Decision for dispute CAC-UDRP-106910

Case number	CAC-UDRP-106910
Time of filing	2024-10-07 11:47:59
Domain names	novartispharmanv-be.com, novartispharmnv-be.com, novartispharmacnv.com, novartispharm-nv.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	Abion GmbH

Respondents

Name	Smith Cole
Name	Angelica Wright

OTHER LEGAL PROCEEDINGS

The Panel is unaware of any other pending or decided legal proceedings in respect of the disputed domain names <novartispharmanv-be.com>, <novartispharmnv-be.com>, <novartispharmacnv.com>, and <novartispharm-nv.com> (collectively referred to as 'the Domain Names').

IDENTIFICATION OF RIGHTS

For the purpose of this UDRP administrative proceeding, the Complainant relies upon the following registered trade marks, amongst others:

- US trade mark registration no. 2997235, registered on 20 September 2005, for the word mark NOVARTIS, in class 5 of the Nice Classification;
- International trade mark registration no. 1349878, registered on 29 November 2016, designating inter alia Norway, for the word mark NOVARTIS, in classes 9, 10, 41, 42, 44, and 45 of the Nice Classification; and
- International trade mark registration no. 1544148, registered on 29 June 2020, designating inter alia EU and UK, for the word mark NOVARTIS, in classes 9, 35, 38, and 42 of the Nice Classification.

(Collectively referred to as 'the Complainant's trade mark').

In addition to the non-exhaustive list of trade marks mentioned above, the Complainant is also the owner of numerous domain

names bearing the sign 'novartis', most notably: 1) <novartis.com>, which was registered in 1996; and 2) <novartispharma.com>, which was registered in 1999.

The Domain Names were registered on the following dates:

<novartispharmanv-be.com>	9 September 2024
<novartispharmnv-be.com>	24 September 2024
<novartispharmacnv.com>	24 September 2024
<novartispharm-nv.com>	9 September 2024

At the time of writing, the Domain Names do not resolve to active websites (for present purposes, the websites are collectively referred to as 'the Respondent's websites', and the registrants/holders of the Domain Names as 'the Respondent').

FACTUAL BACKGROUND

A. Complainant's Factual Allegations

The Complainant's statements of fact can be summarised as follows:

The Complainant is one of the largest global pharmaceutical and healthcare groups, created in 1996 through a merger of the companies Ciba-Geigy and Sandoz. In 2023, the Complainant achieved net sales of USD 45.4bn.

B. Respondent's Factual Allegations

The Respondent has failed to serve a Response in this UDRP administrative proceeding. Hence, the Complainant's factual allegations are uncontested.

PARTIES CONTENTIONS

A. Complainant's Submissions

A.1 Preliminary Issue - Application for Consolidation of Complaints against Multiple Registrants

In the Complaint, the Complainant advises that the Domain Names are owned by the following individuals/entities:

<novartispharmanv-be.com>	Smith Cole
<novartispharmnv-be.com>	Smith Cole
<novartispharmacnv.com>	Angelica Wright
<novartispharm-nv.com>	Angelica Wright

The Complainant submits that the Domain Names are subject to a common control, thereby making the consolidation of the proceedings equitable and procedurally efficient ('the Complainant's Application for Consolidation').

The Complainant's Application for Consolidation is grounded on the following factors:

- the Domain Names were registered at close dates and through the same registrar;
- the Domain Names share similar structure and name servers;
- the Domain Names do not resolve to active websites; and
- the Domain Names are in common control of the same person/entity in CAC Case No. 106656 (in respect of the disputed domain name <novartis-pharmanv.com>) and CAC Case No. 106720 (in respect of the disputed domain names

<novartispharma-nv.com>, <novartis-belgie.com>, <novartispharmac-nv.com>, and <novartispharmanv.com>). The Domain Names share a similar structure to the domain names subject to the above mentioned UDRP administrative proceedings: they all incorporate the Complainant's trade mark along with terms related to the Complainant's subsidiary in Belgium (Novartis Pharma NV). Furthermore, the registrant of record for the Domain Names <novartispharmanv-be.com> and <novartispharmnv-be.com> is 'Smith Cole' who is the same registrant of record for the disputed domain name <novartispharmanv.com> (CAC Case No. 106720) and for the disputed domain name <novartis-pharmanv.com> (CAC Case No. 106656).

