

Decision for dispute CAC-UDRP-105273

Case number CAC-UDRP-105273

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Domain names novartis.cfd

Case administrator

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

Complainant

Organization Novartis AG

Complainant representative

Organization BRANDIT GmbH

Respondent

Name Frank Disk

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 following trademark registrations:

- The Swiss trademark NOVARTIS No. 2P-427370, registered on July 1, 1996, for the goods and services in classes 1, 2, 3, 4, 5, 7, 8, 9, 10, 14, 16, 17, 20, 28, 29, 30, 31, 32, 40 and 42;
- The International trademark NOVARTIS No. 663765, registered on July 1, 1996, for the goods and services in classes 1, 2, 3, 4, 5, 7, 8, 9, 10, 14, 16, 17, 20, 22, 28, 29, 30, 31, 32, 40 and 42;
- The European Union trademark NOVARTIS No. 304857, registered on June 25, 1999, for the goods and services in classes 1, 5, 9, 10, 29, 30, 31 and 32;
- The United States trademark NOVARTIS No. 2336960, registered on April 4, 2000, for the goods in class 5;
- The United States trademark NOVARTIS No. 2997235, registered on September 20, 2005, for the goods in class 5; and
- The United States trademark NOVARTIS No. 4986124, registered on June 28, 2016, for the goods and services in classes 5, 9, 10, 41, 42 and 44.

The Complainant proved its ownership of listed trademark registrations by the submitted extracts from the Registers.

FACTUAL BACKGROUND

The Complainant 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, 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. The Complainant's products are manufactured and sold in many countries worldwide, including in the United States of America, a country where it has an active presence through its subsidiaries and associated companies.

The Complainant is the owner of the registered well-known trademark NOVARTIS in numerous jurisdictions all over the world. The vast majority of these trademark registrations predate the registration of the disputed domain name <novartis.cfd>.

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 owns numerous domain names composed of its trademark NOVARTIS alone, including <novartis.com> (registered in 1996), <novartis.us> (registered in 2002) or in combination with other terms, such as <novartispharma.com> (registered in 1999). The Complainant uses these domain names to resolve to its official websites through which it informs Internet users and potential consumers about its NOVARTIS mark and its related products and services. The Complainant also enjoys a strong presence online via its official social media platforms.

The disputed domain name <novartis.cfd> (hereinafter "disputed domain name") was registered on September 2, 2022 and resolves to a PPC page.

According to the Registrar verification, the Respondent is frank disk. The Respondent's provided address as being at Maryville, United States.

PARTIES CONTENTIONS

COMPLAINANT:

1. The Complainant contends that the disputed domain name is confusingly similar to the Complainant's trademarks.

The Complainant contends that the disputed domain name is confusingly similar to its NOVARTIS well-known and distinctive trademark. The Complainant owns NOVARTIS trademarks registered in numerous jurisdictions, which were registered many years before the registration of the disputed domain name on September 2, 2022, such as but not limited to list above.

The Complainant contends that the disputed domain name incorporates NOVARTIS well-known trademark in its entirety and therefore it is identical to the Complainant's trademark.

1. The Complainant states that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant contends that 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.

The Complainant adds that there is no evidence that the Respondent is known by the disputed domain name or owns any corresponding registered trademarks. The Registrant name "Frank Disk" does not correspond to the disputed domain name nor the name "Novartis". When conducting online trademark databases searches, no information is found in relation to trademarks corresponding to the terms "novartis.cfd" or "novartis cfd".

