

## Decision for dispute CAC-UDRP-104825

Case number	CAC-UDRP-104825
Time of filing	2022-09-09 09:48:45
Domain names	novartispharma-services.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

Name	Marie Therese Affognon
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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 Owner of trademarks in Benin and all over the world. E.g. he has following valid trademarks in Benin with the name NOVARTIS:

Trademark: NOVARTIS

Swiss Reg. No: 2P-427370

Reg. Date: 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: NOVARTIS

Reg. No. 663765

Reg. date: 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

Reg. No.: 1249666

Reg. date: April 28, 2015 in classes 01, 03, 05, 09, 10, 16, 29, 30, 31, 32, 35, 40, 41, 42, 44 and countries GE-IN-OA-PH-RW

African (OAPI) trademark registration: NOVARTIS ACCESS

Reg. No. 094567

Reg. date: September 14, 2018 in classes 5 and 10 in OA

The Complainant also provided evidence that it owns a domain name containing the name <novartis.com>, registered on April 2, 1996, or in combination with other terms, such as <novartispharma.com> (registered in 1999) well before the Respondent registered the disputed domain name.

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## FACTUAL BACKGROUND

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

#### 1. LANGUAGE OF PROCEEDINGS REQUEST:

To the best of Complainant's knowledge, the language of the Registration Agreement of the disputed domain name <novartispharma-services.com> is English. Therefore, the language of the proceedings should be English.

#### 2. ABOUT COMPLAINANT

The Complainant is a pharmaceutical company based in Basel, Switzerland. The Complainant is active in the pharmaceutical business for many decades and has as group about 126 000 people of 145 nationalities work at Novartis around the world. The complainant is represented by BrandIT GmbH, Zürich, Switzerland.

The Complainant is the owner of the registered well-known trademark NOVARTIS as a word and figure mark in several classes in numerous of countries all over the world including in Benin. The Complainant has a presence in Benin, on the African continent, through its subsidiaries and associated companies. For instance, the Complainant showed evidence that it established a dedicated organization to reach more patients in Sub-Saharan Africa (SSA). The Complainants SSA unit, for which about 700 employees work, aims to expand the availability of the Complainants full portfolio of medicines, taking a high-volume, lower-price approach – with an aspiration to double patient reach in the region by 2022.

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

The Complainant owns numerous domain names composed of either its trademark NOVARTIS alone, including <novartis.com> (created on April 2, 1996) or in combination with other terms, e.g. <novartispharma.com> (created on October 27, 1999) and many others. 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.

#### 3. ABOUT RESPONDENT

The Respondent is a Benin citizen, using a hidden domain holder name, who is represented by his Registry nameweb.biz. On September 9, 2022 the Respondent registered disputed domain name. She uses the disputed domain name not active.

#### 4. SUMMARY of Complainant

- NOVARTIS is a well-known, distinctive trademark worldwide.
- 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.
- Respondent has been passively holding the disputed domain name.
- Respondent failed in responding to cease-and-desist letter sent by the Complainant.

- Respondent has been using privacy shield to conceal its identity.

Consequently, the Respondent should be considered to have registered the disputed domain name confusingly similar to the Complainant's well-known, distinctive trademark NOVARTIS. Especially the generic term "Pharma" in the disputed domain name makes obvious that the Respondent was aware what he has done. The Complainant has not found that the Respondent is of any legitimate right or interest in using the disputed domain name, but rather registered and has been using the disputed domain name in bad faith.

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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.

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#### PRINCIPAL REASONS FOR THE DECISION

It is necessary for the Complainant, if it is to succeed in this administrative proceeding, to prove each of the three elements referred to in paragraph 4(a) of the Policy, namely that:

- (A) the disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights; and
- (B) the Respondent has no rights or legitimate interest in respect of the disputed domain name; and
- (C) the disputed domain name has been registered and is being used in bad faith.

A.

