Panel Decision for dispute CAC-ADREU-008361

Case number	CAC-ADREU-008361
Time of filing	2022-06-03 10:32:20
Domain names	novartis-bio.eu

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	Novartis AG

Respondent

Name	PIERRE MARIONE

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

There are no other legal proceedings of which the Panel is aware that are pending or decided and that relate to the disputed domain name.

FACTUAL BACKGROUND

The present case arises further to a complaint filed by Novartis AG and Novartis Pharma GmbH. It is specified that Novartis Pharma GmbH is part of the Novartis Group, of which Novartis AG is the headquarter company.

The Complainant notably owns the following trademarks:

- International word mark NOVARTIS No. 663765, registered on July 1, 1996, in classes 1, 2, 3, 4, 5, 7, 8, 9, 10, 14, 16, 17, 20, 22, 28, 29, 30 , 31, 32, 40, and 42 designating France; and

- International word mark NOVARTIS No. 666218, registered on October 31, 1996, in classes 41 and 42 designating France.

The Complainant has an online presence through its websites, such as www.novartis.fr, “www.novartis.com” or “www.novartis.ch” and social networks. The Complainant also owns numerous domain names incorporating the NOVARTIS mark, including <novartis.fr>, <novartis.com>, and <novartis.ch>, the vast majority of which point to the Complainant’s official websites.

The Respondent, Pierre MARIONE, registered the domain name <NOVARTIS-BIO.EU> on October 25, 2019.

The Complainant being aware of this registration filed a complaint on June 2, 2022 complaint which was acknowledged receipt on June 3, 2022.

According to ADR rules, EURid transmitted the relevant information on the registrant revealing in particular the identity and address of the physical body owner of the disputed domain name. In the light of this further and new information, the ADR Centre requested the Complainant to amend its complaint. This was done accordingly on June 14, 2022.

The Respondent was properly notified and informed that, should it fail to send the Response within the prescribed period of time, the Respondent would be considered in default.

On August 18, 2022, the ADR Centre issued a "notification of Respondent's default" informing the Respondent that he failed to comply with the ADR Centre's request.

The Complainant request the transfer of the disputed domain name to Novartis Pharma GmbH.

The Panel was therefore appointed, and has duly filed the "statement of acceptance and declaration of impartiality and independency".

A. COMPLAINANT

The Complainants in this administrative proceeding are Novartis AG and Novartis Pharma GmbH (jointly referred to as the Complainant).

Novartis Pharma GmbH is part of the Novartis Group, of which Novartis AG is the headquarter company.

In light of the nature of the corporate relationship between these two entities, both entities should be considered as having a common grievance against the Respondent (see Verisure Sàrl and Securitas Direct AB v. Emiel Timmerman, WIPO Case No. DEU2021-0032; Skyscanner Limited and ExperienceOn Ventures S.L. v. Rehman Abdur, WIPO Case No. DEU2021-0006; Allflex USA, Inc. & Allflex Europe SAS v Marek Wierciński, WIPO Case No. DEU2021-0019; Türkiye'nin Otomobili Girişim Grubu Sanayi Ve Ticaret Anonim Şirketiand TOGG Europe GmbH v. Papyrus Verlag, WIPO Case No. DEU2021-0020).

The Complainants also agreed that the disputed domain name shall be transferred to Novartis Pharma GmbH if the decision of the dispute proceedings is to transfer the disputed domain name to the Complainants.

To the best of the Complainant’s knowledge, the language of the Registration Agreement of the disputed domain name <NOVARTIS-BIO.EU> is English according to the Registrar Verification and the WHOIS.

In accordance with paragraph A (3) of the ADR Rules, unless otherwise agreed by the parties, the language of the proceedings is the language of the registration agreement. The Complainant therefore requests the language of the proceedings to be English.

The Complainants described themselves as 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, created in 1996 through a merger of two other companies Ciba-Geigy and Sandoz, is the holding company of the Novartis Group.

The Novartis group produces and markets its products in many parts of the world. In particular, it enjoys a strong presence in France, where the Respondent resides. In 2019, the group's total turnover was made up to thirty-eight percent in Europe. The Novartis group includes, in particular, five subsidiaries or associated companies in France.

The Complainant is the owner of a large number of trademarks including the term "NOVARTIS" registered in several jurisdictions for many years, in particular in France and in the European Union.

In addition, the Complainant enjoys a strong online presence through its websites, such as www.novartis.fr, “www.novartis.com” or “www.novartis.ch” and social networks. The Complainant also owns numerous domain names incorporating the NOVARTIS mark, including <novartis.fr>, <novartis.com>, and <novartis.ch>, the vast majority of which point to the Complainant’s official websites.

