Decision for dispute CAC-UDRP-106997

Case number	CAC-UDRP-106997
Time of filing	2024-10-29 09:06:47
Domain names	fr-novartis.com

Case administrator

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

Complainant

Organization	Novartis AG

Complainant representative

Organization	Abion GmbH

Respondent

Name	Jude Duke

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, Novartis AG, is a leading global pharmaceutical company headquartered in Switzerland. The Complainant owns numerous trademark registrations for the mark NOVARTIS in multiple jurisdictions worldwide, including International Trademark Reg. No. 663765 (registered July 1, 1996), among others. The Complainant also owns domain names incorporating its trademark, such as <novartis.com>.

The Respondent registered the Disputed Domain Name <fr-novartis.com> on September 26, 2024. At the time of the Complaint, the Disputed Domain Name resolved to an inactive page. Active MX records were associated with the Disputed Domain Name.

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. In 2023, Novartis achieved net sales of USD 45.4 billion, and total net income amounted to USD 14.9 billion and employed approximately 76 000 full-time equivalent employees as of December 31, 2023. The Complainant’s products are manufactured and sold in many countries worldwide. Moreover, the Complainant also has an active presence through its subsidiaries and associated companies in Australia and in France.

The Complainant is the owner of the registered trademark NOVARTIS in numerous jurisdictions all over the worldwide. The Complainant also owns numerous domain names composed of either its trademark NOVARTIS alone, including <novartis.com> (created on 2 April 1996), <novartis.us> (created on 19 April 2002) or in combination with other terms, such as <novartispharma.com> (created on 27 October 1999). The Complainant uses these domain names to resolve to its official websites through which it informs Internet users and potential consumers about its NOVARTIS mark and its related products and services.

The Complainant states that he has never granted the Respondent any right to use the NOVARTIS trademark in the Disputed Domain Name, nor is the Respondent affiliated to the Complainant in any form.

The Complainant states that he has never granted the Respondent any right to use the NOVARTIS trademark in the Disputed Domain Name, nor is the Respondent affiliated to the Complainant in any form.

The Complainant has not found that the Respondent is known by the Disputed Domain Name. Indeed, when searching for the Disputed Domain Name terms “fr-novartis” and “fr novartis”, all of the results directly relate to the Novartis group, the Complainant, as well as its website, its social medias accounts or related topics.

The Complainant is of the opinion that 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 still chose to register the Disputed Domain Name as such.

Complainant states that at the time the Complainant found out about the Disputed Domain Name on October 1, 2024, it resolved to an inactive page. 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.

The Disputed Domain Name is thus in the view of Complainant being passively held. Such use of the Disputed Domain Name cannot therefore be considered as a bona fide offering of goods or services nor as legitimate non-commercial or fair use.

Moreover, on October 1, 2024, the Complainant sent a cease-and-desist letter to the Registrant, informing them of the Complainant’s rights regarding the NOVARTIS trademark, to which the Respondent did not reply. The Complainant also sent reminders to the Registrant on October 11, 2024, and October 16, 2024.

The Complainant states that considering that the NOVARTIS trademark is well known and that the Complainant is a globally renowned pharmaceutical company, it clearly appears that the Respondent knew the Complainant and the NOVARTIS trademark at the time it registered the Disputed Domain Name.

The Complainant states that the structure of the Disputed Domain Name reflects the Respondent’s intention to create an association, and a subsequent likelihood of confusion, with the Complainant, its NOVARTIS trademark and the Novartis group in Internet users’ mind, as by reading the Disputed Domain Name, Internet users may believe that it is directly connected to or authorized by the Complainant. In this regard, previous UDRP panels have consistently found that the mere registration of a domain name that is confusingly similar to a widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith.

In addition, at the time of filing of this complaint, the Disputed Domain Name is being passively held.

In the present case, several factual considerations are in view of Complainant's clear indicators of bad faith use under the passive holding doctrine.

