

Decision for dispute CAC-UDRP-103967

Case number CAC-UDRP-103967

Time of filing 2021-08-30 11:40:07

Domain names novartipharm.com

Case administrator

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

Complainant

Organization Novartis AG

Complainant representative

Organization BRANDIT GmbH

Respondent

Name Elizabeth Naseef

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

Complainant's trademark registrations in the USA applying to the present proceedings include the following earlier rights:

Trademark: NOVARTIS
Reg. no: 5420583
Reg. date: 13 March 2018

Trademark: NOVARTIS
Reg. no: 2997235
Reg. date: 20 September 2005
First use in commerce: 1997

FACTUAL BACKGROUND

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

I. LANGUAGE OF PROCEEDINGS REQUEST:

To the best of Complainant's knowledge, the language of the Registration Agreement of the disputed domain name <Novartipharm.com> is English according to the Registrar Verification.

In accordance with Paragraph 11 of the UDRP Rules, unless otherwise agreed by the parties, the language of the proceedings is the language of the registration agreement. The Complainant therefore requested the language of the proceedings to be English.

II. ABOUT COMPLAINANT AND THE BRAND NOVARTIS

The Novartis Group is one of the biggest global pharmaceutical and healthcare groups. It provides solutions to address the evolving needs of patients worldwide by developing and delivering innovative medical treatments and drugs. Novartis AG (the "Complainant"), created in 1996 through a merger of two other companies Ciba-Geigy and Sandoz, is the holding company of the Novartis Group.

The Complainant's products are manufactured and sold in many regions worldwide. The Complainant has especially a strong presence in the United States of America (the "USA") where the Respondent is located. The Complainant has numerous subsidiaries and associated companies based in the USA. Moreover, in 2019, 34% of Novartis Group's total net sales were constituted in the USA.

The Complainant is the owner of the well-known trademark NOVARTIS registered as both a word and device mark in several classes worldwide, including the USA. The vast majority of the Complainant's trademark registrations significantly predates the registration of the disputed domain name.

Moreover, previous UDRP panels have stated that the NOVARTIS trademark is well-known (inter alia Novartis AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org, / Sergei Lir, WIPO Case No. D2016-1688).

The Complainant owns numerous domain names composed of either its trademark NOVARTIS alone, including <novartis.us> (created on 19 April 2002) and <novartis.com> (created on 2 April 1996) or in combination with other terms, e.g. <novartispharma.com> (created on 27 October 1999) (page 1-17, Annex 4). The Complainant uses these domain names to promote the NOVARTIS mark with related products and services.

The Complainant enjoys a strong presence online also via its official social media platforms.

LEGAL GROUNDS:

A. THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR

The disputed domain name <Novartipharm.com> (hereinafter referred to as the "Disputed Domain Name"), which was registered on 5 July 2021 according to the WHOIS, incorporates a typo of the Complainant's well-known, distinctive trademark NOVARTIS by merely removing the last letter "s", in combination with a generic term "pharm", which is closely related to the Complainant's business activities. The addition of the gTLD ".com" does not add any distinctiveness to the Disputed Domain Name. See as an example the 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."

B. RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN RESPECT 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.

The Complainant has not found that the Respondent is commonly known by the Disputed Domain Name or that it has legitimate interest over the Disputed Domain Name. When searched for the term “novartipharm” in the Google search engine, the returned results all suggested or pointed to the Complainant and its business activities; exact match for “novartipharm” only returned few results relating to the registration of the Disputed Domain Name.

The Respondent could have easily performed a similar search before registering the Disputed Domain Name and would have quickly learnt that the trademarks are owned by the Complainant and that the Complainant has been using its trademarks in the USA, where the Respondent resides, and many other countries worldwide. However, the Respondent still chose to register the Disputed Domain Name as such.

In addition, according to the Registrar Verification, the Respondent is an individual named “Elizabeth Naseef”, which is in no way connected to the Complainant nor to the term “Novartis” “Novarti” in any form.

By the time the Complainant prepared this amended Complaint on 2 September 2021, the Disputed Domain Name did not resolve to active website.

