

Decision for dispute CAC-UDRP-105962

Case number **CAC-UDRP-105962**

Time of filing **2023-11-13 09:36:32**

Domain names **novartiswealth.com**

Case administrator

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

Complainant

Organization **Novartis AG**

Complainant representative

Organization **BRANDIT GmbH**

Respondent

Name **Bao Fu**

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 Novartis Group is one of the biggest global pharmaceutical and healthcare groups in the world. It provides solutions to address the needs of patients worldwide by developing and delivering innovative medical treatments and drugs.

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

Novartis' products are sold in about 155 countries and reached nearly 769 million people globally in 2020. About 100,000 people of 142 nationalities work at Novartis around the world. The Novartis group produces and markets its products in many parts of the world including in Europe which is one of the principal markets for Novartis. The Complainant employs 45,000 employees in Europe and has 80 sites from R&D to manufacturing, to commercial.

In Cyprus (where the Respondent seems to be located), the Complainant operates via its subsidiary Novartis Pharma Services Inc. (Nikosia).

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 Cyprus.

The vast majority of the Complainant's trademark registrations significantly predate the registration of the disputed domain name.

Namely, the Complainant's trademark registrations applying to the present proceedings include the following earlier rights:

- EU Trademark: NOVARTIS Reg. no: 000304857 Reg. date: June 25, 1999;
- International Trademark Registration: NOVARTIS Reg. no: 1349878 Reg. date: November 29, 2016;
- International Trademark Registration: NOVARTIS Reg. no: 1544148 Reg. date: June 29, 2020.

The above-mentioned trademarks are a non-exhaustive list of the Complainant's trademarks in Europe.

The Complainant owns numerous trademarks NOVARTIS registered in numerous jurisdictions, which were registered many years before the registration of the disputed domain name on July 28, 2023, such as but not limited to:

- The Swiss trademark NOVARTIS No. 2P-427370, registered on July 1, 1996, 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, 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 International trademark NOVARTIS No. 1349878, registered on November 29, 2016, in classes 5, 9, 41, 42, 44 and 45, designating the Philippines;
- The United States trademark NOVARTIS No. 4986124, registered on June 28, 2016, in classes 5, 9, 10, 41, 42 and 44; and
- The United States trademark NOVARTIS No. 6990442, registered on February 28, 2023, in class 5.

The disputed domain name was registered by the Registrant's name Bao Fu, 793 Mayon St, La Loma, Quezon City, 1114 Metro Manila, Philippines, 28 July 2023 by the Registrar GoDaddy.com and expires on 28 July 2024.

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"), 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 Philippines, 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, including in the Philippines. The vast majority of these trademark registrations predate the registration of the disputed domain name <novartiswealth.com>.

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) (Annex 2). 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 webpage "https://www.novartis.com/ph-en/", associated to the domain name <novartis.com>, is dedicated to the Novartis group in the Philippines. The Complainant also enjoys a strong presence online via its official social media platforms.

PARTIES CONTENTIONS

RESPONDENT

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

COMPLAINANT

In accordance with Paragraph 4(i) of the Policy, the Complainant requests the Administrative Panel appointed in this administrative proceeding that the disputed domain name <novartiswealth.com> be transferred to the Complainant.

(i) The disputed 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 registered in numerous jurisdictions (hereafter "the NOVARTIS trademark"),

which were registered many years before the registration of the disputed domain name on July 28, 2023.

The domain name <novartiswealth.com> (hereinafter referred to as the “disputed domain name”) incorporates in its second level-portion the Complainant’s well-known trademark NOVARTIS in its entirety and the term “wealth”. The addition of such descriptive terms would not prevent a finding of confusing similarity to the trademark.

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.

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

The Complainant 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.

There is no evidence that the Respondent is known by the disputed domain name or owns any corresponding registered trademarks.

The Registrant name “Bao Fu” does not correspond to the disputed domain name <novartiswealth.com> nor the mention “novartiswealth”.

By conducting online trademark databases searches, no information is found in relation with trademarks corresponding to the terms “novartiswealth.com”, “novartiswealth” or “novartis wealth”.

