Decision for dispute CAC-UDRP-106274

Case number	CAC-UDRP-106274
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Domain names	uknovartis.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Name	Michelle Glendining

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's trademark registrations include the following earlier rights:

- United States (USPTO) Trademark registration for NOVARTIS Reg. No.: 2336960 First Reg. date: April 4, 2000;

- United States (USPTO) Trademark registration for NOVARTIS Reg. No.: 4986124 Reg. date: June 28, 2016;

- International Registration for NOVARTIS, designating the United States and the United Kingdom Reg. No.: 1544148 Reg. date: June 29, 2020;

- United Kingdom Trademark registration for NOVARTIS Reg. No.: UK00801349878 Reg date: November 17, 2017.

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, such as <novartispharma.com> (created on 27 October 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.

FACTUAL BACKGROUND

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

The Complainant declares to be one of the biggest pharmaceutical and healthcare groups worldwide. According to the Complainant, Novartis AG products are sold in about 155 countries and reached nearly 800 million people globally in 2018.

The Complainant has duly proved to be the owner of the registered well-known trademark "NOVARTIS" in several classes and in numerous countries all over the world and that these trademark registrations long predate the registration of the disputed domain names which was created only on December 4, 2023.

In the Complainant's view, due to extensive use, advertising and revenue associated with its trademarks worldwide, the Complainant enjoys a high degree of renown around the world, including UK. The Complainant has previously successfully challenged several domain names including the word "NOVARTIS" through UDRP processes.

The Complainant outlines that in the WIPO Case No. D2020-3203 Novartis AG v. Amartya Sinha, Global Webs Link, Novartis RO, the Panel confirmed that "NOVARTIS" is a well-known trademark.

The Complainant has registered a number of domain names under generic Top-Level Domains ("gTLD") and country-code Top-Level Domains ("ccTLD") containing the term "NOVARTIS", for example, <novartis.com> (created on April 2, 1996), <novartis.in> (created on February 15, 2005) and Novartis.us (created on April 19, 2002). The Complainant uses these domain names to connect to a website through which it informs potential customers about its "NOVARTIS" mark and its products and services.

According to the Complainant, the domain name in dispute is similar to its "NOVARTIS" trademark since the disputed domain name resolves in the "NOVARTIS" mark along with the geographic/country identifier “UK”.

The Complainant has never granted the Respondent with any rights to use the "NOVARTIS" trademark.

Furthermore, the Complainant outlines that the domain name <uknovartis.com>, via the e-mail function, has been used to conduct email phishing scheme. Namely, the Respondent created an e-mail address associated with the Disputed Domain Name “[...]@uknovartis.com”) only 3 days after registration of the domain name to distribute a fraudulent phishing email to a third-party, by impersonating the Novartis Group. The fraudster pretended that the Novartis group was interested in buying the third-party companies’ products.

The Complainant filed a takedown action before the Registrar on February 14, 2024, at that time, the disputed domain name was not resolving to any active page;

In the Complainant's view, by using the domain name <uknovartis.com> the Respondent has clearly and intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's mark and business.

PARTIES CONTENTIONS

The Complainant submits that the requirements of the Policy have been met and that the disputed domain name should be transferred to it. The Complainant makes a number of legal arguments (referenced below) and also supplies a set of annexes providing evidence of its activities and of the Respondent's use of the disputed domain names.

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 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

First, it has to be cast the issue of the language proceedings as the registrar's agreement appears to be in Chinese language.

In accordance with Paragraph 11 of the UDRP Rules unless otherwise agreed by the parties, the language of the proceeding is the language of the registration agreement, subject to the authority of the panel to determine otherwise, exercising its “discretion in the spirit of fairness to both parties, which pursuant to paragraph 10(b) of the Rules have to be treated with equality, taking into account all relevant circumstances of the case, including matters such as the parties’ ability to understand and use the proposed language, time and costs” (see Carrefour v. Contact Privacy Inc. Customer 1242379769 / Le Berre, WIPO Case No. D2018-1552).

The Complainant filed the Complaint in English language and provided evidence for this choice which may be summed up as follows:

- use of the "UK" prefix in the disputed domain referring to the two-letters of the country code for United Kingdom;
- Respondent resides in the US, where English is an official language as per the information on the WHOIS
- fraudulent emails (phishing) using the disputed domain name were sent out in English language
- A translation of the Complaint in such a Chinese language would entail significant additional costs for the Complainant and delay in the proceedings.

The Panel is satisfied with the arguments and evidence provided by the Complainant and confirms that use of English language would be fair for both parties, bearing in mind that the Respondent did not contest this.

