

Decision for dispute CAC-UDRP-104169

Case number	CAC-UDRP-104169
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Time of filing	2021-11-16 10:24:28
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Domain names	Novairtis.com
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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	Debra McCann
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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 the owner of the well-known trademark NOVARTIS as a word and figure mark in several classes in numerous of countries all over the world including in the UK. These trademark registrations predate the registration of the disputed domain name.

Trademark registration in UK

- i. NOVARTIS (word mark), EUTM Registration number EU000304857; date of entry in register: 25 June 1999; priority date: 15 February 1996;
- ii. NOVARTIS (word mark), EUTM Registration number EU013393641, date of entry in register: 17 March 2015; and
- iii. NOVARTIS (word mark), WIPO Registration number WE00001349878, date protection granted in EU: 17 November 2017.

The Complainant owns numerous domain names composed of either its trademark NOVARTIS alone, including <Novartis.co.uk> (created on 23 April 1997) and <novartis.com> (created on 2 April 1996) or in combination with other terms, e.g. <novartispharma.com> (created on 27 October 1999). The Complainant uses these domain names to promote the

NOVARTIS mark with related products and services.

FACTUAL BACKGROUND

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

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 a strong presence in the UK where the Respondent is located. The below links connect customers to the official local sales and service locator and to the official websites of the Complainant:

Global Website for Novartis: <https://www.novartis.com>

Local Website for Novartis in the UK: <https://www.novartis.co.uk/>

The Complainant’s subsidiary is registered at Companies House under the name NOVARTIS UK LIMITED and under the name NOVARTIS PHARMACEUTICALS UK LIMITED.

The Complainant has been awarded 2019 UK Top Employer Certification for sixth consecutive year in UK (<https://www.novartis.co.uk/> and has partnership or cooperation with numerous UK organizations (<https://www.novartis.co.uk/>). Furthermore, each year Novartis UK staff will volunteer their time to local organisations and charities, and this has been going on for over 20 years. (<https://www.novartis.co.uk/>).

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

LEGAL GROUNDS:

A. THE DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR

The domain name <Novairtis.com> (hereinafter referred to as the “disputed domain name”), which was registered on 16 January 2020 according to the Registrar Verification, incorporates a typo of the Complainant’s well-known, distinctive trademark NOVARTIS by merely inserting an extra letter “i” between the letters “a” and “r”. 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 and the disputed domain name should be considered as confusingly similar to the trademark NOVARTIS.

B. RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN RESPECT OF THE 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 “novairtis” in the Google search engine, the returned results either suggested “Novartis” or were irrelevant; when searched for “novairtis” in combination with the Respondent’s name “Debra McCann” or with “Mercantile London Ltd”, there was no relevant result.

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 UK, where the Respondent resides, and many other countries worldwide. In particular, the Complainant also owns its official domain names Novartis.com and Novartis.co.uk, which are very similar to the disputed domain name. However, the Respondent still chose to register the disputed domain name as such.

In addition, according to the Registrar Verification, the Respondent is named “Debra McCann / Mercantile London Ltd”, which is not related to the Complainant nor to the term NOVARTIS in any form.

From the Complainant’s perspective, the Respondent deliberately chose to use a typo of the well-known, distinctive trademark NOVARTIS as the body of the disputed domain name, very likely with the intention to benefit from the Complainant’s worldwide renown and to confuse Internet users as to the source or sponsorship and therefore cannot be considered as a bona fide offering of goods or services.

By the time the Complainant prepared this amended Complaint on 22 November 2021, the disputed domain name did not resolve to any active website. The Respondent is not making any bona fide offering of goods or services.

The disputed domain name has active MX records, meaning that it may be used for sending out emails. According to such parameter, the risk of phishing is very high.

For the foregoing reasons, it shall be concluded that the Respondent has no right nor legitimate interest in respect of the disputed domain name, nor is it using the disputed domain name for any bona fide offering of goods or services.

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

i. THE DOMAIN NAME WAS REGISTERED IN BAD FAITH

It should be highlighted that most of the 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 a typo of the Complainant’s well-known, distinctive trademark NOVARTIS by merely inserting an extra letter “i” between the letters “a” and “r”, 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.

Considering the facts that:

- 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 UK 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 DOMAIN NAME IS BEING USED IN BAD FAITH

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.

Furthermore, the Respondent has been using privacy shield to conceal its identity, which adds up to the finding of bad faith in the given context.