When searching on popular Internet search engines for the terms “novartis”, alone or in combination with the term “wealth”, 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 structure of the disputed domain name – incorporating, in its second level portion, the NOVARTIS trademark and the term “wealth” as well as, in its first level portion, the gTLD “.com” – reflects the Respondent’s intention to create an association, and a subsequent likelihood of confusion, with the Complainant, its NOVARTIS trademark and its domain name <novartis.com> in Internet users’ mind. The structure of the disputed domain name may falsely lead Internet users to believe that it is directly connected to the Complainant, which is not the case. The disputed domain name is indeed by its structure close to the Complainant’s domain name <novartis.com> which resolves to the Complainant’s official website. The disputed domain name resolves to a third-party website unaffiliated to the Novartis group.

When filing the Complaint on November 8, 2023, the disputed domain name resolved to a website repeatedly displaying the NOVARTIS trademark. The website allegedly advertised “NovartisWealth financial products” (“Produk keuangan NovartisWealth” as written in Indonesian on the website) for sale. A product list is displayed on the home page with different associated price for each “NovartisWealth financial products”. The website pages named “Investasi”, “Agen” – respectively meaning “Investment” and “Agent” in English – as well as “Profile” display a login page. In similar circumstances, when “The disputed domain names used to resolve to websites featuring Complainant’s marks in connection with purported investment services” and “[t]he websites displayed Complainant’s marks, logos, and images and are clearly part of a fraudulent scheme intended to mislead Internet users into believing that the purported investment services are offered by Complainant”, it has been decided that “[s]uch unlawful activity using Complainant’s mark cannot confer rights or legitimate interests”. At the time of the filing of the present Amended Complaint, the disputed domain name does not resolve to an active website.

The Respondent has therefore deliberately chosen to use the well-known trademark NOVARTIS in the disputed domain name to benefit from the Complainant’s worldwide renown trademark and confuse Internet users as to the source of the disputed domain name and the associated website. Such use of the disputed domain name, of capitalizing on the Complainant’s trademark to obtain a commercial gain, cannot therefore be considered as a *bona fide* offering of goods or services nor as legitimate noncommercial or fair use.

(iii) The disputed domain name was registered and is being used in bad faith.

a) Registration of the disputed domain name in bad faith

As mentioned above, most of the Complainant’s 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 trademarks. 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.com> whom the associated website comprises a web page at “https://www.novartis.com/ph-en/” especially intended for an audience in in the Philippines 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.

Therefore, the Respondent had knowledge of the Complainant and the NOVARTIS trademark at the time of the registration of the disputed domain name.

b) Use of the disputed domain name in bad faith

The disputed domain name, until very recently, resolved to a website repeatedly displaying the NOVARTIS trademark and allegedly selling financial products by using the NOVARTIS trademark without the Complainant’s authorization. In a previous case, it has been

held that “[t]he apparent copying (or near copying) of the Complainant’s ACCENTURE & Design mark on the Respondent’s website” associated to the disputed domain name “creates the clear impression that the Respondent was trying to portray the Respondent’s website as either that of the Complainant or that of an entity associated or affiliated in some way with the Complainant. The aim appears to have been to ride on the back of the Complainant’s reputation in its ACCENTURE marks, to attract investment money”. Moreover, the Panel has decided that the “Respondent’s very choice of a made-up word like ‘Accenture’ as the dominant part of the Domain Name, considered with the content of the Respondent’s website at the time the Complaint was filed, make it clear that the Respondent was targeting the Complainant and its ACCENTURE marks when he registered the Domain Name” and that “The fact that the Domain Name no longer appears to resolve to an active website does not prevent a finding of bad faith.” The Respondent has therefore, by using the domain name, intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your website.

The Complainant sent a cease-and-desist letter to the Respondent informing of the Complainant’s rights regarding the NOVARTIS trademark, to which the Respondent did not reply. Such behavior may show bad faith.

It is likely that the Respondent is trying to conceal its identity regarding the ownership of the disputed domain name – as his name and contact details was until recently covered by a privacy shield in the corresponding Whois record – which is further evidence of bad faith.

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

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

In order to succeed in its claim, the Complainant has to prove that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied:

- (i) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) The Respondent has no rights or legitimate interests with respect to the disputed domain name; and
- (iii) The disputed domain name has been registered and is being used in bad faith.

It is well established that the Complainant is among others the proprietor of the worldwide trademark NOVARTIS.

THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR

The Complainant establishes rights in the NOVARTIS trademark through various trademark registrations in multiple jurisdictions, with registration dates preceding the registration date of the disputed domain name.

The domain name <novartiswealth.com> incorporates in its second level-portion the Complainant’s well-known trademark NOVARTIS

in its entirety and the term "wealth". 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.

