Decision for dispute CAC-UDRP-102706

Case number	CAC-UDRP-102706
Time of filing	2019-10-16 18:13:12
Domain names	novarrtis.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Organization	Weng LLC

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the owner of numerous registrations for the trademark "NOVARTIS", including the Australian trademark No 712454, registered on April 24, 1998, for goods and services in classes 1, 5, 9, 10, 29, 30, 31, 32.

The disputed domain name was registered by the Respondent on September 23, 2019.

FACTUAL BACKGROUND

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

The Complainant states that it is a global healthcare company based in Switzerland that provides solutions to address the evolving needs of patients worldwide.

The Complainant submits that it 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 Australia where the Respondent resides.

The Complainant adds that it has a strong presence in Australia where the Respondent is located.

The Complainant points out that its trademark registrations predate the registration of the disputed domain name.

The Complainant notes that due to extensive use, advertising and revenue associated with its trademarks worldwide, it enjoys a high degree of renown around the world, including in the Australia, where the Respondent is located.

The Complainant submits that it 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 clarifies that it uses these domain names to connect to a website through which it informs potential customers about its "NOVARTIS" trademark and its products and services.

The Complainant argues that the disputed domain name, incorporates the Complainant’s well-known trademark "NOVARTIS" in its entirety and the additional letter “r” is a mere typo.

The Complainant considers that the addition of the top-level domain “.COM” does not add any distinctiveness to the disputed domain name.

The Complainant submits that, as the term “NOVARTIS” is distinctively recognizable in the disputed domain name, the latter should be considered as confusingly similar to the trademark "NOVARTIS" for the purposes of this proceeding.

The Complainant states that it has never granted the Respondent any right to use the "NOVARTIS" trademark within the disputed domain name.

The Complainant adds that the Respondent is not affiliated to it in any form.

The Complainant submits that it became aware of unauthorised emails being sent from the disputed domain name, impersonating the Complainant's staff.

The Complainant clarifies that these phishing emails, requesting a payment by bank transfer to an “escrow account in Hong Kong”, were sent to one of its business partners.

The Complainant indicates that the sender of these emails impersonated the Complainant's staff by copying its signature.

The Complainant points out that it is well-established UDRP case law that the use of a domain name for fraudulent or phishing purposes negates rights and legitimate interests.

The Complainant adds that UDRP Panels in previous cases have found that in the absence of any license or permission from the Complainant to use a widely-known trademark, no actual or contemplated bona fide or legitimate use of the domain name could be claimed.

The Complainant notes that the disputed domain name does not resolve to any active website.

The Complainant argues that there is no evidence showing that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services, or with a legitimate, noncommercial or fair use.

The Complainant takes the view that it is clear that the Complainant has become a distinctive identifier associated with the term "NOVARTIS" and that the Respondent’s sending of fraudulent emails impersonating Complainant’s staff should be considered as evidence that the Respondent has no right nor legitimate interest in respect of the disputed domain name.

The Complainant reaffirms that its trademark registration pre-dates the registration of the disputed domain name.

The Complainant states that the Respondent has never been authorized by the Complainant to use its trademarks nor to register the disputed domain name.

The Complainant argues that the Respondent has chosen to incorporate the well-known trademark NOVARTIS in the disputed domain name in its entirety and added an “r” which is a mere typo of the term "NOVARTIS".

The Complainant considers that it is inconceivable that the Respondent did not have the well-known trademark "NOVARTIS" in mind when it registered the disputed domain name and registered it only for the purpose to mislead Internet users and engage in deceptive and fraudulent activities.

The Complainant highlights that the Respondent’s sending of emails impersonating the Complainant is clearly bad faith use of the disputed domain name.

The Complainant notes that the Respondent has been passively holding the disputed domain name and that a finding of bad faith in this regard is supported by previous UDRP decisions.

The Complainant argues that the Respondent’s conduct demonstrates that the disputed domain name was registered and is being used 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

In accordance with paragraph 4(a) of the Policy, in order to obtain the transfer of the disputed domain name, the Complainant has to demonstrate that:

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

(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.

IDENTICAL OR CONFUSINGLY SIMILAR

The first requirement that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark or service mark rights.

There are two elements of this test: the Complainant must demonstrate that it has rights in a trademark or service mark and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark or service mark.

The Complainant has proven ownership of the registered trademark "NOVARTIS", identified in section "Identification of rights" above.

The Panel observes that the registration of the Complainant's trademark predates the registration of the disputed domain name.

On the question of identity or confusing similarity, what is required is simply a comparison and assessment of the disputed domain name itself to the Complainant's trademark.

It is well established that a domain name which contains a common or obvious misspelling of a trademark normally will be found to be confusingly similar to such trademark, where the misspelled trademark remains the dominant or principal component of the domain name (see, for example, WIPO Case No D2016-2545).

