Decision for dispute CAC-UDRP-102591

Case number	CAC-UDRP-102591
Time of filing	2019-07-25 13:01:19
Domain names	novartis-group.com

Case administrator

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

Complainant

Organization	Novartis AG

Complainant representative

Organization	BrandIT GmbH

Respondent

Name	Bryan Scred

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided proceeding between the parties and related to the disputed domain name at issue.

IDENTIFICATION OF RIGHTS

Trademark registration for NOVARTIS both in the US and Worldwide.
Trademark: NOVARTIS, US Reg. no: 2997235, registered: September 20, 2005.

Several official websites of the Complainant:
- Global Website for NOVARTIS: <www.novartis.com>

FACTUAL BACKGROUND

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

I. LANGUAGE OF PROCEEDINGS REQUEST:

Since the language of the Registration Agreement of the disputed domain name is English, the language of the proceeding should be 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. 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 well-known trademark NOVARTIS, registered as a word and figurative mark in several classes across numerous countries all over the world including in the USA (see the overview of the registered trademarks below). In addition, Complainant has an actively strong presence in USA 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 USA: <www.pharma.us.novartis.com>

For more information about the Complainant, please see the Complainant´s Annual report for 2018 available at <www.novartis.com>.

US Trademark registrations

Trademark: NOVARTIS
Reg. no: 4986124
First use in commerce: 1996

Trademark: NOVARTIS
Reg. no: 2997235
First use in commerce: 1997

These trademark registrations predate the registration of the disputed domain name. 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 USA, 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 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 several 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 disputed domain name <novartis-group.com>, which was registered on June 18, 2019 according to the WHOIS record, incorporates the Complainant's well-known trademark, NOVARTIS, and is combined with a generic term "group". The addition of the gTLD ".com" does not add any distinctiveness to the disputed domain name. Referring to WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0"), as the term "NOVARTIS" is identically recognizable in the <novartis-group.com>, the disputed domain name should be considered as confusingly similar to the trademark NOVARTIS for the purposes of this complaint.

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

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.

UDRP panels in previous cases have found that in the absence of any license or permission from the complainant to use such widely-known trademarks, no actual or contemplated bona fide or legitimate use of the domain name could be claimed (Groupe Auchan v. Gan Yu, WIPO Case No. D2013-0188; and LEGO Juris A/S v. DomainPark Ltd., David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host Master, WIPO Case No. D2010-0138).

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-group" in the Google search engine, the returned results all point to the Complainant and its business activity. The Respondent could have easily performed a similar search before registering the disputed domain name and would have quickly learned that the trademarks are owned by the Complainant and that the Complainant has been actively using its trademarks, including in the United States.

On June 20, 2019 Complainant became aware of unauthorized e-mail being sent from the disputed domain name, impersonating the Novartis Chief Executive Officer. The matter escalated internally resulting in this domain name dispute. It is well-settled UDRP case law that the use of a domain name for fraudulent or phishing purposes negates rights and legitimate interests without the purview of the Policy. See paragraph 2.13 of WIPO Overview 3.0, "Panels have categorically held that the use of a domain name for illegal activity (e.g. the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent.".

Taking the above into consideration, it is clear the Complainant has become a distinctive identifier associated with the term NOVARTIS and that Respondent's sending of fraudulent e-mails impersonating Complainant's employees shall be considered as Respondent having 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

Complainant's trademarks predate the registration of the disputed domain name and the Respondent has never been authorized by the Complainant to use these trademarks nor to register the disputed domain name. The Respondent has chosen to incorporate the well-known trademark NOVARTIS in the disputed domain name combined with the generic term "group" as a postfix, which implicates to the Novartis corporation. From the Complainant's perspective, it is inconceivable that the Respondent did not have the well-known trademark NOVARTIS in mind when he registered the disputed domain name and registered it only for the purpose to mislead Internet users and/or engage in deceptive and/or fraudulent

activities.

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

As previously stated, Respondent's sending of e-mails impersonating the Complainant cannot be held as a bona fide use of the disputed domain name.

Furthermore, the website linked to the disputed domain name is hosting content displaying pay-per-click (PPC) advertising displaying content linked to the Complainant. In terms of paragraph 4(b)(iv) of the Policy, this conduct constitutes bad faith as it has also been confirmed in previous cases, e.g. WIPO Case No. D2016-0873 Corsair S.A. v. Liana Long. See WIPO Case No. D2016-0245, Heraeus Kulzer GmbH. v. Whois Privacy Services Pty Ltd / Stanley Pace, wherein the Panel stated:

The Panel finds that the disputed domain name was registered and is being used to attract, for commercial gain, Internet users to the Respondent's website or other online location, by creating a likelihood of confusion with the Complainant's KULZER Mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. In particular the Respondent's website is a page that offers sponsored-links to third-party sites that have in the past and may in the future sell products that directly compete with the Complainant's dental equipment. Such sites generally advertise by paying registrants on a pay-per-click basis for Internet users redirected to their sites. This means that the Respondent receives a financial reward for every Internet user redirected from the Respondent's website to those third-party sites.

