs of patients worldwide by developing and delivering innovative medical treatments and drugs".

The Complainant's products are manufactured and sold in many regions worldwide. The Complainant has especially a strong presence in the United States of America (the "USA"), where the Respondent is located.

The Complainant is the trademark owner for "NOVARTIS" as a word and figure mark in several classes in numerous countries worldwide. These trademark registrations significantly predate the registration of the disputed domain name.

The Complainant has registered several domain names, including the NOVARTIS mark, such as <novartis.com> (registered 2 April 1996) and <novartis.us> (registered 19 April 2002). The Complainant uses these domain names to promote the NOVARTIS mark with related products and services.

The disputed domain name <novartisusa.info> was registered on 11 January 2021.

FACTUAL BACKGROUND

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

PARTIES' CONTENTIONS:

COMPLAINANT:

- The disputed domain name is identical or confusingly similar to the protected mark

According to the Complainant, the disputed domain name <novartisusa.info>, registered on 11 January 2021, incorporates entirely the Complainant's well-known, distinctive trademark NOVARTIS with the country name "USA", which could mislead consumers that the disputed domain name is related to the Complainant and its activities. The addition of the gTLD ".info" does not add any distinctiveness to the disputed domain name. See as an example the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0"), paragraph 1.11. as well as the International Business Machines Corporation v. Sledge, Inc. / Frank Sledge WIPO Case No. D2014-0581, where the Panel stated the following:

"In addition, it is generally accepted that the addition of the top-level suffix in the domain name (e.g., ".com") is to be disregarded under the confusing similarity test".

The Complainant argues that the same reasoning should apply in the current case, and the disputed domain name should be considered confusingly similar to the trademark NOVARTIS.

- Respondent does not have any rights or legitimate interest in the disputed domain name

The Complainant states that it has never granted the Respondent any right to use the NOVARTIS trademark within the disputed domain name, nor is the Respondent affiliated to the Complainant in any form.

The Complainant has not found that the Respondent is commonly known by the disputed domain name or that it has legitimate interest over the disputed domain name or the major part of it. When entering the terms "Novartisusa" in the Google search engine, the returned results point to the Complainant and its business activities.

According to the Complainant, the Respondent could have easily performed a similar search before registering the disputed domain name and quickly learned that the Complainant owns the NOVARTIS trademarks and that the Complainant has been using its trademarks in the USA where the Respondent resides, and many other countries worldwide. However, the Respondent still chose to register the disputed domain name as such.

From the Complainant's perspective, the Respondent deliberately chose the gTLD ".info" combined with its well-known, distinctive trademark NOVARTIS, very likely with the intention to benefit from the Complainant's worldwide renown to confuse internet users as to the source or sponsorship. Also, the disputed domain name did not resolve to any active website. The Respondent, therefore, has not been using the disputed domain name for any bona fide offering of goods or services.

Therefore, the Complainant contends that the Respondent has no right nor legitimate interest in respect of the disputed domain name.

- The disputed domain name has been registered and is being used in bad faith

According to the Complainant, the Respondent has registered the disputed domain name and uses it in bad faith. The Complainant states that the registration of the Complainant's trademarks predates the registration of the disputed domain name, and the Complainant has never authorized the Respondent to register the disputed domain name.

Given the Complainant's renown, the Complainant argues that it is inconceivable that the combination of the well-known, distinctive trademark NOVARTIS with the country name "USA" as well as the gTLD ".info" in the disputed domain name is a deliberate and calculated attempt to improperly benefit from the Complainant's rights and reputation.

Because i) the Respondent very likely knew about the Complainant and its trademark; ii) the Complainant's trademark NOVARTIS is a well-known, distinctive trademark worldwide and in the USA where the Respondent resides; and iii) the Respondent has failed in presenting a credible evidence-backed rationale for registering the disputed domain name, the disputed domain name shall be according to the Complainant deemed as registered in bad faith, which is supported by WIPO Overview 3.0, para. 3.1.1. and para. 3.1.4.