The Complainant asserts that when searching on popular Internet search engines for the terms "novartis", alone or in combination with the term "cfd", 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 contends that the disputed domain name resolves to a Pay-Per-Click page ("PPC page"). PPC pages generate revenues when Internet users click on the links displayed on the page. The PPC page associated to the disputed domain displays relevant sponsored links which clearly refer to the Complainant and its business activity as they are entitled "Pharma", "Pharma Agenturen", "Pharma Ausbildung" and "Sandoz". The Respondent is very likely obtaining a financial benefit when Internet users are clicking on the aforementioned links. 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 PPC page. When "the business model in this case, was for the Respondent to passively collect click-through revenue generated solely from the Complainant's goodwill and Internet users' inaccurate guessing of the correct domain name associated with the Complainant's RENAULT financial services", it has been held that the "[e]xploitation of the reputation of a trademark to obtain click-through commissions from the diversion of Internet users is a common example of use in bad faith as referred to in paragraph 4(b)(iv) of the Policy and identified in many previous UDRP decisions" (see Renault SAS v. Domain Administrator, See PrivacyGuardian.org / Simon Pan, WIPO Case No. D2019-3208). Moreover, when the use of the disputed domain name was in connection with "a parking page displaying PPC links, from which Respondent derived click-through revenue", the UDRP Panel considered that such use "signals a further attempt on the part of Respondent to take unauthorized commercial advantage of Complainant's trademarks in bad faith" (see Amazon Technologies, Inc. and Amazon Europe Core S.à.r.l. v. Hei Ze Shang Zi, WIPO Case No. D2020-3012).

The Complainant assumes that it the Respondent deliberately chose to use NOVARTIS well-known trademark in the disputed domain name to benefit from the Complainant's worldwide renown trademark and to confuse Internet users as to the source of the disputed domain name and the associated web page. 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.

1. The Complainant contends that the domain name has been registered and is being used in bad faith.

2. Registration of the disputed domain name in bad faith

The Complainant contends that its 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. The Respondent registered the disputed domain name many years after the registrations of the Complainant's NOVARTIS trademark. The NOVARTIS trademark is a widely known trademark registered in many countries and the Complainant enjoys a strong online presence. The Novartis group especially owns and used the domain name <novartis.us> which redirects Internet users to a dedicated web page (<https://www.novartis.com/us-en/>), which is part of its main website at <novartis.com>, especially intended for an audience in the United States and informing on the Novartis group presence and activities in this country. The Complainant is very active on social media to promote its mark, products and services (See, Laboratoires M&L v. Zhaoxingming, CAC Case No. 102277). By conducting a simple online search regarding the name "Novartis" alone or in combination with the term "cfd" on popular search engines, the Respondent would have inevitably learnt about the Complainant, its trademark and business (see Intesa Sanpaolo S.p.A. v. Abayomi Ajileye, CAC Case No. 102396).

Moreover, as indicated above, the Novartis group has an established business presence in United States, via its subsidiaries and associated companies, country where the Respondent is based.

Therefore, according to the Complainant, the Respondent had knowledge of the Complainant and the NOVARTIS trademark at the time of the registration of the disputed domain name. It appears that the Respondent registered the disputed domain name in bad faith.

1. Use of the disputed domain name in bad faith

The Complainant states that the disputed domain name resolves to a PPC page which is likely to generate revenues when Internet users click on the links displayed therein. The Respondent is obtaining a financial benefit when Internet users are clicking on the aforementioned links. 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 PPC page. In that regard, the Complainant contends that the Respondent is using the disputed domain name in bad faith.

The Complainant asserts that the Respondent is likely trying to conceal its identity regarding the ownership of the disputed domain name – as his name and contact details are covered by a privacy shield in the corresponding Whois record – which is further evidence of bad faith (Instagram, LLC v. Registration Private, Domains By Proxy, LLC / Murat Sander, WIPO Case No. D2021-0526).

Furthermore, on September 12, 2022, the Complainant sent a cease-and-desist letter to the Respondent informing of the Complainant's rights regarding the NOVARTIS trademark. On September 13, 2022, the Respondent replied asking "how should [the Parties] go about it". On October 21, 2022, the Complainant offered to the Respondent to settle the matter amicably. In this regard, the Complainant invited the Respondent to provide the authorization code related to the disputed domain name to enable the corresponding transfer from the Respondent to the Complainant. On November 10, 2022, the Respondent sent the authorization code to the Complainant. However, as the disputed domain name was locked, on the same day the Complainant wrote to the Respondent that it takes actions before the Registrar to unlock the disputed domain name. The Complainant sent three reminders via emails to the Respondent to which the latter did not reply.

The aforementioned facts demonstrate that the Respondent has been using the disputed domain name in bad faith.

The overall described circumstances are clear demonstration of the registration and use of the disputed domain name are in bad faith.

RESPONDENT:

No administratively Complaint 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 UDRP).

