

Decision for dispute CAC-UDRP-105352

Case number CAC-UDRP-105352

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Domain names noivartis.com

Case administrator

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

Complainant

Organization Novartis AG

Complainant representative

Organization BRANDIT GmbH

Respondent

Organization jonhfriday

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 registered as both a word and device mark in several classes worldwide, including in the United States. The trademark registrations with the United States Patent and Trademark Office (USPTO) include: "NOVARTIS" Reg. No. 4986124 registered on June 28, 2016, in classes of ICGS: 5, 9, 10, 40, 41, 42, 44; "NOVARTIS" Reg. No. 5420583 registered on March 13, 2018, in classes of ICGS: 9, 10, 41, 42, 44, 45. The Complainant owns International Reg. No. 1544148 for the mark "NOVARTIS" registered on June 29, 2020, in classes of ICGS: 9, 35, 38, 42.

FACTUAL BACKGROUND

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 enjoys a local presence in the United States, where the Respondent is located. The Complainant has subsidiaries and associated companies based in the United States and has been playing an active role on the local market and in its society.

The disputed domain name was registered on March 1, 2023.

PARTIES CONTENTIONS

COMPLAINANT:

- i) The Complainant has rights in the "NOVARTIS" mark as identified in section "Identification of rights" above. The disputed domain name is confusingly similar to the Complainant's NOVARTIS mark because it incorporates, in its second level portion, a typo of the Complainant's well-known, distinctive trademark NOVARTIS by the addition of a second letter "i" after the letter "o."
- ii) The Respondent has no rights or legitimate interests in respect of the disputed domain name: the Respondent does not have any previous relationships with the Complainant, 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 Respondent is not commonly known by the disputed domain name; the Respondent registered the disputed domain name for capitalizing on Internet users' misspelling mistakes, without legitimate interest and did not intend to use it for any bona fide offering of goods or services; and the disputed domain name does not resolve to any active page.
- iii) The Respondent has registered and is using the disputed domain name in bad faith: the Respondent has registered and used the disputed domain name with actual knowledge of the Complainant's rights in the NOVARTIS mark; the mere registration of the disputed domain name that is confusingly similar to the Complainant's famous trademark can by itself create a presumption of bad faith; the disputed domain name does not resolve to any active page, and such a passive holding constitutes bad faith registration and use of the disputed domain name given several factual considerations; typosquatting itself and active MX records associated with the disputed domain name constitute evidence of bad faith registration.

RESPONDENT:

Respondent did not submit a response in this proceeding.

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

Paragraph 15(a) of the Rules for the UDRP ('the Policy') instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

(1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and

(2) Respondent has no rights or legitimate interests in respect of the domain name; and

(3) the domain name has been registered and is being used in bad faith.

In view of the Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. See *Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (FORUM July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); see also *Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) ("In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.").

Rights

The Complainant contends that it is the owner of the registered trademark 'NOVARTIS' as identified in section "Identification of rights" above. The Panel notes that a trademark registration with a national trademark agency such as the USPTO is sufficient to establish rights in that mark. As such, the Panel finds that the Complainant has established its rights in the mark "NOVARTIS."

The Complainant further contends that the disputed domain name is confusingly similar to its mark "NOVARTIS" on the grounds that the disputed domain name <noivartis.com> incorporates, in its second level portion, a typo of the Complainant's well-known, distinctive trademark NOVARTIS by the addition of a second letter "i" after the letter "o," which is a typosquatting situation. Misspelling a mark, such as through adding a letter or exchanging letters, is insufficient to defeat a finding of confusing similarity. See *Omaha Steaks International, Inc. v. DN Manager / Whois-Privacy.Net Ltd*, FA 1610122 (Forum July 9, 2015) (finding, "The domain name differs from the mark only in that the domain name substitutes the letter 'a' in the word 'steak' with the letter 'c' and adds the generic top-level domain ('gTLD') '.com.' These alterations of the mark, made in forming the domain name, do not save it from the realm of confusing similarity under the standards of the Policy."). Given that the Respondent only misspells the NOVARTIS mark by a single letter, the Panel finds the disputed domain name is confusingly similar to the Complainant's NOVARTIS mark under Policy paragraph 4(a)(i).

No rights or legitimate interests

A complainant must first make a prima facie case that a respondent lacks rights and legitimate interests in the disputed domain name under Policy paragraph 4(a)(ii), then the burden shifts to the respondent to show it does have rights or legitimate interests. See *Croatia Airlines d. d. v. Modern Empire Internet Ltd.*, WIPO Case No. D2003-0455 (the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the UDRP). See also *Advanced International Marketing Corporation v. AA-1 Corp*, FA 780200 (FORUM Nov. 2, 2011) (finding that a complainant must offer some evidence to make its prima facie case and satisfy Policy paragraph 4(a)(ii).

