

Decision for dispute CAC-UDRP-106373

Case number	CAC-UDRP-106373
-------------	-----------------

Time of filing	2024-03-26 09:36:27
----------------	---------------------

Domain names	novatis.com
--------------	-------------

Case administrator

Name	Olga Dvořáková (Case admin)
------	-----------------------------

Complainant

Organization	Novartis AG
--------------	-------------

Complainant representative

Organization	BRANDIT GmbH
--------------	--------------

Respondent

Organization	Domain Privacy LTD
--------------	--------------------

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 numerous trademarks NOVARTIS registered in numerous jurisdictions (hereafter "the NOVARTIS trademark"), which were registered many years before the registration of the disputed domain name, such as but not limited to:

- 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, 22, 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 International trademark NOVARTIS No. 1349878, registered on November 29, 2016, in classes 9, 10, 41, 42, 44 and 45;
- The United States trademark NOVARTIS No. 2336960, registered on April 4, 2000, in classes 1, 5, 9, 10, 29, 30, 31, 32; and 42.

FACTUAL BACKGROUND

The Novartis Group 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. Novartis AG (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.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant alleges that the domain name <novatis.com> (hereinafter referred to as "Disputed Domain Name") incorporates in its second level-portion a misspelled version of the Complainant's well-known trademark NOVARTIS to by omitting the letter "r ". The Disputed Domain Name which resolves to an active website impersonating the Complainant postdates the NOVARTIS trademark. The Complainant contends that the registration and use of the Disputed Domain Name violates its rights and the terms of the Uniform Domain Name Dispute Resolution Policy.

The Complainant further contends that the typographical omission is purposeful, namely, to capitalize on Internet users' possible typing or reading errors when looking for information, or to communicate with, the Complainant online. The Complainant further alleges that it did not give the Respondent permission to register the Disputed Domain Name and it was not authorized to do so. The cumulative evidence supports the conclusion that the Respondent had actual knowledge of the Complainant. This is underscored by the use of the Disputed Domain Name in that it resolves to an active website containing hyperlinks to websites suggestive of healthcare and pharmaceutical products for which the Complainant has a world-wide reputation.

Finally, the Complainant alleges that the Respondent deliberately chose to use the well-known trademark NOVARTIS 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, cannot therefore be considered as a bona fide offering of goods or services nor as legitimate noncommercial or fair use of the Disputed Domain Name.

RESPONDENT:

The Respondent has not appeared formally or informally to controvert the evidence submitted by the Complainant.

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

Paragraph 15(a) of the Rules for the UDRP ('the Policy') instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

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

- (i) the domain name registered by respondent is identical or confusingly similar to a trademark or service mark in which complainant has rights; and
- (ii) respondent has no rights or legitimate interests in respect of the domain name; and

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

In view of the Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations and adduced proof pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint and annexes as true unless the evidence is clearly contradictory. See *Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (FORUM July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); see also *Talk City, Inc. v. Robertson*, WIPO Case No. D2000-0009 (WIPO February 29, 2000) ("In the absence of a response, it is appropriate to accept as true all [reasonable] allegations of the Complaint.").

Identical or Confusingly Similar to a Mark in which Complainant has a Right:

To succeed under the first element, a complainant must pass a two-part test by first establishing that it has a mark in which it has rights, and thereafter that the disputed domain name is either identical or confusingly similar to that mark. The first element of a UDRP complaint "serves essentially as a standing requirement." Here, the Complainant has established that it has rights in the word mark NOVARTIS by providing the Panel with the evidence that it has numerous registrations in many jurisdictions for its mark including the United States in which the Respondent resides. The consensus view which the Panel adopts is that a national or an international trademark registration is sufficient to establish rights in that mark. As such, the Panel finds that the Complainant has established that it has a right in the word mark NOVARTIS.

The second part of the test calls for comparing the Complainant's mark with the Disputed Domain Name. This entails "a straightforward visual or aural comparison of the trademark with the alphanumeric string in the domain name. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark." WIPO Overview 3.0 at section 1.7. The Panel observes that the single difference in this case is the omission of the letter "r". Misspellings are immaterial. Where the relevant trademark is recognizable within the disputed domain name it is sufficient to establish confusing similarity. The addition of the gTLD ".com" does not have any impact on the overall impression of the dominant portion of the disputed domain name and is therefore irrelevant in determining the confusing similarity between NOVARTIS and <novatis.com>.