In the present case, the Panel considers that the disputed domain name is confusingly similar to the Complainant's "NOVARTIS" trademark for the following reasons: (a) "NOVARTIS" is a distinctive and invented word; (b) the only difference between the distinctive part of the "NOVARTIS" trademark and the disputed domain name is that in the latter the letter "R" has been doubled; (c) the fact of doubling the letter "R" in the disputed domain name does not create any new word, or give the disputed domain name any distinctive meaning; (d) the disputed domain name is a deliberate misspelling of the Complainant's "NOVARTIS" trademark; and (e) visually the disputed domain name is so close to the Complainant's well-known "NOVARTIS" trademark that confusion is inevitable between them.

It is also well established that the top-level domain may generally be disregarded in the confusing similarity test (see, for example, WIPO case No. D2016-2547).

Therefore, the Panel considers that the disputed domain name is confusingly similar to the Complainant's trademark.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

The second requirement that the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in the disputed domain name:

(i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a bona fide offering of goods or services; or

(ii) [the Respondent] (as an individual, business, or other organization) [has] been commonly known by the [disputed] domain name, even if [the Respondent] [has] acquired no trademark or service mark rights; or

(iii) [the Respondent] [is] making a legitimate non-commercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

This is a non-exhaustive list of circumstances in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement falls on the Complainant. UDRP panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”.

Accordingly, it is usually sufficient for a complainant to raise a prima facie case against the respondent and the burden of proof on this requirement shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in a domain name.

The Panel finds that the Complainant has made out a prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain name.

In particular, the Complainant states that:

- the Complainant has never granted the Respondent any right to use the "NOVARTIS" trademark within the disputed domain name;

- the Respondent is not affiliated to the Complainant in any form;

- the Respondent sent phishing emails to one of the Complainant's business partners;

- the disputed domain name does not resolve to any active website;

- there is no evidence showing that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services, or is making a legitimate, noncommercial or fair use of the disputed domain name.

In the absence of a Response, there is no indication in the present case that the Respondent has any right or legitimate interest in the disputed domain name.

The Respondent does not appear to make any legitimate non-commercial or fair use of the disputed domain name, nor any use in connection with a bona fide offering of goods or services. Indeed, other panels have considered that typosquatting constitutes evidence of the Respondent's lack of rights and legitimate interests in the disputed domain name (see, for example, CAC Case No. 102747).

Furthermore, it is well established that carrying out illegal activities like phishing can never be considered as bona fide offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain name (see, for example, CAC Case No. 102346).

The Panel considers that, on the balance of probability, the Respondent knew of the reputation and goodwill that the Complainant had established in the trademark "NOVARTIS" and registered the disputed domain name with knowledge of the Complainant's rights and reputation. Indeed, it is not conceivable that the Respondent did not have the Complainant's trademark “NOVARTIS” in mind, when registering and using the disputed domain name. Under these circumstances, it cannot be concluded that the Respondent is making a "fair" use of the disputed domain name.

Taking into account that the Complainant has never granted the Respondent any right to use its trademark, that the Respondent is not affiliated to the Complainant, that the Respondent did not use the disputed domain name for any active website but used it for phishing attempts and that there is no indication of any right or legitimate interest on the disputed domain name, the Panel cannot imagine any possible legitimate justification for this use, and the Respondent has not come

forward with any explanation that demonstrates any rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

REGISTERED AND USED IN BAD FAITH

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, including:

(i) circumstances indicating that [the Respondent] [has] registered or [has] acquired the [disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the [disputed] domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of [the Respondent's] documented out-of-pocket costs directly related to the [disputed] domain name; or

(ii) [the Respondent] [has] registered the [disputed] domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the Respondent] [has] engaged in a pattern of such conduct; or

(iii) [the Respondent] [has] registered the [disputed] domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the [disputed] domain name, [the Respondent] [has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent's] web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the Respondent's] web site or location or of a product or service on [the Respondent's] web site or location.

The Panel, on the basis of the evidence presented, agrees with the Complainant's contentions that the disputed domain name was registered in bad faith and that it has been used in bad faith.

Taking into account the distinctiveness and reputation of the trademark “NOVARTIS” also recognized by other panels, the Panel agrees that it is inconceivable that the Respondent was not aware of the Complainant's rights in the trademark “NOVARTIS” when registering the disputed domain name. Other panels considered that knowledge of a corresponding mark at the time of the domain name’s registration can suggest bad faith (see, for example, WIPO Case No. D2017-0100) and the Panel shares this view.

Other panels considered the use of a domain name to impersonate a third party as evidence of bad faith (see, for example, CAC Case No. 102301). Furthermore, the use of a domain name for sending fraudulent e-mails has been considered by other panels as evidence of bad faith (see, for example, CAC Case No. 102138). The Panel shares these views.

The Panel observes that if the Respondent had legitimate purposes in registering and using the disputed domain name it would have filed a Response in this proceeding.

The Panel, having taken into account the Respondent's knowledge of the "NOVARTIS" trademark at the time of the disputed domain name’s registration, that no response to the complaint has been filed and the use of the disputed domain name for impersonating the Complainant and making phishing attempts, considers that the disputed domain name was registered and is being used in bad faith.

Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith within the meaning

of paragraph 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARRTIS.COM**: Transferred

PANELLISTS

Name	**Michele Antonini**

DATE OF PANEL DECISION 2019-12-02

Publish the Decision