Decision for dispute CAC-UDRP-103330

Case number	**CAC-UDRP-103330**
Time of filing	**2021-01-14 09:28:47**
Domain names	**novrtis.com**

Case administrator

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

Complainant

Organization	**Novartis AG**

Complainant representative

Organization	**BRANDIT GmbH**

Respondent

Organization	**Carolina Rodrigues/Fundacion Comercio Electronico, Domain Administrator/Fundacion Privacy Services LTD**

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.

IDENTIFICATION OF RIGHTS

The Complainant owns the following trade mark registrations in Panama that predate the registration of the disputed domain names:
• NOVARTIS, registration no. 80548, registered on 25 April 1996
• NOVARTIS, registration no. 253960, registered on 25 October 2016
The Complainant also owns numerous domain names composed of its trade mark NOVARTIS, including <novartis.com> created on 2 April 1996, and <novartis.net> created on 25 April 1998.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:
The Complainant was created in 1996 through a merger of two other companies, Ciba-Geigy and Sandoz. It is the holding company of the Novartis Group, which is one of the biggest global pharmaceutical and healthcare groups. The Complainant's products are manufactured and sold in many regions worldwide. The Complainant has an active presence in Panama, where the Respondent is located.

The Complainant is the owner of the trade mark NOVARTIS as a word and figure mark in several classes in numerous of countries all over the world, including in Panama. These trade mark registrations predate the registration of the disputed domain names.

The disputed domain names were registered as follows:
• <novrtis.com> on 4 December 2020
• <novartiseyemed.com> on 7 December 2020
• <novartisbenefits.com> on 4 January 2021

The Complainant sent the Respondent a cease-and-desist letter on 21 December 2020 but received no reply.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are identical or confusingly similar to a trade mark 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 names (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 names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

Preliminary issue: Domain names under common control
Under paragraph 3(c) of the UDRP Rules, a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.
The original complaint filed against the Respondent, Fundacion Privacy Services Ltd, involved the disputed domain names, <nortis.com> and <novartiseyemed>. Subsequently, the Complainant filed an amended complaint against the Respondents Carolina Rodrigues/Fundacion Comercio Electronico, Domain Administrator/Fundacion Privacy Services LTD, which included the third disputed domain name, <novartisbenefits.com>. The Complainant submits that the three disputed domain names are under common control and seeks to consolidate the complaint relating to all three.
The registrant of <novrtis.com> is Fundacion Privacy Services LTD, located in Panama with the e-mail address fundacionprivacy@protonmail.com. The registrant of <novartiseyemed.com> and <novartisbenefits.com> is Carolina Rodrigues/Fundacion Comercio Electronico, also located in Panama with e-mail address domains@owld.net.
The Complainant asserts that both e-mail addresses fundacionprivacy@protonmail.com and domains@owld.net belong to the same person, Carolina Rodrigues. It also submits that both <novrtis.com> and <novartiseyemed.com> have close IP addresses (192.187.111.221 and 192.187.111.220), the same name server (ns1.panamans.com) and same e-mail server (1 mail.h-email.net), and on 13 January 2021<novartisbenefits.com> also displayed the same name server and email. All three disputed domain names are listed for sale on the same platform, SEDO.
Fundacion Privacy Services Ltd, was shown as the registrant for all three disputed domain names. GoDaddy, the registrar for the disputed domain names <novartiseyemed> and <novartisbenefits.com> has confirmed that the Respondent, Fundacion Privacy Services LTD is the registrant of <novartiseyemed> and <novartisbenefits.com>, and that the registrant's name is Carolina Rodrigues. Media Elite Holdings, the registrar for the disputed domain name, <novrtis.com> and has confirmed that the Respondent, Fundacion Privacy Services LTD, is the registrant.
It appears from the evidence submitted by the Complainant that the three disputed domain names are controlled by the same person or entity. The e-mail addresses for the disputed domain names belong to the same person, Carolina Rodgrigues. The

disputed domain names, <novrtis.com> and <novartiseyemed.com> have close IP addresses, the same name server and the same e-mail server; and on 13 January 2021, <novartisbenefits.com> also displayed the same name server and e-mail server. All three disputed domain names were registered using the privacy service, Fundacion Privacy Services LTD, and are listed for sale on the same platform, SEDO. The Panel also notes that in, Target Brands, Inc. v. Carolina Rodrigues/Fundacion Comercio Electronico/Domain Administrator/Fundacion Privacy Services LTD, Forum Case No. FA1906001848345, the Respondents were treated as a single entity.
Taking all these factors into consideration, and the uncontested evidence submitted by the Complainant that the disputed domain names are under common control, the Panel will proceed to determine the complaint on the basis that all three disputed domain names are registered by the same domain name holder.
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

Paragraph 4 (a) of the Policy requires the Complainant to prove each of the following three elements:
(i) the disputed domain names are identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;
(ii) the Respondent has no rights or legitimate interests in the disputed domain names; and
(iii) the disputed domain names have been registered and used in bad faith.