The Complainant is the owner of the NOVARTIS trademark (hereinafter “the NOVARTIS trademark”) registered in numerous jurisdictions including in France where the Respondent resides. The first registrations of the NOVARTIS trademark predate by several years the registration of the disputed domain name which took place on October 25, 2019.

Based on this presentation and rights put forward, the Complainant considers that:

A. The domain name is identical or confusingly similar to a name in respect of which the Complainant has a right or rights recognized or established by national law of a Member State and/or Community law;

The domain name <novartis-bio.eu>, which was registered by the Respondent on October 25, 2019 according to the WHOIS, in its second-level portion incorporates entirely the Complainant’s registered trademark NOVARTIS along with the term “bio”, closely connected to the Complainant’s business and activities.

The NOVARTIS trademark is clearly recognizable within the disputed domain name.

The addition of the ccTLD “.eu” does not add any distinctiveness to the disputed domain name.

B. The Respondent has no rights or legitimate interests in respect of the 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-bio" in the Google search engine, the search results all pointed to the Complainant and its business activities except for a few that pointed to the products sold on the website associated to the disputed domain name due to word match.

The Respondent should have already performed a similar search before registering the disputed domain name and should have quickly learnt that the trademarks are owned by the Complainant and that the Complainant has been using its trademarks in France, where the Respondent resides, and in many other countries worldwide – in fact, evidence showed that the Respondent obviously knew about the Complainant and its trademark NOVARTIS when it registered the disputed domain name (see paragraphs below). However, the Respondent still chose to register the disputed domain name as such.

In addition, according to the Registrar Verification, the Respondent is named "PIERRE MARIONE", which is not related to the Complainant nor to the term NOVARTIS in any way.

In April 2022, the Complainant noticed that the website associated to the disputed domain name ("the Website") displayed content that impersonates Novartis' official website (https://www.novartis.com). Not only was the general look-and-feel copied from the official website, but it was also using the Novartis logo in a prominent position. Moreover, it offered "Somatropin Human Growth Hormone" products under the name "Novartis-Bio", printed on the package of the products, as shown on the Website.

Subsequently, the Complainant filed an abuse report to the hosting provider. The Website has been removed on 25 April 2022.

Obviously, the Respondent has been impersonating the Complainant and has been trying to mislead internet user into believing that the Website was authorized by / associated with the Complainant. The Respondent has not been using the disputed domain name for any bona fide offering of goods or services.

For the foregoing reasons, it shall be concluded that the Respondent has no right nor legitimate interest in respect of the disputed domain name and has not been using the disputed domain name for any bona fide offering of goods or services.

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

In accordance with Article 21 of Commission Regulation (EC) No. 874/2004, Paragraph 3, letters c) and d), a domain name should be considered as having been registered or used in bad faith by the Respondent if:

"the domain name was registered primarily for the purpose of disrupting the professional activities of a competitor; or

the domain name was intentionally used to attract Internet users, for commercial gain, to the holder of a domain name website or other on-line location, by creating a likelihood of confusion with a name on which a right is recognized or established by national and/or Community law or a name of a public body, such likelihood arising as to the source, sponsorship, affiliation or endorsement of the website or location or of a product or service on the website or location of the Respondent."

i. THE DOMAIN NAME WAS REGISTERED IN BAD FAITH

It has to be highlighted that the registration of the Complainant's trademarks pre-dates the registration of the disputed domain name and the Respondent has never been authorized by the Complainant to use the NOVARTIS trademark nor to register the disputed domain name. The Respondent has chosen to incorporate the distinctive trademark NOVARTIS in the disputed domain name in its entirety.

As mentioned earlier, the Complainant enjoys a strong online presence. By conducting a simple online search regarding the terms "Novartis-bio", the Respondent would have inevitably learnt about the Complainant, its trademark and business (see Teamreager AB v. Muhsin E.Thiebaut, Walid Victor, WIPO Case No. D2013-0835, Amundi Asset Management v. tang xiao ming, WIPO Case No. D2019-2744).

It is therefore inconceivable that the Respondent was unaware of the existence of the Complainant when it registered the disputed domain name.

