Decision for dispute CAC-UDRP-102292

Case number	CAC-UDRP-102292
Time of filing	2019-01-09 13:34:29
Domain names	usa-novartis.com

Case administrator

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

Complainant

Organization	Novartis AG

Complainant representative

Organization	BrandIT GmbH

Respondent

Name	Anderson Paul

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant registered Novartis trademarks in several countries, e.g. NOVARTIS in UK, Reg. No. 000304857 since 1999, which is valid and registered before the Respondent registered the disputed domain name.

The trademarks of Novartis AG, a well-known pharmaceutical company all over the world, are well-known.

The Complainant also provided evidence that it owns a domain containing the name <novartis.com>, registered on April 2, 1996, well before the Respondent registered the disputed domain name on December 19, 2018 and provides a website in the homeland of the Respondent, https://www.novartis.co.uk/.

FACTUAL BACKGROUND

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

I. LANGUAGE OF PROCEEDINGS REQUEST:

As the language of the registration agreement is English, the proceeding language should be in English.

II. ABOUT COMPLAINANT AND THE BRAND NOVARTIS

Novartis AG (hereinafter referred to as Complainant) is the proprietor of the NOVARTIS trademarks. Novartis is a global healthcare company based in Switzerland that provides solutions to address the evolving needs of patients worldwide (see www.novartis.com). Novartis manufactures drugs such as clozapine (Clozaril), diclofenac (Voltaren), carbamazepine (Tegretol), valsartan (Diovan) and many others.

The Complainant's products are sold in about 155 countries and they reached nearly 1 billion people globally in 2017. About 126 000 people of 145 nationalities work at Novartis around the world.

The Complainant is the owner of the registered well-known trademark NOVARTIS as a word and figure mark in several classes in numerous of countries all over the world including in the United Kingdom. The Complainant has a presence in the United Kingdom where the Respondent is located. The below links connect customers to the official local sales and service locator and to the official websites of the Complainant:

- Global Website for NOVARTIS: <www.novartis.com>

- Local Website for NOVARTIS in the United Kingdom: <www.novartis.co.uk>

More information about the Complainant is provided in the Complainant´s Annual report for 2017 available at <www.novartis.com>.

Trademark registration in the United Kingdom

Trademark: NOVARTIS

Reg. no: 000304857

First use in commerce: 1999

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 the United Kingdom, where the Respondent is located. The Complainant has previously successfully challenged several NOVARTIS domain names through UDRP processes (see among others the following WIPO cases: D2016-1688; D2016-0552; D2015-1989; D2015-1250).

Please note that in the 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 as follows:

"When the disputed domain name was registered by the Respondent in June 2016, the trademark NOVARTIS was already well-known worldwide and directly connected to the Complainant's activities in the pharmaceutical business".

The Complainant has registered a number of domain names containing the term "NOVARTIS", for example, <novartis.com> (created on April 2, 1996) and <novartis.net> (created on April 25, 1998). 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.

LEGAL GROUNDS:

A. THE DISPUTED DOMAIN NAME IS CONFUSINGLY SIMILAR

The domain name <usa-novartis.com> (hereinafter referred to as the “disputed domain name”), which was registered on December 19, 2018, incorporates entirely the Complainant’s well-known, registered trademark NOVARTIS with a geographic indication “USA”. The addition of the gTLD “.com” does not add any distinctiveness to the disputed domain name. These references create the impression that the Respondent is the Complainant or is somehow affiliated with the Complainant. See as an example the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0"), paragraph 1.11. as well as the International Business Machines Corporation v. Sledge, Inc. / Frank Sledge WIPO Case No. D2014-0581 where the Panel stated the following:

“In addition, it is generally accepted that the addition of the top-level suffix in the domain name (e.g., “.com”) is to be disregarded under the confusing similarity test”.

The same reasoning should apply in the current case and the disputed domain name should be considered as confusingly similar to the trademark NOVARTIS.

B. RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN RESPECT OF THE DISPUTED DOMAIN NAME

The Complainant has never granted the Respondent any right to use the NOVARTIS trademark within the disputed domain name, nor is the Respondent affiliated to the Complainant in any form.

The Respondent has sent fraudulent e-mail to a third party from the e-mail address richard.taylor@usa-novartis.com on December 20, 2018, impersonating personnel from the Complainant and asking details on travel agencies used by Complainant’s associates. Such conduct shows that the Respondent registered the disputed domain name for the purpose of sending phishing e-mails instead of bona fide offering of goods or services.

The Complainant has not found that the Respondent is commonly known by the disputed domain name or that it has interest over the disputed domain name or the major part of it. When entering the terms “NOVARTIS” and “United Kingdom” in the Google search engine, the returned results point to the Complainant and its business activity. The same result is given in the USA, the addressed geographic part of the disputed domain name, eg. US Trademark NOVARTIS No. 006018044046051052, active. The Respondent could easily perform a similar search before registering the disputed domain name and would have quickly learnt that the trademarks are owned by the Complainant and that the Complainant has been using its trademarks in the United Kingdom and in the USA. The Respondent has not by virtue of the content of the website, nor by its use of the disputed domain name shown that they will be used in connection with a bona fide offering of goods or services.

Furthermore, the Respondent registered the disputed domain name with a privacy shield, and at the time of preparing this Complaint, the disputed domain name is not active, neither fact shows any sign that the Respondent has any legitimate interest in the disputed domain name.

Considering the above, the intention of the Respondent of the disputed domain name is to take advantage of an association with the business of the Complainant, in particular, to send phishing e-mails to partner/client/employee of the Complainant. Respondent has no right nor legitimate interest in respect of the disputed domain name.

C. THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITH

i. THE DISPUTED DOMAIN NAME WAS REGISTERED IN BAD FAITH

It has to be highlighted that the Complainant’s trademarks predate the registration of the disputed domain name and the Respondent has never been authorized by the Complainant to register the disputed domain name. It is inconceivable that the combination of geographic indication “USA” and the well-known mark NOVARTIS in the disputed domain name is not a

deliberate and calculated attempt to improperly benefit from the Complainant's rights.

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

The disputed domain name has been incorporated in the e-mail address richard.taylor@usa-novartis.com, which was used by the Respondent to send e-mails reproducing the Novartis personnel's signature and to request invoices from third parties in the name of the Complainant. This fraudulent e-mail copied entirely the genuine e-mail address of the personnel and changed the domain into <usa-novartis.com>, which is confusingly similar enough to mislead the recipient(s). More viciously, the Respondent has copied the Complainant's personnel's signature, including the name, company name, address, phone and fax number, and even put the Complainant's logo to the end of his phishing e-mail. The conduct of the Respondent has obviously revealed his intention of impersonating the Complainant with the purpose of unlawful collecting of valuable internal/corporate information and possibly other fraudulent activities.

The Complainant sent an abuse report to the Registrar on January 4, 2019. Subsequently, the disputed domain name was deactivated. To prevent further infringement from the disputed domain name, the Complainant chose to file a UDRP complaint.

The above shows that the Respondent has intentionally been using the disputed domain name in bad faith in order to attempt impersonation of the Complainant and to deceive consumers. See e.g., Accor v. Shangheo Heo / Contact Privacy Inc., WIPO Case No. D2014-1471 where the panel stated that:

"The un-opposed allegation of phishing, and the evidence submitted in support of phishing, combined with the likelihood of confusion, is sufficient evidence of bad faith. …It seems likely, as Complainant alleges, that Respondent intentionally attempted to deceive consumers into providing personal and financial information, believing that Respondent was associated with the bona fide services offered by Complainant."

As noted previously, the disputed domain name currently does not resolve to an active website.

Some panels have found that the concept of passive holding may apply even in the event of sporadic use, or of the mere "parking" by a third party of a domain name. See as example WIPO Overview 2.0, paragraph 3.2.

In the WIPO Case No. D2000-0003 Telstra Corporation Limited v. Nuclear Marshmellows the panel established that the registration and passive holding of a domain name which has no other legitimate use and clearly refers to the complainant's trademark may constitute registration and use in bad faith.

From the Complainant's point of view, the Respondent intentionally chose the disputed domain name based on a registered and well-known trademark in order to only use it for non-legitimate purposes.

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

It is necessary for the Complainant, if it is to succeed in this administrative proceeding, to prove each of the three elements referred to in paragraph 4(a) of the Policy, namely that:

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

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

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

The Panel finds that the disputed domain name is confusing similar to the trademarks of the Complainant. The disputed domain name, <usa-novartis.com>, which was registered on December 19, 2018, incorporates entirely the Complainant's well-known, registered trademark NOVARTIS with a geographic indication "USA". The addition of the gTLD ".com" does not add any distinctiveness to the disputed domain name.

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant has not granted the Respondent any right to use the NOVARTIS trademark within the disputed domain name, nor is the Respondent affiliated to the Complainant.

Moreover, the Complainant contends and provides evidence that the Respondent has not developed a legitimate use in respect of the disputed domain name. The Complainant contends that the Respondent was seeking to use the disputed domain name only to divert consumers to its own business and that the Respondent has no legitimate interests in respect of the disputed domain name.

In lack of 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.

The Complainant also asserted and proved that the Respondent tried to attract internet users for commercial gain by creating a likelihood of confusion with the Complainant's trademarks (phishing email, dated 2018.12.20). The Complainant rightfully contended that the disputed domain name is confusing similar to the prior trademark NOVARTIS of the Complainant. The Complainant also referred to the distinctiveness and reputation of its NOVARTIS trademarks.

This makes it highly unlikely that the Respondent had no knowledge of the Complainant's prior trademark rights at the time of registration of the disputed domain name. The Complainant rightfully contended that the Respondent has used the disputed domain name intentionally to attract visitors for commercial gain by creating confusion with the Complainant's trademarks, and that the Respondent has used the disputed domain name with that intention, namely in bad faith. See e.g., Accor v. Shangheo Heo / Contact Privacy Inc., WIPO Case No. D2014-1471 where the Panel stated that: "The unopposed allegation of phishing, and the evidence submitted in support of phishing, combined with the likelihood of confusion, is sufficient evidence of bad faith. …It seems likely, as Complainant alleges, that Respondent intentionally attempted to deceive consumers into providing personal and financial information, believing that Respondent was associated with the bona fide services offered by Complainant."

Reference is made also to: CAC case N° 101036, Boehringer Ingelheim Pharma GmbH & Co. KG vs. SKYRXSHOP - dulcolax.xyz and WIPO Case no. D2014-0306 Boehringer Ingelheim Pharma GmbH & Co. KG v. Klinik Sari Padma, BAKTI

HUSADA.

Furthermore, the Respondent was using a hidden identity. But this argument is not to be discussed further because bad faith is evident during registration and use, whatsoever.

Accordingly, the Panel finds that the disputed domain name was both registered and used in bad faith and that the Complaint succeeds under the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **USA-NOVARTIS.COM**: Transferred

PANELLISTS

Name	**Dr. jur. Harald von Herget**

DATE OF PANEL DECISION 2019-02-18

Publish the Decision