

Decision for dispute CAC-UDRP-103580

Case number	CAC-UDRP-103580
Time of filing	2021-04-19 10:16:59
Domain names	Verify-Novartis.com

Case administrator

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

Organization	Novartis AG
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Complainant representative

Organization	BRANDIT GmbH
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Respondent

Organization	Victor Iliyushkin
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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 name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the well-known trademark NOVARTIS registered as both a word and device mark in several classes worldwide. The Complainant has adduced evidence of those registrations which the Panel accepts, including registrations at the Federal Service for Intellectual Property of the Russian Federation where its trademarks include:

Trademark: NOVARTIS (combined)
Reg. no: 534451
Priority: 21 January 2013

Trademark: NOVARTIS (combined)
Reg. no: 526567
Priority: 6 August 2013

FACTUAL BACKGROUND

The Complainant is the famous Swiss pharmaceutical company that produces a broad range of products. It was created in 1996

through a merger of two other companies Ciba-Geigy and Sandoz, and is the holding company of the Novartis Group. It has extensive registrations of trademarks throughout the world and a range of domain names that it uses in its business. One of those domain names resolves to the website of Sandoz, which is now a Division of the Complainant, at www.sandoz.com.

It has come to the notice of the Complainant that the disputed domain name <verify-novartis.com> has been registered and is being used to support a website that purports to enable internet users to verify that pharmaceuticals are NOVARTIS products. The disputed domain name was registered on 25 February 2021 and the Respondent is the registrant. The Complainant maintains that the website to which the disputed domain name resolves includes material that has clearly been taken from the website at www.sandoz.com and is a serious infringement on its rights. That is so because the implication is that the disputed domain name is an official Novartis domain name, which it is not, and that it can be used with the approval of the Complainant to verify if products are NOVARTIS products, which it also untrue. The Complainant is concerned that the Respondent's domain name and website are injurious to public health and also that they are a totally unauthorised infringement on the Complainant's rights and good reputation.

The Complainant has therefore instituted this proceeding to have the disputed domain name transferred to itself.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

1. The Novartis Group is one of the world's biggest global pharmaceutical and healthcare groups and has a strong presence in Russia where the Respondent is located.
2. The Complainant is the owner of the well-known trademark NOVARTIS registered as both a word and device mark in several classes worldwide, including Russia.
3. The Complainant adduces in evidence extracts of its trademark registrations worldwide. The NOVARTIS trademark is well-known and has been recognised in prior UDRP proceedings.
4. The Complainant also owns numerous domain names used in its business that include the NOVARTIS trademark, including one in Russia, namely <novartis.ru> that resolves to its Russian website at <http://novartis.ru/>.
5. The disputed domain name, registered on 25 February 2021 is identical or confusingly similar to the NOVARTIS trademark.
6. That is so because it incorporates the Complainant's well-known, distinctive trademark NOVARTIS in its entirety in combination with the generic term "verify", separated by the symbol "-" none of which negates the confusing similarity with the trademark.
7. The Respondent has no rights or legitimate interests in the disputed domain name as it has no relationship with the Complainant and the Complainant has never granted the Respondent any rights to use the NOVARTIS trademark in any form, including in the disputed domain name.
8. The Respondent is not commonly known by the disputed domain name and nor does it have a legitimate interest in the domain name on any other ground.
9. Google search results all point to the Complainant and its business activities. Thus, the Respondent could easily have discovered before registering the disputed domain name that the Complainant had been using its NOVARTIS trademarks in Russia, where the Respondent resides.
10. In any event, the Respondent is named "Victor Iliyushkin", a name which is not connected to the Complainant nor to the term NOVARTIS in any form. The Respondent is therefore not commonly known by the disputed domain name.

11. The disputed domain name resolves to an active website displaying information copied from an official website of the Complainant's subsidiary company at www.sandoz.com.

12. The Respondent's website uses the Novartis logo and the term "Novartis-bio" as trademark in a prominent position. In the upper part of the Website, there is a sector of "product validation", where Internet users can enter a "security code" to "verify" a Novartis product. Such function could be used for phishing. The fact that such sector does not exist on the original official website of Sandoz further adds up to the probability of phishing.

