Decision for dispute CAC-UDRP-106656

Case number	CAC-UDRP-106656
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Domain names	novartis-pharmanv.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	Abion GmbH

Respondent

Organization	Omexom NZ

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 a global pharmaceutical and healthcare provider, and owns and extensively uses the NOVARTIS trademark for which it owns a portfolio of trademark and service mark registrations including the following:

- International Trademark NOVARTIS (designating New Zealand), registration number 1,544,148, registered on June 29, 2020, for goods and services in classes 9, 35, 38, 42;
- International Trademark NOVARTIS (designating New Zealand), registration number 11349878, registered on November 29, 2016 for goods and services in classes 9, 10, 41, 42, 44, 45;
- New Zealand registered trademark, NOVARTIS registration number 264,409, registered on November 17, 1997 for goods in class 9;
- New Zealand registered trademark NOVARTIS registration number 264413, registered on November 17, 1997 for goods in class 32.

FACTUAL BACKGROUND

With headquarters in Switzerland, and approximately 76 000 full-time equivalent employees, in 2023 the Complainant had net sales amounting to USD 45.4 billion, and total net income of USD 14.9 billion.

The Complainant adds that it uses the NOVARTIS mark in numerous jurisdictions all over the world, and in New Zealand where the Respondent is allegedly located, it enjoys a local presence via its subsidiary Novartis New Zealand Ltd.

Additionally, the Complainant asserts that it has an Internet presence and is the owner of numerous domain names composed of either its NOVARTIS mark standing alone, as in <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). Referring to screen captures which are exhibited in annexes to the Complaint, the Complainant submits that these domain names resolve to its official websites, and its extensive online presence is also supported through its official social media accounts.

The disputed domain name was registered on July 23, 2024 and while it does not resolve to any active website, but has been used to create an MX record which is active and may be used to create an email account.

There is no information available about the Respondent except for that provided in the Complaint, the Registrar's WhoIs and the information provided by the Registrar in response to the request by the Center for details of the registration of the disputed domain name for the purposes of this proceeding.

PARTIES CONTENTIONS

The Complaint

The Complainant alleges that the disputed domain name <novartis-pharmanv.com> contains the Complainant's well-known trademark NOVARTIS in its second level-portion; and argues that the addition of the hyphen and the descriptive term "pharmanv" does not prevent a finding of confusing similarity to the trademark (see Minerva S.A. c. Domain Administrator, Fast Serv Inc. d.b.a. QHoster.com, WIPO Case No. D2019-2767).

The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0") 3.0 para. 1.8 states: "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements".

Furthermore the Complainant submits that the presence of the generic Top-Level Domain ("gTLD") extension <.com> in the first level portion of the disputed domain name is a standard registration requirement and may be disregarded when assessing whether the disputed domain name is confusingly similar to the trademark in which the Complainant has rights (see Rollerblade, Inc. v. Chris McCrady, WIPO Case No. D2000-0429; Can Pro Pet Products LTD. v. Matthew Dweck, WIPO Case No. D2020-0615; Sanofi v. Aamir Hitawala, WIPO Case No. D2021-1781).

The Complainant next alleges that the Respondent has no rights or legitimate interest in the disputed domain name arguing that

- the Complainant and the Respondent have no previous relationships;
- the Complainant has never granted the Respondent with any rights to use the NOVARTIS trademark, including in the disputed domain name;
- the exhibited screen captures annexed to the Complaint, the Complainant has not found that the Respondent is known by the disputed domain name;
- when searching for the terms "novartis-pharmanv" in the Google search engine, all top-returned results point to the Complainant; and when entering the disputed domain name terms along with the name of the Respondent "Smith Cole" there are no returned results which show that the Respondent is known by the disputed domain names;
- furthermore, when the Complainant carried out searches for trademarks in the name of the Respondent, no results were found;
- the Respondent could have easily performed a similar search before registering the disputed domain name and would have quickly learnt that the trademark is owned by the Complainant and that the Complainant has been using the trademark for its business activities, however the Respondent nonetheless still chose to register the disputed domain name.

The Complainant also refers to a screen capture exhibited in an annex to the Complaint which shows that on July 25, 2024, the disputed domain name <novartis-pharmanv.com> did not resolve to any active page; adding that the situation remained the same on the date of filing this Complaint.

