

Decision for dispute CAC-UDRP-105168

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| Case number | CAC-UDRP-105168 |
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| Time of filing | 2023-02-01 09:19:00 |
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| Domain names | novartispharmaceuticalcompany.com, novartis-pharmaceutical.org |
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Case administrator

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| Organization | Iveta Špiclová (Czech Arbitration Court) (Case admin) |
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Complainant

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| Organization | Novartis AG |
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Complainant representative

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| Organization | BRANDIT GmbH |
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RESPONDENTS

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| Name | David Micheal |
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| Organization | Chartrand!NOVARTIS |
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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 names.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of trademark registrations for NOVARTIS, including US trademarks

- NOVARTIS, Reg. no: 5420583, Reg. date: March 13, 2018
- NOVARTIS, Reg. no: 4986124, Reg. date: June 28, 2018
- NOVARTIS, Reg. no: 2997235, Reg. date: September 20, 2005

The disputed domain name <novartispharmaceuticalcompany.com> was registered on November 27, 2022. The disputed domain name <novartis-pharmaceutical.org> was registered on November 15, 2022.

FACTUAL BACKGROUND**FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:**

The Complainant, with headquarter in Switzerland, created in 1996 through a merger of two other companies Ciba-Geigy and Sandoz, is the holding company of the Novartis Group, one of the biggest global pharmaceutical and healthcare groups. The Complainant's

products are manufactured and sold in many countries worldwide including the U.S. where the Respondent(s) are allegedly located. The Complainant has subsidiaries and associated companies based in the U.S. and has been playing an active role on the local market and in its society.

The Complainant is the owner of the well-known trademark NOVARTIS registered as both a word and device mark in several classes worldwide, including the U.S. The vast majority of the Complainant's trademark registrations significantly predate the registration of the disputed domain names. Previous UDRP panels have stated that the NOVARTIS trademark is well-known (see *Novartis AG v. Amartya Sinha*, Global Webs Link, Novartis RO, WIPO Case No. D2020-3203).

The Complainant also owns numerous domain names composed of its trademark NOVARTIS alone, including <novartis.com> (registered in 1996) or in combination with other terms, such as <novartispharma.com> (registered in 1999).

(i) The disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights

- The Complainant owns numerous trademarks NOVARTIS which were registered many years before the registration of the disputed domain names.
- The disputed domain names, in their second level portion, incorporate the trademark NOVARTIS in its entirety, followed by the terms "pharmaceutical" and "company", or simply "pharmaceutical" following the hyphen. These terms directly refer to the Complainant and their business, since the Complainant is a company which develops and delivers innovative drugs (pharmaceuticals).
- The NOVARTIS trademark is clearly recognizable within the disputed domain names. Previous UDRP panels have constantly held that the mere addition of a descriptive or generic term would not prevent a finding of confusing similarity to a trademark. Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition 3.0, Section 1.8).
- The addition of a generic word like "shop" to a trademark with or without hyphen does not prevent the confusing similarity that exists between the disputed domain name and the Complainant's trademark....". This is particularly the case here where the generic word describes an important activity of the Complainant.
- The presence of the generic Top-Level Domain ("gTLD") extension ".com" and ".org" in the first level portions of the disputed domain names is a standard registration requirement and may be disregarded when assessing whether the disputed domain names are confusingly similar to the trademark in which the Complainant has rights.
- In light of the above-mentioned circumstances, the disputed domain names are confusingly similar to the Complainant's NOVARTIS trademark.

(ii) The Respondents have no rights or legitimate interests in respect of the disputed domain names

- The Complainant and the Respondents have never had any previous relationships, nor has the Complainant ever granted the Respondents with any rights to use the NOVARTIS trademark in any form, including in the disputed domain names.
- The Complainant has not found that the Respondents are commonly known by the disputed domain names or that they have a legitimate interest over the disputed domain names. When searched for the terms "novartispharmaceuticalcompany.com" or "novartis pharmaceutical company" or "novartis-pharmaceutical" in the Google search engine, the search results all pointed to the Complainant and its business activities.
- The Respondents should have already performed a similar search before registering the disputed domain names and should have quickly learnt that the trademarks are owned by the Complainant and that the Complainant has been using its trademarks in many countries worldwide, including the U.S.
- When searching for the names of the Respondents along with the terms of the disputed domain names there are no returned results showing that the Respondents are known by the disputed domain names.
- At the time the Complainant found out about the disputed domain names (November 2022), they did not resolve to any active page/content. Similarly, at the time of filing of the complaint, the disputed domain names did not resolve to any active content. Therefore, the disputed domain names are not being used in connection with bona fide offering of goods or services.
- There is no available evidence that the Respondents engage in, or have engaged in any activity or work, i.e., legitimate or fair use of the disputed domain names, that demonstrates a legitimate interest in the disputed domain names.
- The Complainant found out about registration of the disputed domain names and sent Cease-and-Desist letters on <novartispharmaceuticalcompany.com> (December 6, 2022), followed by a reminder on January 26, 2023, and <novartis-pharmaceutical.org> (November 22, 2022). The Cease-and-Desist Letters were sent to the e-mail addresses generated by the privacy service displayed in the WHOIS records and there was no response from the Respondents. The Respondents have been granted an opportunity to present some compelling arguments that they have rights or legitimate interests in the disputed domain

