

## Decision for dispute CAC-UDRP-103546

Case number	CAC-UDRP-103546
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Time of filing	2021-02-01 09:06:38
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Domain names	novartis.careers
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### 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	BRANDIT GmbH
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### Respondent

Name	Gabriella Garlo
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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

Brazilian trademarks (Respondent is located in Brazil) no: 819403741 (Priority date: 02/15/1996) and no: 819403725 (Priority date: 02/15/1996).

#### FACTUAL BACKGROUND

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

#### I. LANGUAGE OF PROCEEDINGS REQUEST:

To the best of Complainant's knowledge, the language of the Registration Agreement of the Disputed Domain Name <novartis.careers> is English according to the Registrar Verification. Therefore, the language of the proceedings should be English.

#### II. ABOUT COMPLAINANT AND THE BRAND NOVARTIS

The Novartis Group 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. Novartis AG (the “Complainant”), created in 1996 through a merger of two other companies Ciba-Geigy and Sandoz, is the holding company of the Novartis Group.

The Complainant’s products are manufactured and sold in many regions worldwide. The Complainant has especially an active presence in Brazil, where the Respondent is located. The Complainant has established companies Novartis Biociências S.A., Novartis Biociências S.A., Pharma Production, and Novartis Biociências S.A., Production in different locations in Brazil, including Sao Paulo where the Respondent is located. In 2015, the Complainant was the number one research-based pharmaceutical company and the only global company producing APIs in Brazil, which is one of the key health industrial policy objectives of the Brazilian government and is the only global pharmaceutical company building a new biotech factory.

The Complainant also uses its official website <https://www.novartis.com.br/> dedicated to Brazil to communicate with local consumers.

The Complainant is the owner of the well-known, distinctive trademark NOVARTIS as a word and figure mark in several classes in numerous of countries all over the world including in Brazil. These trademark registrations predate the registration of the Disputed Domain Name.

#### Trademark registration in Brazil

Trademark: NOVARTIS

Reg. no: 819403741

Priority date: 02/15/1996

Trademark: NOVARTIS

Reg. no: 819403725

Priority date: 02/15/1996

Moreover, previous UDRP panels have stated that the NOVARTIS trademark is well-known (inter alia Novartis AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org, / Sergei Lir, WIPO Case No. D2016-1688).

The Complainant owns numerous domain names composed of its trademark NOVARTIS, including <novartis.com> (created on 2 April 1996) and <novartis.net> (created on 25 April 1998). The Complainant uses these domain names to promote the NOVARTIS mark with related products and services.

The Complainant enjoys a strong presence online also via its official social media platforms.

#### LEGAL GROUNDS:

##### A. THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR

The disputed domain name <novartis.careers> (hereinafter referred to as the “Disputed Domain Name”), which was registered on 19 January 2021 according to the WHOIS, incorporates the Complainant’s well-known, distinctive trademark NOVARTIS in its entirety, along with the gTLD “.careers”, which could lead consumers assuming that the domain name at issue is aimed at displaying job offers from Novartis. The addition of the gTLD “.careers” 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 Overview 3.0”), paragraph 1.11. as well as the Swiss Reinsurance Company Ltd. v. Farris Nawas, WIPO Case No. D2014-1873, where the Panel stated the following:

“The Panel considers that the Complainant’s SWISS RE registered trademark is instantly recognizable within the disputed domain name and that the gTLD “.careers” does not differentiate the disputed domain name from the Complainant’s trademark.”

The same reasoning should apply in the current case and the Disputed Domain Name should be considered as identical to the trademark NOVARTIS.

## B. RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN RESPECT OF THE DISPUTED DOMAIN NAME

The 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 in any forms, including the Disputed Domain Name.

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. When searched for “Novartis Careers” in the Google search engine, the returned results all pointed to the Complainant and its business activities.

The Respondent could have easily performed a similar search before registering the Disputed Domain Name and would have quickly learnt that the NOVARTIS trademarks are owned by the Complainant and that the Complainant has been using its trademarks in Brazil, where the Respondent resides, and many other countries worldwide. However, the Respondent still chose to register the Disputed Domain Name as such.

