

Decision for dispute CAC-UDRP-105235

Case number CAC-UDRP-105235

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Domain names novartiseg.com

Case administrator

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

Complainant

Organization Novartis AG

Complainant representative

Organization BRANDIT GmbH

Respondent

Organization ZEZ MEDIA

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 a member of a group of companies ("Complainant's Group") that provide global pharmaceutical and healthcare goods and services including medical treatments and drugs on which it uses its NOVARTIS mark and is the owner of an international portfolio of trademark and service mark registrations including the following:

- Swiss trademark NOVARTIS 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 NOVARTIS 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, designating Egypt;
- International trademark NOVARTIS No. 666218, registered on October 31, 1996, in classes 41 and 42, designating Egypt;
- International trademark NOVARTIS No. 1349878, registered on November 29, 2016, in classes 9, 10, 41, 42, 44 and 45, designating Egypt;
- International trademark NOVARTIS (in Arabic) No. 1502496, registered on October 24, 2019, in classes 5, 10, 41, 42, 44 and 45 designating Egypt; and
- International trademark NOVARTIS (in Arabic) No. 669410, registered on July 1, 1996, in classes 1, 5, 9, 29, 30, 31 and 32, designating Egypt.

FACTUAL BACKGROUND

The Complainant has an established Internet presence and enjoys a strong presence online via its official social media platforms. It owns numerous domain names composed of its trademark NOVARTIS alone, including <novartis.com> (registered in 1996) and <novartis.com.eg> (registered in 1996) or in combination with other terms, such as <novartispharma.com> (registered in 1999) .

The disputed domain name <novartiseg.com> was registered on October 11, 2022 and resolves to a website on which the Respondent purports to sell various products including medical and healthcare products.

PARTIES CONTENTIONS

The Complainant's Contentions

The Complainant claims rights in the NOVARTIS established by its ownership of its portfolio of trademark and service mark registrations described above and extensive use of the mark by itself and other members of Complainant's Group.

The Complainant submits that its products are manufactured and sold in many countries worldwide including through its subsidiaries and associated companies such as Novartis Pharma S.A.E. and Sandoz Egypt Pharma S.A.E.

The Complainant's Group has been present in Egypt for more than 58 years where it is a leading pharmaceutical company in Egyptian pharma market claims to have a legacy of commitment to patients, to Egyptian society, to the local healthcare industry and to the national economy.

The Complainant asserts that previous panels established under the Policy 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).

Additionally, the Complainant submits that it uses the NOVARTIS mark on its websites at <www.novartis.com> (registered in 1996), <www.novartis.com.eg> (registered in 1996) and <novartispharma.com> (registered in 1999) through which it informs Internet users and potential consumers about its NOVARTIS mark and its related products and services.

The Complainant alleges that the disputed domain name <novartiseg.com> is identical or confusingly similar to the NOVARTIS trademark or service mark in which the Complainant has rights arguing that the disputed domain name incorporates in its second level-portion the Complainant's well-known trademark NOVARTIS in its entirety in combination with the term "eg".

The Complainant submits that the letters "eg", are the extension the country code Top-Level Domain ("ccTLD") extension for Egypt <.eg>.

Previous panels established under the Policy have constantly held that the mere addition of a geographical term – in the present case the ccTLD "EG" used for Egypt – would not prevent a finding of confusing similarity to a trademark (see *RooFoods Ltd v. Domain Privacy Service FBO Registrant*, *The Endurance International Group, Inc. / Mustapha Ait Oumejjoud*, WIPO Case No. D2021-0571; *Compagnie Générale des Etablissements Michelin v. yinghui () / Zhang Hang ()*, WIPO Case No. D2021-2020; and *3Shape A/S v. Sparta Polis Hosting*, CAC Case No. 102173 *Minerva S.A. c. Domain Administrator, Fast Serv Inc. d.b.a. QHoster.com*, WIPO Case No. D2019-2767).