Accordingly, Complainant has satisfied Paragraph 4(a)(i) of the Policy.

Determining Whether Respondent Lacks rights or legitimate interests in the Disputed Domain Name:

To establish the second of the three elements, the Complainant must first demonstrate that Respondent lacks rights and legitimate interests in the Disputed Domain Name. Recognizing that the proof for establishing this element is under the Respondent's control, the Complainant may satisfy this burden by offering a prima facie case based on such evidence as there is thus shifting the burden to the Respondent to produce evidence to overcome the presumption that it lacks rights or legitimate interests in the Disputed Domain Name. See *Advanced International Marketing Corporation v. AA-1 Corp*, FA 780200 (Forum November 2, 2011) (finding that a complainant must offer some evidence to make its prima facie case and satisfy Policy paragraph 4(a)(ii)).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. It states that it did not authorize the Respondent to register the Disputed Domain Name, the Respondent is not using the Disputed Domain Name for any bona fide use, nor can it claim to be known by the name "NOVARTIS" as the Registrar disclosed name is DNS Admin of Domain Privacy LTD

Further, the Complainant has adduced evidence based on the use of the Disputed Domain Name that Respondent is not using it for any non-commercial or fair use. See *Croatia Airlines d. d. v. Modern Empire Internet Ltd.*, WIPO Case No. D2003-0455 (the 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 Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the Policy).

The Panel finds that the Complainant's contentions and proof satisfy the presumptive burden that Respondent lacks rights or legitimate interests in the Disputed Domain Name. A respondent has the opportunity to controvert the prima facie case by adducing evidence demonstrating that it has rights or legitimate interests. The Policy sets forth the following nonexclusive list of factors:

- (i) "[B]efore any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services."
- (ii) "[Y]ou (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights."
- (iii) "[Y]ou are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

Evidence of any one of these defences will satisfy the rebuttal burden, but the absence of any evidence supports a complainant's contention that the respondent lacks rights or legitimate interests in the disputed domain name. The failure of a party to submit evidence on facts in its possession and under its control may permit the Panel to draw an adverse inference regarding those facts. See *Mary-Lynn Mondich and American Vintage Wine Biscuits, Inc. v. Shane Brown, doing business as Big Daddy's Antiques*, WIPO Case No. D2000-0004. Here, the Disputed Domain Name is virtually identical to the Complainant's mark. The sole difference is the omission of the letter "r". Misspellings such as omitting letters from the domain name undermine any right or legitimate interest a respondent may have claim

and the Panel so finds in this matter. See *Emerson Electric Co. v. golden humble /golden globals*, FA 1787128 (Forum June 11, 2018) ("lack of evidence in the record to indicate a respondent is authorized to use [the] complainant's mark may support a finding that [the] respondent does not have rights or legitimate interests in the disputed domain name per Policy ¶ 4(c)(ii)").

Noteworthy also in this case and supported by evidence in the record is that the Disputed Domain Name resolves to an active website containing hyperlinks to other websites for products and services suggestive of those associated with the Complainant. Where the "only apparent purpose would be to trade on mistakes by users seeking Complainant's web site" the registration is abusive, *Oxygen Media, LLC v. Primary Source*, WIPO Claim No. D2000-0362 (holding: "The substitution of the digit zero for the letter 'o' appears calculated to trade on Complainant's name by exploiting likely mistakes by users when entering the url address.") See also WIPO Overview 3.0 at 2.9: "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 Panel in *Legacy Health System v. Nijat Hassanov*, WIPO Case No. D2008-1708 found that the respondent had no rights or legitimate interests as "the sole purpose of the disputed domain name is to resolve to pay-per-click advertising websites and collect click-through revenue from advertising links. Such use demonstrates that the Respondent has used the disputed domain name to derive a commercial benefit"; also *Equifax Inc. v. DNS Admin, Buntai LTD*, WIPO Case No. D2023-3504.

