

Decision for dispute CAC-UDRP-105458

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| Case number | CAC-UDRP-105458 |
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| Time of filing | 2023-05-23 09:20:43 |
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| Domain names | globalnovartis.com |
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Case administrator

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| Name | Olga Dvořáková (Case admin) |
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Complainant

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| Organization | Novartis AG |
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Complainant representative

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| Organization | BRANDIT GmbH |
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Respondent

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| Organization | Sharon Monroe (Novartis) |
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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 owns a large portfolio of trade marks consisting of the name NOVARTIS in multiple classes and numerous jurisdictions around the world, including in the United States: United States United States (USPTO) trade mark NOVARTIS, registration number 2336960, first registered on 4 April 2000 in international classes 1, 5, 9, 10, 29, 30, 31, 32 and 42; United States (USPTO) trade mark registration NOVARTIS, registration number 4986124, first registered on 28 June 2016 in international classes 5, 9, 10, 41, 42 and 44; and the International trade mark NOVARTIS, designating the United States, registration number 1349878, first registered on 29 November 2016 in international classes 9, 10, 41, 42, 44 and 45. These trade mark registrations all predate the registration of the disputed domain name.

Furthermore, the Complainant owns multiple domain names consisting of or incorporating the name NOVARTIS, including <novartis.com>, registered on 2 April 1996, and <novartispharma.com>, registered on 27 October 1999, which are all connected to the Complainant's official websites.

The Panel further notes that previous panels have found the Complainant's trade mark NOVARTIS to be well-known worldwide (see WIPO Case No. D2016-1688, Novartis AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org/Sergei Lir <novartis-bio.com>; and WIPO Case No. D2020-3203, Novartis AG v. Amartya Sinha, Global Webs Link, Novartis RO <novartisro.com>). The Panel accepts that the Complainant's trade mark NOVARTIS is well-known around the world, including in the United States, where the Respondent is located.

FACTUAL BACKGROUND

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

The Complainant's products are manufactured and sold in many countries worldwide. The Complainant has a strong presence in the United States, where the Respondent is located. The Complainant has subsidiaries and associated companies based in the United States. Furthermore, the Complainant enjoys a strong presence online via its official social media platforms.

The Respondent registered the disputed domain name <globalnovartis.com> on 18 April 2023. The disputed domain name resolves to an error page and is inactive. There is no evidence before the Panel that the disputed domain name has ever been used for an active website since it was registered.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain name is identical or confusingly similar to a trade mark 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 that 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

With regard to the first UDRP element, the Panel finds that the disputed domain name <globalnovartis.com> is confusingly similar to the Complainant's trade mark Novartis. Indeed, the disputed domain name incorporates the Complainant's trade mark in its entirety but adds the generic term "global" as a prefix to the Complainant's trade mark. The Panel follows in this respect the view established by numerous other decisions that a domain name which wholly incorporates a Complainant's registered trade mark may be sufficient to establish confusing similarity for the purposes of the UDRP (see, for example, WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasilij Terkin <porsche-autoparts.com>). Furthermore, the incorporation of a complainant's well-known trade mark in the disputed domain name has been considered to be sufficient to find the domain name to be confusingly similar to a complainant's trade mark (see WIPO Case No. D2000-0138, Quixtar Investments, Inc. v. Smithberger and QUIXTAR-IBO <quixtar-sign-up.com>; and WIPO Case No. D2001-0110, Ansell Healthcare Products Inc. v. Australian Therapeutics Supplies Pty, Ltd <ansellcondoms.com>). The Panel further considers it to be well established that the addition of a descriptive or generic term does not allow a domain name to avoid confusing similarity with a trade mark (see, for example, WIPO Case No. D2019-2294, Qantas Airways Limited v. Quality Ads <qantaslink.com>; and CAC Case No. 102137, Novartis AG v. Black Roses <novartiscorp.com>). With specific regard to the term "global", other panels

have previously found that “[W]here the relevant trademark is recognizable within the Disputed Domain Name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element” (see WIPO Case No. D2020-0528, Philip Morris Products S.A. v. Rich Ardetea <global-iqos.com>).

Against this background, the Panel finds that the addition of the generic term "global" is not sufficient to alter the overall impression of the designation as being connected with the Complainant's trade mark and does not prevent a likelihood of confusion between the disputed domain name and the Complainant, its trade mark and its associated domain names. To the contrary, the disputed domain name rather adds to the likelihood of confusion because the use of the term "global" in conjunction with the Complainant's trade mark NOVARTIS suggests that the disputed domain name links to an official website of the Complainant, which is a pharmaceutical company operating globally, and implies that it is linked to the Complainant and its business.

With regard to the second UDRP element, there is no evidence before the Panel to suggest that the Respondent has made any use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services. Neither is there any indication that the Respondent is making legitimate non-commercial or fair use of the disputed domain name. Indeed, the disputed domain name is not being used for any active website but resolves to an error page. A lack of content at the disputed domain has in itself been regarded by other panels as supporting a finding that the Respondent lacked a bona fide offering of goods or services and did not make legitimate non-commercial or fair use of the disputed domain name (see, for example, Forum Case No. FA 1773444, Ashley Furniture Industries, Inc v. Joannet Macket/JM Consultants). The Panel further finds that the Respondent is not affiliated with or related to the Complainant in any way and is neither licensed nor otherwise authorised to make any use of the Complainant's trade mark or to apply for or use the disputed domain name. In addition, the Whois information does not suggest that the Respondent is commonly known by the disputed name <globalnovartis.com>.

Against this background, and absent any response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

With regard to the third UDRP element, the Panel considers that, if the Respondent had carried out Google search for the names NOVARTIS and GLOBALNOVARTIS, the search results would have yielded immediate and obvious references to the Complainant. The Panel therefore concludes that it is difficult in the circumstances to believe that the Respondent was unaware of the Complainant's trade mark when she registered the disputed domain name. This view is further reinforced by the fact that the Respondent stated “Novartis” as the registrant’s organisation name when registering the disputed domain name. It is therefore reasonable to infer that the Respondent either knew, or should have known, that the disputed domain name would be identical with or confusingly similar to the Complainant's trade mark and that she registered the disputed domain name in full knowledge of the Complainant's trade mark. Indeed, it is likely that the disputed domain would not have been registered if it were not for the Complainant's trade mark (see, for example, WIPO Case No D2004-0673 Ferrari Spa v. American Entertainment Group Inc).

Furthermore, the website related to the disputed domain name is inactive and resolves to an error page. The Respondent has not demonstrated any activity in respect of the disputed domain name. First, it is difficult to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate on the grounds that it would constitute passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trade mark law under circumstances where that disputed domain name corresponds to the Complainant's trade mark and is similar to the Complainant's genuine domain names currently used by the latter to promote its goods and services. Secondly, numerous other UDRP decisions have taken the view, which this Panel shares, that the passive holding of a domain name with knowledge that the domain name infringes another party's trade mark rights may in itself be regarded as evidence of bad faith registration and use (see, for example, WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows; and WIPO Case No. D2004-0615, Comerica Inc. v. Horoshiy, Inc.).

In the circumstances, the Panel does not need to consider further whether the Respondent's use of a privacy registration service constitutes further evidence of bad faith. Absent any response from the Respondent, or any other information indicating the contrary, the Panel therefore also accepts that the Respondent has registered and is using 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. **globalnovartis.com**: Transferred

PANELLISTS

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| Name | Gregor Kleinknecht |
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DATE OF PANEL DECISION 2023-07-04

