

Decision for dispute CAC-UDRP-104088

Case number CAC-UDRP-104088

Time of filing 2021-10-21 09:05:30

Domain names Novartsmedical.com

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization Novartis AG

Complainant representative

Organization BRANDIT GmbH

Respondent

Organization Tech4A

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, including:

International Trademark Registration NOVARTIS, registration number IR666218, registered on 31 October 1996 for services in classes 41 and 42;

International Trademark Registration NOVARTIS, registration number IR663765, registered on 1 July 1996 for goods and service in the following classes: 01; 02; 03; 04; 05; 07; 08; 09; 10; 14; 16; 17; 20; 22; 28; 29; 30; 31; 32; 40; 42

Additionally, the Complainant enjoys a strong Internet and social media presence with websites including one on the Pakistan country code Top Level Domain < <https://www.novartis.pk> >.

FACTUAL BACKGROUND

The disputed domain name <novartsmedical.com> was registered on 28 July 2021 and resolves to a website which, while it

is unfinished, purports to create the impression that it is in some way associated with the Complainant as described below.

There is no information available about the Respondent who has used a privacy service to conceal his identity on the published WhoIs, except for the information provided in the Complaint, the Registrar's WhoIs, and the information provided by the registrar in response to the request by the Centre for verification of the registration details of the disputed domain name for the purpose of this proceeding. The Registrar confirmed that the Respondent, with an address in Pakistan, is the registrant of the disputed domain name.

The evidence adduced in the Complaint includes copy correspondence between the Complainant and the Respondent in which the Respondent claims to be computer programmer who registered the disputed domain name for a client. For reasons given below this claim is not credible and on the balance of probabilities the Respondent registered and is using the disputed domain name on his own account.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant claims rights in the NOVARTIS trademark and service mark acquired through its international portfolio of trademark registrations described above and extensive use of the mark in pharmaceutical and healthcare business.

The Complainant alleges that the disputed domain name <novartsmedical.com> is confusingly similar to its NOVARTIS mark because, the element "novarts" is almost identical to the Complainant's mark, appearing to be a typo merely removing the letter "i", and the term "medical" is closely related to the Complainant and its business activities.

The Complainant adds that the generic Top-Level Domain ("gTLD") <.com> extension does not add any distinctiveness to the disputed domain name. See the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0"), paragraph 1.11. and 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 Complainant alleges that the Respondent has no rights or legitimate interests in the disputed domain name arguing that there is no evidence that the Respondent is known by the disputed domain name. According to the Registrar's verification of the registration details for the disputed domain name, provided in the course of this proceeding, the Respondent is an organization named Tech4A, with contact person named Majid Sheikh, which is not related to the Complainant nor to the term "Novartis" in any way.

Furthermore, the Complainant, referring to search results which are submitted in an annex to the Complaint, adds that when entering the term "novartsmedical" in the Google search engine, most of the returned results pointed to the Complainant and its business activities and not to the Respondent.

The Complainant asserts that it has never granted the Respondent any right to use its NOVARTIS trademark within the disputed domain name, nor is the Respondent affiliated with the Complainant in any way.

When the disputed domain name was registered on 6 August 2021, it came to the Complainant's attention. The Respondent refers to a screen capture of the website to which the disputed domain name resolves which is adduced in evidence as an annex to the Complaint, and submits that the screenshot shows that the disputed domain name resolves to an active website that promotes surgical instruments. The Complainant states that the website is not yet finalized and some of the contents remain in mock texts, for example the text right below the subject "Take Care of You Health" is a made-up / default text. The screen capture furthermore shows that the Respondent is using a logo which was composed of the Rod of Asclepius, the symbol for medicine, and the term "Novartis Medical" which incorporates the Complainant's well-known, distinctive trademark NOVARTIS in its entirety in the upper-centre position on screen.

The Complainant further refers to correspondence with the Respondent, and in an annex to the Complaint, it has adduced a copy of a cease-and-desist letter that it sent to the Respondent's email <novartismedical.com@superprivacyservice.com> (as provided in the WHOIS) on 6 August 2021.

The cease and desist letter notified the Respondent about the Complainant's prior rights and requested a voluntary transfer. The correspondence shows that the Respondent replied on the same day, saying: "My name is Majid and I'm computer programmer(sic) I registered that domain for my client it's really embarrassing when I know it's someone's trademark. I haven't experience (sic) this before will you please help me to close this case. I informed the customer and he agreed to change the domain name."

