Decision for dispute CAC-UDRP-106369

Case number	CAC-UDRP-106369
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Domain names	novartisresources.com

Case administrator

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

Complainant

Organization	Novartis AG

Complainant representative

Organization	BRANDIT GmbH

Respondent

Organization	Slater

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 is one of the biggest global pharmaceutical and healthcare groups. The Complainant provides solutions to address the evolving needs of patients worldwide by developing and delivering innovative medical treatments and drugs. The Complainant, Novartis AG, with headquarter in Switzerland was 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 regions worldwide, including in the United States of America (hereinafter "the United States") and in China, where the Respondent seems to be located.

The Complainant holds an ample portfolio of the well-known trademark NOVARTIS registered at a worldwide level, including in China, being:

- United States Trademark for NOVARTIS (word mark), Reg. No. 2336960 registered on April 4, 2000, and in force (initially) until April 4, 2030, in connection with International Class ("IC") 05.

- United States Trademark for NOVARTIS (word mark), Reg. No. 4986124, registered on June 28, 2016, and in force (initially) until June 29, 2026, in connection with ICs 05, 09, 10, 41, 42 and 44.

- International Trademark for NOVARTIS (word mark), Reg. No. 1544148, registered on June 29, 2020, and in force until June 29, 2030, in connection with ICs 09, 35, 38, and 42.

- Chinese (CNIPA) Trademark registration for NOVARTIS (word mark), Reg. No.: 68730968, registered on June 28, 2023, and in force until June 27, 2033, in connection with IC 09.

FACTUAL BACKGROUND

The Complainant is one of the biggest global pharmaceutical and healthcare groups. The Complainant provides solutions to address the evolving needs of patients worldwide by developing and delivering innovative medical treatments and drugs. The Complainant, Novartis AG, based in Basel, Switzerland was created in 1996 through a merger of two other companies Ciba-Geigy and Sandoz, is the holding company of the Novartis Group. In 2022, in accordance with its Annual Report, Novartis 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 Complainant's products are manufactured and sold in many regions worldwide, including in China, where the Respondent seems to be located. The Complainant has subsidiaries and associated companies in the United States and in China, playing an active role on the local market and on each society.

The Complainant is the owner of the registered well-known trademark NOVARTIS in numerous jurisdictions all over the world. The Complainant's trademark registrations significantly predate the registration of the disputed domain name, which was registered on **February 1, 2024**.

The Complainant also owns a domain names portfolio, composed of either its trademark NOVARTIS alone, including: <novartis.com> registered on April 2, 1996; <novartis.us> registered on April 19, 2002 or in combination with other terms, e.g. <novartispharma.com> registered on October 27, 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 trademark and its related products and services.

The Complainant also enjoys a strong presence online via its official social media platforms, as Facebook, LinkedIn, X, YouTube, and Instagram.

On February 28, 2024, the Complainant sent a Cease-and-Desist Letter to the Respondent (via the concerned Registrar), which it was not replied.

The disputed domain name <**novartisresources.com**> was registered on **February 1, 2024** and resolves to a pay-per-click ("PPC") website with commercial links related to the Complainant.

PARTIES CONTENTIONS

Complainant´s Contentions:

In relation to the first element of the Policy, in summary, the Complainant contends that the disputed domain name <**novartisresources.com**> incorporates, in its second level portion, the NOVARTIS trademark in its entirety, and the English term "resources"; that the NOVARTIS trademark is clearly recognizable within the disputed domain name, citing the WIPO Overview 3.0, section 1.8.

In relation to the second element of the Policy, in summary, the Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name, since the Complainant and the Respondent have never had any previous relationships, nor has the Complainant ever granted the Respondent with any rights to use the NOVARTIS trademark, including as a domain name; that the Respondent is not commonly known by the disputed domain name; that the composition of the disputed domain done by the Respondent, suggests a false association with the Complainant, citing the WIPO Overview, section 2.5; that before the time of the filing the complaint, the disputed domain name, resolved to an inactive page; afterwards, the disputed domain name resolves to a website where the disputed domain name appears as being registered at dynadot.com, that a website is coming soon, for PPC commercial links related to the Complainant, which doesn't constitute a fair use, citing Bollore v. Tywonia W Hill, WIPO Case No. DCO2017-0012.

In relation to the third element of the Policy, in summary, the Complainant contends that its trademarks significantly predate the registration of the disputed domain name and that the Respondent has never been authorized by the Complainant to register the disputed domain name; that due to the strong online presence that Complainant enjoys, including in social media, the Respondent could have conducted a simple online search regarding the disputed domain name terms on popular search engines, and inevitably learnt about the Complainant, its trademark and business; that the structure of the disputed domain name – which incorporates the Complainant's well-known trademark NOVARTIS plus the term "resources" - shows that Respondent registered it having the Complainant and its NOVARTIS trademark in mind, reflecting the Respondent's clear intention to create an association which doesn't exist, and generating a likelihood of confusion among the Internet users; that given the use of the disputed domain name which resolves to a website with PPC commercial links related to the Complainant, with active MX records, the Respondent is using the disputed domain in bad faith.

