

Decision for dispute CAC-UDRP-105437

Case number CAC-UDRP-105437

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Domain names corpnovartis.com

Case administrator

Name Olga Dvořáková (Case admin)

Complainant

Organization Novartis AG

Complainant representative

Organization BRANDIT GmbH

Respondent

Organization Correo Ilimitado

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 owns several trademark registrations across various jurisdictions, including Peru, where the Respondent is based, inter alia the Peru Trademark for "NOVARTIS", No. P00029207, registered September 16, 1996, the Peru Trademark for "NOVARTIS", No. T00028670, registered September 16, 1996 and the international Trademark for "NOVARTIS", No. 1544148, registered June 29, 2020 (hereinafter cumulatively referred to as the "Trademark").

The Respondent has not presented the Panel with any trademark or common law trademark rights which are relevant for the present case or connected to the disputed domain name.

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. The Complainant, Novartis AG, was created in 1996 through a merger of two other companies Ciba-Geigy and Sandoz, and it is the holding company of the Novartis Group.

The Complainant has an active presence in Peru where the Respondent is located, via its subsidiaries.

The Complainant owns numerous domain names composed of either its trademark NOVARTIS alone, including <novartis.com>, <novartis.net> or in combination with other terms, e.g. <novartispharma.com>.

The disputed domain name <cornovartis.com> was registered on April 11, 2023 and has not been used in connection with an active website so far.

The Respondent is Correo Ilimitado, represented by Luis Angel Arteaga Soria, who is providing software, systems and web development services and under this capacity he has arguably been contracted by the company CORPORACION NOVARTIS S.A.C. and its manager Mr. GUSTAVO HUGO SULLUCHUCO CONDOR, inter alia, for the purpose of registering the disputed domain name. The company CORPORACION NOVARTIS S.A.C. has been created and included in the corporate registry of Peru since May 5, 2022.

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 the language of the proceedings should be English, since according to the website of the Registrar the language of the Registration Agreement of the disputed domain name is English and the Respondent has replied in English in its Response, therefore the parties are well-aware of the English language and able to communicate in this language.

Further, the Parties agreed to suspend the proceedings three times in total and in accordance with Paragraph 11(a) of the CAC's UDRP Supplemental Rules, with the latest suspension lasting until August 7, 2023. On August 9, 2023 the Complainant requested to reinstate the proceedings, whereas the Center confirmed the reinstatement of the proceedings and asked the Complainant to pay the Additional UDRP Fee in accordance with Annex A of UDRP Supplemental Rules of the Czech Arbitration Court.

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

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that the disputed domain name is confusingly similar to the Trademark.

Furthermore, the Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. In this regard, the Complainant states that the Respondent is not commonly known by the disputed domain name, that it is not affiliated with nor authorized by the Complainant in any way, that the Complainant does not carry out any activity for, nor has any business with the Respondent, and that neither license nor authorization has been granted to the Respondent to make any use of the Trademark or apply for registration of the disputed domain name by the Complainant.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. It contends that the Respondent must have been aware of the Complainant and its well-known Trademark at the time of registration of the disputed

domain name, that the Respondent might be engaging in email fraud as the MX records for the disputed domain name suggest that there has been email activity and that the passive holding of the disputed domain name are evidence of bad faith registration and use.

RESPONDENT:

The Respondent contends that the disputed domain name was registered on behalf of the company CORPORACION NOVARTIS S.A.C. and its manager Mr. GUSTAVO HUGO SULLUCHUCO CONDOR, whereas the former has been incorporated in Peru on May 5, 2022 and is currently dedicated to the construction of buildings, rental and lease of motor vehicles and management consulting activities. Further, the Respondent claims that the registrant information for the disputed domain name is supposed to be only temporary under his name, with the intention to change the data to the rightful owner, namely the company CORPORACION NOVARTIS S.A.C.. Moreover, the Respondent states that the disputed domain name was registered because the company CORPORACION NOVARTIS S.A.C. urgently needed to use corporate emails relating to the disputed domain name "@CORPNOVARTIS.COM".

REASONING OF THE DECISION:

After reinstating the proceedings following the unsuccessful rounds of negotiation between the Parties, the Panel is satisfied that all procedural requirements under the UDRP are met and that it is therefore now appropriate to provide its decision.

For clarification purposes, given the absence of actual proof of a contractual relation and agreement for ownership between the Respondent and the COPRORACION NOVARTIS S.A.C., the Panel is not viewing the latter as a Respondent and the three elements of the Policy (as mentioned below) apply only to the Respondent itself.

Under paragraph 4(a) of the Policy, the Complainant must prove that each of the following three elements is present:

- (i) the disputed domain name is identical or confusingly similar to the Complainant's trademark; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

1. The Panel accepts that the disputed domain name is confusingly similar to the Trademark as it fully incorporates it and that the Trademark and the Complainant is a well-known and famous brand. It is well established that a domain name that wholly incorporates a trademark may be confusingly similar to such trademark for purposes of the Policy despite the addition of generic terms. Moreover, in the present case, the term "corp" is clearly referring to the term "corporation" which enhances the confusing similarity.
2. The Complainant has substantiated that the Respondent has no rights or legitimate interests in the disputed domain name. The Panel finds that the Complainant has fulfilled its obligations under paragraph 4(a)(ii) of the Policy. The Respondent has contended that he is not the rightful owner of the disputed domain name but instead the company which has contacted him with the registration of the disputed domain name. However, the registrant data that is included in the Whois records is belonging to the Respondent, and the Respondent did not provide any proof regarding the exact arrangement/contractual agreement between the Respondent and the CORPORACION NOVARTIS S.A.C., for the sake of proving who is the owner of the registration. The Respondent could have easily entered from the beginning the data of the Peruvian CORPORACION NOVARTIS S.A.C.

3.1 The Panel is satisfied that the Respondent registered the disputed domain name with full knowledge of the Complainant and its rights in the Trademark as the Trademark is highly distinctive and well-established. A mere search on the internet would result in finding out that the famous NOVARTIS AG has a local presence in Peru and established rights.

3.2 Furthermore, the Panel accepts the Complainant's contentions that the disputed domain name has been used in bad faith under the principles of passive holding. It is the consensus view that the lack of active use of a domain name does not as such prevent a finding of bad faith under the Policy. In such cases, the panel must examine all the circumstances of the case to determine whether a respondent is acting in bad faith. Examples of circumstances that can indicate bad faith include a complainant having a well-known trademark (cf Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003; Jupiters Limited v. Aaron Hall, WIPO Case No. D2000-0574; Ladbroke Group Plc v. Sonoma International LDC, WIPO Case No. D2002-0131).

Furthermore, the Respondent did not provide evidence of any actual or contemplated good faith use of the disputed domain name.

The Respondent has even confirmed that the disputed domain name has been used for email activity without, however, providing for any evidence as to what this activity entailed and whether it was in good faith. In light of the above, the Panel concludes that the facts of this case do not allow for any plausible actual or contemplated good faith use of the disputed domain name by the Respondent.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **corpnovartis.com**: Transferred

PANELLISTS

Name	Stefanie Efstathiou LL.M. mult.
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DATE OF PANEL DECISION **2023-09-04**

Publish the Decision