A. IDENTICAL OR CONFUSINGLY SIMILAR

It is generally accepted that the addition of the top-level suffix, ".com" is a standard registration requirement and can be disregarded when assessing whether the disputed domain names are confusingly similar to the Complainant's trade mark, NOVARTIS.
The disputed domain names either uses a typo of the Complainant's well-known trade mark NOVARTIS, or combines the trade mark NOVARTIS with the words "eye med" or "benefits", which are closely related to the Complainant's business activities.
The omission of the letter "a" in NOVARTIS to make the disputed domain name <novrtis.com> does not prevent a finding that the disputed domain name is confusingly similar to the Complainant's trade mark, NOVARTIS. (See section 1.9 of the WIPO Jurisprudential Overview 3.0.).
The most distinctive part of the disputed domain names, <novartiseyemed.com> and <novartisbenefits.com>, is the word NOVARTIS. Adding the words "eye med" and "benefits" to the Complainant's trade mark NOVARTIS, does not prevent a finding that <novartiseyemed.com> and <novartisbenefits.com> are confusingly similar to the Complainant's trade mark, NOVARTIS. (See Hoffmann-La Roche Inc. v. Wei-Chun Hsia, WIPO Case No.D2008-0923.).
The Panel finds that the three disputed domain names are confusingly similar to the Complainant's mark NOVARTIS and that the requirements of paragraph 4(a)(i) of the Policy have been met.

B. NO RIGHTS OR LEGITIMATE INTEREST IN THE DISPUTED DOMAIN NAMES

The Complainant asserts that the Respondent has no rights or legitimate interest in the disputed domain names. Its well-known, distinctive trade mark, NOVARTIS, predates the registration of the disputed domain names. The Complainant says the Respondent has no relationship with the Complainant and no rights in the mark NOVARTIS. The Respondent is not commonly known by the disputed domain names and has not been using them for any bona fide offering of goods or services and has listed them for sale. It submits that the Respondent deliberately chose to incorporate the trade mark NOVARTIS in the disputed domain names with the intention to attract Internet traffic by benefiting from the Complainant's worldwide renown.
The Complainant has established a prima facie case that the Respondent has no rights or legitimate interest in the disputed domain names. The Respondent has not challenged the Complainant's assertions, nor submitted any evidence to show that it has rights or any legitimate interest in the disputed domain names.
The Panel finds that the Respondent has no right or legitimate interest in the disputed domain names and that the requirements of paragraph 4(a)(ii) of the Policy have been met.

C. THE DISPUTED DOMAIN NAMES WERE REGISTERED AND USED IN BAD FAITH

The Complainant owns trade mark registrations for NOVARTIS that predate the registration of the disputed domain names. The trade mark is distinctive and well-known, including in Panama where the Respondent resides. It is most likely that the Respondent knew of the Complainant and its trade marks when it registered the disputed domain names. The Respondent has

given no reason nor submitted any evidence of the rationale for registering the disputed domain names. The Panel notes that registration by an unaffiliated entity of a domain name that is confusingly similar to a well-known trade mark can by itself create a presumption of bad faith. (See section 3.1.4 of the WIPO Jurisprudential Overview 3.0).
The disputed domain names are confusingly similar the Complainant's well-known trade mark, NOVARTIS. There appears no reason for the Respondent to register the disputed domain names other than to improperly benefit from the Complainant's rights and reputation. The Respondent has been involved in numerous previous domain name disputes of similar conduct, has used a privacy service to hide its identity, has been using two of the disputed domain names to resolve to random third-party websites, has offered all three disputed domain names for sale, has failed to respond to the Complainant's cease and desist letter, and has not filed a response or submitted any evidence to dispute any of the Complainant's assertions.
Taking all these factors into consideration and the evidence submitted with the complaint, the Panel finds that the Respondent registered and subsequently used the disputed domain names in bad faith and that the requirements of paragraph 4(a)(iii) of the Policy have been met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVRTIS.COM**: Transferred
2. **NOVARTISEYEMED.COM**: Transferred
3. **NOVARTISBENEFITS.COM**: Transferred

PANELLISTS

Name	**Veronica Bailey**

DATE OF PANEL DECISION 2021-03-03

Publish the Decision