Decision for dispute CAC-UDRP-106552

Case number	CAC-UDRP-106552
Time of filing	2024-05-27 10:28:04
Domain names	novartispharmac.com

Case administrator

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

Complainant

Organization	Novartis AG

Complainant representative

Organization	Abion GmbH

Respondent

Name	Ben Bruz

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 the owner of several trademark registrations for the word “NOVARTIS” notably the following:

- The Swiss trademark NOVARTIS No. 2P-427370, registered on July 1, 1996;
- The International trademark NOVARTIS No. 663765, registered on July 1, 1996;
- The European Union trademark NOVARTIS No. 013393641, registered on March 17, 2015;
- The United States trademark NOVARTIS No. 4986124, registered on June 28, 2016; and
- The United States trademark NOVARTIS No. 6990442, registered on February 28, 2023.

(hereinafter referred to also as “NOVARTIS Trademarks” or "NOVARTIS Trademark").

FACTUAL BACKGROUND

The Complainant, Novartis AG, established in Switzerland in 1996, is the holding company of the Novartis Group, one of the world's

largest pharmaceutical companies.

The Complainant's products are manufactured and sold in many countries throughout the world, including Belgium, where the Novartis Group has an active presence through the company Novartis Pharma N.V., which is part of the Group.

The complainant also owns domain names consisting of its trademark NOVARTIS alone, including <novartis.com> (registered in 1996), or in combination with other terms, such as <novartispharma.com> (registered in 1999).

The disputed domain name <novartispharmac.com> was created on 19 March 2024.

PARTIES CONTENTIONS

Complainant

The Complainant argues that the disputed domain name is confusingly similar to its NOVARTIS Trademarks, pointing out that the domain name includes its NOVARTIS marks in their entirety and the term "pharmac", which is likely to be either an abbreviation or a misspelled form of the term "pharmacy" with the last letter "y" removed. The Complainant submits that the addition of such a descriptive term would not prevent a finding of confusing similarity with the NOVARTIS Trademarks.

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain name.

In particular, the Complainant notes that (i) it has never granted the Respondent any right to use the trademark NOVARTIS in the disputed domain name, nor is the Respondent in any way affiliated with the Complainant (ii) there is no evidence that the Respondent is known by the disputed domain name or owns any corresponding registered trademarks, (iii) the Respondent has been identified in the WhoIs record associated to the disputed domain name, to use Novartis Pharma N.V.'s postal address (at Medialaan 40, 1800 Vilvoorde, Belgium). Therefore, it appears that the Respondent is attempting to impersonate the Novartis group, and (iv) the Respondent has not demonstrated any use or demonstrable preparation to use the disputed domain name in connection with a bona fide offering of goods or services.

The Complainant alleges that the Respondent has registered and is using the disputed domain name in bad faith. The Complainant alleges that the NOVARTIS trademarks are well known in many countries around the world and that most of the NOVARTIS trademarks predate the registration of the disputed domain name.

The Complainant is very active on social media to promote its trademark, products and services, and a simple online search of the name "Novartis" would have enabled the Respondent to learn about the Complainant, its trademark and its business. Furthermore, the Respondent used the address of the company Novartis Pharma N.V. in the Whois record. Therefore, the Respondent was aware of the Complainant and the NOVARTIS trademark at the time it registered the disputed domain name.

The Complainant further contends that on April 17, 2024, the disputed domain name resolved to an index page. It now resolves to a webpage displaying the message "Account Suspended This Account has been suspended. Contact your hosting provider for more information". The Complainant argues in the present case that several factual considerations are clear indicators of bad faith use under the passive holding doctrine, particularly (i) the disputed domain name entirely comprises the Complainant's well-known trademark NOVARTIS, (ii) the disputed domain name does not currently resolve to an active website, (iii) the Respondent did not reply to the Complainant's cease and desist letter, (iv) it is likely that the Respondent is trying to conceal its identity regarding the ownership of the disputed domain name, as its name and most of its contact details are covered by a privacy shield in the corresponding WhoIs record, (v) MX servers are configured, suggesting they may be actively used for e-mail purposes, and there is a risk of the disputed domain name being used for fraudulent purposes by impersonating the Complainant, (vi) the Respondent has used the company Novartis Pharma N.V.'s address, and (vii) the Respondent seems engaged in a pattern of conduct of registering domain names incorporating third parties' trademarks, namely the Respondent registered another domain name <abbottsnutritions.us>, which comprises the third-party's trademark ABBOTT and the relevant term "nutrition".

Respondent

No administratively compliant response has been submitted by the Respondent.

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).

The Complainant has successfully demonstrated that it is the rightful owner of several NOVARTIS Trademarks. The Panel acknowledges that the Complainant's NOVARTIS trademark is unmistakably recognizable in the disputed domain name and it notes that the additional word PHARMAC is a misspelling or abbreviation of the word "pharmacy" which due to its generic nature, is insufficient to prevent likelihood of confusion with the Complainant's trademarks.

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).

A complainant is required to establish a prima facie case that the respondent lacks rights or legitimate interests. Once such a case is made, the burden of proof shifts to the respondent to demonstrate their rights or legitimate interests in the disputed domain name. Failure to do so results in the complainant satisfying paragraph 4(a)(ii) of the Policy (as per Article 2.1 of WIPO Jurisprudential Overview 3.0 and WIPO Case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

Based on the contentions of the Complainant, the Panel finds that the Complainant has successfully established a prima facie case that the Respondent lacks rights or legitimate interests. As the Respondent has failed to provide relevant evidence demonstrating any such rights or legitimate interests, the Complainant is deemed to have satisfied the second element.