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 UDRP).

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 UDRP).

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

In the present case, the Respondent has not submitted any Response and consequently has not contested any of the contentions made by the Complainant. The Panel proceeds therefore to decide only on the basis of the Complainant's factual statements and the documentary evidence provided in support of them (Paragraph 5(f) of The Rules).

1. CONFUSING SIMILARITY

The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (hereinafter referred to as "The WIPO Overview 3.0") in Paragraph 1.2.1 states: "Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case".

The WIPO Overview 3.0 in Paragraph 1.7 states: "[...] in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing."

Using of the generic Top-Level Domain ".cfd" is generally disregarded in the similarity test "as it does not add anything to the distinctiveness of the disputed domain name" (see CAC case No. 102399; WIPO Overview 3.0 in Paragraph 1.11.1).

The Complainant has established that owns numerous trademark registrations for the term NOVARTIS designated for classes in connection with, among others, pharmaceutical products.

The Complainant's trademark is incorporated in its entirety and clearly recognizable in the disputed domain name <novartis.cfd>. The addition of the gTLD <.cfd> does not change the overall impression of the disputed domain name either.

As stated in the WIPO Overview 3.0 in Paragraph 1.7 where a domain name incorporates the entirety of a trademark, the domain will normally be considered confusingly similar.

Therefore, the disputed domain <novartis.cfd> as it reproduces the NOVARTIS trademark in its entirety is considered to be confusingly similar to the relevant trademark.

As a result, the Panel finds that the Complainant has satisfied the condition pursuant to Paragraph 4(a)(i) of the UDRP.

1. THE RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAME

The Panel finds that the Respondent lacks rights or legitimate interests in the disputed domain name.

According to Paragraph 4(a)(ii) of the UDRP, the Complainant shall make case that the Respondent lacks rights and legitimate interests in the disputed domain name. If the Complainant fulfills this demand, the burden of proof shifts to the Respondent and so the Respondent shall demonstrate rights or legitimate interests in the disputed domain name. If the Respondent fails to prove its rights or legitimate interests, it is assumed that the Complainant satisfied the element of Paragraph 4(a)(ii) of the UDRP (see CAC Case No. 102430, Lesaffre et Compagnie v. Tims Dozman).

Moreover, past panels were of the view that it is difficult or sometimes impossible to prove negative facts, i.e., absence of rights or

legitimate interest on the part of the Respondent. In this respect, previous panels referred to the WIPO Case No. D2000-1769, Neusiedler Aktiengesellschaft v. Vinayak Kulkarni. Within the meaning of Paragraph 4(a)(ii) of the UDRP, once the Complainant has made something credible (prima facie evidence), the burden of proof shifts to the Respondent to show that he has rights or legitimate interests in the domain name at issue by providing particular evidence.

In the CAC Case No. 102279, FileHippo s.r.o. v. whois agent, the panel stated that “[i]n the absence of a response, the Panel accepts the Complainant’s allegations as true that the Respondent has no authorization to use the Complainant’s trademarks in the disputed domain name. Hence, as the Complainant has made out its prima facie case, and as the Respondent has not demonstrated any rights or legitimate interests as illustrated under Paragraph 4(c) of the Policy, nor has the Panel found any other basis for finding any rights or legitimate interests of the Respondent in the disputed domain name, the Panel concludes that the Complainant has satisfied the requirements of Paragraph 4(a)(ii) of the Policy.”

In the FORUM Case No. FA 1781783, Skechers U.S.A. Inc. v. Chad Moston / Elite Media Group, the panel stated that: “where a response is lacking, WHOIS information can support a finding that the respondent is not commonly known by the disputed domain name”.

In the present case, the Complainant states and proves that the Respondent is not known by the disputed domain name and is not identified in the Whois. The Complainant also contends that the Respondent is not affiliated with nor authorized by the Complainant in any way and so the Respondent does not have any rights or legitimate interests in respect of the disputed domain name.

There was no connection found between the Respondent and the term “Novartis” in the trademark database or on the Internet search engine proven by the search results.