The Complainant adds that the presence of the generic Top-Level Domain ("gTLD") extension <.com> in the first level-portion of the disputed domain name is a standard registration requirement and may be disregarded when assessing whether the disputed domain name is confusingly similar to the trademark in which the Complainant has rights (see *Rollerblade, Inc. v. Chris McCrady*, WIPO Case No. D2000-0429; *Can Pro Pet Products LTD. v. Matthew Dweck*, WIPO Case No. D2020-0615; *Sanofi v. Aamir Hitawala*, WIPO Case No. D2021-1781).

The Complainant next alleges that the Respondent has no rights or legitimate interests in respect of the domain name, arguing that there is no evidence that the Respondent is known by the disputed domain name or owns any corresponding registered trademarks.

The Complainant avers that when conducting online trademark databases searches, no information is found in relation with trademarks corresponding to the terms "novartiseg.com", "novartiseg" or "novartis eg". Moreover, the Registrant under the names "ZEZ MEDIA" or "Doaa Mohamed" appears not to own any trademark rights on the aforementioned terms.

Furthermore, the Complainant submits that the name of the registrant of the disputed domain name is "ZEZ MEDIA, Doaa Mohamed" as disclosed in the Notification of Registrant information dated February 27, 2023. It is contended that the registrant's name does not correspond to the disputed domain name <novartiseg.com>.

Referring to search reports exhibited in an annex to the Complaint, the Complainant submits that when conducting a search online through popular search engines, associating the names "ZEZ MEDIA" or "Doaa Mohamed" with the terms "novartiseg.com", "novartiseg" or "novartis eg" is no relevant results are found.

Referring further to the search reports exhibited with the Complaint, the Complainant adds that when conducting a search online on a dedicated search website regarding a company in Caro, Egypt, named "ZEZ MEDIA" no results are found. A search about the name "Novartis" on the same website leads to the listing of "Novartis Pharma" which is Novartis Pharma S.A.E., based in Cairo, a company part of the Novartis group. Moreover, when searching the name "Novartis Agro Egypt" no results are found as to a company based in Egypt.

Furthermore, the Complainant asserts that it has never granted the Respondent any right to use the NOVARTIS trademark in the disputed domain name, nor is the Respondent affiliated to the Complainant in any form.

It is further alleged that the Respondent is also masking its identity on the publicly available Registrar's Whols regarding the disputed domain name. It appears that the Respondent is aiming at hiding its true identity rather than being known by the disputed domain name <novartiseg.com>.

Moreover, the Complainant submits, referring to search reports exhibited in annexes to the Complaint, when searching on popular Internet search engines for the terms "novartis", alone or in combination with the term "EG", the vast majority of the results directly relate to the Novartis group, the Complainant as well as its website, its social medias accounts or related topics.

The Complainant concludes that Respondent has not been using the disputed domain name in connection with a bona fide offering of goods and services, nor making a legitimate noncommercial or fair use of the disputed domain name.

The Complainant further refers to a screen capture of the website to which the disputed domain name resolves which has been adduced in evidence in an annex to the Complaint. The exhibited screen capture shows that the website to which the disputed domain name resolves purports to offer for sale medical products and devices as well as alleged agriculture fertilizers products.

The exhibited evidence shows that on October 25 and 26, 2023, the website associated to the disputed domain name indeed displayed medical products for sale such as a microscope, thermometer, Covid-19 hand gloves, face masks and hand sanitizer.

The Complainant adds that at the time of filing this Complaint, the same website mainly displayed alleged agriculture fertilizers products. Nevertheless, under the section "Shop", face masks – which can especially be used in the medical field – are still advertised for sale. Under the same section, when clicking on the product "Nova Mix Wheat" displayed, Internet users are led to a corresponding page on which a "Blood Pressure Meter" is also advertised for sale. Moreover, words or mentions on the website associated to the disputed domain name, such as "Offers", "Shop", "My Cart" or "Buy now", clearly refer to the activity of sale.

Furthermore, on the website, under the section "About US", the mention "Novartis Agro Egypt" is displayed. On the same website, under the section "Contact Us" as well as at the bottom of each page, an address email incorporating the NOVARTIS trademark "support@novartiseg.com" is displayed.