It is argued that the evidence shows that the disputed domain name is passively held by the Respondent and therefore the disputed domain name is not being used in connection with bona fide offering of goods or services, i.e., 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" (see Bollore v. Tywonia W Hill, WIPO Case No. DCO2017-0012);

Neither is there is evidence showing 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.

The Complainant argues that in similar circumstances, it has been decided by panels established under the Policy that when "the Respondent has failed to make use of the resolving website and has not demonstrated any attempt to make legitimate use of the Disputed Domain Name and website. Such conduct evinces a lack of rights or legitimate interests in the Disputed Domain Name and thus, is not making a legitimate noncommercial or fair use of the Disputed Domain Name" (see Skandinaviska Enskilda Banken AB

v. Nick Jones, WIPO Case No. D2021-0703.

The Complainant adds that the WHOIS records for the disputed domain name show that the Respondent is using the name third-party company, which appears to be provider of engineering in New Zealand, to register the disputed domain name; although it seems that there is no connection between the mentioned organization and the Respondent. It is submitted that therefore the Respondent is submitting false WHOIS records, inserting different, possibly random, addresses in different countries, which is a further indication of the absence of any legitimate interest in the disputed domain name.

Next alleging that the disputed domain name was registered and is being used in bad faith, the Complainant argues that its rights in its registered trademarks significantly predate the registration of the disputed domain name on July 23, 2024, and the Respondent has never been authorized by the Complainant to register the disputed domain name.

It is further submitted that the Complainant has a global reputation and online presence, including in New Zeeland, where the Respondent purports to be established, which underscores the Respondent's likely knowledge of the Complainant and its trademark when registering the disputed domain name.

The Complainant submits that it is therefore inconceivable that the Respondent was unaware of the existence of the Complainant when it registered the disputed domain name.

Furthermore, the structure of the disputed domain name which incorporates the Complainant's well-known trademark NOVARTIS followed by the term "pharmanv", separated by hyphen, shows that the Respondent registered the dispute domain name having the Complainant and its NOVARTIS trademark in mind. The element "pharmanv" in combination with the NOVARTIS mark evokes a reference to the name of the Complainant's Belgian subsidiary corporation, Novartis Pharma NV.

The choice of the disputed domain name with these elements reflects the Respondent's clear intention to create an association, and a subsequent likelihood of confusion, with the Complainant's trademark in Internet users' mind.

The disputed domain name does not resolve to any active page as illustrated in a screen capture annexed to the Complaint, and is therefore passively held. The Complainant argues that previous panels established under the Policy have held, under the doctrine of passive holding, that "the non-use of a domain would not prevent a finding of bad faith" (see "WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition", section 3.3). More precisely, "it is possible, in certain circumstances, for inactivity by the Respondent to amount to the domain name being used in bad faith." (see Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003). Indeed, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0, section 3.3") points out that, from the inception of the UDRP, panelists have indeed consistently found that non-use of a domain name does not prevent a finding of bad faith under the doctrine of passive holding and that the factors that panelists take into account, whilst looking at all the circumstances, include:

- the degree of distinctiveness or reputation of the complainant's mark;
- the respondent's concealing its identity or use of false contact details which has been noted to be in breach of its registration agreement), and
- the implausibility of any good faith use to which the domain name may be put.

Additionally, the Complainant has exhibited a copy of an MX record for the disputed domain name which allows the creation of an email account. The Complainant submits that this is indicative of an intention to use the disputed domain name to engage in phishing.

Moreover, the Complainant asserts that it has recently filed proceedings regarding a cluster of the domain names and namely: <novartispharma-nv.com>, <novartispharmac-nv.com>, <novartis-belgie.com>, <novartispharmanv.com> (CAC-UDRP-106720), some of which were allegedly used for to conduct fraudulent e-mail phishing scheme with the purpose of deceiving suppliers/partners of the Complainant and potentially divert shipment of products.

The Complainant argues that the disputed domain name is very similar in its structure to the domain names described above one of which in particular refers to the Complainant's subsidiary in Belgium – Novartis Pharma NV.

