Decision for dispute CAC-UDRP-101772

Case number	CAC-UDRP-101772
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Domain names	mynovartis.com

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BrandIT GmbH

Respondent

Organization	novartis

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 names <mynovartis.com> and <notvartisindia.com>.

IDENTIFICATION OF RIGHTS

The Complainant is the owner, among others, of the following trademark registrations relating to "NOVARTIS" which enjoy protection in numerous countries and, inter alia, in India:

- Word mark NOVARTIS, World Intellectual Property Organization (WIPO), Registration No. 666218, registered on October 31, 1996 and duly renewed.

- Word-/design mark NOVARTIS LONG LIVE LIFE, WIPO, Registration No. 1155214, registered on January 24, 2013.

- Word mark NOVARTIS, European Office for Intellectual Property (EUIPO), Registration No. 304857, registered on June 25, 1999 and duly renewed.

- Word mark NOVARTIS, Indian trademark office, Application No. 700020 filed on February 28, 1996 duly regitered and renewed.

FACTUAL BACKGROUND

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

1) Novartis AG (hereinafter referred to as the Complainant) submits that despite some minor differences in the details provided in the official WHOIS records for the two domains included in the complaint, the domains should be considered to be owned by the same registrant and/or under common control.

2) The Complainant declares to be a global healthcare company based in Switzerland that provides solutions to address the evolving needs of patients worldwide. Furthermore the Complainant informs that it manufactures drugs such as clozapine (Clozaril), diclofenac (Voltaren), carbamazepine (Tegretol), valsartan (Diovan) and many others as well as that its products are available in more than 180 countries.

3) The Complainant has duly proved to be the owner of the registered well-known trademark "NOVARTIS" as a word and figure mark in several classes in numerous countries all over the world including in India, where the Respondent is located and that these trademark registrations long predate the registration of the disputed domain names.

4) In Complainant's view, due to extensive use, advertising and revenue associated with its trademarks worldwide, the Complainant enjoys a high degree of renown around the world, including in India, where the Respondent is located. The Complainant has previously successfully challenged several domain names including the word NOVARTIS through UDRP processes.

5) The Complainant outlines that in the WIPO Case No. D2016-1688, Novartis AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org, / Sergei Lir regarding the domain name <novartis-bio.com>, the Panel confirmed that "NOVARTIS" is a well-known worldwide trademark.

6) Complainant has registered a number of domain names under generic Top-Level Domains ("gTLD") and country-code Top-Level Domains ("ccTLD") containing the term NOVARTIS, for example, <novartis.com> (created on April 02, 1996), <novartis.net> (created on April 25, 1998), <novartis.pk> (created on August 7, 2013) & Novartis.us (created on 19.04.2002). The Complainant uses these domain names to connect to a website through which it informs potential customers about its "NOVARTIS" mark and its products and services.

7) According to the Complainant, the domain names in dispute are similar to its "NOVARTIS" trademark. In the case of <mynovartis.com> the disputed domain name directly and entirely incorporates the Complainant’s trademark along with the possessive pronoun “my". In the case of <notvartisindia.com> the disputed domain name resolves in a typo variant of the "NOVARTIS" mark along with the geographic identifier “India”.

8) The Complainant has not found that the Respondent is commonly known by the domain names or that it has interest over the domain names or the major part of it. While the WHOIS information for <mynovartis.com> notes that the registrant organisation is claimed to be “novartis”, there is nothing else in the WHOIS records, or in the content of the associated websites, which relates the Respondent to the disputed domain names. Furthermore, the Complainant outlines that the domain name <mynovartis.com> does not resolve to an active website, while the <notvartisindia.com> resolves to a pay-per-click parking page.

9) The Complainant argues that the Complainant trademarks predate the registration of the domain names and that the Respondent has never been authorized by the Complainant to register the domain names. It is therefore inconceivable in the Complainant's view that the unique combination of the well-known mark “NOVARTIS”, and the typo variant NOTVARTIS in the domain names along with, respectively, the words “my” and “india”, are not a deliberate and calculated attempt to improperly benefit from the Complainant’s rights and confuse internet users.

10) The Complainant informs that an attempt to contact the owner of the disputed domain names was made on October 26, 2017 through a cease and desist letter. The letter was sent to the email address listed in the WHOIS record. In the cease and desist letter, the Complainant advised the Respondent that the unauthorized use of its trademarks within the domain names in disputed violated their trademark rights and the Complainant requested a voluntary transfer of the domain names. Despite

the letter and reminders from the Complainant concerning the use of the domain names in dispute, the Respondent has simply disregarded such communications.