Finally, the Complainant submits that it has tried to reach the Respondent by a cease-and-desist letter sent on 14 January 2021. The Complainant has not received any response from the Respondent. Since the amicable approach has been unsuccessful, the Complainant chose to file a UDRP complaint.

PARTIES CONTENTIONS

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

The UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (UDRP) of the Internet Corporation for Assigned Names and Numbers (ICANN) (the "Policy") provides that complainant must prove each of the following to obtain transfer or cancellation of the domain name:

1. that respondent's domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights; and
2. that respondent has no rights or legitimate interests in respect of the domain name; and
3. the domain name has been registered and is being used in bad faith.

1) The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights

The Panel is satisfied that the Complainant is the owner of international trademark registrations for NOVARTIS that predate the disputed domain name registration.

The disputed domain name comprises the Complainant's well-known trademark NOVARTIS with the country name "USA". The most distinctive part of the disputed domain name is the Complainant's mark, NOVARTIS. The addition of a purely generic top-level domain ("gTLD") ".info" does not, according to the Panel, add any distinctiveness or prevents the disputed domain name from being confusingly similar to the Complainant's trademark NOVARTIS.

Previous UDRP panels have also held that the gTLD is not to be considered when assessing whether a domain name is identical or confusingly similar to a trademark. See, e.g., *Wiluna Holdings, LLC v. Edna Sherman*, FA 1652781 (Forum Jan. 22, 2016) or *Red Hat Inc. v. Haecke*, FA 726010 (Forum July 24, 2006) (concluding that the redhat.org domain name is identical to the complainant's red hat mark because the mere addition of the gTLD was insufficient to differentiate the disputed domain name from the mark).

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark NOVARTIS.

2) The Respondent lacks rights or legitimate interests in the disputed domain name

Under the Policy, a 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 domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP (see WIPO Overview 2.0, paragraph 2.1).

The Panel finds that the Respondent does not have a legal right to use the term "NOVARTIS" as part of its domain name. The Respondent is not in any way affiliated with the Complainant, nor is it authorized to register the disputed domain name. The Panel agrees with the Complainant that the Respondent is not commonly known by the disputed domain name or has legitimate interest over the disputed domain name. When entering the terms "Novartisusa" in the Google search engine, the returned results point to the Complainant and its business activities.

The Panel finds that the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interest in the disputed domain name. The Respondent failed to file a Response in which it could have provided evidence in support of its rights or legitimate interests. The Respondent is not commonly known by the disputed domain name and has not been authorised by the Complainant to use the term "NOVARTIS". Therefore, all these circumstances are sufficient to establish a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name.

Thus, the Panel believes that the Respondent lacks rights or legitimate interests in the disputed domain name.

3) The disputed domain name has been registered and is being used in bad faith

The Panel agrees with the Complainant that its trademark NOVARTIS is distinctive and well-known globally. The Complainant's well-known trademark NOVARTIS predates the registration of the disputed domain name. The Panel finds that there appears no reason why the Respondent would register the Complainant's trademark as part of the disputed domain name, other than to create the impression that it is connected to the Complainant's business. Given the distinctiveness of the Complainant's trademark worldwide and in the USA where the Respondent resides and reputation, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark.

The fact that the Respondent has registered the disputed domain name that is confusingly similar to them indicates and in the absence of any evidence contrary (or any administratively compliant response at all) being put forward by the Respondent, that the Respondent, according to this Panel, had knowledge of the Complainant's trademark and that it had such knowledge before the registration and use of the disputed domain name. The Panel thus takes the view that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or location by creating a likelihood of confusion with the Complainant's mark as to the source or sponsorship.

Accordingly, the Panel concludes that the Complainant has satisfied the third element of the Policy, that is that the Respondent's registration and use of the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **NOVARTISUSA.INFO**: Transferred

PANELLISTS

Name	Mgr. Barbora Donathová, LL.M.
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DATE OF PANEL DECISION 2021-03-11

Publish the Decision