The Respondent has not been using the Disputed Domain Name for any bona fide offering of goods or services.

When Internet users, who search for information about the Complainant and/or about the brand “Novartis”, see the Disputed Domain Name and the inactive website, would very likely be confused and be led to believe that the Disputed Domain Name is somehow related to the Complainant and be disappointed as they would not find the information as expected – which will lead to trademark tarnishment for the Complainant.

From the Complainant’s perspective, the Respondent deliberately chose to incorporate a sign that is confusingly similar to the well-known, distinctive trademark NOVARTIS in the Disputed Domain Name, very likely with the intention to attract Internet traffic by benefiting from the Complainant’s worldwide renown.

For the foregoing reasons, it shall be concluded that the Respondent has no right nor legitimate interest in respect of the Disputed Domain Name and has not been using the Disputed Domain Name for any bona fide offering of goods or services.

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 highlights 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 a typo of the Complainant’s well-known, distinctive trademark NOVARTIS by merely removing the last letter “s”, in combination with a generic term “pharm”, which is closely related to the Complainant’s business activities., it follows that incorporating a typo 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.

Additionally, considering the facts that:

Additionally, Complainant submits following contentions:

- The Respondent very likely knew about the Complainant and its trademark when it registered the Disputed Domain Name;
- The Complainant's trademark NOVARTIS is a distinctive, well-known trademark worldwide and in the USA 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

Firstly, as noted in the previous paragraphs, the Disputed Domain Name did not resolve to active website which constitutes passive holding. In the WIPO Case No. D2000-0003 Telstra Corporation Limited v. Nuclear Marshmallows the Panel established that the registration and passive holding of a domain name which has no other legitimate use and clearly refers to the Complainant's trademark may constitute registration and use in bad faith.

Additionally, the Complainant tried to reach the Respondent by a cease-and-desist letter sent on 14 July 2021 to e-mail address e5525ac75e414f708ce84341e5d5494b.protect@withheldforprivacy.com, as provided in the WHOIS. However, until the time the Complainant prepared the Complaint, it has not received 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 Domain Name was not resolving to an active website at the time of filing. However, the consensus view amongst WIPO panellists is that 'the apparent lack of so-called active use (e.g., to resolve to a website) of the domain name without any active attempt to sell or to contact the trade mark holder (passive holding), does not as such prevent a finding of bad faith. 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'."

In addition, the fact that the Respondent has been using privacy shield service to conceal its identity adds up to the finding of 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). Complainant's trademark registrations in the USA applying to the present proceedings include the following earlier rights:

Trademark: NOVARTIS
Reg. no: 5420583
Reg. date: 13 March 2018

Trademark: NOVARTIS
Reg. no: 2997235
Reg. date: 20 Sep 2005
First use in commerce: 1997

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). 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. The Respondent has not been using the Disputed Domain Name for any bona fide offering of goods or services.

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). The Respondent deliberately chose to incorporate a sign that is confusingly similar to the well-known, distinctive trademark NOVARTIS in the Disputed Domain Name, very likely with the intention to attract Internet traffic by benefiting from the Complainant's worldwide renown. The overall composition of the Disputed Domain Name, i.e. using a typo of the Complainant's well-known, distinctive trademark NOVARTIS by merely removing the last letter "s", in combination with a generic term "pharm", which is closely related to the Complainant's business activities., it follows that incorporating a typo 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

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

- NOVARTIS is a well-known, distinctive trademark.
 - Complainant's trademarks registration predates the registration of the Disputed Domain Name.
 - Respondent has no rights in the mark NOVARTIS, bears no relationship to the Complainant, and is not commonly known by the Disputed Domain Name – accordingly it has no legitimate interest in the Disputed Domain Name.
 - It is highly unlikely that Respondent was not aware of Complainant's prior rights in the trademark NOVARTIS at the time of registering the Disputed Domain Name, given the Complainant's worldwide renown.
-

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTIPHARM.COM**: Transferred
-

PANELLISTS

Name	Mike Rodenbaugh
------	------------------------

DATE OF PANEL DECISION **2021-10-04**

Publish the Decision
