



CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE

ADMINISTRATIVE PANEL

DECISION

CIIDRC case number: 2262-CIRA

Decision date: September 17, 2020

Panelist: Richard Levy

Domain in Dispute: pharmanovartis.ca

Complainant: Novartis AG of Basel, Switzerland

Registrant and Respondent: Pery Priniy of Laval, Quebec

Registrar: Go Get Canada Domain Registrar Ltd.

Registration date: November 12, 2019

Complainant's Counsel: Jeanne Gonin, BRANDIT GmbH

PROCEDURAL HISTORY

1. The procedural history of this matter was set out in a letter from the British Columbia International Commercial Arbitration Centre (predecessor of the CIIDRC) to the Complainant dated July 24, 2020 and to this Panelist on September 15, 2020.
 - a. On July 22, 2020, the above-named Complainant filed a Complaint pursuant to the CDRP and the Rules.
 - b. On July 22, 2020, the CIRA dispute resolution department was notified of this proceeding. On the same day, BCICAC confirmed compliance with the Complaint.

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- c. On July 24, 2020 CIRA confirmed to BCICAC that the disputed domain was placed on a Registrar LOCK and confirmed the identity of the Registrant. On this date BCICAC gave notice of the Complaint to the Registrant by email and indicated the commencement of the Proceeding is July 24, 2020, the deemed date of delivery of the Complaint to the Registrant. The Registrant was informed that its response would be due no later than August 13, 2020.
 - d. As the Complaint with the attachments was filed exclusively online, the Centre delivered the Complaint to the Registrant only by email to the address provided by CIRA. The Complaint was successfully delivered to the Registrant on July 24, 2020.
 - e. Counsel for the Complainant requested suspension of the proceedings to explore settlement options with the Registrant
 - f. On September 11, 2020, counsel for the Complainant requested reinstatement of the proceedings as the parties had not been able to reach an amicable settlement
 - g. The Registrant has not provided a Response. As permitted, given the absence of a Response, the Complainant has elected, under Rule 6.5, to convert from a panel of three to a single arbitrator.
 - h. The Centre appointed me, Richard S. Levy, as a single-member administrative Panel in the above-referenced matter.
2. I am not aware of any other legal proceeding or other arbitration in relation to the Domain Name that would give rise, under paragraph 13 of the Rules, to a need to stay or terminate the progress of this proceeding.

ELIGIBILITY OF COMPLAINANT

3. I have reviewed the material submitted by the Complainant and am satisfied that the Complainant is an eligible complainant under paragraph 1.4 of the Policy. It is the owner of a registered Canadian trademark in which the distinguishing word component of such trademark is within the Domain Name in dispute.

FACTS ALLEGED BY THE COMPLAINANT

4. Background facts alleged by the Complainant and accepted by me as probative are summarized hereinbelow from the Complaint.
5. The Complainant owns numerous NOVARTIS trademark registrations worldwide (thereafter the “NOVARTIS trademark”), such as but not limited to:
 - Canada trademark NOVARTIS No. TMA523129, registered on February 15, 2000, in class 1, 3, 5, 9, 29, 30, 31, 32.
 - International trademark NOVARTIS No. 663765, registered on July 1, 1996,
 - International trademark NOVARTIS No. 666218, registered on July 1, 1996, in classes 41 and 42, in classes 1, 2, 3, 4, 5, 7, 8, 9, 10, 14, 16, 17, 20, 22, 28, 29, 30, 31, 32, 40, 42.
6. The first International trademark registrations and the Canada trademark registration predate the disputed domain name registration (dated November 12, 2019) by at least nineteen years.
7. The NOVARTIS trademark has been actively used in Canada since 2000 in relation to products and services the Complainant and associated companies commercialized under the NOVARTIS trademark.
8. Novartis AG is one of the world’s largest pharmaceutical and healthcare companies. The Novartis Group commercializes its products in numerous regions of the world. It has a strong commercial presence in Canada where the Respondent is located. The Complainant also enjoys a strong online presence via its official website and social media platforms. Due to the extensive use, advertising and revenue associated with the NOVARTIS trademark worldwide, Complainant enjoys renown in Canada and around the world.
9. The Complainant also owns several domain names containing the trademark NOVARTIS, among them <novartis.com> (created on April 2, 1996), <novartis.ca> (created on November 27, 2000) and <novartis.ch> (March 10, 1996). The Complainant uses these domain names to resolve to its official websites through which it informs Internet users and potential customers about its NOVARTIS trademark and its associated products and services.