The Complainant next alleges that the disputed domain name was registered and is being used in bad faith, arguing that the Complainant had long established rights in the NOVARTIS mark established by its ownership of the abovementioned trademark and service mark registrations and long international use of the mark including in Egypt and on the Internet, prior to the registration of the disputed domain name on October 11, 2022.

The Complainant adds that the structure of the disputed domain name being a combination of the NOVARTIS mark and the letters "eg" signifying a relationship with Egypt, reveals that the Respondent's initial intention in registering the disputed domain name was to refer to the Complainant, its trademark and business activities.

The Complainant submits that the registrant had actual knowledge of Complainant and its mark prior to the registration of the disputed domain name and deliberately chose to use the well-known trademark NOVARTIS in the disputed domain name to benefit from the Complainant's worldwide renown trademark, by diverting Internet users to its website. Internet users may be confused as to the source of the disputed domain name as well as the associated website and believe that the products advertised on the website are produced and commercialized by the Novartis group, which is not the case. Such use of the disputed domain name cannot therefore be considered as a bona fide offering of goods or services nor as legitimate noncommercial or fair use.

It therefore appears that the Respondent deliberately chose to use the well-known trademark NOVARTIS in the disputed domain name to capitalize on the Complainant's worldwide renown NOVARTIS trademark and benefit from it, by diverting Internet users to its own website.

With regard to the Respondent's use of the disputed domain name, the Complainant refers to the screen capture of the website to which the disputed domain name resolves and argues that both the structure of the disputed domain name as well as the content displayed on the associated website aim at creating an association, and a subsequent likelihood of confusion, with the Complainant and its NOVARTIS trademark in Internet users' mind.

The Complainant argues that the disputed domain name is being used in the address of the Respondent's website on which medical products and devices as well as alleged agriculture fertilizers products are offered for sale. The Respondent's website also comprises mentions such as "buy now" and "shop now" as well as a cart. The Complainant argues that the Respondent's website may lure Internet users in believing they can purchase corresponding items. Such use of the disputed domain name aims at attracting Internet users for commercial gain by creating a likelihood of confusion with the Complainant's NOVARTIS trademark as to the sources, sponsorship, affiliation, or endorsement of the aforementioned domain name and associated website.

Moreover, the Complainant states that it sent a cease and desist letter to the Respondent informing of the Complainant's rights regarding the NOVARTIS trademark. Following the letter, the content of the website associated to the disputed domain name slightly changed. References to medical items on the website decreased and were mostly replaced by others related to fertilizers products. The Complainant submits that such change in the content of the website is not a coincidence but very likely pretextual, and despite such change, the disputed domain name has kept been used in connection to a website advertising medical products for sale.

The Respondent

No administratively compliant Response has been filed by the Respondent.

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).

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).

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).

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

The Complainant's Rights

The Complainant has provided convincing, uncontested evidence that it has rights in the NOVARTIS mark, established by the ownership of the portfolio of trademark registrations described above. Furthermore, the Complainant has adduced convincing, uncontested evidence that its NOVARTIS trademark and service mark has an extensive international reputation including in Egypt and promoted by its online presence.

Confusing Similarity

The disputed domain name consists of the Complainant's NOVARTIS mark in its entirety in combination with the letters "eg" and the gTLD <com>/.

The Complainant's NOVARTIS mark is the initial, dominant, and only distinctive element in the disputed domain name. The letters "eg" are a reference to Egypt, particularly in the case of a domain name because in the context of the Internet, <.eg> is the extension for the Egypt's ccTLD.

Additionally, the gTLD extension <.com> does not prevent a finding of confusing similarity as the circumstances of this proceeding, it would be considered to be a necessary technical requirement for a domain name registration.

This Panel finds therefore that the disputed domain name is confusingly similar to the NOVARTIS in the first element of the test in Policy paragraph 4(a)(i).

