

Decision for dispute CAC-UDRP-103595

Case number	CAC-UDRP-103595
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Time of filing	2021-02-22 00:00:00
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Domain names	novartis.health
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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	Brian Pate
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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

The Complainant is the owner of the trademark NOVARTIS in different jurisdictions, including but not limited to the following registrations in the US:

Trademark: NOVARTIS
Reg. no: 5420583
Reg. date: 13 March 2018

Trademark: NOVARTIS
Reg. no: 2997235
Reg. date: 20 September 2005
First use in commerce: 1997

The Complainant owns numerous domain names composed of either its trademark NOVARTIS alone, including <novartis.us> (created on 19 April 2002) and <novartis.com> (created on 2 April 1996) or in combination with other terms, e.g.

<novartispharma.com> (created on 27 October 1999). The Complainant uses these domain names to promote the NOVARTIS mark with related products and services.

FACTUAL BACKGROUND

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

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 a strong presence in the United States of America (the “USA”) where the Respondent is located. The Complainant has numerous subsidiaries and associated companies based in the USA. Moreover, in 2019, 34% of Novartis Group’s total net sales were constituted in the USA.

The Registration Date of the disputed domain name is January 30 2021.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant has been using the NOVARTIS trademark since 1997 and has strong presence in the USA where the Respondent is located.

A. The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

The disputed domain name incorporates Complainant's well-known and distinctive trademark NOVARTIS in its entirety. The addition of the gTLD “.health” does not add any distinctiveness to the disputed domain name.

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

B. The Respondent has no rights or legitimate interests 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” in the Google search engine, the returned results all pointed to the Complainant and its business activities.

The Respondent is named “Brian Pate”, which is not related to the Complainant nor to the term “Novartis” in any way.

The Respondent deliberately chose the gTLD “.health”, which is closely related to the Complainant’s business range, 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 18 February 2021, the disputed domain name resolved to a website with blank page. The Respondent has not been using the disputed domain name for any bona fide offering of goods or services.

C. The disputed domain name was registered and is being used in bad faith.

Most of Complainant's trademark registrations predate the registration of the disputed domain name.

The combination of the well-known NOVARTIS trademark and the gTLD ".health" deliberate and calculated attempt to improperly benefit from the Complainant's rights and reputation.

The Respondent very likely knew about the Complainant and its trademark when it registered the disputed domain name and has failed in presenting a credible evidence-backed rationale for registering the disputed domain name.

The disputed domain name resolved to a website with blank page.

The Complainant has tried to reach the Respondent via the Registrar's online contact form but did not receive any response.

RESPONDENT:

A) The disputed domain name was not registered or acquired primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the Complainant, as the alleged owner of the trademark or service mark, or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's out-of-pocket costs directly related to the domain name.

The Complainant noted that the Respondent does not have any rights or legitimate interest in the disputed domain name. This is an assumption by the Complainant. The disputed domain name was purchased on January 26 2021 and the Complainant noted sending a notice to the Respondent on February 5 2021. The domain has been suspended by the Registrar until this arbitration process has completed. The allegation by the Complainant is immature and not supported with sufficient support.

B) The Complainant and the Respondent are not competitors and/or the disputed domain name was not registered by the Respondent primarily to disrupt the Complainant's business.

C) The disputed domain name was not registered by the Respondent in an intentional attempt to attract for commercial gain, Internet users to the Respondent's web site 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 web site or location or of a product or service on the Respondent's web site or location.

The disputed domain name has been available to the Complainant since 2017. There is zero evidence of damage or dilution to the Complainant's brand and trademark due to the Respondent's purchase of the disputed domain name.

The Complainant noted "Non-use of the domain name". As noted, the disputed domain name was suspended by the Registrar in less than 60 days from domain purchase until this arbitration is completed. The Respondent is willing to release a "Coming Soon" landing page to show it being in-use until a final page can be completed.

Overall, the Complainant is using this arbitration process to attempt to invalidate the Respondent and is assuming bad faith without sufficient evidence.

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).

First, the Complainant claims rights in the NOVARTIS mark through its global registrations of the Trademarks. By virtue of its global trademark registrations, Complainant has proved that it has rights in the mark under Policy 4(a). See *Avast Software s. r. o. v Milen Radumilo*, 102384, (CAC 2019-03-12).

Second, the Complaint claims that the disputed domain name incorporates Complainant's NOVARTIS trademark in its entirety and the ".health" gTLD does not add any distinctiveness to the disputed domain name. The Panel accepts that the prominent part of the disputed domain name is an exact match to the NOVARTIS trademark.