Accordingly, the Panel finds that the Respondent has registered and is using the disputed domain name in bad faith under paragraph 4(a)(iii) of the Policy.

Based on the above, Respondent's conduct demonstrates that the disputed domain name was registered and is being used in bad faith.

Consequently, the Respondent should be considered to have registered the disputed domain name confusingly similar to the Complainant's registered, well-known trademark NOVARTIS. The Complainant has not found that the Respondent is of any legitimate right or interest in using the disputed domain name, but rather registered and has been using the disputed domain name in 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

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

I. LANGUAGE OF PROCEEDINGS REQUEST:

Since the language of the Registration Agreement of the disputed domain name is English, the proceeding should be 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. Novartis has a strong presence in the USA where the Respondent and its registrar are located. The oldest NOVARTIS trademark in the USA dates back to 1996.

For more information about the Complainant, the Complainant has filed its Annual report for 2018.

The Complainant is the owner of the registered well-known trademark NOVARTIS as a word in several classes in numerous of countries all over the world including in USA.

These trademark registrations predate the registration of the disputed domain name, on June 18, 2019 as shown in the WHOIS incorporates the Complainant's well-known trademark. Due to extensive use, advertising and revenue associated with its trademarks worldwide, the Complainant enjoys a high degree of renown around the world and in the USA. 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 disputed domain name <NOVARTIS-GROUP.COM> (hereinafter referred to as the "disputed domain name") incorporates the Complainant's well-known, registered trademark NOVARTIS. The addition of the gTLD ".com" does not add any distinctiveness to the disputed domain name. The addition of the term "group" is not distinctive and refer even more to the Novartis worldwide Group.

Referring to WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0"), as the term “NOVARTIS” is distinctively recognizable in the disputed domain name, 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 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 in the Google search engine, the returned results all point to the Complainant and its business activity.

The Respondent does know the reputation of the trademark NOVARTIS given has sent out phishing e-mails with the NOVARTIS logo.

From the Complainant’s perspective, by associating the disputed domain name with phishing mail, the Respondent is intending for commercial gain to misleadingly divert consumers to its website or to website of others, which is obviously not making a legitimate, non-commercial or fair use of the disputed domain name.

There is no evidence showing that the Respondent’s use of the disputed domain name is in connection with a bona fide offering of goods or services.

Taking into account of the above, the Respondent shall be considered as having 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 use these trademarks nor to register the disputed domain name. The Respondent has chosen to incorporate the well-known trademark NOVARTIS in the disputed domain name combined with the general term “group” as a suffix, which is confusingly similar to <www.novartis.com>. From the Complainant’s perspective, it is very likely that the Respondent had the trademark in mind when he registered the disputed domain name and registered it only to mislead Internet users. The Respondent was in bad faith at the moment of the registration of the disputed domain name as well as in its use later on through phishing e-mails.

Furthermore the website linked to the disputed domain name is hosting content displaying pay-per-click adverts.

In a similar case Paris Hilton v. Deepak Kumar, WIPO Case No. D2010-1364 where pay-per-click website is involved, the panel states in the decision that:

“it is use in bad faith within the scope of paragraph 4(b)(iv) of the Policy where the registrant is using the domain name in this manner because of its similarity to a mark or name of another person in the hope and expectation that that similarity would lead to confusion on the part of Internet users and result in an increased number of Internet users being drawn to that domain name parking page (see, for example, Express Scripts, Inc. v. Windgather Investments Ltd, supra). The confusion that is usually relevant here is the confusion that draws the Internet user to the respondent's website in the first place (for example, confusion that leads an Internet user to type the domain name into his Internet browser). It does not matter that

when the Internet user arrives at the pay–per-click site that it then becomes clear that the website is unconnected with the trade mark holder."

Therefore, it is very likely that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website advertising displaying content linked to the Complainant and doing this has intentionally triggered a likelihood of confusion with the Complainant's trademark. This is even more serious considering the phishing activities proven by the Complainant carried out by the Respondent through the disputed domain name.

For the above mentioned reasons the Complaint is accepted.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	**Massimo Cimoli**

DATE OF PANEL DECISION 2019-08-22

Publish the Decision