13. Thus, the intention of the Respondent was to trade on the Complainant's worldwide renown and to confuse Internet users as to the source or sponsorship. Such impersonation of the Complainant's official website is blatant evidence of bad faith use and can never be considered as legitimate use or bona fide offering of goods/services.

14. The disputed domain name was registered and used in bad faith. It was registered in bad faith because most of the Complainant's NOVARTIS 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. It is thus clear that the disputed domain name is a deliberate and calculated attempt to benefit improperly from the Complainant's rights and reputation.

15. The Respondent very likely knew about the Complainant and its trademark when it registered the disputed domain name.

16. The Complainant's trademark NOVARTIS is a distinctive, well-known trademark worldwide and in Russia where the Respondent resides.

17. The Respondent has failed in presenting a credible evidence-backed rationale for registering the disputed domain name.

18. Therefore, the disputed domain name should be deemed as having been registered in bad faith.

19. The disputed domain name was also used in bad faith because it resolved to a website copied from another official website of the Complainant, www.sandoz.com. Sandoz is a division of the Complainant. In the upper part of the Respondent's website, there is a sector of "product validation", where Internet users can enter a "security code" to "verify" a Novartis product. Therefore, it appears that Respondent is using the disputed domain name to impersonate the Complainant and lead Internet users to believe that the Website is connected or operated by the Complainant. Moreover, requiring a "security code" is very likely an attempt to collect data of Internet users and possibly be used to carry out other malicious schemes. The disputed domain name has active MX records which means that it could be used to send out emails. According to such parameter, the risk of phishing is very high.

20. The circumstances of the present case, as described, therefore show that the Respondent registered and has used the disputed domain name primarily with the intention of attempting to attract, for commercial gain, Internet users to its potential website or other online locations, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of such website or location, or of a product or service on such website or location.

21. The Respondent has also been using a privacy shield to conceal its identity.

22. All of these circumstances show that the Respondent's conduct is in bad faith within the meaning of Paragraph 4(a)(iii) of the Policy.

RESPONDENT:

The Respondent did not file a Response in this proceeding.

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

This is a mandatory administrative proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP") of the Internet Corporation for Assigned Names and Numbers ("ICANN"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the CAC Supplemental Rules.

FIRST PRELIMINARY ISSUE: LANGUAGE OF THE PROCEEDING

In this proceeding, the Complainant requests that the Panel exercise its discretion to order that the language of the proceeding should be English, rather than Russian, which is the language of the registration agreement. The Complainant has set forward its reasons why the Panel should exercise its discretion in that way. The reasons advanced by the Complainant are:

- The disputed domain name resolves to an active website entirely in the English language. It demonstrates that the Respondent has a good understanding and knowledge of English and that the intention of the Respondent is to address its visitors in English, i.e. English speaking visitors;
- The Respondent chose to register the disputed domain name with the generic top level TLD .com. This shows that by registering the disputed domain name the Respondent is trying to target a broad audience, not limited to Russian speaking visitors;
- The disputed domain name is composed by the English term "verify" and the Complainant's name "Novartis", both being correctly spelt. It further demonstrates that the Respondent understands the English language;
- The Complainant is a Swiss-based company, having its website at <novartis.com> displayed in the English language. According to the Registrar Verification, the Respondent is located in Russia. The English language, being commonly used internationally, would thus be considered as neutral for both parties in the present case (see Intesa Sanpaolo S.p.A. v. Ida Ekkert, CAC Case No. 102263);
- Moreover, a translation of the Complaint to Russian would entail significant additional costs for the Complainant and delay in the proceedings.

The Panel has considered that submission and examined the evidence in support.

Having done so, the Panel has concluded that it is appropriate that it should exercise its discretion in the manner requested. Accordingly, pursuant to Paragraph 11 of the UDRP Rules, the Panel determines that the language of the proceeding shall be English.

