Decision for dispute CAC-UDRP-106177

Case number	CAC-UDRP-106177
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Domain names	novartlis.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Name	chai xu hua

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

Rights

The Complainant relies on its many national and other registered trade marks, including:

1.The European Union trade mark, for the word mark, NOVARTIS, No. 013393641, registered on 17 March 2015, in classes 9 and 10;

2.The International trade mark for the word mark, 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 and designating 50 countries;

3.The Swiss national trade mark, for the word mark, 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;

4.The United States trade mark for the word mark, NOVARTIS No. 4986124, registered on June 28, 2016, in classes 5, 9, 10, 41, 42 and 44 and No. 6990442, registered on February 28, 2023, in class 5;

5.The Chinese national trade mark for the word mark, NOVARTIS, No. 12128356, registered on July 28, 2014, in class 35 and No. 42520145, registered on September 7, 2020, in class 5.

Previous UDRP panels have held 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 also owns many 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). These 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.

FACTUAL BACKGROUND

Novartis AG (the "Complainant") of Switzerland, was created in 1996 through a merger of two other companies Ciba-Geigy and Sandoz, is the holding company of the Novartis Group, one of the biggest global pharmaceutical and healthcare groups in the world.

The Complainant's products are manufactured and sold in many countries worldwide, including in China, country where it has an active presence through its subsidiaries and associated companies.

The domain name <novartlis.com> (hereinafter referred to as the "disputed domain name") was registered on 26 September 2023. The Complainant sent a cease and desist letter to the Respondent on 9 October 2023 informing of the Complainant's rights regarding the NOVARTIS trademark, to which the Respondent did not reply.

PARTIES CONTENTIONS

COMPLAINANT:

This is a typosquatting case. The Complainant's trademark NOVARTIS has been deliberately misspelled by the addition of a second letter "l" after the letter "t" –in the disputed domain name. This is to capitalize on Internet users' typing errors when looking for information on the Complainant. Previous UDRP Panels have stated in this regard that "minor alterations cannot prevent a finding of confusing similarity between the trademark and the domain name" (see LinkedIn Corporation v. Daphne Reynolds, WIPO Case No. D2015-1679).

The Complainant has not granted the Respondent any rights, nor is the Respondent affiliated to the Complainant or known by the disputed domain name. The disputed domain name reflects the Respondent's intention to create an association, and a likelihood of confusion. Previous Panels and the WIPO Overview, Third Edition ("WIPO Jurisprudential Overview 3.0") at section 2.5 says: "a respondent's use of a domain name will not be considered 'fair' if it falsely suggests affiliation with the trademark owner". This cannot be considered a bona fide offering of goods or services nor a legitimate non-commercial or fair use of the disputed domain name.

Novartis group owns and uses the domain name <novartis.com.cn> whom the associated website is especially intended for an audience in China as well as informing on the Novartis group presence and activities in this country where the Respondent is based. The Complainant is very active on social media to promote its mark, products and services (See, Laboratoires M&L v. Zhaoxingming, CAC Case No. 102277). By conducting a simple online search regarding the name "novartlis" on popular search engines, the Respondent would have inevitably learnt about the Complainant, its trademark and business (see Intesa Sanpaolo S.p.A. v. Abayomi

Ajileye, CAC Case No. 102396). Therefore, the Respondent had knowledge of the Complainant and the NOVARTIS trademark at the time of the registration of the disputed domain name. The disputed domain name has been passively held. See Telstra Corporation Limited v. Nuclear Marshmallows, supra). 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 behaviour supports a finding of bad faith (see Altarea v. Loretta Zayas, WIPO Case No. D2020-2337). Moreover, active MX records are associated with the disputed domain name. The latter may therefore be used in email addresses. There is therefore a risk of the disputed domain name being used for fraudulent purposes, by impersonating the Complainant.

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 implied request as to the language of the proceeding is also granted. The Registration agreement is in Chinese, but the Respondent remained inactive in these proceedings and did not contest Complainant´s implied request to hold the proceeding in English language.

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

There is no question about the rights of the Complainant. It has Rights in a name and mark identical/similar to the disputed domain name. This Panel concurs that the registered word mark is a well-known mark. By use of the whole mark in the disputed domain name, the impression is given that the site is official and there is a risk of impersonation. The .com reinforces that impression. The suffix has no bearing at the first factor. The disputed domain name is <novartlis.com> so this appears to be a classic typo-squatting case.

As to the second limb, a complainant is only required to make out a prima facie case that a respondent lacks rights or legitimate interests and then the burden shifts to the respondent to show it has rights or legitimate interests in the domain name. If it fails to do so, the complainant is deemed to have satisfied the limb in paragraph 4(a) (ii). See WIPO Case No. D2003-0455, Croatia Airlines d. d. v. Modern Empire Internet Ltd. The Complainant has discharged its burden on this limb. Past panels have held that a Respondent was not commonly known by a disputed domain name if the Whois information was not similar to the disputed domain name. See the Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com>. Here it is very clear that the Respondent, Chai Xu Hua, is not known by the name Novartis in the WHOIS records.

There is no use as such to be bona fide use at the second factor. While passive holding is not Bad Faith per se, it is fact sensitive. Often, where there is no website, the purpose will be for emails. Here the MX records are all configured. The configuration of MX records suggests that the purpose was phishing or fraud. Such purposes include sending email, phishing, identity theft, or malware distribution. WIPO Overview 3.0, section 3.4. See, e.g., DeLaval Holding AB v. Registration Private, Domains By Proxy LLL / Craig Kennedy, WIPO Case No. D2015-2135. In such a case, the Panel is entitled to draw such inferences as are appropriate and they are that registration was not for a legitimate purpose or interest. The Respondent has therefore been granted an opportunity to come forward and answer or present compelling arguments that he has rights or legitimate interests in the disputed domain names but

has failed to do so.

As to bad faith, the WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows is apposite. This is sometimes known as the passive Bad Faith test. Where a famous or well-known mark is incorporated into a domain name without any legitimate reason or explanation, Bad Faith can often be inferred. The Respondent did not come forward to explain the reasons for the selection of the disputed domain names and why there is no Bad Faith.

Here it appears that the likely purpose of the Registrant/Respondent was for email purposes as the MX records are enabled. That purpose will very likely be for phishing and illegitimate and possibly criminal. That pushes passive holding over the line and the Panel finds there is bad faith.

The Complainant has discharged its burden and made out all three limbs of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **novartlis.com**: Transferred

PANELLISTS

Name	**Victoria McEvedy**

DATE OF PANEL DECISION 2024-02-28

Publish the Decision