Panel Decision for dispute CAC-ADREU-008480

Case number	CAC-ADREU-008480
Time of filing	2023-02-08 09:39:15
Domain names	novartisbio.eu

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Novartis AG
Organization	Novartis Pharma GmbH

Complainant representative

Organization	BRANDIT GmbH

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 case has been initiated by a complaint filed jointly by Novartis AG, a Swiss company, and Novartis Pharma GmbH, a company seated in Nürnberg, Germany. The Complainants clarify that Novartis Pharma GmbH is part of the Novartis Group, whereas Novartis AG is the headquarter company (henceforth: "the Complainant").

The Complainants owns the following trademarks, applicable to these proceedings:

EU TM registration NOVARTIS No. 000304857 registered on 25.06.1999 in Classes 1, 5, 9, 10, 29, 30, 32 of ICGS;

EU TM registration NOVARTIS No. 1544148 registered on 29.06.2020 in Class 35 of ICGS;

EU TM registration NOVARTIS No. 013393641 registered on 13.03. 2018 in Class 9, 10 of ICGS;

Cyprus Trademark registration NOVARTIS No. 45686 registered on 10.11.200 in Class 29 of ICGS.

The Complainants also own numerous domain names incorporating the NOVARTIS mark, including <novartis.fr>, <novartis.com>, <novartis.ch> and many others, pointing to the Complainant's official websites.

The Respondent, Pierre MARIONE, registered the domain name <NOVARTIS-BIO.EU> on January 3, 2023.

On February 7, 2023, the Complainants submitted a complaint. Following submission, the standard procedures according to ADR rules took place: EURid transmitted the relevant information on the registrant, revealing in particular the identity and address of the owner of the disputed domain name. As a consequence, the ADR Centre requested the Complainant to amend its complaint. This was done accordingly on February 20, 2023. The time of filing of the complaint is February 21, 2023.

The Respondent was properly notified and informed that, should he fail to send the Response within the prescribed period of time, the Respondent would be considered in default. On April 4, 2023, 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 Complainants request the transfer of the disputed domain name to Novartis Pharma GmbH. The Panel was therefore appointed, and has filed the "statement of acceptance and declaration of impartiality and independency".

A. COMPLAINANT

The Complainants are two companies: Novartis AG and Novartis Pharma GmbH. The latter is part of the former; Novartis AG is the headquarter company. In light of the nature of the corporate relationship, both entities should be considered as having a common grievance against the Respondent. The Complainants agree that, in case of success, the domain name shall be transferred to Novartis Pharma GmbH, i.e., the company situated within the EU (Germany).

According to the Registrar Verification and the WHOIS, the language of the Registration Agreement of the domain name <NOVARTIS-BIO.EU> is English. In accordance with Article A (3) ADR [Rules Language of Proceedings], unless otherwise agreed by the parties, the language of the proceedings is the language of the registration agreement. The Complainants therefore requests the language of the proceedings to be English.

The Complainants claim themselves as one of the biggest global pharmaceutical and healthcare groups. 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. It has especially strong presence in the European Union. Novartis employs 45,000 employees across the European Union and has 80 sites located across the EU (manufacturing, commercial and other). The Brussels team of Novartis represents the link between the Novartis Group and EU institutions, as well as trade associations.

The Complainants are the owners of a large number of trademarks including the term "NOVARTIS" registered in several jurisdictions for many years, in particular in the European Union. The Complainants enjoy a strong online presence through its websites, such as www.novartis.fr, “www.novartis.com” or “www.novartis.ch”, and social networks. The Complainants also own 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 first registrations of the NOVARTIS trademark predate by several years the registration of the disputed domain name which took place on January 3, 2023.

On the grounds of the facts mentioned above, the Complainants assert that:

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

The disputed domain name <novartisbio.eu>, which was registered by the Respondent on January 3, 2023 according to the WHOIS records, 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 term “bio”, which is a known abbreviation of “biology/biological” is descriptive to the Complainant’s activities being leading pharmaceutical and biotechnology innovation organization committed to discovering innovative medicines and solutions. 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 disputed domain name

The Complainants and the Respondent have never had any previous relationships, nor has the Complainant ever granted the Respondent with any right to use the NOVARTIS trademark in any form, including the disputed domain name. At the time of filing of this Complaint the disputed domain name does not resolve to any active page. There is no evidence that the Respondent has engaged in fair non-commercial use of the disputed domain name.

The Complainants have 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 the Complainants searched for “novartisbio” or “novartisbio.eu” in the Google search engine, all search results pointed to the Complainant and its business activities. The results also refer to the products manufactured by the Complainants such as “Novartis Bio Somatropin Human Growth Hormone”.