The Complainant argues that the domain names at issue in the above proceeding are under common control with the disputed domain name. In this regard the Complainant notes that the Respondent in the current proceedings was disclosed as the registrant of the domain name <novartispharmanv.com> in other proceedings (CAC-UDRP-106720), however purporting to have a different address, located in Belgium but not New Zealand as in the case of the disputed domain name in the present dispute.

The Response

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

Rights and Confusing Similarity

The Complainant has provided uncontested convincing evidence of its rights in the NOVARTIS mark established by its portfolio of trademark registrations and extensive use of the mark in its global pharmaceutical business with approximately 76 000 full-time equivalent employees, and net sales amounting to USD 45.4 billion, and total net income of USD 14.9 billion in 2023.

The disputed domain name consists solely of the Complainant’s NOVARTIS mark in its entirety in combination with a hyphen and the term “pharmanv” and the Top Level Domain (“ gTLD”) extension <.com>.

The Complainant's NOVARTIS mark is the initial, dominant and only distinctive element in the disputed domain name. Neither the hyphen, nor the element "pharmanv", has any distinctive character and their presence in the disputed domain name following the NOVARTIS mark does not prevent a finding of confusing similarity with the mark.

In the circumstances of this Complaint the gTLD extension <.com> within the disputed domain name may be ignored for the purposes of comparing the mark and the disputed domain name, and therefore does prevent a finding that the disputed domain name is identical to the Complainant’s mark.

This Panel finds therefore that the disputed domain name is identical to the NOVARTIS mark in which the Complainant has rights and the Complainant has therefore succeeded in the first element of the test in Policy paragraph 4(a)(i).

Legitimate Interest

In its Complaint, the Complainant has made out a prima facie case that the Respondent has no rights legitimate interests in the disputed domain name as set out in the Complainant’s detailed submissions above.

It is well established that once a complainant makes out a prima facie case that a respondent has no rights or legitimate interests in the domain name at issue, the burden of production shifts to the respondent to prove its rights or legitimate interests.

The Respondent has failed to discharge that burden and therefore this Panel must find that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has therefore succeeded in the second element of the test in Policy paragraph 4(a)(ii).

Bad Faith

The disputed domain name was registered on July 23, 2024, whereas in 2023 the Complainant had an extensive global business, goodwill and reputation with the Complainant had net sales amounting to USD 45.4 billion, and total net income of USD 14.9 billion, and the Complainant has held registered trademark rights in New Zealand since 2020.

It is most improbable that the registrant of the disputed domain name was unaware of the Complainant when the disputed domain name was chosen and registered. Because of the distinctive character and fame of the NOVARTIS mark it is implausible that the disputed domain name was registered for any reason other than to create an association with Complainant's mark.

This Panel finds therefore that on the balance of probabilities the disputed domain name was chosen and registered in bad faith with the Complainant, its business, and NOVARTIS mark in mind with the intention of taking predatory advantage of the Complainant's goodwill and reputation in the mark.

The evidence shows that the disputed domain name is being passively held by the Respondent in the sense that it does not resolve to any active website.

However, the Respondent has used the disputed domain name to create an MX record. Taking such a step in circumstances where the disputed domain name does not resolve to any active website, and where the Respondent has chosen and registered the disputed domain name intending that it is confusingly similar to the Complainant's trademark, and where the disputed domain name is almost identical to the name of the Complainant's Belgian subsidiary, and there is no engagement by the Respondent in this proceeding, is very sinister.

Taking into account, the distinctive and famous character of the NOVARTIS mark, that the Respondent has not engaged with this proceeding, and has not used the disputed domain name for any purpose except to create an MX record, and furthermore that it appears that the Respondent has engaged in a pattern of registration of domain names which incorporate the Complainant's NOVARTIS mark while using incorrect WhoIs information, this Panel finds that the passive holding of the confusingly similar disputed domain name constitutes use in bad faith for the purpose of the Policy.

This Panel finds therefore that the disputed domain name was registered and is being used in bad faith and the Complainant has succeeded in the third element of the test in Policy paragraph 4(a)(iii).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **novartis-pharmanv.com**: Transferred

PANELLISTS

Name	**James Bridgeman**

DATE OF PANEL DECISION 2024-08-25

Publish the Decision