It is very likely that the Respondent registered the disputed domain name incorporating the trademark NOVARTIS intentionally in order to take advantage of reputation of the trademark NOVARTIS and the Complainant's goodwill, free-riding on the Complainant's reputation.

ii. THE DOMAIN NAME IS BEING USED IN BAD FAITH

Firstly, as noted in the previous paragraphs, the Respondent has used the Complainant's trademark NOVARTIS on the Website and has offered "growth hormone" for sale under the name "Novartis-Bio", without any authorization from the Complainant. The bad faith has been established by the Panel in the decision of a very similar case - WIPO case n.2016-1688, Novartis AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org, / Sergei Lir, where the respondent has used the domain name in exactly the same way. In this case, the panel stated:

"The disputed domain name encompasses the trademark NOVARTIS, together with a hyphen and the generic word 'bio'. Also, it resolves to a website that contains a reproduction of the Complainant's trademark, offering pharmaceutical products for sale. […] In the Panel's view this evidence may be regarded as an attempt by the Respondent to impersonate the Complainant."

Therefore, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website.

In addition, the Respondent has been using privacy shield to conceal its identity. The Registrar Verification showed that the Registrant is located at "99 ,Rue du Pré,sident É,douard Herriot,Lyon, Lyon, 7740, , FR" (should be "99, Rue du Président Édouard Herriot, Lyon"). However, public search showed that this is a commercial district and the postcode should actually be 69002. It seems very likely that the Respondent has provided false WHOIS information.

According to the Registrar Verification, the Respondent's email is ac50786f7f6169d71c502a16be7d3563.gdrp@customers.whoisprivacycorp.com, which is still under privacy shield. The fact that the Respondent has provided false WHOIS information and has been using privacy shield to conceal its identity further added up to the finding of bad faith.

B. RESPONDENT

Respondent did not provide any response to the complaint, and is therefore in default.

DISCUSSION AND FINDINGS

Pursuant to article 21 (1) of the European Regulation n° 874/2004 relating to the Speculative and abusive registrations: "a registered domain name shall be subject to revocation, using an appropriate extra-judicial or judicial procedure, where that name is identical or confusingly similar to a name in respect of which a right is recognized or established by national and/or Community law, such as the rights mentioned in Article 10(1), and where it:

(a) has been registered by its holder without rights or legitimate interest in the name; or
(b) has been registered or is being used in bad faith"

As a result, to dispute the registration of a domain name the Complainant has to demonstrate that:

1- The Domain Name is identical or confusingly similar to a name in respect of which a right is recognized or established by national and/or Community law.

2- The Domain Name is registered by the holder without rights or legitimate interest in the name; or

3- The Domain Name is registered or is being used in bad faith.

(i) Identical or confusingly similar

Complainants demonstrate they have valid trademark rights in the NOVARTIS sign.

The Panel recognizes that Complainants' trademark rights in the NOVARTIS sign are established.

The Panel also agrees that the disputed domain name is confusingly similar to Complainant's NOVARTIS trademark, the suffix "BIO" making no difference per se. On the contrary, the reference to "BIO" for biology refers to the known activity of the Complainants.

In addition, the disputed domain name <novartis-bio.eu> incorporates Complainants' Registered Trademarks "NOVARTIS" in its entirety. In several decisions, panels considered that the incorporation of a trademark in its entirety may be sufficient to establish that the domain name is identical or confusingly similar to Complainant's trademark (WIPO Case No. D2021-2689, Virgin Enterprises Limited v. Guman Sulaen, Sulaen Company / Ivan Petrenkos / Leonid Duhar / Josh White, Build LMTD / Name Redacted ; WIPO Case No. D2011-1627, L'Oréal, Lancôme Parfums et Beauté & Cie v. Jack Yang, WIPO Case No. D2010-1059, Rapidshare AG, Christian Schmid v. InvisibleRegistration.com, Domain Admin, WIPO Case No. D2007 1629, F. Hoffmann-La Roche AG v. Relish Entreprises, and WIPO Case No. D2000-0113, The Stanley Works and Stanley Logistics, Inc. v. Camp Creek Co., Inc. and WIPO Overview 3.0 , section 1.7). This occurs to be the case here.

Accordingly, by registering said domain name, Respondent has created a likelihood of confusion with Complainants' trademark. It is likely that the domain name could mislead Internet users into thinking that it is, in some way, associated with the Complainants.

As a result, the Panel finds that the domain name is identical or at least confusingly similar to the trademark "NOVARTIS" owned by Complainants.

(ii) No rights nor legitimate interests

Complainants shall provide a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain name. The burden of proof thereto shifts to Respondent.

This standard has been recognized throughout continuous case law, see WIPO Case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd., where it was established that 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 Respondent carries the burden of demonstrating rights or legitimate interests in the domain name.

Complainants assert that Respondent is not identified in the Whois database as the disputed domain name and therefore was not commonly known by the disputed domain name. In addition, Complainant never granted any authorization to Respondent to use their trademark nor to register the disputed domain name.

