

## Decision for dispute CAC-UDRP-105373

Case number	CAC-UDRP-105373
Time of filing	2023-04-19 10:39:12
Domain names	novartispharmaceutical.com

### Case administrator

Name	Olga Dvořáková (Case admin)
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### Complainant

Organization	Novartis AG
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### Complainant representative

Organization	BRANDIT GmbH
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### Respondent

Organization	Novartis Pharmaceuticals
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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 registered in several classes worldwide, including in the United States. The Complainant's trademark registrations in the United States applying to the present proceedings include the following earlier rights:

#### United States (USPTO) Trademark registration for NOVARTIS

Reg. No.: 2336960

First Reg. date: April 4, 2000

#### United States (USPTO) Trademark registration for NOVARTIS

Reg. No.: 4986124

Reg. date: June 28, 2016

#### International Registration for NOVARTIS, designating the United States

Reg. no: 1544148

Reg. date: June 29, 2020

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) or in combination with other terms, such as <novartispharma.com> (registered in 1999).

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#### FACTUAL BACKGROUND

The Complainant as a large pharmaceutical company owns numerous trademarks consisting or including of the sign NOVARTIS which were registered before the registration of the Disputed Domain Name on March 4, 2023.

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#### PARTIES CONTENTIONS

##### COMPLAINANT:

**(i) The domain name is 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 Name, which, according to the publicly available WHOIS records and the Registrar verification was registered on March 4, 2023.

The Disputed Domain Name, in its second level portion, incorporates the trademark NOVARTIS in its entirety, followed by the term “pharmaceutical” which is a misspelled form of the common noun “pharmaceutical”, which directly refers to the Complainant and its business, since, as previously mentioned, the Complainant is a company which develops and delivers drugs (pharmaceuticals) worldwide.

The NOVARTIS trademark is clearly recognizable within the Disputed Domain Name. 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 (see *Novartis AG v. Black Roses*, CAC Case No. 102137).

WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Jurisprudential Overview 3.0”) 3.0 para. 1.8 states: “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”.

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).

**(ii) The Respondent has no rights or legitimate interests in respect of the domain name(s)**

The Complainant and the Respondent have never had any previous relationship, nor has the Complainant ever granted the Respondent with any rights to use the NOVARTIS trademark in any form, including in the Disputed Domain Name.

The Complainant has not found that the Respondent is commonly known by the Disputed Domain Name or that they have a legitimate interest over the Disputed Domain Name. When searching for the Disputed Domain Name terms “novartispharmaceutical” or “novartispharmaceutical.com” in the Google search engine, the search results all pointed to the Complainant and its business activities. Moreover, when searching on the Google search engine for the terms of the domain name “novartispharmaceutical” or “novartispharmaceutical.com” in combination with the name of the Respondent “John Key”, no results show that the Respondent is known in relation with these terms.

When searching for any trademarks registered including the Disputed Domain Name terms “novartispharmaceutical” or “novartispharmaceutical.com” there are no returned results.

The Respondent should have already performed a similar search before registering the Disputed Domain Name 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 in the United States.

At the time the Complainant found out about the Disputed Domain Name it did not resolve to any active page/content. Similarly, at the time of filing of the complaint, the Disputed Domain Name did not resolve to any active content. Therefore, the Disputed Domain Name is not being used in connection with a bona fide offering of goods or services.

There is no available evidence that the Respondent engages in, or has 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” (see *Bollore v. Tywonina W Hill*, WIPO Case No. DCO2017-0012).

The Complainant found out about the registration of the Disputed Domain Name and sent a Cease and Desist letter on March 13, 2023. The Cease and Desist letter was sent to the e-mail address generated by the privacy service displayed in the WHOIS records. There was no response from the Respondent.

The Respondent has been granted an opportunity to present arguments that they have rights or legitimate interests in the Disputed Domain Name but have failed to do so. This behavior, coupled with the absence of use of the Domain Names in connection with a bona fide offering of goods and services, as well as the fact that the disputed domain name incorporates, in its second level portion, the Complainant’s trademark and a misspelled form of a generic term relevant to the Complainant’s business clearly demonstrate the Respondents’ absence of rights or legitimate interests in respect to the Disputed Domain Name.