The Panel finds that the disputed domain name <NOVARTISPHARMA-SERVICES.COM> is confusingly similar to the trademarks of the Complainant. The domain name <NOVARTISPHARMA-SERVICES.COM> (hereinafter referred to as the "Disputed Domain Name"), which was registered on September 9, 2022 (according to the Registrar Verification), incorporates entirely the Complainant's well-known, registered trademarks NOVARTIS with generic indications "pharma" and "services". The Disputed Domain Name in its structure directly refers to the Complainant, its trademark and business. Moreover, previous UDRP panels have stated that the NOVARTIS trademark is well-known, especially for the pharmaceutical business. Therefore is the generic term

“Pharma” in combination with NOVARTIS an amplification of Complainants rights (inter alia, Novartis AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org,/ Sergei Lir, WIPO Case No. D2016-1688).

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”. The same reasoning should apply in the current case.

B.

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. The Complainant has not granted the Respondent any right to use the NOVARTIS trademarks within the Disputed Domain Name, nor is the Respondent affiliated to the Complainant.

Moreover, the Complainant contends and provides evidence that the Respondent has not developed a legitimate use in respect of the Disputed Domain Name. The Complainant contends that the Respondent was seeking to use the Disputed Domain Name only to divert consumers to its own business and that the Respondent has no legitimate interests in respect of the Disputed Domain Name.

In detail: 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 trademarks in any forms, including the Disputed Domain Name. Until very recently, it has indeed resolved to a page indicating that soon there will be a website associated to 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 “Novartispharma-services” in the Google search engine, the search engine returned numerous results about the Complainant and its business activities.

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 Benin, 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’s name is not related to the Complainant nor to the term “Novartis” in any way.

By the time the Complainant prepared this amended Complaint, 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.

In lack of any Response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests 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.

THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITH

THE DISPUTED DOMAIN NAME WAS REGISTERED IN BAD FAITH

The Complainant also referred to the distinctiveness and reputation of its NOVARTIS trademarks. This makes it highly unlikely that the Respondent had no knowledge of the Complainant’s prior trademark rights at the time of registration of the Disputed Domain

Name. Especially the generic term “Pharma” as a part of the Disputed Domain Name makes obvious that the Respondent was aware what the combination of the word with NOVARTIS will mean. The Complainant rightfully contended that the Respondent has used the Disputed Domain Name intentionally to attract visitors for commercial gain by creating confusion with the Complainant’s trademarks, and that the Respondent has used the Disputed Domain Name with that intention, namely in bad faith. See e.g., *Accor v. Shangheo Heo / Contact Privacy Inc.*, WIPO Case No. D2014-1471 where the Panel stated that: “The unopposed allegation of phishing, and the evidence submitted in support of phishing, combined with the likelihood of confusion, is sufficient evidence of bad faith. ...It seems likely, as Complainant alleges, that Respondent intentionally attempted to deceive consumers into providing personal and financial information, believing that Respondent was associated with the bona fide services offered by Complainant.”

Reference is made also to: CAC case N° 101036, *Boehringer Ingelheim Pharma GmbH & Co. KG vs. SKYRXSHOP - dulcolax.xyz* and WIPO Case no. D2014-0306 *Boehringer Ingelheim Pharma GmbH & Co. KG v. Klinik Sari Padma, BAKTI HUSADA*.

It should be highlighted 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. incorporates the Complainant’s well-known, distinctive trademark NOVARTIS in its entirety along with the terms “pharma” and “services”, which are closely related to the Complainant and its business activities, it follows that incorporating 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.

In detail considering the facts that:

- The Respondent very likely knew about the Complainant and its trademark;
- The Complainant’s trademark NOVARTIS is a distinctive, well-known trademark worldwide and in Indonesia 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.”

#### 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 the Registrar as the Respondent’s contact details were under privacy shield in the publicly available WHOIS. However, until the time the Complainant prepared this 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’.”

Furthermore, the Respondent was using a hidden identity. But this argument is not to be discussed further because bad faith is evident, whatsoever.

Accordingly, the Panel finds that the Disputed Domain Name was both registered and used in bad faith and that the Complaint succeeds under the third element of the Policy.

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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. **novartispharma-services.com**: Transferred

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## **PANELLISTS**

Name	<b>Harald von Herget</b>
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DATE OF PANEL DECISION **2022-10-28**

**Publish the Decision**

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