11) The Complainant insists that there is no active website associated with the domain <mynovartis.com> and that the website associated with <notvartisindia.com> is a pay-per-click parking page. In the Complainant's view, passive holding may apply even in the event of sporadic use, or of the mere “parking” by a third party of a domain name as it happens in the current case.

12) The Complainant also notes that the Respondent registered three domain names on the same day using the "NOVARTIS" mark or a confusingly similar version thereof and that such pattern of abusive conduct constitutes evidence of bad faith.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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).

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 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

A. Consolidation of Respondents

According to Article 3(c) of Rules for Uniform Domain Name Dispute Resolution Policy ("Rules"), the complaint may relate to more than one domain name, provided that the disputed domain names are registered by the same domain-name holder. According to Article 10(e) of Rules a Panel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules.

The whois details for the registrant of <notvartisindia.com> domain are as follows:

Registrant Name: Aravind R
Registrant Organization:
Registrant Street: 12-2-800/109/110
Registrant City: Hyderabad
Registrant State/Province: Telangana
Registrant Postal Code: 500028
Registrant Country: IN
Registrant Phone: +91.9573135734
Registrant Phone Ext:

Registrant Fax:
Registrant Fax Ext:
Registrant Email: vishwanath.kantam@gmail.com

The whois details for the registrant of the <mynovartis.com> domain are as follows:

Registrant Name: meghna
Registrant Organization: novartis
Registrant Street: hitech city
Registrant City: hyderabad
Registrant State/Province: Telangana
Registrant Postal Code: 500008
Registrant Country: IN
Registrant Phone: +91.9573135734
Registrant Phone Ext:
Registrant Fax:
Registrant Fax Ext:
Registrant Email: vishwanath.kantam@gmail.com

Although the names of the disputed domain name registrants are different, the Panel is convinced that one single person or entity controls both the disputed domain names since the official email address for both domains is identical "Vishwanath.kantam@gmail.com", both have an address in Hyderabad in India and share the Registrant Phone.

The Panel therefore accepts the Complainant's request to address all the disputed domain names in one case under the Rules, paragraphs 10(e) and 3(c). Accordingly, the Respondents will be collectively referred to as the "Respondent" hereinafter.

The Panel outlines that in previous cases a similar decision was taken (please see Philip Morris USA Inc. v. Domain Administrator, Eastern Valley Limited / Domain Administrator, China Capital Investment Limited - WIPO Case No. D2017-1978 and Cephalon Inc v. Alen Mironassyan, Vesju Pere, Michael Thornton, Mike Bento - CAC Case No. 100892).

B. Material Requirements of the Policy

Paragraph 4(a) of the Policy provides that to obtain the transfer of the disputed domain name, the Complainant must prove that each of the following elements is present:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

1a) <notvartisindia.com>

The disputed domain name is a misspelling of the Complainant's trademark; it differs from the Complainant's trademark for adding the letter "T" to "NOVARTIS" in order to obtain NOTVARTIS. It is well established that "typosquatting" can constitute confusing similarly (please see Deutsche Bank Aktiengesellschaft v. New York TV Tickets Inc. - WIPO Case No. D2001-1314; DaimlerChrysler Corporation v. Worshipping, Chrisler, and Chr, aka Dream Media and aka Peter Conover - WIPO Case No. D2000-1272; Playboy Enterprises v. Movie Name Company - WIPO Case No. D2001-1201; First American Financial Corporation v. VistaPrint Technologies Ltd - WIPO Case No. DCO2016-0008.). Also, it is added to the word NOTVARTIS the word INDIA. In this respect the Panel notes that many previous panels under the Policy have found that a geographic

identifier in a domain name (as in the disputed domain name <notvartisindia.com>) does not alter the finding of similarity between the domain name in dispute and the previous registered trademark (please see Six Continents Hotels, Inc. v. Sdf fdgg, WIPO Case No. D2004-0384 and Credit Agricole SA v. Frederik Hermansen, CAC Case No. 101249). Accordingly, the Complainant has, to the satisfaction of the Panel, shown that the domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

1b) <mynovartis.com>

The disputed domain name fully incorporates the Complainant's "NOVARTIS" mark, merely adding the generic term "my". This Panel believes that the addition of the generic term "my" does not distinguish the <mynovartis.com> domain name from Complainant's "NOVARTIS" mark (please see Vanguard Trademark Holding USA LLC v. Privacy Protection Service INC - CAC Case No. 100946).

Accordingly, the Complainant has, to the satisfaction of the Panel, shown that the domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

2a) <notvartisindia.com>

The Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain name as it is not commonly known under the disputed domain name and was never authorized to use the disputed domain name by the Complainant. The Respondent, in the absence of any response, has not shown any facts or element to justify prior rights or legitimate interests in the disputed domain name. The Complainant therefore succeeds on the second element of the Policy.