In a case with similar factual and legal background, the Panel has asserted that: *“The Respondent has not answered the cease-and-desist letter sent by the Complainant, (...) and has not even explained why he has chosen the peculiar expression “greenlightcarrd” to compose the disputed domain name. (...) Moreover, the composition of the disputed domain name, namely the addition of the misspelled “carrd” to the Complainant’s mark, is such to carry a risk of implied affiliation that cannot constitute fair use.”* (See *Greenlight Financial Technology, Inc. v. Domain Administrator, Fundacion Privacy Services LTD*, WIPO Case No. D2021-3206).

### **(iii) The domain name was registered and is being used in bad faith**

#### **1. Registration of the disputed domain name in bad faith**

It has to be highlighted that the registration of the Complainant’s trademarks pre-date the registration of the Disputed Domain Name and the Respondent has never been authorized by the Complainant to use the NOVARTIS trademark in any form, including in the Disputed Domain Name. The Respondent has chosen to incorporate the distinctive well-known trademark NOVARTIS in the Disputed Domain Names in its entirety, which is in and of itself a strong indication of bad faith in the registration of the Disputed Domain Name (See “WIPO Jurisprudential Overview 3.0”, par 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”*).

As mentioned earlier, the Complainant enjoys a strong online presence. By conducting a simple online search regarding the terms “novartispharmaceutical” or “novartispharmaceutical.com” in the Google search engine the Respondent would have inevitably learnt about the Complainant, its trademark and business (see *Teamreager AB v. Muhsin E.Thiebaut, Walid Victor*, WIPO Case No. D2013-0835, *Amundi Asset Management v. tang xiao ming*, WIPO Case No. D2019-2744).

Furthermore, the Registrar verification revealed that the Respondent’s details mention “Novartis Pharmaceuticals”. To the best of the Complainant’s knowledge, the Complainant and the Respondent have never had any previous relationship. Therefore, the mention of “Novartis Pharmaceuticals” in the Respondent’s details is a clear attempt to refer to the Complainant and may also be seen as an attempt to impersonate the same, which further demonstrates the fact that the Respondent knew the Complainant and its business at the time of registering the Disputed Domain Name, and hence the registration of the Disputed Domain Name in bad faith.

It is therefore inconceivable that the Respondent was unaware of the existence of the Complainant when it registered the Disputed Domain Name.

Furthermore, and as mentioned before, the Disputed Domain Name incorporates, in its second level portion, the Complainant’s Novartis® trademark entirely, with the addition of the term “pharmaceutical”. It must also be highlighted that the term “pharmaceutical” is a misspelled form of the common noun “pharmaceutical”, which directly refers to the Complainant’s business, as the Complainant is a company which develops and delivers drugs (pharmaceuticals) worldwide. Therefore, the combination of such terms in the Disputed Domain Name creates a direct association to the Complainant and its business. The inclusion of (a misspelled form of) a term directly 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 Respondent is most likely intentionally trying to confuse consumers by creating a similarity between the Disputed Domain name and the Complainant. By doing so, the Respondent is 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. Indeed, in similar circumstances, Panels have found that *“the disputed domain name is inherently misleading and constitutes an impersonation of the Complainant. Not only does it wholly incorporate the Complainant’s invented and widely-known trademark VERIZON, but it also includes a misspelling by way of the additional term “comunication”* (See *Verizon Trademark Services LLC v. Mohammad Noman*, *Verizon Communication*, WIPO Case No. D2020-3384).

Moreover, according to the Registrar Verification, the Respondent appears in the WHOIS records as “Novartis Pharmaceuticals” located at 101 Radney Rd, Houston, TX 77024-7334. There is no office/subsidiary of the Complainant under such address and therefore the WHOIS information is false. Also, such WHOIS information shows that the Respondent was well aware of the Complainant when registering the Disputed Domain Name and used the Complainant’s trademark and company name/tradename to submit false WHOIS data.

In light of the above-mentioned circumstances, it is evident that the Respondent registered the Disputed Domain Name incorporating the well-known distinctive trademark NOVARTIS (with the addition of a misspelled form of a term 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 Respondent knew the Complainant's trademark(s) at the time it registered the Disputed Domain Name and therefore registered the Disputed Domain Name in bad faith.

## 1. Use of the Domain Name 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."

Firstly, as previously mentioned, the Disputed Domain Name incorporates, in its second level portion, the Complainant's Novartis® trademark entirely with the addition of the term "pharmaceutical". As highlighted before, this term is a misspelled form of the common English noun "pharmaceutical", which directly refers to the business of the Complainant.

