

## Decision for dispute CAC-UDRP-104742

Case number	CAC-UDRP-104742
Time of filing	2022-07-18 09:46:15
Domain names	novartispharmacy.com

### Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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### Complainant

Organization	Novartis AG
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### Complainant representative

Organization	BRANDIT GmbH
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### Respondent

Name	Robert Jackson
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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 has submitted evidence of the following registrations of the NOVARTIS trademark in relation to a range of products and services relating to a range of pharmaceutical and healthcare products and services:

- Swiss trademark registration No. 2P-427370, registered on July 1, 1996, in classes 1, 2, 3, 4, 5, 7, 8, 9, 10, 14, 16, 17, 20, 28, 29, 30, 31, 32, 40, and 42;
- International trademark registration No. 663765, registered on July 1, 1996, in classes 1, 2, 3, 4, 5, 7, 8, 9, 10, 14, 16, 17, 20, 22, 28, 29, 30, 31, 32, 40, and 42;
- International trademark registration No. 1349878, registered on November 29, 2016, in classes 9, 10, 41, 42, 44, and 45;
- United States trademark registration No. 2997235, registered on September 20, 2005, in class 5; and
- United States trademark registration No. 4986124, registered on June 28, 2016, in class 5, 9, 10, 41, 42, and 44.

#### FACTUAL BACKGROUND

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

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. The Complainant, Novartis AG, maintains headquarters in Switzerland and was created in 1996 through a merger of two other companies Ciba-Geigy and Sandoz. Complainant is the holding company of the Novartis Group.

The Complainant's products are manufactured and sold in many regions worldwide including the United States of America, a country where it has an active presence through its subsidiaries – such as Novartis Pharmaceuticals Corporation – based in East Hanover, New Jersey and associated companies. Further, the Complainant owns a number of registrations, in several countries, for the trademark NOVARTIS listing a wide variety of goods and services in the fields of pharmaceuticals and healthcare.

The disputed domain name was registered on June 20, 2022 and resolves to an inactive index page.

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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 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).

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#### 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).

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#### 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).

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#### 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.

However, a preliminary procedural question has been raised with respect to the adequacy of service upon the Respondent. The ADR Center of the Czech Arbitration Court, on August 16, 2022, issued a communication to the parties noting that, while “neither the written notice of the Complaint nor the advice of delivery thereof was returned to the Czech Arbitration Court”, “[t]he e-mail notice sent to [the Registrant email address disclosed by the concerned Registrar] and postmaster@novartispharmacy.com was returned back undelivered as the e-mail address had permanent fatal errors”. This communication goes on to say that “[n]o further e-mail address could be found on the disputed site... [and] [t]he Respondent never accessed the online platform.”

This raises the question of whether the Respondent received notice of the present proceedings. Under Rule 4(c) of the Policy, the Provider is required to “send Written Notice of the complaint ... to the Respondent, in the manner prescribed by Paragraph 2(a)....” The phrase “Written Notice” is defined in Rule 1 of the Policy as “hardcopy notification by the Provider to the Respondent of the commencement of an administrative proceeding under the Policy which shall inform the respondent that a complaint has been filed against it, and which shall state that the Provider has electronically transmitted the complaint including any annexes to the Respondent by the means specified herein. Written notice does not include a hardcopy of the complaint itself or of any annexes.” Under Rule 2(a) of the Policy, “it shall be the Provider's responsibility to employ reasonably available means calculated to achieve actual notice to Respondent.” This Rule goes on to state that this responsibility may be discharged by the Provider “sending Written Notice of the complaint to all postal-mail and facsimile addresses ... shown in the domain name's registration data in Registrar's Whois database” or by sending the complaint and any annexes by email to the email addresses listed in the Whois database, to “postmaster@<the contested domain name>”,

and “any e- mail address shown or e-mail links on that web page” to which the disputed domain name resolves.

Though not mentioned in the more current WIPO Overview 3.0, the WIPO Overview 2.0 notes on this issue that “Panels have also noted that: (i) there are limits to what can reasonably be done by parties and providers to identify an ‘underlying registrant’ in the context of the UDRP, and if WhoIs information is not readily usable for communication purposes in such case the registrant must expect to bear any consequences”. This approach has been adopted in a number of decisions such as Singapore Pools (Private) Limited v. WhoisGuard, Inc. / Chicho Vancho, D2016-0290 (WIPO April 2, 2016) (“the contact details provided for the Respondent Chicho Vancho are false and ... the address and telephone number provided do not exist. The Panel is satisfied that proper notice of this proceeding was provided to whomever that Respondent really is in accordance with the Rules.”).

In the present case, the CAC notes that “neither the written notice of the Complaint nor the advice of delivery thereof was returned to the Czech Arbitration Court”. This indicates a high likelihood that such notice was received at the postal address listed in the Whois record for the disputed domain name. Although notice to the email address stated in the Whois record was returned back undelivered, the Panel agrees with the position noted above that this does not create a fatal flaw to service upon the Respondent and, in any event, it is the Respondent’s sole responsibility to ensure that any contact information listed in the Whois record is accurate and up-to-date. If the address used by the CAC to send email notification of these proceedings failed due to an inaccurate or outdated address, the Respondent must expect to bear any consequences as the CAC has employed reasonably available means calculated to achieve actual notice to the Respondent. Under these circumstances, the Panel determines that this case may proceed despite the fact that emails to the Respondent were undeliverable.

