Decision for dispute CAC-UDRP-103247

Case number	CAC-UDRP-103247
Time of filing	2020-08-20 11:27:55
Domain names	novartispharmacies.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Organization	LiteHost Ng

OTHER LEGAL PROCEEDINGS

There are no other legal proceedings regarding the Disputed Domain Name.Identification of rights

IDENTIFICATION OF RIGHTS

Various trademarks worldwide including: US Trademarks
NOVARTIS, Reg. no: 5420583, Reg. date: 13 March 2018 and NOVARTIS, Reg. no: 2997235, Reg. date: 20 September 2005.

FACTUAL BACKGROUND

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

Respondent has registered the Disputed Domain Name novartispharmacies.com (hereinafter referred to as the “Disputed Domain Name”), on 3 April 2020.

Complainant argues that the disputed domain name should be transferred to her.

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

IDENTITY OR CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAME
The domain name novartispharmacies.com incorporates Complainant's well-known, distinctive trademark NOVARTIS in its entirety combined with a generic term "pharmacies", which is closely related to the Complainant and its business activities. The addition of the gTLD ".com" does not add any distinctiveness to the Disputed Domain Name. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO 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 Panel follows the same reasoning. The Disputed Domain Name is considered to be confusingly similar to the trademark NOVARTIS.

NO RIGHTS OR LEGITIMATE INTERESTS OF THE RESPONDENT
The onus to make out a prima facie case that the Respondent lacks rights or legitimate interests is placed on the Complainant. However, once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the Policy (see point 2.1 of the WIPO UDRP Overview 3.0; WIPO case no.D2003-0455 Croatia Airlines d.d. v. Modern Empire Internet Ltd.).
The Complainant has put forward that the Respondent is not affiliated with nor authorized by NOVARTIS AG in any way. The Complainant has put forward that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. The Complainant has put forward that the Respondent does not carry out any activity for, nor has any business with the Respondent.
The Complainant has put forward that no authorization has been granted to the Respondent to make any use of the Complainant’s trademarks, or apply for registration of the Disputed Domain Name.
The Complainant and the Respondent have never had any previous relationships, nor has the Complainant ever granted the Respondent with any rights to use the NOVARTIS trademark in any forms, including the Disputed Domain Name.

Complainant has put forward that the Disputed Domain Name has been used for resolving to an active website impersonating the Complainant.
The Complainant has put forward that the Respondent’s website had also put in the header position the below phrases:
"Coronavirus disease (COVID-19) advice for the public
Basic protective measures against the new coronavirus"

The Panel notes that Respondent is using the epidemic of COVID-19 to strengthen the false and misleading impression that the Disputed Domain Name is associated to or authorized by the Complainant, as fighting against diseases is one of the

Complainant's most important business activities.
The website associated to the Disputed Domain Name also provided online purchase options and asked for consumers' personal details including payment options
The Panel holds that the use of the Disputed Domain Name and the use of the website is infringing the Complainant's trademark rights and could potentially phish for users' data and lead to trademark tarnishment.

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

i. THE DISPUTED DOMAIN NAME WAS REGISTERED IN BAD FAITH

It should be highlighted that most of Complainant's trademark registrations predate the registration of the Disputed Domain Name and the Respondent has never been authorized by the Complainant to register the Disputed Domain Name. Considering the renown of the Complainant and its trademark NOVARTIS, and the overall composition of the Disputed Domain Name, i.e. using the term "Novartis" in connection with the term "pharmacies" which is closely related to the Complainant and its business activities, it follows that the combination of the well-known trademark NOVARTIS in the Disputed Domain Name is a deliberate and calculated attempt to improperly benefit from the Complainant's rights and reputation.

Considering the fact that:

• The Respondent very likely knew about the Complainant and its trademark;
• The Complainant's trademark NOVARTIS is a distinctive, well-known trademark worldwide and in Nigeria where the Respondent resides;
• The Respondent has failed in presenting a credible evidence-backed rationale for registering the Disputed Domain Name,

the Disputed Domain Name shall be deemed as registered in bad faith, which is supported by WIPO Overview 3.0, para. 3.1.1.:

"If on the other hand circumstances indicate that the respondent's intent in registering the disputed domain name was in fact to profit in some fashion from or otherwise exploit the complainant's trademark, panels will find bad faith on the part of the respondent. While panel assessment remains fact-specific, generally speaking such circumstances, alone or together, include: (i) the respondent's likely knowledge of the complainant's rights, (ii) the distinctiveness of the complainant's mark, … (vii) failure of a respondent to present a credible evidence-backed rationale for registering the domain name,…"

and para.3.1.4:

"Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith."

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

As noted in the previous paragraphs, the Disputed Domain Name has been used to resolve to an active website impersonating the Complainant, which is a clear evidence of bad faith use. See in Asendia Management v. Domain Admin, Privacy Protect, LLC (PrivacyProtect.org) / Jide Amoo, WIPO Case No. D2020-0489 where the panel states:

"UDRP panels have categorically held that registration and use of a domain name for illegal activity – including impersonation, passing off, and other types of fraud – is manifestly considered evidence of bad faith within paragraph 4(b)(iv) of the Policy."

And also refers to cases: Graybar Services Inc. v. Graybar Elec, Grayberinc Lawrenge, WIPO Case No. D2009-1017; seealso GEA Group Aktiengesellschaft v. J. D., WIPO Case No. D2014-0357.

Additionally, the Complainant has tried to reach the Respondent by sending a cease-and-desist letter on 15 April 2020 (Annex 10). As the Respondent has been using privacy service, the letter was sent to the privacy email pw-99901353490e0625a92b4925a98ac08b@privacyguardian.org. However, until the day when the Complainant prepared this Complainant on 18 Aug 2020, it has not received any response from the Respondent.

In terms of paragraph 4(b)(iv) of the Policy, the above facts demonstrate the Respondent's use of the Disputed Domain Name in bad faith. See "Dr. Martens" International Trading GmbH and "Dr. Maertens" Marketing GmbH v. Godaddy.com, Inc., WIPO Case No. D2017-0246:

"The panel must examine all the circumstances of the case to determine whether the respondent is acting in bad faith. Examples of what may be cumulative circumstances found to be indicative of bad faith include the complainant having a well-known trade mark, no response to the complaint having been filed, and the registrant's concealment of its identity'."

The fact that the Respondent has been using privacy service to conceal its identity while operating a commercial and trademark-abusive website further supports the finding of bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTISPHARMACIES.COM**: Transferred

PANELLISTS

Name	**Mr. E.J.V.T. van den Broek**

DATE OF PANEL DECISION 2020-09-16

Publish the Decision