The Disputed Domain Name comprises the Complaint’s well-known trademark NOVARTIS in its entirety, preceded by the term “fr” and separated by a hyphen. The geographical term “fr” refers to country code for France, a country where the Complainant has an active business presence. The Disputed Domain Name is currently passively held. At the time the Complainant found out about the Disputed Domain Name on October 1, 2024, it resolved to an inactive page. Similarly, at the time of filing of this complaint, the Disputed Domain Name also resolves to an inactive page.

Furthermore, on October 1, 2024, the Complainant sent a cease-and-desist letter to the Registrant. In the cease-and-desist letter, the Complainant advised the Respondent that the unauthorized use of their trademark within the Disputed Domain Name violates their trademark rights and requested a voluntary transfer of the Disputed Domain Name. The Complainant also sent reminders to the Registrant on October 11, 2024, and October 16, 2024. There was no response from the Respondent, which infers in the view of Complainant bad faith.

In addition, active MX records are associated to the Disputed Domain Name. There is therefore in the view of the Complainant a risk that corresponding fraudulent e-mail addresses be used. Internet users receiving e-mails from e-mail addresses associated with the Disputed Domain Name (such as “[…]@fr-novartis.com”) may be led to believe that they are personally contacted by the Complainant client. Being deceived, Internet users may start to interact with the sender and be victims of fraud attempts. There is therefore a risk of the Disputed Domain Name being used for fraudulent purposes, by impersonating the Complainant.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be

transferred to it.

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

A. Identical or Confusingly Similar

The Disputed Domain Name incorporates the Complainant's well-known trademark NOVARTIS in its entirety, preceded by the geographic abbreviation "fr" and separated by a hyphen. As recognized in prior UDRP decisions, the addition of geographic or descriptive terms does not prevent a finding of confusing similarity where the trademark remains clearly recognizable. The generic Top-Level Domain ("gTLD") ".com" is therefore disregarded in this assessment.

Accordingly, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's trademark.

B. Rights or Legitimate Interests

The Complainant has made a prima facie case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. The Respondent is not affiliated with or authorized by the Complainant to use the NOVARTIS mark. The Respondent is not commonly known by the Disputed Domain Name, nor is there any evidence of the Respondent's legitimate use of the Disputed Domain Name. At the time of the Complaint, the Disputed Domain Name resolved to an inactive webpage, and no evidence suggests any preparation for bona fide use.

The Respondent's failure to respond to the Complainant's cease-and-desist letters further supports a lack of legitimate interests.

The Panel concludes that the Respondent has no rights or legitimate interests in the Disputed Domain Name.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent registered and is using the Disputed Domain Name in bad faith for the following reasons:

The Complainant's NOVARTIS trademark is well-known, and the Respondent's incorporation of the trademark alongside the geographic term "fr" (indicating France, where the Complainant operates) strongly suggests that the Respondent was aware of the Complainant and intended to create an association with the Complainant.

The Disputed Domain Name resolves to an inactive page. Passive holding of a domain name incorporating a well-known trademark constitutes bad faith under UDRP principles (Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003).

Active MX records associated with the Disputed Domain Name indicate a risk of the domain being used for phishing or other fraudulent activities.

Moreover, on October 1, 2024, the Complainant sent a cease-and-desist letter to the Registrant, informing them of the Complainant's rights regarding the NOVARTIS trademark, to which the Respondent did not reply. The Complainant also sent reminders to the Registrant on October 11, 2024, and October 16, 2024.

Based on these factors, the Panel finds that the Disputed Domain Name was registered and is being used in bad faith.

Decision

For the foregoing reasons, in accordance with Paragraph 4(i) of the Policy and Paragraph 15 of the Rules, the Panel orders that the Disputed Domain Name <fr-novartis.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. **fr-novartis.com**: Transferred

PANELLISTS

Name	**Jan Schnedler**

DATE OF PANEL DECISION 2024-11-21

Publish the Decision