Decision for dispute CAC-UDRP-106182

Case number	CAC-UDRP-106182
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Domain names	novartis-corporation.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Organization	PERSONA FISICA CON ACTIVIDAD EMPRESARIAL

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 <novartis-corporation.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 Mexico, where the Respondent is allegedly located. The vast majority of the Complainant's trademark registrations significantly predate the registration of the disputed domain name.

The Complainant’s trademark registrations applying to the present proceedings include the following earlier rights:

- Mexican trademark registration (IMPO) for NOVARTIS, Reg. No.: 2400833 , Reg. date: November 1, 2021;
- United States (USPTO) Trademark registration for NOVARTIS, Reg. No.: 2336960, First Reg. date: April 4, 2000;
- EU trademark registration for NOVARTIS (EUIPO), Reg. No.: 013393641 Reg. date: March 17, 2015;
- International Registration for NOVARTIS, Reg. No.: 663765, Reg. date: July 1, 1996.

The Complainant owns numerous domain names composed of either its trademark NOVARTIS alone, including <novartis.com> (created on 2 April 1996) and <novartis.us> (created on 19 April 2002) 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. In 2022, the Complainant achieved net sales from continuing operations of USD 50.5 billion, and total net income amounted to USD 7.0 billion and employed approximately 102 000 full-time equivalent employees as of December 31, 2022.

The disputed domain name <novartis-corporation.com> was registered on December 1, 2023.

PARTIES CONTENTIONS

COMPLAINANT:

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

According to the Complainant, the disputed domain name <novartis-corporation.com> incorporates entirely the Complainant's well-known, distinctive trademark NOVARTIS with the term "corporation", 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 its business activities.

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 Minerva S.A. c. Domain Administrator, Fast Serv Inc. d.b.a. QHoster.com, WIPO Case No. D2019-2767)).

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 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 (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 "novartiscorporation.com" or "novartis-corporation.com" in the Google search engine, the returned results point to the Complainant and its business activities. Similarly, when searching for the disputed domain name along with the name of the Respondent "Alvaro Rodriguez Espinosa", there are no returned results showing that the Respondent is known by the disputed domain name.

Furthermore, when searching for any trademarks incorporating the disputed domain name terms "novartis-corporation" on online trademark search platforms, no registered trademarks are to be found. Similarly, no registered trademarks were found in the name of the Respondent.

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 trademark for its business activities. However, the Respondent still chose to register the disputed domain name as such.

Moreover, the Complainant is known in Mexico due to extensive use and recognition of the NOVARTIS trademark in connection with its business activities. The Respondent, in choosing to register the disputed domain name, has not only failed to establish any legitimate rights or interests in the term "novartis-corporation" but has also demonstrated a lack of due diligence in researching and respecting the Complainant's pre-existing trademark rights.

The Complainant's established presence in Mexico, coupled with the absence of any legitimate association between the Respondent and the NOVARTIS trademark, raises concerns about the Respondent's motives behind registering the disputed domain

name. The apparent attempt to create confusion by incorporating the well-known trademark into the disputed domain name suggests bad faith on the part of the Respondent.

The Complainant also points out that at the time the Complainant found out about the disputed domain name, it was observed to be Pay Per Click page displaying sponsored links directly related to the Complainant's business e.g. “Pharmaceutical Company”, “Pharma Company”, “Pharmaceutical”. Similarly, around the time of filing this Complaint, the disputed domain name continued to display such sponsored links.

In additon, the Complainant sent a Cease-and-Desist letter on December 18, 2023 via abuse contact of the Registrar as well as initiated a contact request via the service provided by the Registrar, GoDaddy LLC. The Complainant also received two emails from the Respondent, with the offer to sell the disputed domain name for a sum which is clearly in excess of the Respondent’s out-of-pocket expenses for registering the disputed domain name. The Complainant replied reiterating the content of Cease-and-Desist Letter and concluded that such behavior further shows that the Respondent lacks rights or legitimate interests in the disputed domain name.