The Complainant alleges that this is however, incorrect because the Respondent has previously been involved in a domain name dispute filed by the Complainant and its trademark NOVARTIS, see Novartis AG v. Majid Sheikh, Tech4A, WIPO Case No. DCO2021-0055, where the Respondent registered a domain name novartismedical.co. The Complainant asserts that the Respondent has already been sufficiently informed about the Complainant's prior rights by both the cease-and-desist letter sent to it by that time and the panel decision which clearly stated why and how he did not have rights or legitimate interest in that domain name, and that its registration and use of that domain name was in bad faith.

Although the Complainant was of the view that the Respondent clearly knew about the Complainant and its trademark before it registered the disputed domain name on 6 August 2021 it nonetheless replied and requested a voluntary transfer in order to close the case, as requested by the Respondent. Further, the Complainant expressed its willingness to compensate the out-of-pocket expenses of the Respondent. The Respondent replied on 15 September 2021 and rejected the offer and instead, asked for a price of USD \$500 to transfer the disputed domain name.

It is contended that such price significantly exceeds the registration costs of a <.com > domain name at the registrar Dynadot, which is 10.99 USD as shown in a screen capture of the Registrar's published pricing rates which is exhibited in an annex to the Complaint.

It is further argued that at the time the Complainant prepared this amended Complaint on 26 October 2021, the disputed domain name still resolved to the Respondent's website, text still at default setting, and only the logo has been slightly modified from "Novartis Medical" to "Novarts Medical". This is evidenced by a screenshot provided in an annex to the Complaint.

The Complainant submits that the evidence proves that the Respondent obviously intends to make a commercial gain from the registration and sale of the disputed domain name which does not create any right or legitimate interest in the disputed domain name nor is the disputed domain name being used to provide any bona fide offering of goods or services. The Complainant then alleges that the disputed domain name was registered in bad faith arguing that the Respondent 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, including Pakistan where the Respondent resides; the Respondent has been involved in previous domain name dispute regarding a very similar domain name <novartismedical.co> that applied a similar pattern of infringement; the Respondent has failed in presenting a credible evidence-backed rationale for registering the disputed domain name.

The Complainant concludes by alleging that the disputed domain name is being used in bad faith submitting that it resolved to an active website promoting surgical instrument, using a logo in prominent position which was composed by a symbol for medicine, namely the Rod of Asclepius and the term "Novartis Medical", when the Complainant checked the disputed domain name again on 26 October 2021 the Respondent has modified the logo from "Novartis Medical" to "Novarts Medical". The Complainant submits that this it does not alter the fact that the Respondent had been deliberately using the trademark NOVARTIS in its logo in combination with the term "medical", and that this modified logo is still confusingly similar to the Complainant's NOVARTIS trademark and it shows that the Respondent is using the disputed domain name to resolve to an active website using a logo which is confusingly similar to the Complainant's trademark NOVARTIS, deliberately intending to mislead Internet users to believe that the Respondent's website is connected or operated by the Complainant.

The Complainant furthermore submits that the Respondent offered the disputed domain name for sale to the Complainant at the price of 500 USD, which significantly exceeds its out-of-pocket registration expenses; that the Respondent which also constitutes bad faith use.

In conclusion the Complainant submits that the circumstances, as described above, 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 his website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his website.

RESPONDENT:

No administratively complaint 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

The Complainant has provided clear, convincing and uncontested evidence that it has rights in the NOVARTIS trademark established by its ownership of the registrations described above and extensive use of the mark in its medical supplied business across the world including Pakistan where the Respondent purports to reside.

The disputed domain name <novartsmedical.com> consists of a misspelling of the Complainant's NOVARTIS trademark in combination with the word "medical" and the gTLD <.com> extension.

The element "novarts" is the initial, dominant and only distinctive element in the disputed domain name. It is clearly a misspelling of the distinctive trademark NOVARTIS.

Neither the element "medical" nor the gTLD have any distinguishing character.

This Panel finds therefore that the disputed domain name is confusingly similar to the NOVARTIS mark in which the Complainant has rights and the Complainant has therefore succeeded in the first element of the test in paragraph 4(a)(i) of the Policy.

The Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name arguing that:

- there is no evidence that the Respondent is known by the disputed domain name.;
- according to the Registrar's verification of the registration details for the disputed domain name, provided in the course of

this proceeding, the Respondent is an organization named Tech4A, with contact person named Majid Sheikh, which is not related to the Complainant nor to the term "Novartis" in any way;

