Decision for dispute CAC-UDRP-106135

Case number	CAC-UDRP-106135
Time of filing	2024-01-16 10:07:31
Domain names	novartis-support.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Name	John Doe

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 trademarks NOVARTIS registered in different jurisdictions, which were registered many years before the registration of the disputed domain name on November 13, 2023, including but not limited to the followings:

- 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 United States trademark NOVARTIS No. 2997235, registered on September 20, 2005, in class 5;
- The United States trademark NOVARTIS No. 4986124, registered on June 28, 2016, in classes 5, 9, 10, 41, 42 and 44;
- The United States trademark NOVARTIS No. 5420583, registered on March 13, 2018, in classes 9, 10, 41, 42, 44 and 45; and
- The United States trademark NOVARTIS No. 6990442, registered on February 28, 2023, in class 5.

FACTUAL BACKGROUND

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

The Complainant 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, 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 United States, 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. The vast majority of these trademark registrations predate the registration of the disputed domain name.

Moreover, previous UDRP panels have stated that the NOVARTIS trademark is well-known. 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). 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 Complainant also enjoys a strong presence online via its official social media platforms.

The Respondent appears to be an individual domiciled in the United States and has not submitted an official response within the required period of time.

The disputed domain name was registered on November 13, 2023.

PARTIES CONTENTIONS

The Complainants contentions are summarized above.

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).

First, the Complainant asserts rights in the NOVARTIS mark based upon the international registrations. International Registration of a mark is a valid showing of rights in a mark. See Avast Software s. r. o. v Milen Radumilo, 102384, (CAC 2019-03-12). The Panel finds that the Complainant has rights in the NOVARTIS mark under paragraph 4(a)(i) of the Policy.

Second, the Complainant argues the disputed domain name incorporate the whole of the Complainant's trademark NOVARTIS and the descriptive term "support". The addition of the term "support" and the ".com" gTLD would not prevent a finding of confusing similarity to the Complainant's NOVARTIS mark.

By doing side-by-side comparison, the Panel is of the view that the additional term "support", hyphen "-" and the ".com" gTLD do not negate the similarity between the disputed domain name and the Complainant's trademark. See TOD'S S.p.A. vs.shikai qiang, 104283, (CAC 2022-02-19). The disputed domain name is confusingly similar to Complainant's NOVARTIS trademark.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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). More specifically, the Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name, and the burden of prove then shifts to the Respondent to show it does have rights or legitimate interests. See PepsiCo, Inc. v Smith power production, 102378, (CAC 2019-03-08) ("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.").

First, the Complainant 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. In addition, 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 them. The Complainant has also conducted online trademark databases searches and there is no information found in relation with trademarks corresponding to the terms “novartis-support.com”, “novartis-support” or “novartis support”.

Second, the Complainant also claims that the Respondent has 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 conduct fraudulent activities and obtain a commercial gain, cannot therefore be considered as a bona fide offering of goods or services nor as legitimate non-commercial or fair use.

The Panel finds that the Complainant has established a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name. The burden of proof has been shifted to the Respondent to prove that it has right or legitimate interests to the disputed domain name. However, the Respondent has not submitted any response to rebut the assertion within the required period of time.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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 are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

First, the Complainant claims 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 registration of Complainant's first NOVARTIS trademark. Considering NOVARTIS is a distinctive and well-known trademark worldwide especially in the United States as well as the strong online presence via the primary domain name <novartis.com> and social media, the Respondent had knowledge of the Complainant and the NOVARTIS trademark at the time of the registration of the disputed domain name.

Second, the Complainant alleges that the disputed domain name has been used to conduct email phishing scheme. The Complainant further asserts the disputed domain name resolves to a website without any active content and the Respondent ignores the Cease and Desist letter served by the Complainant. The Respondent has also tried to conceal its identity by applying a privacy shield in the WHOIS record of the disputed domain name.

Having reviewed the Complaint Annexes presented by the Complainant, the Panel is of the view that the Respondent should have actual knowledge of Complainant's NOVARTIS trademark during the registration of the disputed domain name considering the distinctiveness of the NOVARTIS trademark and Complainant's prior trademark rights on NOVARTIS, the registration of the disputed domain name constitutes bad faith. At the meantime, although the Panel is not satisfied with Complainant's allegation of phishing attack without attaching a copy of the actual phishing emails, the Panel accepts that passively holding the disputed domain name and failing to respond to Complainant's Cease and Desist letter evince the use of the disputed domain name in bad faith. See paragraph 3.3 of the WIPO Overview 3.0 and Carsten Johne (Siemens Trademark GmbH & Co. KG) v. LEONEL LOPEZ CASTILLO (BUILDPOINT CONSTRUCTION GROUP), 106070 (CAC 2024-01-31) ("Failure to respond to a cease-and-desist letter can be indicative of bad faith per Policy paragraph 4(a)(iii). See Arla Foods Amba v. James Moore, UDRP-105866 (CAC November 25, 2023) (finding that failing to respond to a cease-and-desist demand letter constitutes bad faith).")

For the foregoing reasons, the Panel finds the Complainant has satisfied 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

Having established all three elements required under the UDRP Policy, the Panel concludes that the disputed domain name should be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **novartis-support.com**: Transferred

PANELLISTS

Name	**Mr Paddy TAM**

DATE OF PANEL DECISION 2024-02-15

Publish the Decision