2b) <mynovartis.com>

The Complainant has duly proved that while WHOIS information for <mynovartis.com> notes that the registrant organisation is claimed to be "novartis", there is nothing else in the WHOIS records, or in the content of the associated websites, which relates the Respondent to the disputed domain name. The disputed domain name <mynovartis.com> does not resolve to an active website. The Respondent, in the absence of any response, has not shown any facts or element to justify prior rights or legitimate interests in the disputed domain name.

On this record, the Panel considers that Respondent indicated the company name "novartis" and registered the disputed domain name <mynovartis.com>, with the Complainant's "NOVARTIS" mark in contemplation. The reasons for indicating said company name and registering said domain name remain unknown in the absence of any response and considering the passive holding. It must be noted, anyway, that the domain name <notvartisindia.com> resolves in a pay-per-click parking page where the Respondent intends to gain a profit taking advantage from the "NOVARTIS" trademark.

Panels have generally declined to find respondent rights or legitimate interests in the disputed domain name on the basis of a corresponding trademark registration or company name where the overall circumstances demonstrate that such trademark or company name were obtained primarily to circumvent the application of the UDRP (please see Tata Sons Ltd. v. Domain Admin, C/O ID#10760, Privacy Protection Service INC d/b/a PrivacyProtect.org / Accounting Tata Communications, Tata Communications Limited - WIPO Case No. D2017-1210 and Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com" - WIPO Case No. D2000-0847). In the Panel's view, considering the circumsatances of the present case, the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant therefore succeeds on the second element of the Policy.

3a) <notvartisindia.com>

The Panel is of the opinion that the disputed domain name has been registered in bad faith because the Respondent was or must have been perfectly aware of the existence of "NOVARTIS" trademark, which is highly distinctive, when it registered the domain name <notvartisindia.com>. Furthermore Respondent is using the disputed domain name for a parking site that

diverts Internet users to other websites. The above represents an action taken by the Respondent to intentionally attract, for commercial gain, Internet users by creating a likelihood of confusion with Complainant's "NOVARTIS" mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. Previous Panels have held that using the domain name as a parking page with pay-per-click links to third party websites may be evidence of bad faith when the registrant is using the domain name in this manner because of the similarity to the Complainant's trademark in the hope and expectation that the similarity will lead to confusion on the part of Internet users and results in an increased number of Internet users being drawn to that domain name parking page (please see MpireCorporation v. Michael Frey, WIPO Case No. D2009-0258; Paris Hilton v. Deepak Kumar, WIPO Case No. D2010-1364 and La Fee v. Pavol Icik, WIPO Case No. D2013-0526). Therefore, the Panel finds that the Complainant has also satisfied paragraph 4(a)(iii) of the Policy.

3b) <mynovartis.com>

The Complainant must show that the Respondent registered and is using the disputed domain name in bad faith. In the Panel's view the Respondent has engaged in an opportunistic bad faith registration of the domain name because the Complainant's mark is famous and there is no other good faith explanation for such an unauthorized registration. This Panel finds that the Complainant's "NOVARTIS" mark is well-known on an international basis. There are previous cases in which panels had clarified that registration of a domain name that is confusingly similar to a well-known trademark by any entity that has no relationship to that mark, may be sufficient evidence of bad faith registration and use (Allianz, Compañía de Seguros y Reaseguros S.A. v. John Michael, WIPO Case No. D2009-0942; Veuve Cliquot Ponsardin, Maison Fondee en 1772 v. The Polygenix Group Co., WIPO Case No. D2000-0163; Pepsico, Inc. v. "null", aka Alexander Zhavoronkov, WIPO Case No. D2002-0562; Pepsico, Inc. v. Domain Admin, WIPO Case No. D2006-0435). It is clear that the Respondent must have known of the Complainant's "NOVARTIS" mark at the time of registration of the disputed domain name and therefore the Respondent registered the domain name in bad faith. According to previous decisions the fact that the Respondent is passively holding the disputed domain name can also be characterized as bad faith use. In particular, in Intel Corporation v. The Pentium Group, WIPO Case No. D2009-0273 and in Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003 panels concluded that passive holding of a domain name can be in bad faith when complainant's mark has a strong reputation and respondent has provided no evidence of whatsoever of any actual or contemplated good faith use by it of the domain name. Therefore, the Panel finds that the Complainant has also satisfied paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **MYNOVARTIS.COM**: Transferred
2. **NOTVARTISINDIA.COM**: Transferred

PANELLISTS

Name	**Avv. Guido Maffei**

DATE OF PANEL DECISION 2017-12-28

Publish the Decision