names but have failed to do so. This behavior, coupled with the absence of use of the disputed domain names in connection with a bona fide offering of goods and services, further demonstrate the Respondents' absence of rights or legitimate interests in respect of the disputed domain names.

- The Respondents have therefore no rights or legitimate interests in respect of the disputed domain names.

(iii) The disputed domain names were registered and are being used in bad faith

- The registration of the Complainant's trademarks pre-dates the registration of the disputed domain names and the Respondent has never been authorized by the Complainant to use the NOVARTIS trademark in any form, including in the disputed domain names. The Respondent has chosen to incorporate the distinctive well-known trademark NOVARTIS in the disputed domain names in its entirety.
- By conducting a simple online search regarding for "novartispharmaceuticalcompany.com" or "novartis pharmaceutical company" or "novartis-pharmaceutical" in the Google search engine the Respondents would have inevitably learnt about the Complainant, its trademark and business. It is therefore inconceivable that the Respondents were unaware of the existence of the Complainant when it registered the disputed domain names.
- The disputed domain names incorporate, in their second level portion, the Complainant's NOVARTIS trademark entirely, with the addition of the term(s) "pharmaceutical" and "company", or simply "pharmaceutical" following the hyphen. These terms are closely related to the Complainant's business, as the Complainant is a company which develops and delivers innovative drugs (pharmaceuticals), and therefore create a direct association to the Complainant and its business, capable of creating a likelihood of confusion in internet users' minds.
- The inclusion of terms related to the complainant's business along with their trademark in a disputed domain name is a strong indicator of bad faith registration. This is because the Respondents are most likely intentionally trying to confuse consumers by creating a similarity between the disputed domain names and the Complainant's. By doing so, the Respondents are seeking to benefit from the Complainant's established reputation and potentially harm their business by diverting traffic to a different website. This conduct not only violates the Complainant's trademark rights, but also demonstrates a lack of good faith in the registration of the disputed domain name. Thus, the addition of terms related to the Complainant's business to the trademark in the disputed domain names is a clear sign of registration in bad faith.
- It is evident that the Respondents registered the disputed domain names incorporating the trademark NOVARTIS and with the addition of terms directly related to the Complainant's business intentionally, in order to take advantage of reputation of the trademark NOVARTIS and the Complainant's goodwill.
- Therefore, the Respondents knew the Complainant's trademark at the time it registered the disputed domain names and registered them in bad faith.
- Paragraph 4(b) of the Policy identifies, in particular but without limitation, four circumstances which shall be evidence of the registration and use of a domain name in bad faith. Among those circumstances Paragraph 4(b)(iv) of the Policy reads: "by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location."
- The disputed domain names incorporate, in their second level portion, the Complainant's NOVARTIS trademark entirely, with the addition of the term(s) "pharmaceutical" and "company", or simply "pharmaceutical" following the hyphen. These terms are directly related to the Complainant and their business.
- The disputed domain names are passively held. They do not resolve to an active website now and did not in the time the Complainant found out about the disputed domain names. There is therefore no evidence of any actual or contemplated good-faith use of the disputed domain names. The non-use of a domain would not prevent a finding of bad faith ("WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, Section 3.3). It is possible, in certain circumstances, for inactivity by the Respondent to amount to the domain name being used in bad faith.
- Moreover, the Complainant tried to contact the Respondents through Cease-and-Desist Letters, advised the Respondents that the unauthorized use of their trademarks within the disputed domain names violates the trademark rights and requested a voluntary transfer of the disputed domain names. The Respondents however chose not to reply to the Cease-and-Desist letters which infers bad faith.
- In view of the above, the Complainant finds that the Respondents have registered and used the disputed domain names in bad faith and its conduct falls within the meaning of Paragraph 4(a)(iii) of the Policy.