Finally, as stated above, MX records exist in connection with the disputed domain name. There is a risk that the Respondent uses an email address incorporating the disputed domain name to perpetrate "fraudulent actions while pretending to be the Complainant" (see Credit Industriel et Commercial S.A. v. Zabor Mok, supra; Cofidis Participations, SA v. WhoisGuard Protected, WhoisGuard, Inc. / Phillipe Beaussier, supra). Such possible use would characterize bad faith.

Therefore, the Complainant concludes that the Respondent has registered and used the disputed domain name in bad faith.

SUMMARY

- NOVARTIS is a well-known, distinctive trademark worldwide.
- Complainant's trademarks registration predates the registration of the disputed domain name.
- Respondent has no right 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 has been using privacy shield to conceal its identity.
- Disputed domain name has active MX records.

Consequently, the Respondent should be considered to have registered the disputed domain name confusingly similar to the Complainant's well-known, distinctive trademark NOVARTIS. 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.

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).

This is a case of "typosquatting", i.e. the disputed domain name contains an obvious misspelling of the Complainant's trademark. It is well established that the specific top level of a domain name such as ".com", ".org" or in casu ".net" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar.

Previous panels have found that the slight spelling variations does not prevent a domain name from being confusingly similar to the complainant's trademark. Adding the letter "i" in the middle of the trademark NOVARTIS to spell NOVAIRTIS does not take away the confusing similarity between the domain name and the trademark

Simple exchange or adding of letters is not a sufficient element to escape the finding that the disputed domain name is confusingly similar to the Complainant's trademarks and domain names.

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 contends that the Respondent is not affiliated with him nor authorized by them in any way to use their trademarks in a domain name or on a website. The Complainant does not carry out any activity for, nor has any business with the Respondent.

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).

Given the circumstances of the case, including the provided information of the use and reputation of the Complainant's trademark NOVARTIS and the distinctive nature of this mark, it is inconceivable to the Panel in the current circumstances that the Respondent registered the disputed domain name without prior knowledge of the Complainant and the Complainant's mark.

The Panel therefore finds that the disputed domain name was registered in bad faith.

The disputed domain name does not currently resolve to an active website. In this case the Complainant has however evidenced that the disputed domain name enables the Respondent to send emails using an e-mail address that contains the disputed domain name.

Though no concrete examples of such use have been presented to this Panel, it seems inconceivable that the Respondent will be able to make any good faith use of the disputed domain name as part of an e-mail address. The Panel notes in this connection that passive holding of a domain name does not prevent a finding of bad faith use under 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

1. The three essential issues under the paragraph 4(a) of the Policy are whether:

- i. the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- ii. the Respondent has no rights or legitimate interests with respect to the disputed domain name; and
- iii. the disputed domain name has been registered and is being used in bad faith.

2. The Panel reviewed carefully all documents provided by the Complainant. The Respondent did not provide the Panel with any documents or statements. The Panel also visited all available websites and public information concerning the disputed domain name, namely the WHOIS databases.

3. The UDRP Rules clearly say in its Article 3 that any person or entity may initiate an administrative proceeding by submitting a complaint in accordance with the Policy and these Rules.

4. The Panel therefore came to the following conclusions:

a) The Complainant states and proves that the disputed domain name is confusingly similar to its trademarks and its domain names. Indeed, the trademark is partially incorporated in the disputed domain name.

The disputed domain name is therefore deemed confusingly similar.

b) The Respondent is not generally known by the disputed domain name and have not acquired any trademark or service mark rights in the name or mark, nor is there any authorization for the Respondent by the Complainant to use or register the disputed domain name.

The Panel therefore finds that the Respondent does not have rights or legitimate interest with respect to the disputed domain name.

c) It is clear that the Complainant's trademarks and website(s) were used by the Complainant long time before the disputed domain name was registered. There is no present use of the disputed domain name but the disputed domain name enables the Respondent to send emails using an e-mail address that contains the disputed domain name. Though no concrete examples of such use have been presented to this Panel, it seems inconceivable that the Respondent will be able to make any good faith use of the disputed domain name as part of an e-mail address. It is concluded that the Respondent makes bad faith use of the disputed domain name.

The Panel therefore finds that the disputed domain name has been registered and is being used in bad faith.

For the reasons stated above, it is the decision of this Panel that the Complainant has satisfied all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVAIRTIS.COM**: Transferred

PANELLISTS

Name	Lars Karnoe
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DATE OF PANEL DECISION 2021-12-14

Publish the Decision