In light of the introduction of new gTLDs, it is well settled that Panels may determine that the top-level suffix impacts the disputed domain name's confusing similarity to Complainant's trademarks. In this case, the new gTLD ".health" not only does not reduce the similarity between the disputed domain name and Complainant's trademark, but also further confuses Internet users that the disputed domain name is potentially owned by or linked to the Complainant due to its industrial related nature and Complainant's well known pharmaceutical business. See *TruGreen Limited Partnership v. Somsak Jinaphan*, D2017-2190 (WIPO Jan 3, 2018) ("While Top-Level Domains generally are disregarded when evaluating the identity or confusing similarity of the complainant's mark to the disputed domain name under paragraph 4(a)(i) of the Policy, it is well settled that where the applicable TLD and the second-level portion of the domain name in combination contain the relevant trademark, panels may consider the domain name in its entirety for purposes of assessing confusing similarity.").

For the foregoing reasons, the Panel finds the Complainant has satisfied 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). More specifically, the Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name, and the burden of prove then shifts to the Respondent to show it does have rights or legitimate interests. See *PepsiCo, Inc. v Smith power production*, 102378, (CAC 2019-03-08) ("The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.").

First, the Complainant claims that it has never had any previous relationship with the Respondent nor granted any permission to the Respondent to use the NOVARTIS trademark. In addition, the Complainant further claims that the Respondent is not commonly known by the disputed domain name and the name of the Respondent is not related to the Complainant nor the term "Novartis". It is very likely that the intentions for the Respondent to register the disputed domain name with Complainant's trademark and the industrial related gTLD is to create confusion among the Internet users.

The Panel finds that the Complainant has established a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name. The burden of proof has been shifted to the Respondent to prove that it has right or legitimate interests to the disputed domain name.

The Respondent rebuts that the current proceeding was initiated within 1 month after the domain registration and the allegation by the Complainant is immature and not supported with sufficient support. There is zero evidence of damage of dilution to the Complainants brand and trademark due to the Respondent's purchase of the disputed domain name.

Paragraph 4(c) of the Policy listed some common circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate Respondent's rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel is of the view that the Respondent fails to demonstrate its rights or legitimate interests to the disputed domain name and has not provided any reasonable excuse for registering the disputed domain name which incorporates Complainant's trademark as well as the industrial related gTLD ".health", see paragraph 2.14.1 of the WIPO Overview 3.0 ("Particularly when the TLD is descriptive of or relates to goods or services (including their natural zone of expansion), a geographic region, or other term associated with the complainant, the respondent's selection of such TLD would tend to support a finding that the respondent obtained the domain name to take advantage of the complainant's mark and as such that the respondent lacks rights or legitimate interests in the domain name.").

For the foregoing reasons, the Panel finds the Complainant has satisfied 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).

Registration of the disputed domain name in bad faith

The Complainant claims that the Respondent very likely knew the Complainant and its trademark when it registered the disputed domain name considering the distinctiveness and global reputation of the NOVARTIS trademark. The Respondent rebuts that it is not a competitor of Respondent and the disputed domain name was not registered primarily to disrupt the Complainant's business nor an intentional attempt to attract for commercial gain, Internet users to the Respondent's web site 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 web site or location or of a product or service on the Respondent's web site or location. Pursuant to paragraph 3.1.4 of the WIPO Overview 3.0 which states that "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." , the Panel is of the view that the response submitted by the Respondent was not supported by any material evidence. Considering the distinctiveness of the NOVARTIS trademark and its reputation in the US where the Respondent domiciled, the Panel agrees that the disputed domain name was registered in bad faith.

Use of the disputed domain name in bad faith

The Complainant submits that it has served a notice to the Respondent via the Registrar's online form as the WHOIS of the disputed domain name was masked and no response to the notice was received. The Complainant further claims that the disputed domain name does not resolve to any active content. The Respondent explains that the disputed domain name has been suspended by the Registrar in less than 60 days and is willing to release a "Coming Soon" landing page to show it is being in-use. Pursuant to paragraph 3.3 of the WIPO Overview 3.0 which provides that "from the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding." The Panel agrees that passive holding of a domain name incorporating a famous trademark constitutes use of the domain name in bad faith, and the ignorance of the previous notice and the masking service of the WHOIS further evince the use of the disputed domain name in bad faith.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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

Having established all three elements required under the UDRP Policy, the Panel concludes that relief shall be granted.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **NOVARTIS.HEALTH:** Transferred

PANELLISTS

Name	Mr Paddy TAM
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DATE OF PANEL DECISION 2021-03-30

Publish the Decision