The Panel finds that the incorporation of the NOVARTIS trademark in its entirety within the disputed domain name, along with the addition of the descriptive term "wealth," does not negate the confusing similarity. The addition of such terms is not sufficient to distinguish a domain name from a registered trademark which is well-known.

The Panel finds that the addition of the word "wealth" to the trademark "NOVARTIS" in the disputed domain name <novartiswealth.com> does not prevent a finding of confusing similarity. Furthermore, the gTLD extension ".com" is typically disregarded when assessing confusing similarity because it is a standard technical requirement of domain name registration.

The Panel therefore considers the disputed domain name to be confusingly similar to the trademark NOVARTIS in which the Complainant has rights and its conduct falls within the meaning of paragraph 4(a)(i) of the Policy.

RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN RESPECT OF THE DISPUTED DOMAIN NAME

The Panel does not find that the Complainant and the Respondent have ever had any previous relationships, nor that the Complainant has ever granted the Respondent with any rights to use the NOVARTIS trademark in any forms, including the disputed domain name. The Panel does not find that the Respondent is commonly known by the disputed domain name or that it has legitimate interests over the disputed domain name. The Panel researches whether the information is to be found in relation with trademarks corresponding to the terms "novartiswealth.com", "novartiswealth" or "novartis wealth" in the Google search engine but it does not find any connection neither by the Respondent's name "Bao Fu" nor by the disputed domain name <novartiswealth.com> and the name of the Respondent.

The structure of the disputed domain name – incorporating, in its second level portion, the NOVARTIS trademark and the term "wealth" as well as, in its first level portion, the gTLD ".com" – does in the Panel view reflect the Respondent's intention to create an association, and a subsequent likelihood of confusion, with the Complainant, its NOVARTIS trademark and its disputed domain name <novartis.com> in Internet users' mind. The structure of the disputed domain name may falsely lead Internet users to believe that it is directly connected to the Complainant, which is not the case.

The Respondent has therefore deliberately chosen to use the well-known trademark NOVARTIS in the disputed domain name to benefit from the Complainant's worldwide renown trademark and confuse Internet users as to the source of the disputed domain name and the associated website. Such use of the disputed domain name, of capitalizing on the Complainant's trademark to obtain a commercial gain, cannot therefore be considered as a *bona fide* offering of goods or services nor as legitimate noncommercial or fair use.

The Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain name and its conduct falls within the meaning of paragraph 4(a)(ii) of the Policy).

THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITH

Registration of the disputed domain name in bad faith

The Panel finds that most of the Complainant's 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 trademarks. 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.com> whom the associated website comprises a web page at "https://www.novartis.com/ph-en/" especially intended for an audience in the Philippines 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.

The Panel concludes that the Respondent should have already performed a similar search before registering the disputed domain name and should have actually learnt that the trademarks are owned by the Complainant and that the Complainant has been using its trademarks in many other countries worldwide. Nevertheless, the Panel finds that the evidence shows that the Respondent obviously knew about the Complainant and its trademark NOVARTIS when it registered the disputed domain name and chose to register the disputed domain name as such.

The Panel finds that the Respondent had knowledge of the Complainant and the NOVARTIS trademark at the time of the registration of the disputed domain name and the registration of the dispute domain name was therefore made in bad faith.

The disputed domain name is being used in bad faith

The disputed domain name, until very recently, resolved to a website repeatedly displaying the NOVARTIS trademark and allegedly selling financial products by using the NOVARTIS trademark without the Complainant's authorization.

The Panel holds that the copying and near copying of the Complainant's NOVARTIS trade mark on the Respondent's website associated to the disputed domain name creates the clear impression that the Respondent was trying to portray the Respondent's website as either that of the Complainant or that of an entity associated or affiliated in some way with the Complainant and to attract investment money.

Moreover, the Respondent has, by using the domain name, intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website.

The Panel finds that the Complainant sent a cease-and-desist letter to the Respondent informing of the Complainant's rights regarding the NOVARTIS trademark, to which the Respondent did not reply. Such behavior infers bad faith.

In the Panel's view the Respondent was trying to conceal its identity regarding the ownership of the disputed domain name – as his name and contact details was until recently covered by a privacy shield in the corresponding WHO IS record – which is further evidence of bad faith.

In view of the above, the Complainant 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.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **novartiswealth.com**: Transferred

PANELLISTS

Name	Vojtěch Trapl
------	----------------------

DATE OF PANEL DECISION **2023-12-16**

Publish the Decision