PARTIES CONTENTIONS

Complainant's contentions are summarised above.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name <novartispharmaceuticalcompany.com> is 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 <novartispharmaceuticalcompany.com> (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 <novartispharmaceuticalcompany.com> has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

According to Registrar, the registrants of the disputed domain names have been identified as David Micheal, Altamonte Springs, USA (<novartispharmaceuticalcompany.com>) and Chartrand Jackson, Chartrand!NOVARTIS, New York, USA (<novartis-pharmaceutical.org>).

The Complainant claimed that both disputed domain names were under common control and likely to be registered by the same person/company using fictitious names and providing false addresses. The Complainant therefore asked the Panel to allow the consolidation of the Respondents based on the following factors:

1. Both disputed domain names were registered within a short period of time (November 15, 2022 and November 27, 2022);
2. Both disputed domain names have not been resolving to any active websites (i) at the time the Complainant sent C&D Letters (ii) At the time of filing and amending of the complaint. Therefore, there is a pattern of passive holding;
3. Both disputed domain names are registered with the same Registrar – Google LLC and have the same/extremely similar Name Servers [...].googledomains.com;
4. The Respondents used the same privacy service – Contact Privacy Inc. Furthermore, the WHOIS of the disputed domain names are the same or extremely similar to one another when examined in their entirety;
5. The Respondents are both located in the US;
6. There are no such people or entities that correspond to the information provided in the WHOIS records;
7. The Complainant has a number of offices in the US including “Novartis Pharmaceuticals Corporation” in different states of the US. The information provided in the WHOIS referring to “Chartrand!NOVARTIS” based in New York is not accurate;
8. The e-mail addresses of the Registrants are both using the same e-mail provider – Gmail and apparently consist of names, with the addition of a few digits, the first two of which are the exact same, e.g. [...].459@gmail.com and [...].45@gmail.com.

According to the paragraph 10(e) of the Rules of UDRP Policy “a Panel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules”. According to Paragraph 3(c) of the UDRP Rules states that: “The complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder”. In order to file a single complaint against multiple respondents, the complaint must meet the following criteria: (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, Section 4.11.2).

The Panel finds that the Complainant has not furnished any concrete evidence to establish that the disputed domain names are indeed subject to common control. Use of the same Registrar, same name servers and same free e-mail provider as millions of other domain names, websites or e-mail users does not prove that the disputed domain names belong to or are controlled by the same entity. The same applies as for the location of both Registrants in the same country (even if the WHOIS records could be inappropriate), and for the inactivity of the websites under the disputed domain names.

Given the above reasons, the Panel rejects the Complainant's request to have the Complaint filed against multiple respondents. In the circumstances, with a view to expediting the administrative proceeding, **this decision shall, in the Panel's sole discretion, deal only with the disputed domain name <novartispharmaceuticalcompany.com>.**

Therefore, the disputed domain name <novartis-pharmaceutical.org> is not analyzed under this proceeding and the Panel orders that the Complaint is terminated without prejudice as to the disputed domain name <novartis-pharmaceutical.org>. Nevertheless, this Panel leaves the rights of the Complainant intact, regarding the disputed domain name <novartis-pharmaceutical.org>, should the Complainant decide to file another complaint under the Policy in relation to said disputed domain name.

Otherwise, 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

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

- 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 in respect of the disputed domain name; and
- iii. The disputed domain name has been registered and is being used in bad faith.

As mentioned in the Procedural Factor Section of this decision, the Panel found that the Complainant had not furnished any concrete evidence to establish that the disputed domain names are subject to common control. This decision therefore deals only with the disputed domain name <novartispharmaceuticalcompany.com>.

Identical or Confusingly Similar

1. The Complainant has established the fact that it has valid rights for the US trademark registrations NOVARTIS, Reg. no: 5420583, Reg. date: March 13, 2018, Reg. no: 4986124, Reg. date: June 28, 2018 and Reg. no: 2997235, Reg. date: September 20, 2005.
2. The disputed domain name <novartispharmaceuticalcompany.com> has been registered on November 27, 2022, i.e. more than 17 years after the first of the above mentioned NOVARTIS trademark registration, and fully incorporates the Complainant's trademark NOVARTIS in its first part. It is therefore confusingly similar to the trademark for purposes of UDRP (WIPO Jurisprudential Overview 3.0, Section 1.7).
3. The generic terms "PHARMACEUTICALCOMPANY" in the second part of the disputed domain explicitly describes the nature of business of the Complainant (pharmaceutics) and its form (company). The term "NOVARTISPHARMACEUTICALCOMPANY" doesn't have any specific meaning itself and should be perceived as a combination of three separate elements "NOVARTIS PHARMACEUTICAL COMPANY". The first of these elements "NOVARTIS" is identical to the Complainant's trademark, is the dominant element of the disputed domain name and will immediately trigger a corresponding link to the Complainant and its trademarks.
4. Therefore, the addition of the non-distinctive terms "PHARMACEUTICAL COMPANY" does not prevent the disputed domain name from being confusingly similar to the Complainant's trademarks. The addition of the generic top level domain ".COM" does not change the overall impression of the designation as being connected to Complainant's trademark.