Respondents contentions:

The Respondent did not reply to the Complainant's contentions.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is 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 accordance with Paragraph 4(a) of the Policy, the onus is on the Complainant to prove:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

(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 will consider each of these requirements in turn.

No Response or any kind of communication has been submitted by the Respondent, despite the fair opportunity given by the CAC to present its case in accordance with paragraph 2(a) of the Rules. Therefore, this Panel shall analyze the evidence submitted by the Complainant and decide this dispute based on the "balance of probabilities" or "preponderance of the evidence". See, paragraphs 14 and 15(a) of the Rules, and WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("WIPO Overview 3.0"), section 4.2.

1. **Identical or Confusingly Similar**

The Complainant has provided vast and sufficient evidence of having Trademark Rights over the word NOVARTIS, at least in this case, since April 4, 2000.

The disputed domain name <**novartisresources.com**> incorporates, in its second level portion, the Trademark NOVARTIS in its entirety, plus the addition of the term "resources". The Panel finds that Complainant's well-known Trademark NOVARTIS is recognizable within the disputed domain, and that the additional term doesn't prevent a finding of confusing similarity under the first element of the Policy (see Novartis AG v. Giselle Perez (Epsilon Comunicacion SL), CAC-UDRP-105977; Novartis AG v. Bao Fu, CAC-UDRP-105962 and WIPO Overview 3.0, section 1.8).

In relation to the gTLD ".com", it is well established that such element may typically be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark, as it is a technical requirement of registration (see WIPO Overview 3.0, section 1.11.1).

Therefore, the disputed domain name <**novartisresources.com**> is confusingly similar to Complainant's NOVARTIS Trademark.

2. **Rights or Legitimate Interests**

According to the submitted evidence, and given the absence of Response, this Panel finds that the Complainant has established its prima facie case in relation to the Second Element of the Policy, due to:

(1) nothing in the record suggests that there has been or there is a commercial relationship between the Complainant and the Respondent; the Complainant has never granted any rights or authorization to the Respondent to use the Trademark NOVARTIS, included as a domain name; nor the Respondent is a licensee, or it is associated or affiliated to the Complainant in any form.

(2) the Respondent purposely selected a well-known Trademark as NOVARTIS which it is protected at a worldwide level, including in China, add a term, suggesting a false affiliation and generating confusion among the Internet Users who expects to find the Complainant on the Internet.

In relation to the nature of the domain name, section 2.5.1 of the WIPO Overview 3.0, states that:

> "UDRP panels have found that domain names identical to a complainant's trademark carry a high risk of implied affiliation.
>
> **Even where a domain name consists of a trademark plus an additional term** (at the second- or top-level), UDRP panels have largely held that **such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner**." (emphasis added).

(3) there is no evidence that the Respondent has become commonly known by the term "novartisresources.com"; in contrary, and as the Complainant argued, by conducting a simple Google search, including in any IP database, of the word "Novartis", the Respondent could easily have noticed the Complainant's existence and value of NOVARTIS Trademark.

(4) there is no evidence that could possibly suggests to this Panel, that the Respondent has been using, or preparing to use, the disputed domain name in connection with a bona fide offering of goods and services or has made a legitimate noncommercial or fair use of the disputed domain name, as set out in paragraph 4(c)(i) and (iii) of the Policy.

In relation to the use of PPC websites with commercial links who looks to trade-off a complainant's (or its competitor's) trademark, section 2.9 of the WIPO Overview 3.0, states that:

> "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."

(5) Furthermore, the disputed domain name has active MX Records, fact that falls into potential illegal activities as the sale of counterfeit goods or illegal pharmaceuticals, phishing, malware distribution, or other types of frauds, as stated in section 2.13.1 of the WIPO Overview 3.0.

Therefore, this Panel concludes, that the Respondent has no rights or legitimate interests in respect of the disputed domain name **<novartisresources.com>**.

3. Registered and Used in Bad Faith

3.1. Registration in Bad Faith:

The Complainant owns a worldwide well-known Trademark, which Rights significantly predate the time of the disputed domain name's registration, i.e.: February 1, 2024.

Given the status of the Trademark NOVARTIS, the uses performed by the Respondent, the nature of the disputed domain name, to this Panel, it is very clear, that the Respondent registered the disputed domain name with the Complainant in mind, meaning in bad faith (see section 3.2.2 of the WIPO Overview 3.0).

Therefore, this Panel concludes that the disputed domain name was registered in bad faith.

3.2. Bad Faith Use:

Given the current use of the disputed domain name, i.e.: for a PPC website with commercial links related to the Complainant, the lack of response to the Complainant's Cease and Desist Letter, the presence of active MX records, to this Panel, it is also very clear, that the Respondent conduct falls into paragraph 4.(b)(iv) of the Policy. (Additionally see section 3.5 and 3.4 of the WIPO Overview 3.0).

Therefore, this Panel concludes that, the disputed domain name is being used in faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **novartisresources.com**: Transferred

PANELLISTS

Name	**María Alejandra López García**

DATE OF PANEL DECISION 2024-04-28

Publish the Decision