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 significantly 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 emphasizes that it enjoys a strong online presence as well as the fact that the Complainant has wide recognition in Mexico, with a substantial presence in the region. The Complainant's trademark NOVARTIS holds significant recognition and reputation in the Mexican market due to its longstanding use and promotion. This information further underscores the Respondent's likely knowledge of the Complainant and its trademark when registering the disputed domain name.

Furthermore, the structure of the disputed domain name – incorporating the Complainant’s well-known trademark NOVARTIS followed by the relevant term “corporation” separated by hyphen - shows that the Respondent registered the dispute domain name having the Complainant and its NOVARTIS trademark in mind. 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. Indeed, by reading the disputed domain name, Internet users may believe that it is directly connected to or authorized by the Complainant. In this regard, previous UDRP panels have consistently found that the mere registration of a domain name that is confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith.

In addition, at the time the Complainant found out about the disputed domain name, it was observed to be a Pay Per Click Page displaying sponsored links directly related to the Complainant. Similarly, around the time of filing of this complaint, the disputed domain name continued to display such links.

PPC pages generate revenues when Internet users click on the links displayed therein. The PPC page associated to the disputed domain name displayed relevant sponsored links which clearly referred to the Complainant and its business activities. According to the Complainant, the Respondent likely obtained a financial benefit when Internet users clicked on the aforementioned links. Such use of the disputed domain name is aimed at attracting Internet users for commercial gain by creating a likelihood of confusion with the Complainant’s NOVARTIS trademark as to the source, sponsorship, affiliation, or endorsement of the aforementioned PPC page.

Also, the Respondent offered to sell the disputed domain name to the Complainant for a sum which is clearly in excess of the Respondent’s out-of-pocket expenses for registering the disputed domain name. Such behaviour is a clear indication of bad faith use of the disputed domain name, according to the Complainant.

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:

In the Response to the Complaint, the Respondent claims that "Novartis" and "novartis-corporation.com" are neither identical nor confusingly similar, and that the disputed domain name was registered with a legitimate business purpose, targeting an industry where the Complainant has no presence or trademark claims.

The Respondent provides evidence of two trademark applications for "novartis-corporation.com" mark in Classes 25 and 38 before the Mexican Trademark Office, filed on February 23, 2024 .

The Respondent provides that the term “corporation” is generic and widely used in both the business and online realms, diminishing its potential to create a unique and direct association with the Complainant.

The Respondent also emphasizes that the disputed domain name was acquired legally from the Registrar, GoDaddy LLC and registered trademark applications for Class 25 (Clothing and Footwear) and Class 38(Telecommunication Services), both categories where the Complainant has no registered trademarks, ensuring no overlap or infringement in the Complainant's

intellectual property rights.

The Respondent contests the claim of intentionally attempting to attract Internet users for commercial gain by creating confusion. According to the Respondent, the disputed domain name's use within a distinct industry (Clothing and Footwear) is aimed at developing a separate brand identity, not capitalizing on the Complainant's reputation.

The Respondent's response to the Cease-and-Desist Letter, mentioning a selling price for the disputed domain name was a direct reaction to an unsolicited approach and not indicative of an initial intent to sell the disputed domain name to the Complainant at an inflated price.

The Respondent concludes that it's conduct has been consistent with the practices of fair competition and respectful of intellectual property rights, distinguishing it from the accusations levied by the Complainant.

COMPLAINANT:

In the Reply to the Response, the Complainant reiterates arguments and position expressed in the Complaint and addresses new information followed by the Respondent's Response.

Namely, the Complainant wishes to point out that the trademark applications for "novartis-corporation.com" mark in Classes 25 and 38 were filed online before Mexican Trademark Office on February 23, 2024 according to copies of trademark applications submitted by the Respondent (No. 20240074014 and No. 20240064187). Therefore, the applications were filed after the Respondent was notified of the subject UDRP complaint and following 2 previous communications from the Respondent with no mention of any intention to use such terms in relation to goods and services in Classes 25 and 38.