Furthermore, the disputed domain resolves to a Pay-Per-Click page (evidenced by print-screen of the webpage) which generates revenue when users click on the links displayed on the page. As was evidenced by the Complainant, the disputed domain resolves to a website displaying sponsored links that clearly refer to the Complainant and its business activities as they are entitled “Pharma”, “Pharma Agenturen”, “Pharma Ausbildung” and “Sandoz”. This Panel agrees with the Complainant that the Respondent is financially benefiting from the likelihood of confusion created by the incorporation of the Complainant’s trademark into the disputed domain name.

To the satisfaction of this Panel, the Complainant has shown a prima facie case that the Respondent has no rights to the Complainant’s trademarks nor the disputed domain name.

The Respondent did not reply to the Complaint and so failed to demonstrate its rights or legitimate interests in the disputed domain name.

Therefore, the Panel finds that the Complainant has satisfied the requirement under Paragraph 4(a)(ii) of the UDRP.

1. THE REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME IN BAD FAITH

The Panel finds that the Respondent registered and used the disputed domain name in bad faith.

The WIPO Overview 3.0 in Paragraph 3.1 states: “bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant’s mark. To facilitate assessment of whether this has occurred, and bearing in mind that the burden of proof rests with the complainant, UDRP paragraph 4(b) provides that any one of the following non-exclusive scenarios constitutes evidence of a respondent’s bad faith: [...] by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the respondent’s website or location or of a product or service on the respondent’s website or location.”

The WIPO Overview 3.0 in Paragraph 3.1.4 states: “Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar [...] to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.”

In the WIPO Case No. D2006-1440, National Football League v. Thomas Trainer, the Panel stated: “when a registrant, such as the Respondent here, obtains a domain name that is confusingly similar to a famous mark, with no apparent rights or legitimate interests in the name, and then fails to respond to infringement claims and a UDRP Complaint, an inference of bad faith is warranted.”

In the present case, the Complainant owns various trademark registrations consisting of the term NOVARTIS (evidenced by excerpts from the pertinent registers). Moreover, the Complainant has a certain reputation in the pharmaceutical and healthcare industry globally as proven by the Complainant. Past Panels declared that the Complainant’s trademark is well-known (see WIPO Case No. D2020-3203, Novartis AG v. Amartya Sinha, Global Webs Link, Novartis RO).

It was also demonstrated that a common Internet search for the term “Novartis” refers mostly to the Complainant’s domain name and trademark. Therefore, this Panel assumes that the Respondent must have been aware of the Complainant’s trademarks and its reputation before the registration of the disputed domain on September 2, 2022.

To the satisfaction of this Panel, it is established that the Respondent registered the disputed domain name which incorporates the

entirety of the Complainant's well-known trademark.

Additionally, the Respondent is not recognized as the disputed domain name and cannot be identified from the Whois database. Therefore, the domain name was registered by an unknown and unaffiliated entity.

Furthermore, the disputed domain name resolves to a PPC page which, by displaying the commercial (pharmaceutical-like) links, generates revenue for the Respondent. Past panels declared that "[e]xploitation of the reputation of a trademark to obtain click-through commissions from the diversion of Internet users is a common example of use in bad faith as referred to in paragraph 4(b) (iv) of the Policy and identified in many previous UDRP decisions" (see WIPO Case No. D2019-3208, Renault SAS v. Domain Administrator, See PrivacyGuardian.org / Simon Pan). Moreover, when the use of the disputed domain name was in connection with "a parking page displaying PPC links, from which Respondent derived click-through revenue", the UDRP Panel considered that such use "signals a further attempt on the part of Respondent to take unauthorized commercial advantage of Complainant's trademarks in bad faith" (see WIPO Case No. D2020-3012, Amazon Technologies, Inc. and Amazon Europe Core S.à.r.l. v. Hei Ze Shang Zi).

To the satisfaction of this Panel, the Respondent is using the disputed domain name in order to obtain financial gain in relation to created likelihood of confusion with the Complainant's trademark NOVARTIS and therefore the Respondent registered and is using the disputed domain name in bad faith.

Following the above-mentioned, the Panel finds that the Complainant has satisfied Paragraph 4(a)(iii) of the UDRP.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **novartis.cfd**: Transferred

PANELLISTS

Name	Radim Charvát
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DATE OF PANEL DECISION **2023-04-18**

Publish the Decision