For the foregoing reasons, the Complainant requests that the Domain Names and the named Respondents be consolidated into a single UDRP administrative proceeding.

A.2 Substantive grounds

The Complainant's contentions can be summarised as follows:

A.2.1 The Domain Names are identical or confusingly similar to a trade mark in which the Complainant has rights

The Complainant advances the following submissions under this UDRP Policy ground:

• **<novartispharma-nv.com>**: the Domain Name incorporates the Complainant's well-known trade mark followed by the terms 'pharma' and 'nv', separated by a hyphen. The Complainant's subsidiary in Belgium is named 'Novartis Pharma NV';

• **<novartispharmanv-be.com>**: the Domain Name incorporates the Complainant's well-known trade mark followed by the terms 'pharma', 'nv' and 'be' (common abbreviation for Belgium), separated by a hyphen. The Complainant's subsidiary in Belgium is named 'Novartis Pharma NV';

• **<novartispharmacnv.com>**: the Domain Name incorporates the Complainant's well-known trade mark followed by the terms 'pharmac' (a misspelled version of the terms pharma and pharmacy) and 'nv'. The Complainant's subsidiary in Belgium is named 'Novartis Pharma NV'; and

• **<novartispharmnv-be.com>**: the Domain Name incorporates the Complainant's well-known trade mark followed by the (misspelled) term 'pharm', as well as the terms 'nv' and 'be' (common abbreviation for Belgium), separated by a hyphen. The Complainant's subsidiary in Belgium is named 'Novartis Pharma NV'.

The Complainant submits that the addition of these descriptive terms is insufficient to escape the finding that the Domain Names are confusingly similar to the Complainant's trade mark. In particular, the terms 'pharmac', 'pharma', 'pharm', 'nv', and 'be; directly refer to the Complainant (and Complainant's subsidiaries in Belgium) as well as the Complainant's business. Furthermore, the generic Top-Level Domain ('the gTLD') suffix (<.com>) is a standard registration requirement and have no bearing on the test under this UDRP Policy ground.

The Complainant further alludes to the decisions rendered in CAC Case No. 106656 and CAC Case No. 106720, in which the panels have found the disputed domain names to be confusingly similar to the Complainant's trade mark NOVARTIS.

A.2.2 The Respondent has no rights or legitimate interests in respect of the Domain Names

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the Domain Names. The Respondent does not carry out any activity for, or has any business with, the Complainant. The Complainant has not authorised the Respondent to make any use of the Complainant's trade mark, or to apply for registration of the Domain Names.

The Complainant further submits that there is no evidence that the Respondent has acquired any rights in a trade mark corresponding to the Domain Names. In addition, the Domain Names are being held passively, and there is no evidence showing bona fide or legitimate noncommercial or fair use.

A.2.3 The Respondent registered and is using the Domain Names in bad faith

A.2.3.1 Registration

The Complainant submits that it is inconceivable that the Respondent would have registered the Domain Names without actual knowledge of the Complainant owing to the distinctiveness and reputation of the Complainant’s business and the Complainant’s trade mark. In addition, the structure of the Domain Names – bearing the Complainant’s trade mark followed by the terms ‘pharmac’, ‘pharm’, ‘pharma’, ‘nv’, and ‘be’ – underscores that the Respondent has registered the Domain Names with the Complainant in mind.

A.2.3.2 Use

The Complainant avers that the Respondent has used the Domain Names to attract Internet users and monetarily capitalised on that confusion. The Complainant seeks a finding of bad faith use under paragraph 4(b)(iv) of the UDRP Policy. The Complainant also refers to the doctrine of passive holding to support its claim for a finding of bad faith. The present case scenario would have fulfilled the criteria of the passive holding test (see Telstra Corporation Limited v Nuclear Marshmallows, WIPO Case No. D2000-0003; and paragraph 3.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, 'the WIPO Jurisprudential Overview 3.0').