The Panel would nevertheless raise the fact that the complainants' argument based on the use of an "anonymised" email may not necessarily be relevant. Indeed, pursuant the GDPR regulations, physical person, including email that may contain personal data, should be anonymised. This does not mean that the Respondent would not receive the emails. Indeed, the email address is only an alias of a potential correct and valid email address. Furthermore, and for the same reasons, the whois privacy is in line with the necessity of anonymisation of personal data, being in fine revealed for the sake of the Complaint. Unless specific malicious conduct, this sole element ought not to be considered as a bad faith pattern.

Hence, this could not been considered as an overabundant element.

Furthermore, Respondent did not provide a reply to the Complaint. In previous cases, panels have held that such mutism from the Respondent's part was proof that Complainant and Respondent had no relation and that Respondent is not commonly known under the disputed domain name (see FILEHIPPO S.R.O. v. whois agent, Case No. 102279 (CAC January 31, 2019), "In the absence of a response, the Panel accepts the Complainant's allegations as true that the Respondent has no authorization to use the Complainant's trademarks in the disputed domain name. Hence, as the Complainant has made out its prima facie case, and as the Respondent has not demonstrated any rights or legitimate interests as illustrated under paragraph 4(c) of the Policy, nor has the Panel found any other basis for finding any rights or legitimate interests of the Respondent in the disputed domain name, the Panel concludes that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.").

Respondent failed to answer the allegations discussed in the Complaint. Therefore, the contentions in the Complaint are presumed correct.

Because there is an absence of an apparent right or legitimate interest and the failure of the Respondent to provide evidence illustrating

that they have a legal right or legitimate interest, the Panel determines that Respondent has no rights or legitimate interests regarding the disputed domain name.

(iii) Registration or Use in Bad Faith

To comply with article 21 (1) of the European Regulation n° 874/2004, Complainant must demonstrate that the disputed domain name is registered or is being used in bad faith. It is then not necessary to prove both registration and use in bad faith but rather it is sufficient if evidence illustrates one of the two elements discussed is met in order to comply with article 21 (1) of the European Regulation n° 874/2004.

It is established that the disputed domain name directed originally to a website presenting products of the Complainants or alike. It is only by the filing of an abuse report to the hosting provider, that the Website has been removed on April 25, 2022.

In this regards, the Panel considers that the pattern of conduct constitutes a bad faith conduct.

The Panel thus considers that the disputed domain name is being used in bad faith by Respondent and that the third element is fulfilled.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that

the domain name <NOVARTIS-BIO.EU> be transferred to the Complainant, Novartis Pharma GmbH.

PANELISTS

Name	David-Irving TAYER

DATE OF PANEL DECISION 2022-08-29

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: NOVARTIS-BIO.EU

II. Country of the Complainant: Switzerland, country of the Respondent: France

III. Date of registration of the domain name: October 25, 2019

IV. Rights relied on by the Complainant (Art. 21 (1) Regulation (EC) No 874/2004) on which the Panel based its decision:

1. word international trademark registered in France, reg. No. 663765, for the term NOVARTIS, filed on July 1, 1996, registered on July 1, 1996 in respect of goods and services in classes 1, 2, 3, 4, 5, 7, 8, 9, 10, 14, 16, 17, 20, 22, 28, 29, 30 , 31, 32, 40, and 42
2. word international trademark registered in France, reg. No. 666218, for the term NOVARTIS, filed on October 31, 1996, registered on October 31, 1996 in respect of goods and services in classes 41 and 42

V. Response submitted: No

VI. Domain name/s is identical / confusingly similar to the protected right/s of the Complainant

VII. Rights or legitimate interests of the Respondent (Art. 21 (2) Regulation (EC) No 874/2004):
1. No
2. Why: The records show no rights or legitimate interest on the part of the Respondent in the disputed domain name and the Complainant has shown that the disputed domain name not providing bona fide products and has been suppress pursuant an abused reporters to the web hosting company. No evidence shown that the Respondent has any connection with the Complainants.

VIII. Bad faith of the Respondent (Art. 21 (3) Regulation (EC) No 874/2004):
1. Yes
2. Why: illicit selling of products bearing the trademark of the Complainants - Cancellation of the website by web hosting company

pursuant an abuse reported

IX. Other substantial facts the Panel considers relevant:

X. Dispute Result: Transfer of the disputed domain name

XI. Procedural factors the Panel considers relevant:

XII. [If transfer to Complainant] Is Complainant eligible? Yes