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 Complainants and that the Complainants have been using their trademarks in many other countries worldwide. In fact, the Complainants believe that the Respondent knew about the Complainants and its trademark NOVARTIS when it registered the disputed domain name. However, the Respondent still chose to register the disputed domain name as such.

The Complainants believe that the Respondent is involved in pattern of abusive domain name registrations incorporating the terms “Novartis” and “bio”. In April 2022 the Complainant found out about the website associated to the domain name <novartis-bio.eu> (“the Website”) displaying the content that impersonated Complainants’ 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 Complainants filed an abuse report to the hosting provider and filed an ADR complaint with the CAC (CAC-ADREU-008361). The decision was rendered in favor of the Complainant and the domain name was transferred accordingly.

Furthermore, there are other domain names likely registered by the same individuals targeting the Complainants, such as <novartis-bio.info>, where the Respondent appeared to be the same individual as in the case of <novartis-bio.eu> mentioned above (CAC Case No. 104971). The Complainant recovered the domain name due to favourable UDRP decision.

Obviously, the Respondent has been impersonating the Complainants and has been trying to mislead internet users into believing that the Website was authorized by / associated with the Complainants.

For the foregoing reasons, it shall be concluded that the Respondent has no right or 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 disputed domain name was registered or is being used in bad faith.

The Complainant invokes (Article 21 of Commission Regulation (EC) No. 874/2004, Paragraph 3); ADR Rules, paragraph B(1)(b) (10)(i)(C) and B(11)(f)). 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."

1. THE DISPUTED 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 Complainants 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.

The Complainants enjoy a strong online presence. By conducting a simple online search regarding the terms "Novartisbio", the Respondent would have inevitably learnt about the Complainants, its trademark and business.

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

2. THE DISPUTED DOMAIN NAME IS BEING USED IN BAD FAITH

Taking into account the fact that the Complainants are well-known worldwide, the Complainants considers that by using the disputed domain name incorporating the trademark NOVARTIS along with the relevant term "bio" directly referring to the Complainants, their business and products, 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.

In addition, the Complainants believe that the Respondent is engaged in a pattern of abusive registrations targeting the Complainants, which is an indication of bad faith.

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 trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website.

B. RESPONDENT

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

DISCUSSION AND FINDINGS

Before entering into the merits of the case, the Panel wishes to underline that the pending dispute has been initiated after the entry into force of Commission Regulation (EC) No 2019/517 OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 19 March 2019 on the implementation and functioning of the .eu top-level domain name and amending and repealing Regulation (EC) No 733/2002 and repealing Commission Regulation (EC) No 874/2004. Pursuant to article 22 of this Regulation, this Regulation ... shall apply from 13 October 2022. In addition, according to article 21, Regulations (EC) No 733/2002 and (EC) No 874/2004 are repealed with effect from 13 October 2022. Hence, the law applicable to the present case is Regulation 2019/517, not Regulation 874/2004.

In accordance with **Article 4(4) of Regulation 2019/517**, a domain name may be revoked, and where necessary subsequently transferred to another party, following an appropriate ADR or judicial procedure, in accordance with the principles and procedures on the functioning of the .eu TLD laid down pursuant to Article 11, where that name is identical or confusingly similar to a name in respect of which a right is established by Union or national law, 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.

The above provision has replaced article 21 (1) of the European Regulation n° 874/2004 relating to the Speculative and abusive registrations, which had the following wording: "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". Paragraph 3 of the above article featured a long list of bad faith situations (letters a-e), which is not anymore embedded in the text of the new EU Regulation.

Recitals 19-20 of Regulation 2019/517 provide that:

(19) A domain name that is identical or confusingly similar to a name in respect of which a right is established by Union or national law and which has been registered without rights or legitimate interest in the name, should, in principle, be revoked and, where necessary, transferred to the legitimate holder. Where such a domain name has been found to have been used in bad faith, it should always be revoked.

(20) The Registry should adopt clear policies aiming to ensure the timely identification of abusive registrations of domain names and, where necessary, should cooperate with competent authorities and other public bodies relevant to cybersecurity and information security which are specifically involved in the fight against such registrations, such as national computer emergency response teams (CERTs).

From the provisions aforementioned, it follows that the criteria for establishing a bad faith case are to be found in pertinent case law, which was shaped and developed through the long practice and implementation of EU Regulation 874/2004, coupled with the .eu Alternative Dispute Resolution Rules (the "ADR Rules") (Article 11(f).