In addition, and as mentioned before, at the time the Complainant found out about the Disputed Domain Name (March 2023), it did not resolve to any active page/content. Similarly, at the time of filing of this complaint, the Disputed Domain Name does not resolve to any active content.

The Disputed Domain Name is passively held. There is no evidence of any actual or contemplated good-faith use of the Disputed Domain Name, as previous UDRP panels held (see *British Airways Plc. v. David Moor*, WIPO Case No. D2006-1224; *Boehringer Ingelheim Pharma GmbH & Co.KG v. Raju Khan*, CAC Case No. 101517).

Moreover, previous UDRP panels have held, under the doctrine of passive holding, that "the non-use of a domain would not prevent a finding of bad faith" (see "WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition", section 3.3). More precisely, "it is possible, in certain circumstances, for inactivity by the Respondent to amount to the domain name being used in bad faith." (see *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003). Indeed, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#), section 3.3") points out that, from the inception of the UDRP, panelists have indeed consistently found that non-use of a domain name does not prevent a finding of bad faith under the doctrine of passive holding and that the factors that panelists take into account, whilst looking at all the circumstances, include":

- (i) the degree of distinctiveness or reputation of the complainant's mark,
- (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use,
- (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and
- (iv) the implausibility of any good faith use to which the domain name may be put."

The Complainant tried to contact the Respondent through a Cease and Desist Letter sent on March 13, 2023. In the Cease-and-Desist letter, the Complainant advised the Respondent that the unauthorized use of their trademarks within the Disputed Domain Names violates their trademark rights and requested a voluntary transfer of the Disputed Domain Names. The Respondents chose not to reply to the Cease and Desist letter sent by the Complainant which infers bad faith (see *International Business Machines Corporation v. Adam Stevenson*, Global Domain Services, WIPO case No. D2016-1695; *Carrefour v. PERFECT PRIVACY, LLC / Milen Radumilo*, WIPO Case No. D2018-2201).

Moreover, active MX records are associated with the Disputed Domain Name (**Annex 10**), which further increases the possibility of internet users to be misdirected by phishing emails sent by email addresses connected to the Disputed Domain Name (such as [info@novartispharmaceutical.com](mailto:info@novartispharmaceutical.com)).

In light of the above mentioned circumstances, the Complainant cannot think of any plausible good faith use to which the Disputed Domain Name may be put. Indeed, in a case with similar factual and legal background, the Panel found "*the Complainant's trademark SODEXO to be distinctive in nature and notes the Respondent's combination of that trademark with the misspelled word "benefgit" and the word "center" within the disputed domain name. In the circumstances, the Panel can conceive of no purpose to the disputed domain name other than to confuse Internet users into believing that the disputed domain name is connected with the Complainant and its services, and the Panel finds therefore that the disputed domain name constitutes an instrument of fraud.*" (See *Sodexo v. Carolina Rodrigues*, WIPO Case No. D2021-1408).

The aforementioned facts demonstrate that the Respondent has been using the Disputed Domain Name in bad faith.

RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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## 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).

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#### 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).

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#### 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).

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#### 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.

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#### PRINCIPAL REASONS FOR THE DECISION

The Disputed Domain Name consists of the Complainant's NOVARTIS trade mark (registered in the USA since 2000 for pharmaceuticals), a misspelling of the common noun pharmaceutical, namely "pharmaceutical" and the gTLD .com. The addition of a misspelling of a common word and a gTLD do not prevent confusing similarity between the Disputed Domain Name and the Complainant's mark.

The Respondent has not been authorised by the Complainant and there is no evidence other than the registration details of the Disputed Domain Name itself to suggest the Respondent is commonly known by the Disputed Domain Name.

The Domain Name has not been used and so there is no bona fide offering of goods or services or a non commercial legitimate or fair use. The Respondent has not replied to this Complaint and has not rebutted the prima facie case evidenced by the Complainant as set out herein.

The Domain Name is being passively held which in the circumstances of an unexplained registration of a domain name containing an unconnected famous mark is registration and use in bad faith.

The Respondent has falsely identified itself as Novartis Pharmaceutical in the Whois details. This in itself is an indication of registration and use in bad faith.

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#### FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **novartispharmaceutical.com** : Transferred
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## PANELLISTS

Name	<b>Dawn Osborne</b>
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DATE OF PANEL DECISION 2023-05-18

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Publish the Decision

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