

Decision for dispute CAC-UDRP-105372

Case number **CAC-UDRP-105372**

Time of filing **2023-04-19 09:50:50**

Domain names **novartisjob.com**

Case administrator

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

Complainant

Organization **Novartis AG**

Complainant representative

Organization **BRANDIT GmbH**

Respondent

Name **Rickey Stevenson**

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 <novartisjob.com>.

IDENTIFICATION OF RIGHTS

Novartis AG (the Complainant) is the owner of registered trademarks for "NOVARTIS" as a word and figure mark in several classes in numerous countries all over the world, including the USA. The vast majority of the Complainant's trademark registrations significantly predate the registration of the disputed domain name.

The Complainant's trademark registrations in the USA 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.

The Complainant owns numerous domain names composed of either its trademark NOVARTIS alone, including <novartis.com> (created on 2 April 1996) or in combination with other terms, e.g. <novartispharma.com> (created on 27 October 1999). The Complainant uses these domain names to promote the NOVARTIS mark with related products and services. The Complainant enjoys a strong presence online also via its official social media platforms.

FACTUAL BACKGROUND

The Complainant is a global pharmaceutical and healthcare company based in Switzerland that provides solutions to address the evolving needs of patients worldwide by developing and delivering innovative medical treatments and drugs. Novartis AG was created in 1996 through a merger of two other companies Ciba-Geigy and Sandoz. The Complainant has a strong presence in the USA where the Respondent is located.

The disputed domain name <novartisjob.com> was registered on 31 March 2023.

PARTIES CONTENTIONS

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

- The disputed domain name is identical or confusingly similar to the protected mark

According to the Complainant, the disputed domain name <novartisjob.com> incorporates entirely the Complainant's well-known, distinctive trademark NOVARTIS with the term "job", which is closely related to the Complainant and its business activities. It's important to underline that these terms directly refer to the Complainant and their business, since, as previously mentioned, the Complainant is global pharmaceutical company with numerous career opportunities and talent acquisition programs.

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"), paragraph 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."

In addition, the presence of the generic Top-Level Domain ("gTLD") extension ".com" in the first level portion of the disputed domain names 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).

Therefore, the Complainant argues that the disputed domain name is confusingly similar to the Complainant's NOVARTIS trademark within the meaning of Paragraph 4(a)(i) of the Policy.

- Respondent does not have any rights or legitimate interest in the disputed domain name

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

The Complainant has not found that the Respondent is commonly known by the disputed domain name or that it has legitimate interest over the disputed domain name or the major part of it. When searched for "novartisjob.com" or "novartisjob" in the Google search engine, the returned results point to the Complainant, its business activities and career opportunities.

According to the Complainant, the Respondent could have easily performed a similar search before registering the disputed domain name and would have quickly learnt that the trademarks are owned by the Complainant and that the Complainant has been using its trademarks in the USA, where the Respondent resides, and in many other countries worldwide. However, the Respondent still chose to register the disputed domain name as such.

From the Complainant's perspective, the Respondent deliberately chose to use the term "job" combined with its well-known, distinctive trademark NOVARTIS clearly with the intention to create an association, and a subsequent likelihood of confusion, with the Complainant and its NOVARTIS trademark in Internet users' mind. The disputed domain name in its structure directly refers to the Complainant and its career opportunities.

At the time of filing of this complaint, the disputed domain name does not resolve to any active page. The disputed domain is passively held. 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. In similar circumstances, it has been decided that when "the Respondent has failed to make use of the resolving website and has not demonstrated any attempt to make legitimate use of the disputed domain name and website. Such conduct evinces a lack of rights or legitimate interests in the disputed domain name and thus, is not making a legitimate noncommercial or fair use of the disputed domain Name" (see *Skandinaviska Enskilda Banken AB v. Nick Jones*, WIPO Case No. D2021-0703; see also *ArcelorMittal (Société Anonyme) v. Registration Private, Domains By Proxy, LLC / Joel Tinoco*, Pixel Design Costa Rica, WIPO Case No. D2021-0909).

Moreover, the Complainant states that the disputed domain name via the e-mail function has been used in order to conduct e-mail

phishing scheme. Namely, the Respondent created an e-mail address associated to the disputed domain name - <brendacobos@novartisjob.com> impersonating the employee of Novartis AG and presenting as a recruiter of Novartis Pharmaceutical (Brenda Cobos) promoting remote administrative job position. The signature reads as "Brenda R Cobos, Recruiter, Novartis". The evidence shows that one of the e-mails was sent on April 3, 2023. One of the job seekers replied to such e-mail confirming availability for a call. In response, the fraudsters informed that the interview will be conducted through messaging and sent a file about "Administrative Job Briefing" which appears to be PDF file having Novartis logo displayed at the background. The file also contains "Job Description". Such e-mails were sent to unknown number of people with malicious intent likely aiming at collecting personal information of job seekers.

According to the Complainant, such actions may also result in monetary loses of the Complainant, its business partners and customers as they may be misled and unintentionally involved in fraud. Consequently, the disputed domain name has therefore not been used in any way in connection with a bona fide offering of goods and services.

Therefore, the Complainant contends that the Respondent has no right nor legitimate interest in respect of the disputed domain name, within the meaning of the Paragraphs 4(a)(ii) and (4)(c) of the Policy.