- when entering the term "novartsmedical" in the Google search engine, most of the returned results pointed to the Complainant and its business activities and not to the Respondent;
- the Complainant has never granted the Respondent any right to use its NOVARTIS trademark within the disputed domain name, nor is the Respondent affiliated with the Complainant in any way;
- the screen capture of the website to which the disputed domain name resolves which is adduced in evidence as an annex to the Complaint shows that the disputed domain name resolves to an active but unfinished website that promotes surgical instruments and the content uses the Complainant's mark and a logo which was composed of the Rod of Asclepius, the symbol for medicine;
- that the Respondent changed the use of the Complainant's mark to a confusingly similar misspelling of same on the website;
- the Respondent has previously been involved in a domain name dispute filed by the Complainant and its trademark NOVARTIS, see *Novartis AG v. Majid Sheikh, Tech4A, WIPO Case No. DCO2021-0055*, where the Respondent registered a domain name *novartismedical.co*;
- when the Complainant expressed its willingness to compensate the out-of-pocket expenses of the Respondent. The Respondent replied on 15 September 2021 and rejected the offer and instead, asked for a price of USD \$500 to transfer the disputed domain name which significantly exceeds the registration costs of a .com domain name at the registrar Dynadot, which is 10.99 USD as shown in the evidence.

It is well established that once a Complainant makes out a prima facie case that the respondent has no rights or legitimate interests in a disputed domain name the burden of production shifts to the respondent to establish such rights or interests.

The Respondent has failed to discharge that burden and this Panel must therefore find that the Respondent has no rights or legitimate interests in the disputed domain name The Complainant has therefore succeeded in the second element of the test in paragraph 4(a)(ii) of the Policy

Complainant's trademarks registration predates the registration of the disputed domain name. NOVARTIS is a distinctive trademark and the evidence adduced shows that is well-known worldwide including in Pakistan where the Respondent purports to reside. It is hardly a coincidence that the Respondent chose to register <novartismedical.co> and the disputed domain name <novartsmedical.com>, each of which includes the word "medical" which is a reference to the Complainant's core business.

The evidence shows that the Respondent has previously been an unsuccessful respondent in the see *Novartis AG v. Majid Sheikh, Tech4A, WIPO Case No. DCO2021-0055*, relating to the domain name <novartismedical.co> in that case the domain name at issue was registered on June 1, 2021, the complaint was filed on July 5, 2021, and the decision of the WIPO panel was published on September 14, 2021. In the present case under consideration, the disputed domain name <novartsmedical.com> was registered on 28 July 2021. The Respondent was therefore well aware of the Complainant and its rights in the NOVARTIS mark when the disputed domain name was registered.

It is significant that the Respondent did not reply to the Complainant's contentions in said *Novartis AG v. Majid Sheikh, Tech4A, WIPO Case No. DCO2021-0055*.

This Panel finds therefore that on the balance of probabilities the disputed domain name was chosen and registered in bad faith with Complainant's mark in mind in an act of typosquatting, with the intention of taking predatory advantage of Complainant's name, mark, reputation and goodwill.

The evidence further shows that the Respondent has caused the disputed domain name to resolve to a website, which displayed the Complainant's name and mark, and was then changed to display a confusingly similar mark, The Respondent's website is unfinished with little effort put into its design and includes "lorem ipsum" placeholder text , and in the circumstances outlined in the Amended Complaint, this Panel finds the evidence adduced by the Complainant on the balance of probabilities the Respondent has no intention of investing in or finishing the website.

The email correspondence between the Complainant and the Respondent, clearly indicates that the Respondent is disingenuous. It is most improbable that he was unaware of the Complainant and its rights when the disputed domain name was registered. In fact, the evidence proves that he was defending a very similar complaint at the time.

It is most improbable that he registered the disputed domain name for a client as he claims.

The email correspondence shows that in response to this Complaint he stated "My name is Majid and I'm computer programmer (sic) I registered that domain for my client it's really embarrassing when I know it's someone's trademark. I haven't experience (sic) this before will you please help me to close this case. I informed the customer and he agreed to change the domain name."

He also added however "I also loss some money because of this.". This Panel has considered whether the request for payment of USD\$ 500 constituted use in bad faith. The Complainant certainly made the first offer to pay reasonable expenses, however that followed on the Respondent's statement that he was at a loss of money, which was a clear reference to a request for payment for the transfer of the disputed domain name.

This Panel finds therefore that the Respondent 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 NOVARTIS trademark or service mark for valuable consideration in excess of his documented out-of-pocket costs directly related to the disputed domain name which constitutes use in bad faith for the purposes of the Policy.

As this Panel has found that the disputed domain name was registered and is being used in bad faith, the Complainant has succeeded in the third and final element of the test in the third element of the test in paragraph 4(a)(iii) of the Policy and entitled to succeed in this Complaint.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTSMEDICAL.COM**: Transferred

PANELLISTS

Name	Mr James Jude Bridgeman
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DATE OF PANEL DECISION 2021-11-28

Publish the Decision