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#### PRINCIPAL REASONS FOR THE DECISION

A. The disputed domain name is confusingly similar to a trademark or service mark in which the Complainant has rights

Paragraph 4(a)(i) of the Policy is a standing requirement which is satisfied if the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. Furthermore, it is not as extensive as the “likelihood of confusion” test for trademark infringement applied by many courts. Rather, under the Policy confusing similarity is commonly tested by comparing the Complainant’s trademark and the disputed domain name in appearance, sound, meaning, and overall impression. See *Administradora de Marcas RD, S. de R.L. de C.V. v. DNS Manager / Profile Group*, 101341 (CAC November 28, 2016).

It has been consistently held that “[r]egistration of a mark with governmental trademark agencies is sufficient to establish rights in that mark for the purposes of Policy paragraph 4(a)(i).” *Teleflex Incorporated v. Leisa Idalski*, FA 1794131 (FORUM July 31, 2018). In this case, the Complainant has submitted screenshots from the trademark office of Switzerland, the World Intellectual Property Organization (WIPO), and the United States Patent and Trademark Office (USPTO) websites demonstrating that it owns registrations of the NOVARTIS trademark. The Panel accepts this evidence as proof of the Complainant’s asserted trademark rights.

Where a disputed domain name consists of the entirety of a trademark and adds generic or descriptive terms, confusing similarity has frequently been found under paragraph 4(a)(i) of the Policy. See, e.g., *Mooney S.p.A. v. Jose Risi*, 104685 (CAC October 4, 2022) (confusing similarity found where “[t]he disputed domain name includes the MOONEY trademarks in its entirety, preceded by the letter ‘X and with the addition of the generic term ‘token’.”). Here, the second level of the disputed domain name contains the entirety of the NOVARTIS trademark followed by the word “pharmacy”. Thus, the Complainant’s trademark is clearly recognizable in the disputed domain name and the added generic term does not lessen confusion but rather enhance it as it directly relates to the field of business of the Complainant.

Of course, the extension “.com” adds no meaning to the second level of the disputed domain name. *Lesaffre et Compagnie v. Tims Dozman*, 102430 (CAC May 2, 2019) (“the top-level suffix in the domain name (i.e. the ‘.com’) must be disregarded under the identity / confusing similarity test as it is a necessary technical requirement of registration.”).

Accordingly, the Panel finds that the Complainant has rights to the NOVARTIS trademark and that the disputed domain name

is confusingly similar to such trademark. Thus, the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. The Respondent has no rights or legitimate interests in respect of the disputed domain name

Pursuant to paragraph 4(a)(ii) of the Policy, a complainant has the burden of making a prima facie showing that the respondent has no rights or legitimate interests in a domain name. *Cephalon, Inc. v. RiskIQ, Inc.*, 100834 (CAC September 12, 2014). Once this standard is met, the burden shifts to the respondent to demonstrate that it does have rights or legitimate interests in the domain name.

Paragraph 4(c) of the Policy offers respondents several examples of how to demonstrate their rights or legitimate interests to a domain name.

With reference to 4(c)(ii), the Complaint states that the Respondent is not commonly known by the disputed domain name and that the Complainant “has never granted the Respondent any rights to use the NOVARTIS trademark”. The Complainant has submitted into evidence the results of a WIPO Global Brand Database trademark search for the term “novartis pharmacy” which shows no results thus indicating that the Respondent holds no trademark rights to the phrase which is used in the disputed domain name. The Respondent has not filed a Response or made any other submission in this case and so it does not contest any of this. Further, reference may be made to the WHOIS record when considering this issue. *MAJE v. enchong lin*, 102382 (CAC April 14, 2019) (“panels have held that a Respondent was not commonly known by a disputed domain name if the WHOIS information was not similar to the disputed domain name.”). The WHOIS record for the disputed domain name lists the Registrant name as “Robert Jackson”. This name bears no resemblance to the Complainant’s trademark or to the disputed domain name and the Respondent has not submitted any claim or evidence that it is known otherwise. As such, the Panel finds no evidence upon which to conclude that the Respondent is commonly known by the disputed domain name.