From the Complainant's perspective and taking into accounts all the arguments as submitted in UDRP complaint, it is obvious that such trademark applications filings were pre-textual and were filed in order circumvent application of UDRP Policy by claiming legitimate rights in the disputed domain name. According to WIPO Overview 3.0, para 2.12.2. "panels have generally declined to find respondent rights or legitimate interests in a domain name on the basis of a corresponding trademark registration where the overall circumstances demonstrate that such trademark was obtained primarily to circumvent the application of the UDRP or otherwise prevent the complainant's exercise of its rights (even if only in a particular jurisdiction)".

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

Preliminary issues – the Complainant's unsolicited supplemental filing

On March 1, 2024, the Complainant made an unsolicited supplemental filing. This filing contains contentions regarding new information as disclosed in the Respondent's Response.

Paragraph 10 of the Rules provides panels with the authority to determine the admissibility, relevance, materiality, and weight of the evidence, and also to conduct the proceedings with due expedition.

Accordingly, unsolicited supplemental filings are generally discouraged, unless specifically requested by the panel, pursuant to its general powers under paragraph 12 of the Rules. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 4.6. However, prior WIPO decisions state that supplemental filings should only be permitted where there exist "new, pertinent facts that did not arise until after the submission of the complaint" (Gordon Summer, p/k/a Sting v. Michael Urvan, D2000-0596).

Having reviewed the Complainant's unsolicited supplemental filing in this case, the Panel considers that the filing contains significant material which could not have been included in the Complainant's original Complaint, or material which is of such importance that it is liable to be critical to the outcome of the case. In the circumstances, the Panel determines that the Complainant's unsolicited supplemental filing shall be admissible in this proceeding.

For all the reasons above, 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 "corporation". Essentially, the Respondent has appropriated the trademark NOVARTIS by adding a generic term "corporation" to presumably lead consumers to believe that it is affiliated with the Complainant and its business. 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). Previous UDRP panels have also constantly held that the mere addition of a descriptive or generic term would not prevent a finding of confusing similarity to a trademark (see Minerva S.A. c. Domain Administrator, Fast Serv Inc. d.b.a. QHoster.com, WIPO Case No. D2019-2767)).

The Respondent acknowledges that the term "corporation" is generic and widely used in both the business and online realms, thus diminishing its potential to create a unique and direct association with the Complainant. However, such argumentation is in light of the Rules and above interpretation of the case law irrelevant.

Additionally, the disputed domain name not only fully incorporates 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 "corporation" in the Google search engine, the returned results point to the Complainant and its business activities.

The Respondent's 2024 trademark applications for the disputed domain name

The Respondent relies heavily on its 2024 trademark applications for "novartis-corporation.com" mark in Classes 25 and 38, filed online before the Mexican Trademark Office on February 23, 2024. The Respondent argues that the disputed domain name was acquired legally from the Registrar, GoDaddy LLC, and registered trademark applications for Class 25 (Clothing and Footwear) and Class 38 (Telecommunication Services), both categories where the Complainant has no registered trademarks, ensuring no overlap or infringement in the Complainant's intellectual property rights. However, as explained in paragraph 2.7 of WIPO Overview 2.0, a respondent's registration of a trade mark corresponding to the disputed domain name will not suffice to establish rights or

legitimate interests if the overall circumstances demonstrate it was obtained primarily to circumvent the application of the UDRP.

The Panel suspects that the trademark applications were indeed applied for in bad faith in light of the fact that first, they were filed after the Respondent was notified of the subject UDRP complaint and following 2 previous communications from the Respondent with no mention of any intention to use such terms in relation to goods and services in Classes 25 and 38. Secondly, the Panel agrees with the Complainant that it is very likely that these trademark applications filings were pre-textual and were filed in order circumvent application of UDRP Policy by claiming legitimate rights in the disputed domain name.

