

## Decision for dispute CAC-UDRP-104102

Case number **CAC-UDRP-104102**

Time of filing **2021-10-26 09:23:37**

Domain names **novartis.guru, novartis.media, novartis.ninja, novartis.press, novartis.services, novartis.team, novartis.technology, novartis.today**

### Case administrator

Organization **Denisa Bilík (CAC) (Case admin)**

### Complainant

Organization **Novartis AG**

### Complainant representative

Organization **MSA IP - Milojevic Sekulic & Associates**

### Respondent

Name **Marc Jennens**

#### 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

Australian Trade Mark Registration No. 712454 NOVARTIS in various classes including in relation to various pharmaceutical preparations and medical goods.

#### FACTUAL BACKGROUND

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

The Complainant was created in 1996 through a merger of Ciba-Geigy and Sandoz. The Complainant and its predecessor companies trace their roots back more than 250 years. Today, the Complainant operates an international pharmaceutical business based in Switzerland that provides healthcare solutions worldwide.

The Complainant's global pharmaceuticals portfolio of products includes more than 50 key marketed products in many therapeutic areas, such as cardiometabolic indications, dermatology, immunology, neuroscience, oncology, ophthalmology and pulmonology. The Complainant's products are available in more than 155 countries around the world and they have reached

769 million patients globally.

In 2020, the Complainant achieved net sales from continuing operations of USD 48.7 billion, while operating income from continuing operations amounted to USD 10.2 billion and total net income to USD 8.1 billion. Companies from the Novartis Group employ more than 110,000 full-time equivalent associates as of December 31, 2020. With net sales of USD 48.7 billion, the Complainant has been rated 4th on the list of pharmaceutical companies with the highest revenue in 2020 by the Pharmaceutical Technology magazine.

The complex corporate structure of Novartis Group includes two major divisions - Innovative Medicines, and Sandoz, which are supported by functional organizations on a global scale. The Innovative Medicines division commercializes innovative patented medicines to enhance health outcomes for patients and healthcare professionals, and is made up of two business units – Novartis Pharmaceuticals which includes Novartis Gene Therapies, and Novartis Oncology. Sandoz division is the global leader in generic pharmaceuticals and biosimilars that pioneers novel approaches to help people around the world access high-quality medicines.

The Complainant is the owner of numerous trade marks in numerous jurisdictions that contain or consist of the word NOVARTIS. These include the Australian registered trade mark list above, which has a priority date of February 15, 1996.

The disputed domain names were all registered with the Registrar, Go Daddy, in early 2021. They were all registered using a privacy service to attempt to hide the identity of the Respondent.

According to subsequent disclosure from the Registrar for the disputed domain names on 26 October 2021 the Respondent is Marc Jennens of Hamersley in Western Australia.

Mr Jennens has not submitted in response in this proceeding however evidence of correspondence between him and the Complainant's representative has been filed.

In April 2021, the Complainant became aware of the registration of one of the disputed domain names, namely <novartis.guru>.

The Complainant attempted to prevent any potential abuse related to this disputed domain name <novartis.guru> by sending a short communication to the Respondent on April 7, 2021, alleging violation of its trademark rights. The communication was sent via the domain name Registrar as the domain name is under a privacy shield.

The following day, on April 8, 2021, an email was received from the Respondent in which he claimed to be the domain name owner and requested further clarification regarding the issue. The Complainant thereafter sent a cease-and-desist letter to the Respondent on April 14, 2021, through its representatives, in which it instructed the Respondent to cease use of the domain name <novartis.guru> and to transfer it to the Complainant, as well as to desist from registering or using any domain names or brands, trademarks, company/trade names conflicting with, or infringing on, the Complainant's intellectual property rights.

A response was received from the Respondent on May 10, 2021, in which he advised that as a result of the cease-and-desist letter sent on behalf of the Complainant, he had "(...) bought a few more extensions with the word "Novartis in it" (...)" (sic); adding that:

"I have no use for these web domains rather than to piss this company off that works by allowing people to buy web domains and then threatening legal action like a bunch of muppets. I had fun with them for a while but now they won't respond. I called checkmate."

A search conducted by the Complainant confirmed that the domain names <novartis.media>, <novartis.ninja>, <novartis.press>, <novartis.services>, <novartis.team>, <novartis.technology>, and <novartis.today> had subsequently been registered, as indicated by the Respondent. All eight domain names redirect to the website of an online store by the name of "The Emporium Wonderstore" at the domain name <wonderstore.com.au>. At the time of filing the Complaint the website appeared to be under construction as no products are listed on it, while the homepage states that it is, "opening soon".

However, the website did invite visitors to create an account and list their name, email address and phone number. Further the domain name <wonderstore.com.au> is registered by the Respondent.

Before the present re-directions to the domain name <wonderstore.com.au>, all the disputed domain names were redirecting to an adult website and thereafter to the official website of Pfizer Australia (i.e. the Complainant's direct competitor) at various points in time.