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).

Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant’s mark (see Article 3.1. of WIPO Jurisprudential Overview 3.0).

Registration in bad faith

In determining whether the disputed domain name was registered in bad faith, the Panel specifically considered the following factors

(a) The reputation of the NOVARTIS trademark. The Complainant contends that the Complainant's trademark is widely known. In support of this claim, the Complainant refers, inter alia, to the previous decision confirming the reputation of the NOVARTIS mark, namely WIPO Case No. D2020-3203, Novartis AG, Switzerland v. Amartya Sinha, Global Webs Link and Novartis RO, India. Referring to Article 4.1 of the WIPO Jurisprudence Overview 3.0, the Panel considers that, in identical or similar circumstances, recognition of the reputation of a mark in a prior UDRP decision should be considered as a factor in determining whether the Complainant's mark enjoys such reputation. On this basis, and also taking into account the evidence submitted by the Complainant, the Panel concludes that the Complainant has sufficiently demonstrated that the NOVARTIS Trademarks are well known.

(b) The long history of registration of the Complainant's NOVARTIS marks, some of which date back to 1996, whereas the disputed domain name was registered more recently.

(c) The fact that the Respondent used the address of the Complainant's affiliate Novartis Pharma N.V. as its address in the WHOIS records.

(d) That the Respondent used the words "pharmac", whereas the Complainant is best known as a pharmaceutical company.

Based on the foregoing, the Panel concludes that the Respondent must have been aware of the Complainant and its trademark when it registered the disputed domain name.

Therefore, the Panel finds that the Respondent registered the disputed domain name in bad faith.

Use in bad faith

The disputed domain name includes the Complainant's trademark in its entirety, giving the impression of a connection to the goods/services marketed by the Complainant and creating a likelihood of confusion with the NOVARTIS Trademarks.

There is no active website associated with the disputed domain name. In this regard, the Panel considered whether, in the circumstances of this particular case, the Respondent's passive holding of the disputed domain name could be considered a use of the disputed domain name in bad faith. According to the WIPO Jurisprudence Overview 3.0, non-use of a domain name would not preclude a finding of bad faith under the passive holding doctrine. Factors considered relevant in applying the passive holding doctrine include (i) the degree of distinctiveness or reputation of the complainant's mark; (ii) the respondent's failure to file a response or to provide evidence of actual or intended good faith use; (iii) the respondent's concealment of its identity or use of false contact information (in violation of its registration agreement); and (iv) the implausibility of any good faith use to which the domain name might be put (see also Telstra Corporation Limited vs. Nuclear Marshmallows, WIPO Case No. D2000-0003, <telstra.org>).

In the circumstances of this case, the Panel finds that the Complainant has successfully demonstrated the acquired distinctiveness and reputation of the Complainant's NOVARTIS trademark. In addition, the Panel notes that the Respondent has not provided any response or evidence of actual or intended use in good faith. The Panel also notes that the Respondent has used the same address as is the address of the Complainant´s affiliate in Belgium and that the Respondent appears to have engaged in similar pattern of conduct with respect to other domain names (see registration of the domain name <abbotnutrition.com>).

Finally, the Panel verified that MX records had been set up for the disputed domain name. An MX record is a resource record in the Domain Name System that specifies which email server is responsible for accepting email on behalf of a domain name (see WIPO Case No. D2022-0479 CKM Holdings Inc. v. Grant Chonko, Genesis Biosciences). The Panel notes that it is not necessary to assign MX records to a domain name if the registrant does not intend to use the domain name to send and receive e-mail. The activation of MX records to designate an e-mail server and enable e-mail is an action that goes beyond the mere registration of the disputed domain name and indicates that the Respondent has associated the disputed domain name with e-mail servers, which creates a risk that the Respondent may use the disputed domain name for misrepresentation and/or phishing and spamming activities.

Therefore, the Panel is satisfied that the totality of the circumstances of this case supports a finding that the Respondent's failure to use the domain name for a functional website, coupled with the setting of MX records, supports the Panel's finding that the disputed domain name is being used in bad faith.

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

The Panel has determined that the disputed domain name is confusingly similar to the Complainant's trademark.

Based on the contentions presented by the Complainant, the Panel has found that the Complainant has satisfactorily made a prima facie case that the Respondent lacks rights or legitimate interests. As the Respondent has failed to provide relevant evidence demonstrating any such rights or legitimate interests, the Complainant is deemed to have satisfied the second element.

The Panel finds that, based on the Complainant's contentions and evidence, it can be concluded that the Respondent must have been aware of the Complainant's trademarks when it registered the disputed domain name, and as such, the Respondent has registered the disputed domain name in bad faith.

Lastly, the Panel has concluded that the Complainant has successfully proven that the disputed domain name is being used in bad faith.

Therefore, for the aforementioned reasons, the Panel orders that the disputed domain name <novartispharmac.com> be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **novartispharmac.com**: Transferred

PANELLISTS

Name	**Karel Šindelka**

DATE OF PANEL DECISION 2024-07-10

Publish the Decision