The Panel is not satisfied on the totality of evidence in support of the Respondent's rights or legitimate interests in the disputed domain name. In the Panel's view, the following matters seriously undermine credibility of the Respondent's claim to be commonly known by the disputed domain name: the clear misinterpretation of the generic term "corporation"; the lack of evidence of any significant level of business by the Respondent; the various vague and unsupported claims by the Respondent in connection with the internet user's knowledge and expectations; the Respondent's desire to fill a market niche distinctly separate from the Complainant's business activities by registering the trademark applications for "novartis-corporation.com" mark in Classes 25 and 38 before the Mexican Trademark Office .

In conclusion, in a present case, the Respondent filed a Response in which it could have provided evidence in support of its rights or legitimate interests. However, the Panel notes that the Respondent has provided zero evidence to support its legitimate interests in the disputed domain name. While the Respondent acknowledges the Complainant's established presence and reputation in the pharmaceutical industry, a simple Google search of the Complainant's business at the time of registration would have returned results of the Complainant's trademark and brand. Accordingly, the evidence adduced by the Respondent has not convinced the Panel of its 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 significantly 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 activities. Given the distinctiveness of the Complainant's trademark worldwide including the Complainant's established presence in Mexico, 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 Panel finds that the disputed domain name is confusingly similar to the Complainant's well-known trademark NOVARTIS. The Complainant's use and registration of the trademark NOVARTIS significantly precede the registration date of the disputed domain name. The fact that the Respondent has registered a domain name that includes the term NOVARTIS with the addition of the generic term "corporation", and despite the addition of the gTLD ".COM", clearly indicates that the Respondent had knowledge of the Complainant's trademark at the time of registration of the disputed domain name. It is reasonable to conclude that this is evidence of registration of the domain name in bad faith.

In fact, the use of the term "corporation" in connection with the NOVARTIS trademark rather strengthens the impression that the disputed domain name is in some way connected to the Complainant or the Complainant's business activities, and at least the Respondent may be seen to free ride on the reputation of the Complainant and its name and trademark NOVARTIS.

In addition, the Complainant provides evidence that the disputed domain name displayed sponsored links directly related to the Complainant. Applying UDRP paragraph 4(c), panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users. The PPC links directly relate to the Complainant's business. Accordingly, the Panel is of the view that the Respondent was likely trying to capitalize on the reputation and goodwill of the Complainant's trademark. Consequently the Panel believes that the disputed domain as not being used in connection with bona fide offering of goods or services.

Also, the Respondent's argument that the disputed domain name's use within a distinct industry (Clothing and Footwear), aiming at developing a separate brand identity cannot sustain in connection with bona fide offering of goods and services in line with the lack of legitimate interests in the disputed domain name explained above.

Further, the Complainant has provided evidence of an exchange with the Respondent via email, during which the Respondent offered to sell the disputed domain name for USD 100,000, a sum which is clearly in excess of the Respondent's out-of-pocket expenses for registering the disputed domain name.

Out-of-pocket costs include the costs of obtaining, registering, and maintaining a domain name. This issue of "excessive" out-of-pocket costs is typically considered on a case-by-case basis. However, in the Panel's experience, the Respondent's offer is largely in excess of any out-of-pocket costs directly related to the disputed domain name. The Panel finds that such behaviour is a clear indication of bad faith use of the disputed domain name under paragraph 4(b)(i) of the Policy. The Respondent's argument that the offer to sell the disputed domain name was a negotiation stance in light of legal pressures is therefore highly irrelevant.

In the present case, the Panel is of the opinion that the Complainant's NOVARTIS trademark is distinctive and well-known, which makes it difficult to conceive any plausible legitimate future use of the disputed domain name by the Respondent. The Panel notes that the only reason that the Respondent registered the disputed domain name was to presumably take advantage of the

Complainant’s goodwill and use its reputation for the Respondent’s own commercial benefit.

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

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	**Barbora Donathová**

DATE OF PANEL DECISION 2024-03-18

Publish the Decision