As the Complainant has clearly established and the Respondent has not controverted the evidence that it lacks right or legitimate interests in the Disputed Domain Name, and for the reasons herein stated, the Panel finds that the Complainant has satisfied Paragraph 4(a)(ii) of the Policy.

Registration and Use in Bad faith:

It is the Complainant's burden under Paragraph 4(a)(iii) of the Policy to prove that the Respondent both registered and is using the Disputed Domain Name in bad faith. It is not sufficient for a complainant to rest its case on the finding under Paragraph 4(a)(ii) of the Policy, although the fact that the Respondent lacks rights or legitimate interests in the Disputed Domain Name will be a factor in assessing Respondent's motivation for registering a domain name that but for the omitted letter "r" is virtually identical to the Complainant's mark.

In this case, the Respondent employs a strategy of use known as typosquatting, which is defined as the "intentional misspelling of words with intent to intercept and siphon off traffic from its intended destination, by preying on Internauts who make common typing errors," *Nat'l Ass'n of Prof'l Baseball League, Inc. v. Zuccarini*, WIPO Case No. D2002-1011. The addition of a hyphen and another letter is a purposeful attempt to disguise the Disputed Domain Name as sponsored by the Complainant and is likely to confuse Internet viewers. *Cost Plus Management Services, Inc. v. xushuaiwei*, FA 1800036 (Forum Sep. 7, 2018) ("Typosquatting itself is evidence of relevant bad faith registration and use.").

The Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:

- (i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that the complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

The preamble to Paragraph 4(b) states: "For the purposes of Paragraph 4(a)(iii) [the finding of any of the circumstances] shall be evidence of the registration [...] of a domain name in bad faith." In the absence of a respondent to explain and justify its registration and use of a domain name corresponding to a famous or well-known mark, a Panel is compelled to examine the limited record for any exonerative evidence of good faith, *Talk City, supra*. (holding that on default the Panel "is left to render its decision on the basis of the uncontroverted contentions made, and the evidence supplied, by complainant.")

The Complainant's proof in this case focuses the Panel's attention on the fourth factor. As there is no proof that would support the other factors, the Panel will not address them. Here, the Complainant contends and submits proof that the Disputed Domain Name has been used to conduct malicious activities. More precisely, it has been used to create subdomains clearly inferring an association to the Novartis group, as they include terms related to the Novartis group's structure such as <aaa.novatis.com> - which refers to Advanced Accelerator Applications, a Novartis company - and <cibavision.novatis.com> - which refers to Ciba Vision, a former subsidiary of the Novartis group. These subdomains redirect to the web locations <http://ww12.novatis.com/?usid=18&utid=25147957745> and <http://ww12.novatis.com/?usid=18&utid=25147240833> displaying pay-per-click pages.

Moreover (the Complainant demonstrates) that the Disputed Domain Name is associated with an active mail exchange record. In addition, there have been four malicious files - all are associated with malware infections, cryptocurrency mining and of trojan-nature - which are communicating with the disputed domain name when they are executed. Analyzed by the VirusTotal tool, security vendors (respectively 56, 57, 56, 60) and sandboxes (2, 2, 4 and 3) flagged these files as malicious, associated with cryptocurrency mining, Trojan malware and ransomware. In similar circumstances, when the disputed domain name "has been used for pay-per-click links and to offer malware", it has been decided that "using the Domain Name to disseminate malware indicates bad faith and constitutes a disruption of the Complainant's business." See *International Business Machines Corporation v. Registration Private, Domains By*

Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico, WIPO Case No. D2021-0633.

While use of privacy services is not evidence conclusive of bad faith, *Rockhard Tools, Inc. v. jeff mcclure*, FA 1998526 (Forum July 8, 2022), purposeful concealment of the beneficial ownership of a domain name together with other facts set forth in the record may be conclusive. See *Instagram, LLC v. Registration Private, Domains By Proxy, LLC / Murat Sander*, WIPO Case No. D2021-0526 (“Respondent has taken active steps to conceal its identity behind a privacy service.”)

As the Complainant has demonstrated that the Respondent registered and is using the Disputed Domain Name in bad faith, it has satisfied 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. **novatis.com**: Transferred

PANELLISTS

Name Gerald Levine Ph.D, Esq.

DATE OF PANEL DECISION 2024-05-06

Publish the Decision