From the Complaint’s perspective, the Respondent deliberately chose the gTLD “.careers” and chose to use the well-known, distinctive trademark NOVARTIS as the body of the Disputed Domain Name, very likely with the intention to benefit from the Complainant’s worldwide renown and to confuse Internet users as to the source or sponsorship and therefore cannot be considered as a bona fide offering of goods or services.

By the time the Complainant prepared this Complaint on 28 January 2021, the Disputed Domain Name resolved to a parked page comprising pay-per-click links.

Pursuant to WIPO Overview 3.0, para. 2.9, the Respondent has not been using the Disputed Domain Name for any bona fide offering of goods or services as the panels hold the opinion that:

“Applying UDRP paragraph 4(c), panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant’s mark or otherwise mislead Internet users.”

For the foregoing reasons, it shall be concluded that the Respondent has no right nor legitimate interest in respect of the Disputed Domain Name.

## C. THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITH

### i. THE DISPUTED DOMAIN NAME WAS REGISTERED IN BAD FAITH

Most of Complainant’s trademark registrations predate the registration of the Disputed Domain Name and the Respondent has never been authorized by the Complainant to register the Disputed Domain Name. Considering the renown of the Complainant and its trademark NOVARTIS, and the overall composition of the Disputed Domain Name, i.e. using the term “Novartis” together with the gTLD “.careers”, it follows that incorporating the well-known trademark NOVARTIS in the Disputed Domain Name is a deliberate and calculated attempt to improperly benefit from the Complainant’s rights and reputation.

Additionally, considering the fact that:

- The Respondent very likely knew about the Complainant and its trademark
- The Complainant's trademark NOVARTIS is a distinctive, well-known trademark worldwide and in Brazil where the Respondent resides
- The Respondent has failed in presenting a credible evidence-backed rationale for registering the Disputed Domain Name

The Disputed Domain Name shall be deemed as registered in bad faith, which is supported by WIPO Overview 3.0, para. 3.1.1.:

"If on the other hand circumstances indicate that the respondent's intent in registering the disputed domain name was in fact to profit in some fashion from or otherwise exploit the complainant's trademark, panels will find bad faith on the part of the respondent. While panel assessment remains fact-specific, generally speaking such circumstances, alone or together, include: (i) the respondent's likely knowledge of the complainant's rights, (ii) the distinctiveness of the complainant's mark, ... (vii) failure of a respondent to present a credible evidence-backed rationale for registering the domain name,..."

and para.3.1.4:

"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."

## ii. THE DISPUTED DOMAIN NAME IS BEING USED IN BAD FAITH

Firstly, as noted in the previous paragraphs, the Disputed Domain Name resolved to a pay-per-click website. In terms of paragraph 4(b)(iv) of the Policy, this conduct constitutes bad faith as it has been confirmed in previous cases, e.g. WIPO Case No. D2016-0245, Heraeus Kulzer GmbH. v. Whois Privacy Services Pty Ltd / Stanley Pace, wherein the Panel stated:

"The Panel finds that the Domain Name was registered and is being used to attract, for commercial gain, Internet users to the Respondent's Website or other online location, by creating a likelihood of confusion with the Complainant's KULZER Mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's Website. In particular the Respondent's Website is a page that offers sponsored-links to third-party sites that have in the past and may in the future sell products that directly compete with the Complainant's dental equipment. Such sites generally advertise by paying registrants on a pay-per-click basis for Internet users redirected to their sites. This means that the Respondent receives a financial reward for every Internet user redirected from the Respondent's Website to those third-party sites.

Accordingly, the Panel finds that the Respondent has registered and is using the Disputed Domain Name in bad faith under paragraph 4(a)(iii) of the Policy."

Secondly, the Respondent has been using privacy shield to conceal its identity.