- The disputed domain name has been registered and is being used in bad faith

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. The Complainant states that the registration of the Complainant's well-known and distinctive trademarks predates the registration of the disputed domain name. The Respondent has never been authorized by the Complainant to register and use the disputed domain name.

The Complainant argues that it is inconceivable that the combination of the well-known, distinctive trademark NOVARTIS and the term "job" in the disputed domain name is not a deliberate attempt to improperly benefit from the Complainant's rights. It reflects the Respondent's clear intention to create an association, and a subsequent likelihood of confusion, with the Complainant's trademark in Internet users' mind. By reading the disputed domain name, the Internet users may believe that it is directly connected to or authorized by the Complainant.

In addition, the dispute domain name was used to send out phishing e-mails. According to the Complainant, the phishing incident took place on April 3, 2023, only few days after registration of the disputed domain name which shows that the Respondent was well aware of the Complainant, its trademarks and business name.

Considering the fact that i) the Complainant enjoys a strong online presence and that the Respondent very likely knew about the Complainant and its trademarks; ii) the Complainant's trademark NOVARTIS is a well-known, distinctive trademark worldwide; the disputed domain name shall be according to the Complainant deemed as registered in bad faith, which is supported by WIPO Overview 3.0, para. 3.1.4.

Therefore, the Complainant contends that the Respondent has registered and used the disputed domain name in bad faith and its conduct falls within the meaning of Paragraph 4(a)(iii) of the Policy.

RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT 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 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 UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (UDRP) of the Internet Corporation for Assigned Names and Numbers (ICANN) (the "Policy") provides that complainant must prove each of the following to obtain transfer or cancellation of the domain name:

1. that respondent's domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights; and
2. that 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.

- 1) The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights

The Panel is satisfied that the Complainant is the owner of trademark registrations for NOVARTIS that predate the registration of the disputed domain name.

The disputed domain name is comprised of the Complainant's well-known trademark NOVARTIS with the term "job". Essentially, the Respondent has appropriated the trademark NOVARTIS by adding a generic term "job" to presumably lead consumers to believe that it is affiliated with the Complainant, its business and career opportunities. Previous UDRP panels have found that the fact that a domain name wholly incorporates a complainant's registered mark is sufficient to establish identity or confusing similarity for the purposes of the Policy (see, e.g., *Oki Data Americas Inc. v ASD, Inc.*, WIPO Case No. D2001-0903).

Additionally, the disputed domain name not only fully incorporate the NOVARTIS trademark but also includes a purely generic top-level domain ("gTLD") "com". Previous UDRP panels have also held that the gTLD ".com" is not to be taken into account when assessing whether a domain name is identical or confusingly similar to a trademark. See e.g., *Wiluna Holdings, LLC v. Edna Sherman, FA 1652781* (Forum 22 January 2016).

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark NOVARTIS.

- 2) The Respondent lacks rights or legitimate interests in the disputed domain name

Under the Policy, a 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 burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy (see WIPO Overview 2.0, paragraph 2.1).

The Panel finds that the Respondent does not have a legal right to use the term "NOVARTIS" as part of the disputed domain name. The Respondent is not in any way affiliated with the Complainant nor is it authorized to register the disputed domain name. The Panel agrees with the Complainant that the Respondent is not commonly known by the disputed domain name or that it has legitimate interest over the disputed domain name. When entering the terms "Novartis" and "job" in the Google search engine, the returned results point to the Complainant, its business and career opportunities.

The Panel finds that the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interest in the disputed domain name. The Respondent failed to file an administratively compliant Response in which it could have provided evidence in support of its rights or legitimate interests. The Respondent is not commonly known by the disputed domain name and has not been authorised by the Complainant to use the term "NOVARTIS". Therefore, all these circumstances are sufficient to establish a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name.

The Panel thus takes the view that the Respondent lacks rights or legitimate interests in the disputed domain name.

- 3) The disputed domain name has been registered and is being used in bad faith

The Panel agrees with the Complainant that its trademark NOVARTIS is distinctive and well-known globally. The Complainant's well-known trademark NOVARTIS predates the registration of the disputed domain name. The Panel finds that there appears no reason why

the Respondent would register the Complainant's trademark as part of the disputed domain name, other than to create the impression that it is connected to the Complainant's business and career opportunities. Given the distinctiveness of the Complainant's trademark worldwide and its strong online presence, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark.

The fact that the Respondent has registered the disputed domain name that is confusingly similar to them indicates and in the absence of any evidence contrary (or any administratively compliant response at all) being put forward by the Respondent, that the Respondent, according to this Panel, had knowledge of the Complainant's trademark and that it had such knowledge prior to the registration and use of the disputed domain name.

Further, the disputed domain name is passively held and was used to send out phishing e-mails only few days after registration of the disputed domain name. This further suggests that the Respondent was well aware of the Complainant, its trademarks and business name. This also suggests the Respondent's sole intention in registering the disputed domain name was to take unfair advantage of the Complainant's NOVARTIS mark and reputation, and suggests registration and use in bad faith.

For all reasons stated above, the Panel is satisfied that the Complainant has proven the third element of the Policy that is that the Respondent's registration and use of the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **novartisjob.com**: Transferred

PANELLISTS

Name	Barbora Donathová
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DATE OF PANEL DECISION 2023-05-25

Publish the Decision