Second, according to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that the disputed domain name should be transferred or cancelled:

(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 in respect of the disputed domain name; and
(iii) the disputed domain name has been registered and is being used in bad faith.

The Panel has examined the evidence available to it and has come to the following conclusion concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

RIGHTS

The Complainant has established rights in the name NOVARTIS. The disputed domain name <uknovartis.com> is found to be confusingly similar to the Complainant’s trademark and company name. This finding is based on the settled practice in evaluating the existence of a likelihood of confusion of:

a) disregarding the top-level suffix in the domain names (i.e. “.com") in the comparison; and

b) finding that the simple combination of a trademark and a generic term such as a geographic indicator referring to a country or region in which the Complainant is conducting business (in this case “UK”) would by no means be considered sufficient to distinguish a domain name from a trademark.

The disputed domain name is therefore found to be confusingly similar to the earlier rights in the name NOVARTIS and the Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The onus to make out a prima facie case that the Respondent lacks rights or legitimate interests is placed on the Complainant. However, once such a prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Respondent has no rights or legitimate interests in the disputed domain name. The Complainant and the Respondent have never had any previous relationship, nor has the Complainant ever granted the Respondent with any rights to use the NOVARTIS trademark in any form, including in the disputed domain name. The disputed domain name did not resolve to any active

page/content. Therefore, the disputed domain name cannot be in use in connection with a bona fide offering of goods or services. There is no available evidence that the Respondent engages in, or has engaged in any activity or work, i.e., legitimate or fair use of the disputed domain name, that demonstrates a legitimate interest in the disputed domain name, so that there is nothing that could be interpreted as rights or legitimate interests of the Respondent. Since the Respondent has not filed a response, the Respondent has also failed to put forward any arguments at all which could change this finding.

Additionally, the use of the disputed domain name to perpetrate an illegal activity (phishing scheme) characterized bad faith and, as previously held by UDRP panelists in similar circumstances, "can never confer rights or legitimate interests on a respondent" (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, section 2.13.1; SAP SE v. Anuoluwapo Akobi, WIPO Case No. D2018-0624; Ingenico Group v. Sammi Wilhi, Lng Group Pty Ltd, WIPO Case No. D2019-1079; Pepsico, Inc. v. Bill Williamson, CAC Case No. 102290).

The Respondent was given an opportunity to present arguments relating to rights or legitimate interests in the disputed domain name but have failed to do so. This behavior, coupled with the absence of use of the disputed domain name in connection with a bona fide offering of goods and services, demonstrates the Respondents' absence of rights or legitimate interests in respect of the disputed domain name.

The Panel therefore concludes that the Respondent did not refute the Complainant's prima facie case and has not established any rights or legitimate interest in the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy). The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Panel finds that the Complainant has established that the disputed domain name was registered by the Respondent and is being used by the Respondent in bad faith.

The well-known nature of the NOVARTIS trademark has been confirmed in earlier decisions. The name is distinctive and well known in numerous countries including the United Kingdom for the products manufactured and sold by the Complainant.

The Respondent has copied the Complainant's trademark "NOVARTIS" and has combined it with a generic term referring to a location in which the Complainant has an active business presence. Therefore, this registration can only be viewed as an attempt to exploit the goodwill vested in the trademark by attracting Internet users and confusing them to the extent that they would believe that a website connected to the disputed domain name offers the services of an entity that is affiliated to the Complainant.

The Respondent initiated correspondence by using the identity of one of the Complainant's employee in order to deceive Complainant's partner/supplier. This clearly demonstrate that the Respondent did not act randomly but knew the Complainant and its trademark when it undertook such fraudulent manoeuvre. In similar circumstances, previous UDRP Panels have stated that "[t]he fact that the Respondent in its scam email...used false banking information of Tetra Pak New Zealand (in its correct spelling) and used the name of an actual employee of Tetra Pak Marketing Pty Ltd. is evidence of the Respondent having known the Complainant's name and trade mark when registering the disputed domain name. In view of this, it is inconceivable that the Respondent was unaware of the TETRA PAK name and trademark" (Tetra Laval Holdings & Finance S.A. v. VistaPrint Technologies Ltd, WIPO Case No. D2014-1387; Bollore v. James White, CAC Case No. 101771).

The Panel therefore concludes that the Respondent has registered and is using the disputed domain name in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy). The Complainant has therefore also satisfied the requirement under 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. **uknovartis.com**: Transferred

PANELLISTS

Name	**David-Irving Tayer**

DATE OF PANEL DECISION 2024-03-27

Publish the Decision