Decision for dispute CAC-UDRP-106994

Case number	CAC-UDRP-106994
Time of filing	2024-10-25 09:47:19
Domain names	novartisusdt.com, novartissvip.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	Abion GmbH

Respondent

Organization	Sophie

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 names.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of several trademarks for NOVARTIS. In particular, Novartis AG owns:

- International registration No. 663765 registered on July 1, 1996 and duly renewed for goods and services in classes 1, 2, 3, 4, 5, 7, 8, 9, 10, 14, 16, 17, 20, 22, 28, 29, 30, 31, 32, 40 and 42;

- International registration No. 1544148 registered on June 29, 2020 for goods and services in classes 9, 35, 38 and 42;

- US trademark No. 2336960 registered on April 4, 2000 and duly renewed for goods and services in classes 1, 5, 9, 10, 29, 30, 31, 32 and 42;

- US trademark No. 4986124 registered on June 28, 2016 for goods and services in classes 5, 9, 10, 41, 42 and 44;

- US trademark No. 6990442 registered on February 28, 2023 for goods in class 25;

- EU trademark No. 304857 registered on June 25, 1999 and duly renewed for goods and services in classes 1, 5, 9, 10, 29, 30, 31 and 32

FACTUAL BACKGROUND

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

The Complainant, 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 informs that its products are manufactured and sold in many countries worldwide, including in the United States, where it has an active presence through its subsidiaries and associated companies and where it has been playing an active role on the local markets and societies.

The Complainant is the owner of the registered well-known trademark NOVARTIS in numerous jurisdictions all over the world. The Complainant trademark registrations predate the registration of the disputed domain names <novartissvip.com>, which was registered on October 3, 2024, and <novartisusdt.com>, which was registered on September 29, 2024.

According to the Complainant, the domain names in dispute are similar to its NOVARTIS trademark since both incorporate the well-known distinctive trademark NOVARTIS in its entirety combined with generic terms.

The Complainant has not found that the Respondent is known by the disputed domain names terms. Indeed, when searching for “novartissvip”, “novartiss vip”, “novartisusdt” and “novartis usdt” in the Google search engine, all top returned results point to the Complainant, except for the results related to the disputed domain names themselves. When entering the disputed domain names terms along with the name of the Respondent “Sophie” there are no returned results showing that the Respondent is known by the disputed domain names. The Complainant argues that the Complainant trademarks predate the registration of both domain names in dispute and that the Respondent has never been authorized by the Complainant to register the domain names.

The Complainant has also shown that, at the time the Complainant found out about the disputed domain names, they resolved to identical websites showing the NOVARTIS trademarks in prominent positions, along with texts, videos and other materials clearly related to the Complainant. The above websites were allegedly posing as financial investment platforms operated by Novartis, where internet users can register for an account and deposit funds. It suggests a potential intent to deceive or confuse internet users, by falsely associating the websites at the disputed domain names with the Complainant, in order to lure unsuspecting internet users into a potential fraud.

In order to stop such abuse, the Complainant respectively sent takedown requests to the Registrar and Hosting Provider of the disputed domain names and, at the time of filing of the complaint, the disputed domain names resolved to inactive pages

In the Complainant's view, the structure of the disputed domain names in and of itself reflects the Respondent’s intention to create an association, and a subsequent likelihood of confusion, with the Complainant's NOVARTIS trademark and the Novartis group in Internet users’ mind, as by reading the disputed domain names, Internet users may believe that they are directly connected to or authorized by the Complainant.

Therefore, according to the Complainant, it is obvious that the Respondent registered and used the disputed domain names to attract Internet users to the websites to which they resolved, by the means of creating a likelihood of confusion with the Complainant and its trademarks, for commercial gain.

The Complainant informs that different attempts to contact the Respondent were made through cease and desist letters sent to the Registrar of the disputed domain names and that it has never received any response. The Complainant insists that, at present time, there is no active website associated with the domain names in dispute which constitutes passive holding of the disputed domain names. Finally, Complainant notes that the Respondent has been using privacy shield to conceal its identity.

PARTIES CONTENTIONS

The Complainant´s contentions are summarized above.

No administratively compliant Response has been filed.

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 Respondent 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 are 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

In the case at hand the Complaint relates to two domain names:

- <novartisusdt.com>
- <novartissvip.com>

According to Article 3(c) of Rules for Uniform Domain Name Dispute Resolution Policy ("Rules"), the Complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder. In the present case the Registrar Verification has clarified that both the domain names in dispute are registered in the name of Sophie (Sophie). Therefore the Panel does not see any obstacles in rendering a decision in the present case even if the Complaint relates to more than one domain name.
Paragraph 4(a) of the Policy provides that to obtain the transfer of the disputed domain name, the Complainant must prove that each of the following elements is present:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

1) Both the disputed domain names <novartisusdt.com> and <novartissvip.com> reproduce the Complainant's NOVARTIS trademark in its entirety with the addition of other terms or letters.