Next, under Paragraphs 4(c)(i) and 4(c)(iii) of the Policy the Panel considers whether the Respondent is using the disputed domain name to make a bona fide offering of goods or services or whether it is making a legitimate non-commercial or fair use of the disputed domain name. Failing to resolve a confusingly similar domain name to any web content or resolving it to a static parking page is typically not considered to be a bona fide use. See, *Consorzio Vino Chianti Classico v. Fabio Baccilli*, 104426 (CAC May 9, 2022) (no bona fide use found, in part, because the disputed domain name “does not resolve to an active website”). Here, the Complainant has submitted a screenshot of the website resolution for the disputed domain name which shows only a typical index page and a link labelled “cgi-bin”. The Respondent has not offered any explanation for its use of the disputed domain name and the Panel notes the distinctiveness and global reputation of the Complainant’s trademark. Considering the available evidence, it is apparent to the Panel that the Respondent is not using the disputed domain name for a bona fide offering of goods or services or in connection with a legitimate non-commercial or fair use under Paragraphs 4(c)(i) and 4(c)(iii) of the Policy.

For all of the above-stated reasons, this Panel finds, by a preponderance of the evidence, that the Complainant has met its burden of proof and that the Respondent has not refuted this. Thus, the Panel determines that the Respondent has no rights or legitimate interests in respect of the disputed domain name under Paragraph 4(a)(ii) of the Policy.

C. The disputed domain name was registered and is being used in bad faith

Under paragraph 4(a)(iii) of the Policy, the complainant must demonstrate both that the domain name was registered and is being used in bad faith. Further guidance on that requirement is found in paragraph 4(b) of the Policy, which sets out four examples of actions by a respondent that may satisfy this burden of proof.

A threshold question is whether, at the time that it registered the disputed domain name, Respondent was aware of the Complainant’s trademarks. The registration of the Complainant’s trademarks preceded the creation of the disputed domain name by many years. Further, the Complainant asserts that “[t]he NOVARTIS trademark is a widely known trademark registered in many countries and the Complainant enjoys a strong online presence.” In support of this claim the Complainant submits images from its own website as well as pages of its accounts on popular social media channels such as Facebook

and Instagram. Also submitted are the results of a Google search for the term “novartis” in which the results refer exclusively to the Complainant. Under such circumstances, the uniqueness and reputation of an asserted trademark may lead to a presumption that a disputed domain name was targeting the mark and was thus registered in bad faith. See *Intesa Sanpaolo S.p.A. v. marano tu si, antonio di bartolomeo*, 104690 (CAC August 8, 2022) (“UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trade mark can by itself create a presumption of bad faith (paragraph 3.1.4 of the WIPO Jurisprudential Overview 3.0), and the Panel accepts that the Complainant’s trade mark is widely known in its field of business.”). The evidence submitted in this case indicates a high likelihood that the Respondent had actual knowledge of the Complainant’s trademark and leads to a presumption that the disputed domain name was registered in bad faith.

Next, attention is given to the Complainant’s claim that the Respondent uses the disputed domain name in bad faith. Here, the disputed domain name was created on June 20, 2022, which is long after the issuance of the Complainant’s cited trademark registrations. The disputed domain name resolves only to a typical index website with no substantive content. It has been held in many prior UDRP decisions that non-use of a domain name for website content, will not prevent a finding of bad faith under the doctrine of passive holding. Rather “panellists will look at the totality of the circumstances in each case, including: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.” *3Shape A/S v. Michael Nadeau*, 102312 (CAC March 12, 2019), citing the seminal decision in *Telstra Corporation Limited v. Nuclear Marshmallows*, D2000-0003 (WIPO February 18, 2000). As noted above, Complainant has submitted evidence of the uniqueness and reputation of its trademark; the Respondent has failed to submit a response or submit any evidence of good faith use; the public WHOIS record for the disputed domain name does not disclose the Respondent’s identity, and the Panel finds no plausible good faith use to which the disputed domain name may be put given its use of a well-known trademark coupled with a generic word that directly relates to the Complainant’s field of business. In this case, the Respondent’s failure to resolve the disputed domain name to any web page, along with the totality of the circumstances, supports the Complainant’s assertion that the domain name is used in bad faith.

Finally, the Complainant notes that it sent a cease and desist letter to the Respondent identifying the NOVARTIS trademark but the Respondent did not reply. A respondent’s failure to engage with a dispute can, after taking into account all the circumstances of a case, can lend support to a claim of bad faith. See *Bloomberg Finance L.P. v. Usman Ik / Divers Marine Contracting LLC*, FA 1820452 (FORUM January 10, 2019) (“Respondent did not reply or respond in any way to this [demand letter] communication. Again, in light of the nonexclusive nature of Policy ¶ 4(b), failure to respond to a cease and desist notice has been held to support a finding of bad faith”), citing *Fareportal, Inc. v. Arun Meelyan*, FA 1736954 (FORUM August 17, 2017) and *Seiko Epson Corporation v. Asish Sen*, FA 1702054 (FORUM December 12, 2016) (finding that failing to respond to a demand letter has been found to constitute bad faith). Under all of the circumstances of the present case, the Panel finds that the Respondent’s failure to reply to the Complainant’s cease and desist letter further supports the finding that the Respondent acted in bad faith when it registered and used the disputed domain name.

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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. **NOVARTISPHARMACY.COM**: Transferred

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## PANELLISTS

Name	Steven M. Levy, Esq.
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DATE OF PANEL DECISION 2022-08-22

Publish the Decision

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