Pursuant to article B(1)(b)(10) ADR Rules (in force since October 13, 2022), for the purposes of challenging the registration of a domain name, the complainant has to prove that 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; the Domain Name is registered by the holder without rights or legitimate interest in the name; or, the Domain Name is registered or is being used in bad faith.

Following the facts and assertions submitted by the Complainants, and taking into account the default of the Respondent (article B(10)(1) ADR Rules), the Panel will proceed to the examination of the conditions aforementioned.

(a) Identical or confusingly similar

The Complainants demonstrate they have valid trademark rights in the NOVARTIS sign. Based on the evidence furnished by the Complainants, the Panel recognizes that the 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" is not reason enough for convincing the Panel that it could influence the position of the court. On the contrary, the reference to "BIO" for biology refers to the known activity of the Complainants.

The disputed domain name <novartisbio.eu> incorporates Complainants' Trademarks "NOVARTIS" in its entirety. In a decision concerning a case with the same parties, it was ruled 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 (CAC-ADREU-008361). This is evidently the case in the dispute at hand.

Accordingly, by registering the disputed domain name, the 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 disputed domain name is confusingly similar to the trademark "NOVARTIS".

(b) No rights nor legitimate interests

Pursuant to article 4(4)(a) Regulation 2019/517, the Complainants have to prove prima facie that the Respondent lacks rights and legitimate interests in the disputed domain name. The burden of proof thereto shifts to the Respondent. This standard has been recognized by continuous case law (see CAC-ADREU-008361, and the cases cited there), 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.

As already mentioned above, the Respondent did not provide a reply. In previous cases, panels have held that the Respondent's default was proof that Complainant and Respondent had no relation and that the Respondent is not commonly known under the disputed domain name (see CAC-ADREU-008361, and the cases cited there). In the absence of a response, and in accordance with article B(10)(1) ADR Rules, the Panel accepts 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, 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 **article 4(4)(a) Regulation 2019/517 and B(1)(b)(10)(B) ADR Rules** ").
Given the absence of an apparent right or legitimate interest and the failure of the Respondent to appear and provide evidence to the contrary, the Panel decides that the Respondent has no rights or legitimate interests regarding the disputed domain name.

(c) Registration or Use in Bad Faith

To comply with articles 4(4)(b) Regulation 2019/517 and B(1)(b)(10)(C) ADR Rules), the Complainant must demonstrate that the disputed domain name is registered or is being used in bad faith. It is not necessary to prove both registration and use in bad faith; it is sufficient if evidence illustrates that one of the two elements discussed is met, in order to comply with the provisions above. It is established that the disputed domain name directed originally to a website presenting products of the Complainants. Therefore, the Panel considers that the pattern of conduct constitutes a bad faith conduct, and that the disputed domain name is being used in bad faith by the Respondent. Hence, the third condition is also fulfilled.

DECISION

For all the foregoing reasons, in accordance with Paragraph B12 (b) of the Rules, the Panel orders that the disputed domain name <novartisbio.eu> be transferred to the Complainant, Novartis Pharma GmbH.

PANELISTS

Name	**Apostolos Anthimos**

DATE OF PANEL DECISION 2023-05-10

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

I. Disputed domain name: NOVARTISBIO.EU

II. Country of the Complainant: Switzerland and Germany, country of the Respondent: **Cyprus**

III. Date of registration of the domain name: **January 3, 2023**

IV. Rights relied on by the Complainant (Article 4(4)(a) Regulation 2019/517) on which the Panel based its decision:
EU TM registration NOVARTIS No. 000304857 registered on 25.06.1999 in Classes 1, 5, 9, 10, 29, 30, 32 of ICGS;
EU TM registration NOVARTIS No. 1544148 registered on 29.06.2020 in Class 35 of ICGS
EU TM registration NOVARTIS No. 013393641 registered on 13.03. 2018 in Class 9, 10 of ICGS
Cyprus Trademark registration NOVARTIS No. 45686 registered on 10.11.200 in Class 29 of ICGS.

V. Response submitted: No

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

VII. Rights or legitimate interests of the Respondent (Article 4(4)(a) Regulation 2019/517):
1. No
2. Why: Default of Respondent; no evidence proving rights or legitimate interest on the part of the Respondent in the disputed domain name. No evidence that the Respondent has any connection with the Complainants.

VIII. Bad faith of the Respondent (Article 4(4)(b) Regulation 2019/517):
1. Yes
2. Why: The disputed domain name directed originally to a website presenting products of the Complainants or alike.

IX. Other substantial facts the Panel considers relevant: Pattern of conduct to engage in bad faith registrations by the Respondent.
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, seat of Novartis Pharma GmbH located in Germany