SECOND PRELIMINARY ISSUE: ADMINISTRATIVE DEFICIENCY

By notification dated April 22, 2021 and in accordance with paragraph 4 (b) of the Rules, the CAC notified the Complainant that the Complaint was administratively deficient in that:

1. It had not sufficiently identified the Respondent. The CAC invited the Complainant to review the Registrar's Verification available in the online case file in the form of a Nonstandard Communication regarding the appropriate identification of the domain name holder.
2. The CAC also invited the Complainant to note that it enclosed no annexes to its Complaint.
3. The CAC also noted that it had been informed by the Registrar that the language of the Registration Agreement was Russian and it invited the Complainant to see the Registrar's Verification to that effect.

On April 26, 2021, the Complainant filed an Amended Complaint and on April 27 the CAC determined that the Complaint should be admitted to proceed further in the Administrative Proceeding.

The Panel has reviewed all of the above matters and makes a finding that within the meaning of paragraph 4(b) of the Rules, the administrative deficiencies have been corrected and that this matter has proceeded properly to the Panel in accordance with the Policy and the Rules.

SUBSTANTIVE MATTERS

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable. In that regard, the Panel also notes that the onus is on the complainant to make out its case and past UDRP panels have consistently said that a complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

The Panel therefore turns to discuss the various issues that arise for decision on the facts as they are known.

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

- (i) The 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 domain name; and
- (iii) The domain name has been registered and is being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.

IDENTICAL OR CONFUSINGLY SIMILAR

The Panel finds that the disputed domain name is confusingly similar to the Complainant's NOVARTIS trademark as it incorporates the Complainant's well-known, distinctive trademark NOVARTIS in its entirety in the disputed domain name and that fact gives rise to the presumption that an internet user would think that the disputed domain name related in some way to

the Complainant, which it does not.

Secondly, the disputed domain name includes the generic word "verify" which implies that the purpose of the domain name and any website to which it might lead deals in an official way with the verification of products sold under the NOVARTIS mark to ascertain if they are genuine NOVARTIS goods.

Thirdly, the disputed domain name includes the symbol "-" and the generic top level domain .com. It is also now well established that the addition of such a symbol and a generic top level domain, such as ".com" in the present case, cannot negate confusing similarity that is otherwise present, as it is in the present case.

Accordingly, the domain name is confusingly similar to the Complainant's trademark and the Complainant has thus shown the first of the three elements that it must establish.

RIGHTS AND LEGITIMATE INTERESTS

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

But by virtue of paragraph 4(c) of the Policy, it is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [respondent] of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) you [respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you [respondent] are making a legitimate non commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Thus, if a respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the domain name, the complainant will have failed to discharge its onus and the complaint will fail.

It is also well-established that a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests and that when such a prima facie case is made out, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent cannot do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Panel, after considering all of the evidence in the Complaint, finds that the Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name.

That prima facie case is made out from the following considerations.

The evidence of the Complainant is to the effect that the Respondent is not related in any way to the Complainant's business, is not affiliated with the Complainant or authorized by it in any way to use the NOVARTIS trademark and does not carry out any activity for, nor has any business with, the Complainant. It is also clear from the evidence that the Respondent is not commonly known by the disputed domain name under Policy 4(c)(ii).

The Panel also agrees with the Complainant that as Google search results all point to the Complainant and its business

activities, the Respondent could easily have discovered before registering the disputed domain name that the Complainant had been using its trademarks in Russia, where the Respondent resides.

Also, the Respondent's name is Victor Iliyushkin, which is a name not connected to the Complainant nor to the word NOVARTIS in any form. Therefore the Respondent is not commonly known by the disputed domain name.

The Panel notes and agrees with the Complainant that the disputed domain name resolves to an active website displaying information copied from another official website of the Complainant's, www.sandoz.com. The Panel has looked at the evidence in support of this proposition and agrees with the conclusion reached by the Complainant that the Respondent must have known of the Complainant and its NOVARTIS trademark before registration of the disputed domain name.