Additionally, the Complainant asserts that the Respondent has configured the Domain Names with an MX (mail exchange) record, and that this may be indicative of the Respondent's intention to capitalise on the Complainant by engaging in email phishing or other

fraudulent activities.

The Complainant further states that the registrant of record for the Domain Names <novartispharmanv-be.com> and <novartispharmnv-be.com>, Smith Cole, appears to have registered other domain names bearing third party's brands, and this showcases a pattern of abusive conduct on the Respondent's part. In addition, Smith Cole appears to have used false information in the Whois, and this constitutes bad faith use of the domain name.

The Complainant alludes once again to the decisions rendered in CAC Case No. 106656 and CAC Case No. 106720, in which the panels have found the disputed domain names to be used for a fraudulent e-mail phishing scheme.

The Complainant concludes that the Respondent has registered and is using the Domain Names in bad faith.

B. Respondent's Submissions

The Respondent has defaulted in this UDRP administrative proceeding and has therefore failed to advance any substantive case on the merits.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that the Domain Names are identical or confusingly similar to a trade mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the UDRP 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 Domain Names (within the meaning of paragraph 4(a)(ii) of the UDRP Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Domain Names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the UDRP Policy).

PROCEDURAL FACTORS

1. Complainant's Application for Consolidation

The Complainant has filed a Complaint against two respondents (identified in section A.1 above), in respect of four domain names. Paragraph 4(f) of the UDRP Policy and paragraph 3(c) of the UDRP Rules do not expressly permit the manner in which the Complaint has been brought. On the contrary, the UDRP legal framework permits the filing of a complaint in respect of more than one domain name in the situation where the holder of the domain names is the one and the same entity. Consequently, it falls on the Panel to determine whether the filing of the Complaint in its current form is acceptable.

The Panel has considered the available record, the UDRP legal framework, and the WIPO Jurisprudential Overview 3.0 (paragraph 4.11.2) which enumerates circumstances underpinning the panel's consideration of a consolidation request.

Under the UDRP Rules (Rule 10(b) and Rule 10(c)), the Panel shall seek to promote procedural (cost and time) efficiency while also ensuring that the parties are treated with equality and that each party is given a fair opportunity to present its case.

The Panel considers that the consolidation request sought by the Complainant requires the Panel to apply the balance of convenience test, according to which the Panel would have a duty to consider which party would suffer the greatest inconvenience as a result of the Panel’s determination. Such an exercise, however, will need to be balanced within the parameters of the UDRP legal framework.

The Panel has perused paragraph 4.11.2 of the WIPO Jurisprudential Overview 3.0, which lists a whole host of considerations which may assist panels in the determination of whether a consolidation is appropriate.

Considerations conducive to a finding of common control would include commonalities, links and patterns in the registrant information, for example shared administrative or technical contacts, email or postal addresses, the website to which the domain name resolve, and any other circumstances which could point in the direction of a unity of interests, such that the registrants may be treated as a single domain name holder within the scope of Rule 3 (c) of the UDRP Rules.

Turning to the facts of the present case, the Panel has identified the following details related to the registrants and the Domain

Names:

Registrant / Country	Domain Name	Registration date	Registrar
Smith Cole (Norway)	<**novartispharma**nv-be.com>	9 September 2024	PDR Ltd. d/b/a PublicDomainRegistry.com
Smith Cole (Norway)	<**novartispharm**nv-be.com>	24 September 2024	PDR Ltd. d/b/a PublicDomainRegistry.com
Angelica Wright (United Kingdom)	<**novartispharma**cnv.com>	24 September 2024	PDR Ltd. d/b/a PublicDomainRegistry.com
Angelica Wright (United Kingdom)	<**novartispharm**-nv.com>	9 September 2024	PDR Ltd. d/b/a PublicDomainRegistry.com

(emphasis added)

The Domain Names share readily identifiable commonalities. In addition to having been registered around the same time, through the same registrar, and delegated to the same nameservers, there is a pattern of domain name string structure. These factors underpin the Complainant's asserted common grievance. Despite not sharing registrant names or contact details, it seems far-fetched to the Panel that these registrations were coincidental, by pure chance. In the Panel's view, there is compelling evidence that the two different registrants of record are either one and the same entity, or in some way under the control of another person, or aliases for a single entity.