The Complainant contends that i) the Respondent does not have any previous relationships with the Complainant, nor has the Complainant ever granted the Respondent with any rights to use the NOVARTIS trademark in any forms, including the disputed domain name; ii) the Respondent is not commonly known by the disputed domain name from the fact that the WHOIS information lists the Respondent as "Jonh Friday," which is not connected to the Complainant nor to the term "Novartis" in any form; iii) when entering the term "noivartis" or "noivartis.com" in the Google search engine, the returned results all pointed to the Complainant and its business activities; and iv) there is no evidence showing that the Respondent has been using, or preparing to use, the disputed domain name in connection with a bona fide offering of goods and services or has made a legitimate noncommercial or fair use of the disputed domain name.

Given the circumstances above, the Panel finds the Respondent is not commonly known by, and lacks rights or legitimate interests in, the disputed domain name per Policy paragraph 4(c)(ii). The Complainant provides a screenshot showing the disputed domain name resolves to an error page which states, "This site can't be reached." The Panel finds the Respondent's failure to actively use the disputed domain name as evidence that the Respondent lacks rights or legitimate interests in the disputed domain name under Policy paragraph 4(c)(ii). The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

Bad faith

Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that the complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting

the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 the respondent's website or location or of a product or service on the respondent's website or location.

The Complainant contends that the Complainant's trademark predates the registration of the disputed domain name; and the Respondent very likely knows about the Complainant and its trademark because the Complainant's trademark NOVARTIS is a distinctive and well-known trademark worldwide.

While constructive knowledge is insufficient for a finding of bad faith, per Policy paragraph 4(a)(iii), registration of an infringing domain name with actual knowledge of another's trademark rights is sufficient to establish bad faith, and can be shown by the notoriety of the mark and the use Respondent makes of the disputed domain name. See *Orbitz Worldwide, LLC v. Domain Librarian*, FA 1535826 (Forum February 6, 2014) ("The Panel notes that although the UDRP does not recognize 'constructive notice' as sufficient grounds for finding Policy paragraph 4(a)(iii) bad faith, the Panel here finds actual knowledge through the name used for the domain and the use made of it."); see also *AutoZone Parts, Inc. v. Ken Belden*, FA 1815011 (Forum December 24, 2018) ("Complainant contends that Respondent's knowledge can be presumed in light of the substantial fame and notoriety of the AUTOZONE mark, as well as the fact that Complainant is the largest retailer in the field. The Panel here finds that Respondent did have actual knowledge of Complainant's mark, demonstrating bad faith registration and use under Policy paragraph 4(a)(iii)."). The Panel agrees and infers, due to the notoriety of the Complainant's mark around the world and in the United States where the Respondent resides that the Respondent had actual knowledge of the Complainant's rights in the NOVARTIS mark at the time of registering the disputed domain name, and thus the Panel finds the bad faith registration of the disputed domain name.

Next, the Complainant contends that the disputed domain name resolves to an inactive page, which constitutes registration and use of the disputed domain name in bad faith on the grounds that:

i) given the strong online presence of the Complainant and its NOVARTIS trademark as well as its business presence in the United States, where the Respondent appears to be based, it is implausible that the Respondent did not know them when he registered the disputed domain name;

ii) there is no evidence of any actual or contemplated good-faith use of the disputed domain name;

iii) the Respondent's non-response to the Complainant's Cease and Desist letter infers bad faith use of the disputed domain name; and

iv) a reverse Whois search with the e-mail address of the Respondent indicates that the Respondent is involved in a pattern of abusive registrations of the domain names incorporating other brands, including widely known.

The Panel agrees that the passive holding of a domain name does not necessarily circumvent a finding that the domain name is being used in bad faith within the requirements of paragraph 4(a)(iii) of the Policy. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003 (finding that in considering whether the passive holding of a domain name, following a bad faith registration of it, satisfies the requirements of paragraph 4(a)(iii), the panel must give close attention to all the circumstances of the respondent's behavior, and a remedy can be obtained under the Policy only if those circumstances show that the respondent's passive holding amounts to acting in bad faith.).

Taking into account the notoriety of the Complainant's mark; the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the disputed domain name; and other factual circumstances as the Complainant points out, the Panel concludes that the Respondent's passive holding of the disputed domain name constitutes bad faith registration and use per paragraph 4(b) (iii) and (iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **noivartis.com**: Transferred

PANELLISTS

Name **Mr. Ho-Hyun Nahm Esq.**

DATE OF PANEL DECISION **2023-05-14**
