Decision for dispute CAC-UDRP-106560

Case number	CAC-UDRP-106560
Time of filing	2024-05-27 09:42:04
Domain names	novartismexico.com, novartis-satgob.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	Abion GmbH

Respondents

Name	Sofia Vergara
Name	Avior Administracion

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 several trademarks consisting either of the word element “NOVARTIS” alone or where “NOVARTIS” represents the main distinctive feature.

Some of the most relevant trademarks are as follows:

- United States (USPTO) Trademark registration for NOVARTIS, Reg. No.: 2336960, Priority date: 4 April 2000;
- United States (USPTO) Trademark registration for NOVARTIS, Reg. No.: 4986124, Priority date: 28 June 2016;;
- International Registration for NOVARTIS, Reg. No.: 1544148, Priority date: 29 June 2020;
- Mexican (IMPI) Trademark Registration for NOVARTIS (figurative), Reg. No.: 559142, Priority date: 26 September 1997;
- Mexican (IMPI) Trademark Registration for NOVARTIS, Reg. No.: 620661, Priority date: 31 August 1999.

Moreover, the Complainant owns an important domain names portfolio containing the wording NOVARTIS, such as:

- <novartis.com> registered on 2 April 1996;
- <novartis.us> registered on 19 April 2002;
- <novartispharma.com> registered on 27 October 1999.

FACTUAL BACKGROUND

Preliminary Procedural Issue: CONSOLIDATION OF MULTIPLE RESPONDENTS IN A SINGLE PROCEEDING

The Complainant relates to two disputed domain names which he wishes to have dealt within a single administrative proceeding.

Paragraph 10(e) of the Rules states that a Panel decides a request by a party to consolidate multiple domain name disputes in accordance with the Policy and the Rules. Paragraph 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0") states that in the case of complaints brought against more than one respondent, consolidation may be allowed where (i) the domain names or the websites to which they resolve are subject to common control; and (ii) the consolidation would be fair and equitable to all parties.

The Complainant explains that it is appropriate to consolidate the two disputed domain names disputes as one common proceeding appears to be more efficient and equitable to all parties, providing that the two disputed domain names have:

- one Registrar;

- same name servers;

- same hosting provider;

And were registered on the same day, i.e. May 2 2024.

Moreover, the Complaint explains that the websites placed historically or currently on the disputed domain names provided information and/or advertised the sale of various vehicles, purportedly from the Novartis fleet, and mention PROFECO (i.e, the Procuraduria Federal del Consumador), most likely in an attempt to provide consumers/internet users with a false sense of security.

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

The Complainant is a multinational healthcare company based in Switzerland. Novartis was founded in 1996 and nowadays manufactures several well-known drugs which are commercialized worldwide. Its operations overs most of the important jurisdictions, including the United States and Mexico, countries where it has an active presence through its subsidiaries and associated companies.

The disputed domain name <novartismexico.com> is not currently used in connection with any goods or services and resolves to a parking page with commercial links ("pay per click" links). However, prior to the take and down notice sent by the Complainant to hosting provider on 2024, a website allegedly advertising for sale several vehicles, apparently sold by Novartis, was placed on the disputed domain name <novartismexico.com>.

The disputed domain name <novartis-satgob.com> resolves to a website in Spanish allegedly in the name of the Mexican Government (Gobierno de México) and features claims regarding the sale of a vehicle fleet by Novartis allegedly with approvals from Profeco (Procuraduría Federal del Consumidor).

PARTIES CONTENTIONS

COMPLAINANT' CONTENTIONS:

Identical or confusingly similar

The Complainant argues that the disputed domain names <novartismexico.com> and <novartis-satgob.com>, which include the Complainant's registered trademarks featuring the distinctive element "NOVARTIS," are confusingly similar.

The Complainant asserts that the distinctive element "NOVARTIS" is well-known trademark. The disputed domain names incorporate this element entirely within their second-level portions. Furthermore, the Complainant contends that any differences between the disputed domain names and its registered trademarks involve generic or descriptive elements, which do not diminish the overall confusion between the signs.

Finally, according to the Complainant, the presence of the generic Top-Level Domain ("gTLD") extension ".com" in the first-level portion(s) of the disputed domain names is a standard registration requirement and should be disregarded when assessing whether the disputed domain names are confusingly similar to the trademark in which the Complainant holds rights.

No rights or legitimate interests

The Complainant argues that there is no evidence that the Respondents are commonly known by the disputed domain names or a name corresponding to them. Additionally, the Complainant states that the Respondents have not been authorized to use any of the Complainant's trademarks, nor to apply for or use any domain name incorporating such trademarks. The Complainant and the

Respondents have never had any previous relationships.

Furthermore, the Complainant contends that they contacted the Respondent through a Cease-and-Desist Letter regarding the disputed domain name <novartismexico.com> on 20 May, 2024, and received no response. In their view, this lack of response further demonstrates the Respondents' lack of rights or legitimate interests in respect to the disputed domain names.

Registered and used in bad faith

As for the issue of bad faith registration, the Complainant points out that their trademark registrations significantly predate the registration of the disputed domain names. Given the Complainant's worldwide presence and reputation, particularly in Mexico and North America, and considering that their trademarks are well-known, the Respondents could not have been unaware of the Complainant's rights over the name "NOVARTIS" at the time of registering the disputed domain names.

According to the Complainant, this is particularly evident considering that shortly after their registration, the disputed domain names began resolving to developed websites explicitly referring to the Complainant. These websites allegedly promoted the sale of a vehicle fleet connected to the Complainant.

Regarding bad faith use, the Complainant argues that the Respondent not only registered but also used the disputed domain names to attract Internet users to these websites, creating a likelihood of confusion with the Complainant and its trademark(s) for commercial gain. The aim was reportedly to induce internet users to purchase vehicles purportedly offered for sale on the websites.