Rights and Legitimate Interests

The Complainant has made out a prima facie case that Respondent has no rights legitimate interests in the disputed domain name arguing that:

- there is no evidence that the Respondent is known by the disputed domain name or owns any corresponding registered trademarks;
- the Complainant conducted online trademark databases searches and no information was found in relation to any trademarks corresponding to the terms "novartiseg.com", "novartiseg" or "novartis eg";
- the disclosed name of Respondent as registrant of the disputed domain name is "ZEZ MEDIA" or "Doaa Mohamed" and neither own any trademark rights on the aforementioned terms;
- the Respondent as registrant of the disputed domain name is known as "ZEZ MEDIA, Doaa Mohamed" as disclosed in the

Notification of Registrant information dated February 27, 2023, and therefore the registrant's name does not correspond to the disputed domain name <novartiseg.com>;

- reports of searches carried out by the Complainant on a popular search engine, show no results for "ZEZ MEDIA" or "Doaa Mohamed" associated with the terms "novartiseg.com", "novartiseg" or "novartis eg";
- by contrast the exhibited results show that a search about the name "Novartis" on the same website produces listing of "Novartis Pharma" which is Novartis Pharma S.A.E., based in Cairo, a company part of the Novartis group;
- the Complainant has never granted the Respondent any right to use the NOVARTIS trademark in the disputed domain name;
- the Respondent affiliated to the Complainant in any form;
- the Respondent is also masking its identity on the publicly available Registrar's Whois regarding the disputed domain name and is aiming at hiding its true identity rather than being known by the disputed domain name <novartiseg.com>;
- a screen capture which has been adduced in evidence in an annex to the Complaint shows that over a period, the website to which the disputed domain name resolves has purported to offer for sale medical products and devices such as microscopes, thermometers, Covid-19 hand gloves, face masks and hand sanitizer, as well as alleged agriculture fertilizers products;
- the same website, under the section "About US", mentions "Novartis Agro Egypt" is displayed and the Complaint has carried out internet searches but has not found any results for "Novartis Agro Egypt";
- therefore Respondent has not been using the disputed domain name in connection with a bona fide offering of goods and services, nor making a legitimate noncommercial or fair use of the disputed domain name.
- It is well established that once a complainant makes out a prima facie case that a respondent has no rights or legitimate interests in the domain name at issue, the burden of production shifts to the respondent to prove its rights or legitimate interests.

Respondent has failed to discharge that burden and therefore this Panel must find that Respondent has no rights or legitimate interests in the disputed domain name.

Complainant has therefore succeeded in the second element of the test in Policy paragraph 4(a)(ii).

Registration and Use in Bad Faith

The Complainant has adduced clear and convincing, uncontested evidence that it has trademark and service mark rights in the NOVARTIS mark which predate the registration and first use of the disputed domain name on October 11, 2022.

The evidence shows that the Complainant's has an extensive goodwill and reputation in the use of the NOVARTIS mark which is distinctive in character.

Given the fame and reputation of the NOVARTIS mark is it improbable that the disputed domain name which consists of the mark in its entirety in combination with only the letters "eg", signifying Egypt and the <.eg> ccTLD, might have been registered without knowledge of the Complainant's name, mark, reputation and pre-existing rights.

This Panel finds therefore that on the balance of probabilities the disputed domain name was registered in bad faith with Complainant in mind. The intention of the registrant was to create an association with the Complainant and to take predatory advantage of the goodwill and fame of the NOVARTIS mark.

The uncontested evidence adduced by Complainant shows that the disputed domain name has been used to as the address of a website which purports to offer the same types of goods as those produced by the Complainant as well associated agricultural goods. It is also worrying that it appears that the Respondent has used the disputed domain name to establish an email account which it invites unsuspecting Internet users to use as a means of contact with the Respondent.

The similarity of the disputed domain name and the Complainant's mark will inevitably create confusion among Internet users who will associate the Respondent's website with the Complainant.

On the balance of probabilities, such use of the disputed domain name for the purposes and confusing and misdirecting unsuspecting Internet users constitutes use of the disputed domain name in bad faith for the purposes of the Policy.

As this Panel has found that the disputed domain name was registered and is being used in bad faith, Complainant has succeeded in the third element of the test in Policy paragraph 4(a)(iii).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **novartiseg.com**: Transferred

PANELLISTS

Name James Bridgeman

DATE OF PANEL DECISION 2023-03-31

Publish the Decision