The Panel therefore considers the disputed domain name <novartispharmaceuticalcompany.com> to be confusingly similar to the Complainant's trademark NOVARTIS which the Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

Rights or Legitimate Interests

1. As stated in the WIPO Jurisprudential Overview 3.0 at Section 2.1, while the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.
2. The Complainant has established a prima facie case (not challenged by the Respondent who did not file any response to the complaint) that the Respondent has no rights or legitimate interests in the disputed domain name.
3. The disputed domain name does not resolve to any active webpage (and didn’t resolve to any webpage from the month of its registration) and there is no available evidence that the Respondent is engaged in, or have engaged in any activity or work, i.e. legitimate or fair use of the disputed domain name, that demonstrates a legitimate interest in the disputed domain name.
4. There is further no evidence, that the Respondent is known by the disputed domain name or that it has a legitimate interest over the disputed domain name. It has not been proved by the Respondent that he has rights or legitimate interests in the disputed domain name or the Respondent is related with the Complainant. Neither license nor authorization has been proven to be granted to the Respondent to make any use of the Complainant’s trademark or apply for registration of the disputed domain name.
5. Finally, the Respondent had an opportunity to present its argument or evidence that it has rights or legitimate interests in the disputed domain name but failed to respond to the Cease-and-Desist Letter sent by the Complainant.

The Panel therefore considers that the Respondent has no rights or legitimate interests in respect of the disputed domain name <novartispharmaceuticalcompany.com> within the meaning of paragraph 4(a)(ii) of the Policy.

Registered and Used in Bad Faith

1. The Respondent has registered the disputed domain name which consists of the full content of the Complainant’s trademark “NOVARTIS” and generic terms “PHARMACEUTICAL COMPANY” that refer to the nature of Complainant’s business (pharmaceutics) and directly to the Complainant (company). There are no doubts that the Complainant’s trademark is distinctive, famous and is well-known worldwide. It could be therefore concluded that the Respondent had or should have the Complainant and its trademark in mind when registering the disputed domain name.
2. The Complainant has established the fact, that the disputed domain name creates direct association to the Complainant and its business and is therefore capable of creating a likelihood of confusion of the internet users. The registration and usage of the disputed domain name could therefore potentially harm Complainant’s business by diverting traffic to a different website and violate the Complainant’s trademark rights, as well as demonstrate a lack of good faith in the registration of the disputed domain names. The addition of terms related to the complainant’s business to the trademark in the disputed domain name is a clear sign of registration in bad faith.
3. Considering the (i) confusing similarity between the Complainant’s well-known trademark and the disputed domain name, (ii) long time between the registration of the Complainant’s trademark and the disputed domain name, (iii) non-use of the disputed domain name, (iv) distinctiveness of the Complainant’s trademark and (v) the failure of the Respondent to respond to the Cease and Desist Letter, to submit a response in the UDRP proceedings and to provide any evidence of good faith use, the Panel finds that the disputed domain name has been registered and is being used in bad faith.

The Panel therefore considers that the disputed domain name <novartispharmaceuticalcompany.com> has been registered and is being used in bad faith within the meaning of paragraph 4(a)(iii) of the Policy.

The Panel finally considers that the Complainant has shown that the disputed domain name <novartispharmaceuticalcompany.com> is confusingly similar to a trademark in which the Complainant has rights, the Respondent has no rights or legitimate interests in respect of the disputed domain name and the disputed domain name has been registered and is being used in bad faith. The Complainant has thus established all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINANT IS

Partially Accepted/Partially Rejected

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

1. **novartispharmaceuticalcompany.com**: Transferred
2. **novartis-pharmaceutical.org**: Remaining with the Respondent

PANELLISTS

| | |
|------|--------------------|
| Name | Petr Hostaš |
|------|--------------------|

DATE OF PANEL DECISION 2023-03-09

Publish the Decision