With reference to <novartisusdt.com> the Panel finds that the disputed domain name is confusingly similar to the Complainant’s NOVARTIS trademark, as it incorporates the said trademark in its entirety, with the mere addition of the letters “usdt" largely used as an acronym for “US Dollar Transactions” for most cryptocurrency or market exchange denominations. Considering that the entirety of the mark is reproduced within the disputed domain name, the addition of the term “usdt” does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy (see International Business Machines Corporation v. chenxu, chenxu, WIPO Case No. D2024-0039, GEA Group Aktiengesellschaft v. Sophia, Sophia, WIPO Case No. D2024-3203, International Business Machines Corporation v. noon noon, WIPO Case No. D2022-4199, Pentair Flow Services AG v. chenxu and CAC Case No. 106038).

With reference to <novartissvip.com> the Panel finds that, also in this case, the disputed domain name entirely incorporates the NOVARTIS trademark. Moreover, the adding of an additional letter "s" and the combination of the element "vip" have no significant impact on the confusing similarity assessment as the letter "s" will be totally unnoticed by internet users while "vip" will be associated with its generic meaning of "Very Important Person". Therefore said additional elements may not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy (see Compagnie Générale des Etablissements Michelin v. xuxu, WIPO Case No. D2023-5374 and Novartis AG v. xudao, CAC Case No. 106184).

In both cases it must be considered that the ".com" extension does not impact the confusing similarity assessment due to its merely technical function.

Consequently, the Panel finds that the disputed domain names are confusingly similar to the Complainant's trademark, for the purposes of the first element of the Policy.

2) Pursuant to paragraph 4(a)(ii) of the Policy, a complainant must make out a prima facie case that a respondent lacks rights or legitimate interests in the disputed domain name(s). Once such a prima facie case is made, the respondent carries the burden of demonstrating its rights or legitimate interests in the disputed domain name(s). If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. In this case, the Panel finds that the Complainant's submitted evidence and allegations are sufficient to establish a prima facie case of the Respondent's lack of rights and legitimate interests in the disputed domain names, also considering the fact that the Respondent had the chance to justify the registration and use of the disputed domain names, but failed to do so. According to the information provided by the Complainant and not contested, the Respondent is not commonly known by the disputed domain names nor authorized to use the Complainant's trademark NOVARTIS. Furthermore, the Complainant points out that the disputed domain names were used for a bona fide activity, because they resolved to websites evoking the Complainant and displaying the NOVARTIS trademark.

For these reasons, the Panel takes the view that the Respondent lacks rights or legitimate interests in the disputed domain names for the purpose of the second element of the Policy.

3) The disputed domain names were registered by the Respondent on October 2024, almost 30 years after the mark NOVARTIS was registered with WIPO by the Complainant for the first time. The Complainant has used the NOVARTIS trademark worldwide and so intensively that it is impossible to believe that Respondent had no knowledge of the Complainant's trademark rights at the time of registration of the disputed domain names. Furthermore, given the distinctive trademark at stake, which has a very high grade of recognition on a worldwide basis, it is inconceivable that the disputed domain names have been registered by the Respondent without having in mind the Complainant's trademark. Therefore, in the Panel's view, the disputed domain names <novartisusdt.com> and <novartissvip.com> were registered in bad faith. The Respondent used the disputed domain names to confuse internet users, by falsely associating the websites at the disputed domain names with the Complainant, in order to lure unsuspecting internet users into a potential fraud. The pattern of behavior demonstrated by the Respondent, involving the use of both disputed domain names to create misleading impressions of legitimacy and association with the Complainant, underscores a clear intent to exploit the Complainant's trademark for fraudulent purposes. Therefore, there is no evidence that Respondent registered the disputed domain name to provide a bona fide offering of its goods and services.

The disputed domain names are now inactive. This circumstance does not prevent a finding of bad faith use. Previous panels have held that the passive holding of a domain name can be considered as use in bad faith (see WIPO Case No. D2000-0003 <telstra.org> and WIPO Case No. D2011-0421<browns.com>).

In addition, the Complainant insists that bad faith has to be considered also due to the Respondent's lack of reaction to the cease and desist letter sent by the Complainant and in consideration of the fact that the Respondent has been using privacy shield to conceal its identity. In this respect the Panel confirms that the use of a privacy shield and the Respondent's failure to respond to the Complainant contentions and as a result to provide any evidence whatsoever of any good faith registration and use of the disputed domain names are additional indications of bad faith (see, e.g., News Group Newspapers Limited and News Network Limited v. Momm Amed la, WIPO Case No. D2000-1623, Nike, Inc. v. Azumano Travel, WIPO Case No. D2000-1598, America Online, Inc. v. Antonio R. Diaz, WIPO Case No. D2000-1460). Therefore, the Panel finds that the Complainant has also satisfied the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **novartisusdt.com**: Transferred
2. **novartissvip.com**: Transferred

PANELLISTS

Name	**Guido Maffei**

DATE OF PANEL DECISION 2024-12-03

Publish the Decision