In terms of paragraph 4(b)(iv) of the Policy, the above facts demonstrate the Respondent's use of the Disputed Domain Name in bad faith. See "Dr. Martens" International Trading GmbH and "Dr. Maertens" Marketing GmbH v. Godaddy.com, Inc., WIPO Case No. D2017-0246:

"The Domain Name was not resolving to an active website at the time of filing. However, the consensus view amongst WIPO

panellists is that ‘the apparent lack of so-called active use (e.g., to resolve to a website) of the domain name without any active attempt to sell or to contact the trade mark holder (passive holding), does not as such prevent a finding of bad faith. The panel must examine all the circumstances of the case to determine whether the respondent is acting in bad faith. Examples of what may be cumulative circumstances found to be indicative of bad faith include the complainant having a well-known trade mark, no response to the complaint having been filed, and the registrant’s concealment of its identity’.”

## SUMMARY

- NOVARTIS is a well-known, distinctive trademark worldwide, including Brazil where the Respondent resides
- Complainant’s trademarks registration predates the registration of the Disputed Domain Name
- Respondent has no rights in the mark NOVARTIS, bears no relationship to the Complainant, and is not commonly known by the Disputed Domain Name - accordingly it has no legitimate interest in the Disputed Domain Name
- It is highly unlikely that Respondent was not aware of Complainant’s prior rights in the trademark NOVARTIS at the time of registering the Disputed Domain Name, given the Complainant’s worldwide renown
- Respondent has been using the Disputed Domain Name to resolve to a pay-per-click website
- Respondent has been using privacy shield to conceal its identity

Consequently, the Respondent should be considered to have registered the Disputed Domain Name identical to the Complainant’s well-known, distinctive trademark NOVARTIS. The Complainant has not found that the Respondent is of any legitimate right or interest in using the Disputed Domain Name, but rather registered and has been using the Disputed Domain Name in bad faith.

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## PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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## 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).

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## 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).

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## 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).

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## 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.

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## PRINCIPAL REASONS FOR THE DECISION

## FIRST CONDITION

It is commonly accepted that the first condition functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name. In this comparison, the cc- or g-TLD is usually not taken into account.

The Disputed Domain Name includes entirely the Complainant's trademark with the adjunction of the generic word "careers". The Panel is of the opinion that in a situation where the Complainant's trademark is entirely included in the Disputed Domain name, the adjunction of generic terms does not generally change the assessment as far as the first condition is concerned. (see also WIPO, Swiss Re, No. D2014-1873).

First condition is satisfied.

## SECOND CONDITION

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.

The Complainant claims, without being contradicted, that:

- The Complainant has not licensed or authorized the Respondent to register or use the Disputed Domain Name;
- There is no evidence that the Respondent is known by the Disputed Domain Name or owns any corresponding registered trademarks; and
- The Respondent could have easily performed a search before registering the Disputed Domain Name and would have quickly learnt about the Complainant's trademarks and activities worldwide.

The Respondent has chosen not to answer to the Complaint.

Based on the elements presented by Complainant, the Panels find that the second condition is satisfied.

## THIRD CONDITION

The Disputed Domain Name incorporates nearly entirely the Complainant's trademark. In the absence of any credible explanation, such incorporation appears as a direct reference to the Complainant's trademark. It is even more probable when the notoriety of the Complainant's trademark is taken into account. There is no apparent plausible reason for the Respondent to register the domain name, except its probable intention of taking advantage of the distinctiveness of the Complainant's trademark.

It is therefore prima facie highly probable that the Respondent registered and used the Disputed Domain Name having the Complainant in mind, and acted in order to attract traffic by using the notoriety of the Complainant in order to make money when a visitor clicks on the commercial links inserted on the Respondent's website.

The Respondent has chosen not to answer to the Complaint.

Based on the elements presented by Complainant, the Panel finds that the third condition is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **NOVARTIS.CAREERS**: Transferred

PANELLISTS

Name	Mr. Etienne Wéry
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DATE OF PANEL DECISION 2021-03-16

Publish the Decision