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#### PARTIES CONTENTIONS

#### NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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#### RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 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

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 lists three elements that the Complainant must prove to merit a finding that the disputed domain names registered by the Respondent be transferred to the Complainant:

- 1) the domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- 2) the Respondent has no rights or legitimate interests in respect of the domain names; and
- 3) the domain names have been registered and is being used in bad faith.

The Panel is satisfied the Complainant has satisfied all three elements for the principal reasons set out below.

#### 1) RIGHTS IN AN IDENTICAL OR CONFUSINGLY SIMILAR TRADEMARK

The Complainant has demonstrated to the satisfaction of the Panel that it has registered rights in the trade mark NOVARTIS that predates the registration of the disputed domain names by the Respondent.

The disputed domain names vary from this trademark only by way of the addition of various generic top-level domains (gTLDs), which are unlikely to distinguish the disputed domain name in the eyes of an internet user from the trademark. The Panel finds that the gTLDs do no more to distinguish the disputed domain names than if the most common gTLD, being ".com", was adopted in lieu of them. All such gTLDs fail to distinguish one brand from another. They are generic by definition and in use by multiple traders and internet users. The Panel refers to Walgreen Co v. Usama Nizamani Forum Case No. FA 1801001767423 in which the less common ".xyz" gTLD was equally given little or no weight in deciding whether a disputed domain name was similar to a registered trademark.

Reliance on registered rights in a single jurisdiction is sufficient for the purposes of establishing rights referred to in paragraph 4(a)(i) of the UDRP (see *Koninklijke KPN N.V. v. Telepathy, Inc.*, WIPO Case No. D2001-0217; WIPO Case Nos. D2012-0141 and D2011-1436). Even though it is not a requirement that that jurisdiction be the resident jurisdiction of the Respondent, here the Complainant has gone as far as to prove such rights in an Australian trade mark registration.

The disputed domain name is confusingly similar to the NOVARTIS trademark.

## 2) NO RIGHTS OR LEGITIMATE INTERESTS

The Respondent's name bears no resemblance to "NOVARTIS". Further, there is no basis to conclude legitimate interests from any use of NOVARTIS on the website to which the domain names resolve. And finally, in his correspondence the Respondent did not indicate he had any legitimate interest in NOVARTIS.

In such circumstances, and in absence of a Response which would rebut the apparent lack of rights or legitimate interests, the Panel concludes that the Respondent has no rights or interests in the disputed domain names (see the reasoning of the Panelist in *Bloomberg L.P. v. Global Media Communications a/k/a Dallas Internet Services Forum* Case No. FA 0105000097136).

## 3) BAD FAITH

The Panel finds that the Respondent has both registered and used the disputed domains in bad faith for the following three reasons.

First, based on the undistributed facts above NOVARTIS is a well-known internationally used trademark. It is implausible that the Respondent did not know this when he first registered <novartis.guru> and it is apparent from correspondence that he most certainly knew this when he registered the remaining disputed domain names. As correctly identified by the Complainant, bad faith has been properly found by other panelists in circumstances where a domain name is so obviously connected with a well-known trademark that its very use by someone with no connection to the trademark suggests opportunistic bad faith (*Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. D2000-0163 and *Sanofi-Aventis v. Nevis Domains LLC*, WIPO Case No. D2006-0303). Such opportunistic bad faith has occurred here.

Second, in correspondence to the Complainant's representative the Respondent admitted to registering a number of the disputed domain names for no other purpose than to "piss [the Complainant] off". It is clear from this communication that after first registering <novartis.guru> the Respondent registered the remaining disputed domain names with an intent to annoy (i.e. 'piss off') the Complainant. Under paragraph 4(b)(iii) of the Policy evidence of bad faith may include, without limitation, evidence that domain names were registered "primarily for the purpose of disrupting the business of a competitor". Here no evidence suggests that the Respondent was a competitor of the Complainant. However, in the Panel's view the express reference to such disruption in the Policy indicates that it is proper to consider motivations for registration that are more focused on causing disruption than using the domain name for any ordinary fair commercial purpose. Registering a domain name for the sole purpose of causing annoyance that results in disruption to a business is registration in bad faith. It is not a proper purpose for the use of a domain name that is consistent with the Policy. However, it must be noted it is rare case like the present where such clear express evidence of bad faith registration exists. Namely, where for some unknown reason the Respondent openly admits their motivation with such hubris.

Third, it is asserted by the Complainant, and not contested, that at one point in time all the disputed domain names redirected web-users to the website of one of the Respondent's competitors. Such conduct has no fair commercial purpose and is likely to divert the Complainant's customers through confusion to a competitor.

All the disputed domain names were registered and used in bad faith.

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FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTIS.GURU**: Transferred
2. **NOVARTIS.MEDIA**: Transferred
3. **NOVARTIS.NINJA**: Transferred
4. **NOVARTIS.PRESS**: Transferred
5. **NOVARTIS.SERVICES**: Transferred
6. **NOVARTIS.TEAM**: Transferred
7. **NOVARTIS.TECHNOLOGY**: Transferred
8. **NOVARTIS.TODAY**: Transferred

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## PANELLISTS

Name	<b>Mr Andrew Norman Sykes</b>
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DATE OF PANEL DECISION	2021-11-30
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Publish the Decision	
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