10. In response to a cease and desist letter dated December 12, 2019, sent by the Complainant, the Respondent refused to disclose the purpose of the Registration and to voluntarily transfer the Domain Name to the Complainant.
11. At the time of this cease and desist letter, the Domain Name resolved to an inactive Word Press blog page. After receipt of the letter it, resolved to an error page.
12. The Domain Name is associated with an active MX (Mail Exchange) record that allows the Domain Name to be incorporated into email addresses.

CONTENTIONS OF THE COMPLAINANT

13. In accordance with Paragraph 3 of the Policy, the Complainant contends:
 - a. That the Domain Name is confusingly similar to a Mark in which the Complainant had rights prior to the date of registration of the Domain Name and continues to have such rights;
 - b. That the Respondent has no legitimate interests in the Domain Name; and
 - c. That the Domain Name has been registered in bad faith.
14. In accordance with Paragraph 3 of the Policy, the onus is on the Complainant to prove the above-mentioned contentions.
15. Even if the Complainant proves (a) and (c) and provides some evidence of (b), the Registrant will succeed in the Proceeding if the Registrant proves, on a balance of probabilities, that the Registrant has a legitimate interest in the domain name as described in paragraph 3.4.

DISCUSSION AND FINDINGS

16. To consider each of these requirements in turn:

That the Domain Name is Confusingly Similar to a Mark in which the Complainant has Rights

17. The Complainant is the owner of a registered Canadian trademark in which the word component is included identically within the Domain Name. The Complainant established

that it has rights in a trademark that was a “Mark” prior to the date in this case, well prior to the date) on which the Domain Name was registered.

18. The NOVARTIS trademark has been actively used in Canada since 2000 in relation to products and services listed in the registration
19. The Domain Name, in its second-level portion, incorporates in its entirety the Complainant’s trademark NOVARTIS, with the addition of the term “pharma”, a generic term that does not function to prevent confusion in appearance, sound or idea.
20. I am satisfied that the Complainant has established that the Domain Name is confusingly similar to the Complainant’s Mark.

That the Respondent has No Legitimate Interest in the Domain Name

21. The Complainant has not licensed or authorized the Respondent to register or use the disputed Domain Name, nor is the Respondent affiliated to the Complainant in any form.
22. There is no evidence that the Respondent is known by the Domain Name or owns any registered trademark including the distinguishing element NOVARTIS.
23. There is no evidence that the disputed Domain Name was the geographical name of a location of the Registrant’s non-commercial activity or place of business.
24. The Domain Name is currently passively held. It resolves to an error page. On December 12, 2019, when the cease and desist letter was sent to the Respondent, until April 9, 2020, the Domain Name resolved to a Word Press blog not actively used.
25. I am satisfied that the Complainant has established that the Respondent has no legitimate interest in the Domain Name.

That the Respondent has Registered the Domain Name in Bad Faith

26. The Respondent registered the Domain Name nineteen years after the registration of the Complainant’s NOVARTIS trademark in Canada. During that period of nineteen years, the prevalence of this trademark on search engines, in social media accounts, in advertising and on products make it implausible that the Registrant was unaware of the Complainant’s trademark

and its association with the Complainant. It is also highly plausible that the Registrant registered the Domain Name to attract, for commercial gain, internet users to the Registrant's website, by creating confusion with the Complainant's trademark.

- 27.** In view of the passive use of the Domain Name, which does not resolve to an active website, there is no evidence of actual or contemplated good-faith use of the Domain Name.
- 28.** The non-responsive replies by the Registrant to the Complainant's cease and desist letter and the evidence that the Domain Name, that had resolved to an inactive Word Press page, later resolved to an error page, after attempts by the Complainant to settle the matter, are further indications of bad faith on the part of the Registrant.
- 29.** I am satisfied that the Complainant has established that the Domain Name has been registered in bad faith.

DECISION and ORDER

- 30.** For the above reasons, in accordance with Paragraph 4 of the Policy, Paragraph 15 of the Rules, and Rule 10 of the Supplemental Rules, the Panel orders that the Domain Name in issue be transferred to the Complainant.

Dated: September 17, 2020



Richard S. Levy, member of the Quebec Bar; Sole Panelist