The website to which the domain name resolves uses the Novartis logo and the term "Novartis-bio" as a trademark in a prominent position. The Complainant notes that on the upper part of the website, there is a sector marked "product validation", where Internet users can enter a so called "security code" to "verify" a Novartis product. Such a function could be used for phishing and the fact that such sector does not exist on the original official website of Sandoz, further adds up to the probability of phishing by the Respondent.

Thus, the submission of the Complainant that these facts show that the intention of the Respondent was to trade on the Complainant's worldwide renown and to confuse Internet users as to the source or sponsorship of the website, is one with which the Panel agrees. Such an impersonation of the Complainant's official website is, as the Complainant submits, blatant evidence of bad faith use and can never be considered as legitimate use or bona fide offering of goods or services.

The Respondent has not filed a Response or shown in any other way that it can rebut the prima facie case made out against it and accordingly the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has therefore made out the second of the three elements that it must establish.

REGISTERED AND USED IN BAD FAITH

The Complainant must prove on the balance of probabilities both that the disputed domain name was registered in bad faith and that it is being used in bad faith: *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003.

Paragraph 4(b) of the Policy sets out four circumstances, any one of which is evidence of the registration and use of a domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive. The four specified circumstances are:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the 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 domain name; or

(ii) the respondent has registered the 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 domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's website 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 website or location or of a product or service on the site or location.

The Panel finds that the Complainant has shown that the Respondent registered and used the disputed domain name in bad faith both in general and in particular because the Respondent's conduct puts the case squarely within several of the above mentioned specific criteria of bad faith.

The Panel agrees with the Complainant that the disputed domain name was registered in bad faith because most of the Complainant's NOVARTIS 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. It is thus clear, as the Complainant submits, that the disputed domain name is a deliberate and calculated attempt to benefit improperly from the Complainant's rights and reputation.

Thus, the Panel draws the inference that the Respondent knew about the Complainant and its trademark when it registered the disputed domain name. That is so for the following reasons.

The Complainant's trademark NOVARTIS is a distinctive, well-known trademark worldwide and in Russia where the Respondent resides.

The Respondent has failed in presenting a credible evidence-backed rationale for registering the disputed domain name. The only reason why the Respondent would have registered the disputed domain name must have been to trade on the Complainant's good name and reputation, mislead internet users and benefit the Respondent itself and in all probability by engaging in improper and illegal activities which the evidence shows it has done.

Therefore, the Complainant submits and the Panel agrees, the disputed domain name should be deemed as having been registered in bad faith.

The Panel also finds that the Respondent has used the disputed domain name in bad faith. In that regard the Panel agrees with the submissions of the Complainant that:

(a) it is clear from the evidence that the disputed domain name was used in bad faith because it resolved to a website copied from another official website of the Complainant, www.sandoz.com. In the upper part of that Website, there is a sector marked "product validation", where Internet users can enter a "security code" to "verify" a Novartis product. Therefore, it appears that Respondent is using the disputed domain name to impersonate the Complainant and lead Internet users to believe that the Website is connected or operated by the Complainant. Moreover, requiring a "security code" is very likely an attempt to collect data of Internet users and possibly be used to carry out other malicious schemes;

(b) The disputed domain name also has active MX records which means that it could be used to send out e-mails and according to such a parameter, the risk of phishing is very high;

(c) The circumstances of the present case, as described, show that the Respondent registered and has used the disputed domain name primarily with the intention of attempting to attract, for commercial gain, Internet users to its potential website or other online locations, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of such website or location, or of a product or service on such website or location. The Respondent clearly wants the internet user to conclude that the disputed domain name and the website are official NOVARTIS activities or that they are approved by NOVARTIS which they are not. Therefore the disputed domain name and the website are in bad faith.

The Respondent has also been using a privacy shield to conceal its identity.

All of these circumstances show that the Respondent's conduct is in bad faith within the meaning of Paragraph 4(a)(iii) of the Policy.

The Complainant has therefore shown both registration and use in bad faith and has thus made out the third of the three elements that it must establish.

Accordingly, the Complainant has shown all three elements and is entitled to the relief it seeks.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	The Hon. Neil Brown, QC
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DATE OF PANEL DECISION	2021-05-29
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Publish the Decision