The Panel is therefore persuaded by the Complainant's arguments supporting the application for consolidation and, on that basis, the application is granted.

In light of the above, the Panel will refer to the registrants of record collectively as 'the Respondent' in the remainder of the decision.

2. Miscellaneous

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

A. UDRP Threshold

Pursuant to Rule 15 of the UDRP Rules, the Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the UDRP Policy, the UDRP Rules, and any rules and principles of law that the Panel deems applicable.

Paragraph 4(a) of the UDRP Policy sets out the grounds which the Complainant must establish to succeed:

i. The Domain Names are identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;

ii. The Respondent has no rights or legitimate interests in respect of the Domain Names; and

iii. The Domain Names have been registered and are being used in bad faith.

It is incumbent on the Complainant the onus of meeting the above threshold. The evidentiary standard under the UDRP proceedings is the balance of probabilities and, on that basis, the Panel will now proceed to determine each of the three UDRP Policy grounds in turn.

B. Identical or Confusingly Similar

The Panel is satisfied that the Complainant has UDRP-relevant rights in the registered trade mark NOVARTIS since at least 2005.

The Domain Names, which were registered in 2024, are <novartispharmanv-be.com>, <novartispharmnv-be.com>, <novartispharmacnv.com>, and <novartispharm-nv.com>. Each of them incorporates the Complainant's trade mark NOVARTIS in their strings. The Domain Names also contain the additional – and generic – words 'pharma', the misspelled versions 'pharm' and 'pharmac', as well as the adjacent keyboard letters or abbreviations 'nv' and 'be'. These generic terms, nonetheless, have no bearing on the recognisability of the Complainant's trade mark NOVARTIS. On the contrary, they heighten the risk of affiliation with the Complainant given that they are readily associated with the Complainant's business segment. Moreover, TLDs are typically immaterial to the test under this UDRP Policy ground (see eg WIPO Jurisprudential Overview 3.0, paragraph 1.11).

The Panel therefore finds that the Complainant has met the requirement under paragraph 4(a)(i) of the UDRP Policy.

C. Rights or Legitimate Interests

The Respondent has defaulted in this UDRP administrative proceeding and the Panel is empowered to draw adverse inferences therefrom (Rule 14 (b) of the UDRP Rules).

The Panel is convinced that the Respondent (as an individual, business, or other organisation) has not been commonly known by the Domain Names, and it likewise has not been authorised by the Complainant to make any use of the Domain Names.

Furthermore, the Panel finds on the undisputed evidence on record that the Respondent has made no use of the Domain Names whether for a bona fide offering of goods or services, or for a legitimate noncommercial or fair use.

The Complainant has therefore satisfied the second requirement of the UDRP Policy.

D. Registered and Used in Bad Faith

The Panel has no hesitation in finding that the Respondent registered and has used the Domain Names with full knowledge of, and intention to target, the Complainant. The case's factual matrix largely supports a presumption of bad faith registration and use: (i) the worldwide reputation of the Complainant and the Complainant's trade mark; (ii) the evident similarity between the Domain Names and the Complainant's trade mark, and the Respondent's attempt to create such unwarranted link or connection; (iii) the Respondent's default in this UDRP administrative proceeding, and failure to refute the Complainant's prima facie case; (iv) the Respondent's attempt to gain reputational advantage by redirecting Internet users for a likely fraudulent purpose; and (v) the absence of any conceivable good faith use of the Domain Names.

In view of the above, the Panel finds that the Complainant has satisfied the third and final requirement of the UDRP Policy.

E. Decision

For the foregoing reasons, in accordance with paragraph 4(a) of the UDRP Policy and Rule 15 of the UDRP Rules, the Panel orders that the Domain Names <novartispharmanv-be.com>, <novartispharmnv-be.com>, <novartispharmacnv.com>, and <novartispharm-nv.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. **novartispharmanv-be.com**: Transferred
2. **novartispharmnv-be.com**: Transferred
3. **novartispharmacnv.com**: Transferred
4. **novartispharm-nv.com**: Transferred

PANELLISTS

Name	**Gustavo Moser**

DATE OF PANEL DECISION 2024-11-15

Publish the Decision