Furthermore, at the time of filing this complaint, the disputed domain name <novartismexico.com> no longer resolves to the previous website but instead to a Parking Page with "pay per click" links. According to the Complainant, this use of the disputed domain name exemplifies bad faith, as it is motivated by commercial gain through creating confusion with the Complainant's trademark NOVARTIS.

RESPONDENT'S CONTENTIONS:

The Respondents did not respond to the Complaint.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 Respondents to have no rights or legitimate interests in respect of the disputed domain names (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 names have 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 of the Rules states that the Panel shall decide a Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law deemed applicable.

In the case of default by a Party, Rule 14 states that if a Party, in the absence of exceptional circumstances, does not comply with a provision of, or requirement under the Rules, the Panel shall draw such inferences therefrom as appropriate.

In the present case, the Respondent has not submitted any Response and consequently has not contested any of the contentions

made by the Complainant.

The Panel proceeds therefore to decide only on the basis of the Complainant's factual statements and the documentary evidence provided in support of them.

The first issue in this case is whether the complaint can be consolidated against two Respondents, as requested by the Complainant.

The Complainant argues that the Complaint should be consolidated on the basis that the disputed domain names are under the control of a single individual or entity.

Moreover, according to the Complainant, the following elements cumulatively demonstrate, on balance, that consolidation of all the disputed domain names is possible:

- same date of registration: 2 May 2024;

- same identity shield: Domains By Proxy, LLC;

- same extension hosting provider;

- same registrar, i.e. GoDaddy.com, LLC; and

- same name Servers: NS29.DOMAINCONTROL.COM NS30.DOMAINCONTROL.COM and NS09.DOMAINCONTROL.COM, NS10.DOMAINCONTROL.COM

Furthermore, according to the Complainant, there are indications of interconnection between the current and/or previous websites associated with the disputed domain names. Both websites have referenced or currently reference the sale of various vehicles allegedly from the Novartis fleet, and mention PROFECO (Procuraduría Federal del Consumidor), likely in an attempt to deceive consumers/internet users.

Considering all these circumstances together, rather than in isolation, the Panel accepts the Complainant's arguments. The Panel agrees that the similarities between the two websites in question, along with the fact that the disputed domain names were registered on the same date, are sufficient to establish, on the balance of probabilities, that these domain names are under common control.

Therefore, the Panel finds that the combination of these factors is sufficient to establish common control between the disputed domain names. Consolidation represents a procedurally more efficient solution for both parties in this case.

Based on the above mentioned, the Panel determines that the dispute in respect of the disputed domain names <novartismexico.com> and <novartis-satgob.com> can be consolidated within this proceeding.

1st UDRP element

The Complainant is owner of a considerable number of trademarks whose common distinctive element is a particle "NOVARTIS", which does not have any known meaning. Besides the EU protection, the trademark "NOVARTIS" have been registered by the Complainant in various non-EU countries, including the Mexico and the US.

The first disputed domain name, <novartismexico.com>, consists of the distinctive element "NOVARTIS" followed by the geographical term "Mexico" and the Top-Level domain ".com". The term "Mexico" is descriptive and non-distinctive in relation to the domain name <novartismexico.com>.

The second disputed domain name, <novartis-satgob.com>, includes the distinctive element "NOVARTIS" followed by the terms "SAT GOB", likely referring to the Mexican governmental Tax Administration Service (Servicio de Administración Tributaria, SAT). These terms are inherently less distinctive compared to the dominant term "NOVARTIS". The second disputed domain name also uses the Top-Level domain ".com".

Since the Complainant's trademark "NOVARTIS" is fully comprised within the disputed domain names that the additional elements have lower degree of distinctiveness, the Panel considers that the domain names are confusingly similar to Complainant's previously registered trademarks.

The Panel accordingly concludes that paragraph 4(a)(i) of the Policy is satisfied.

2nd UDRP element

The Respondents do not appear to be related to the Complainant's business and have never been known as "NOVARTIS" or any variation of this trademark.

Both disputed domain names resolved or resolves to webpages at some point that displayed content connected to the Complainant, despite no authorization being granted to the Respondent to use such content.

As a result, and in the absence of a Response, the Panel concludes that the Respondents lack rights or legitimate interests in the disputed domain name, thereby meeting the requirements of paragraph 4(a)(ii) of the Policy.

3rd UDRP element

As to the bad faith at the time of the registration, the Panel finds that, in light of the distinctiveness of the Complainant's trademark with which the disputed domain name is confusingly similar, and due to the worldwide presence of the Complainant's business known under the name "NOVARTIS", the Respondent was more likely be aware of the Complainant's trademark at the time of the registration of the disputed domain names.

Furthermore, the Complainant notes that the disputed domain names resolved and/or resolve to developed websites that clearly and explicitly refer to the Complainant, allegedly promoting the sale of a vehicle fleet associated with the Complainant.

While it is established that the Panel does not evaluate the content of the webpages connected to the disputed domain names, but rather assesses whether their registration and use comply with the Policy and the Rules, considering these circumstances and the fact that one of the disputed domain names (<novartismexico.com>) currently resolves to a parking page with pay-per-click advertisements, it can be inferred that the Respondents registered the disputed domain names for unjustified commercial gain through earnings from pay-per-click advertising or other activities that rely on the likelihood of confusion between the disputed domain names and the Complainant's registered trademark.

In light of these circumstances, the Panel finds that the disputed domain names were registered in bad faith.

Accordingly, the Panel finds that the Complainant 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. **novartismexico.com**: Transferred
2. **novartis-satgob.com**: Transferred

PANELLISTS

Name	**Hana Číslerová**

DATE OF PANEL DECISION 2024-07-01

Publish the Decision