Decision for dispute CAC-UDRP-107098

Case number	CAC-UDRP-107098
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Domain names	novartisglobal.com

Case administrator

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

Complainant

Organization	Novartis AG

Complainant representative

Organization	Abion GmbH

Respondent

Organization	Healthcare

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 has submitted evidence of the following registrations of the NOVARTIS trademark in relation to a range of products and services relating to a range of pharmaceutical and healthcare products and services:

- Swiss trademark registration No. 2P-427370, registered on July 1, 1996, in classes 1, 2, 3, 4, 5, 7, 8, 9, 10, 14, 16, 17,20, 28, 29, 30, 31, 32, 40, and 42;

- International trademark registration No. 663765, registered on July 1, 1996, 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 trademark registration No. 1349878, registered on November 29, 2016, in classes 9, 10, 41, 42, 44, and 45;

- United States trademark registration No. 4986124, registered on June 28, 2016, in classes 5, 9, 10, 41, 42, and 44; and

- United States trademark registration No. 6990442, registered on February 28, 2023, in class 5.

FACTUAL BACKGROUND

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

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. The Complainant, Novartis AG, maintains headquarters in Switzerland and was created in 1996 through a merger of two other companies Ciba-Geigyand Sandoz. Complainant is the holding company of the Novartis Group.

The Complainant's products are manufactured and sold in many regions worldwide including the United States of America, a country where it has an active presence through its subsidiaries and associated companies. Further, the Complainant owns a number of registrations, in several countries, for the trademark NOVARTIS listing a wide variety of goods and services in the fields of pharmaceuticals and healthcare.

The disputed domain name was registered on October 29, ,2024 and resolves to an inactive registrar parking page.

PARTIES CONTENTIONS

COMPLAINANT

Rights to the NOVARTIS trademark have been demonstrated by the submission of evidence from relevant trademark registration offices. and the disputed domain name is confusingly similar as it incorporates the entirety of the trademark and only adds the generic term "global" and the ".com" TLD.

The Respondent has no rights or legitimate interest in the disputed domain name where it is not commonly known thereby and it is not making a bona fide offering of goods or service nor a legitimate noncommercial or fair use of the disputed domain name.

The disputed domain name was registered and is used in bad faith where it resolves only to a registrar parking page, it has associated MX records, and the Respondent failed to reply to a cease-and-desist letter sent to it by the Complainant's Representative.

RESPONDENT

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

1. The disputed domain name is confusingly similar to a trademark or service mark in which the Complainant has rights

Paragraph 4(a)(i) of the Policy is a standing requirement which is satisfied if the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. Furthermore, it is not as extensive as the "likelihood of confusion" test for trademark infringement applied by many courts. Rather, under the Policy confusing similarity is commonly tested by comparing the Complainant's trademark and the disputed domain name in appearance, sound, meaning, and overall impression. See Administradora de Marcas RD, S. de R.L. de C.V. v. DNS Manager / Profile Group, 101341 (CAC November 28, 2016).

It has been consistently held that "[r]egistration of a mark with governmental trademark agencies is sufficient to establish rights in that mark for the purposes of Policy paragraph 4(a)(i)." Teleflex Incorporated v. Leisa Idalski, FA 1794131 (FORUM July 31, 2018). In this case, the Complainant has submitted screenshots from the trademark office of Switzerland, the World Intellectual Property Organization (WIPO), and the United States Patent and Trademark Office (USPTO) websites demonstrating that it owns registrations of the NOVARTIS trademark. The Panel accepts this evidence as proof of the Complainant's asserted trademark rights.

Where a disputed domain name consists of the entirety of a trademark and adds generic or descriptive terms, confusing similarity has frequently been found under paragraph 4(a)(i) of the Policy. See, e.g., Mooney S.p.A. v. Jose Risi, 104685 (CAC October 4, 2022) (confusing similarity found where "[t]he disputed domain name includes the MOONEY trademarks in its entirety, preceded by the letter 'X and with the addition of the generic term 'token'."). Here, the second level of the disputed domain name contains the entirety of the NOVARTIS trademark followed by the word "global". Thus, the Complainant's trademark is clearly recognizable in the disputed domain name and the added generic term does not lessen confusion but rather enhance it as it relates to the geographic scope of the Complainant's business.

Of course, the extension ".com" adds no meaning to the second level of the disputed domain name. Lesaffre et Compagnie v. Tims Dozman, 102430 (CAC May 2, 2019) ("the top-level suffix in the domain name (i.e. the '.com') must be disregarded under the identity / confusing similarity test as it is a necessary technical requirement of registration.").

Accordingly, the Panel finds that the Complainant has rights to the NOVARTIS trademark and that the disputed domain name is confusingly similar to such trademark. Thus, the Complainant has satisfied paragraph 4(a)(i) of the Policy.

2. The Respondent has no rights or legitimate interests in respect of the disputed domain name

Pursuant to paragraph 4(a)(ii) of the Policy, a complainant has the burden of making a prima facie showing that the respondent has no rights or legitimate interests in a domain name. Cephalon, Inc. v. RiskIQ, Inc., 100834 (CAC September 12, 2014). Once this standard is met, the burden shifts to the respondent to demonstrate that it does have rights or legitimate interests in the domain name.

Paragraph 4(c) of the Policy offers respondents several examples of how to demonstrate their rights or legitimate interests to a domain name.

With reference to 4(c)(ii), the Complaint states that the Respondent is not commonly known by the disputed domain name and that the Complainant "has never granted the Respondent any rights to use the NOVARTIS trademark". The Complainant has submitted into evidence the results of a WIPO Global Brand Database trademark search for the term "novartis global" which shows no results thus indicating that the Respondent holds no trademark rights to the phrase which is used in the disputed domain name. The Respondent has not filed a Response or made any other submission in this case and so it does not contest any of this. Further, reference may be made to the WHOIS record when considering this issue. MAJE v. enchong lin, 102382 (CAC April 14, 2019) ("panels have held that a Respondent was not commonly known by a disputed domain name if the WHOIS information was not similar to the disputed domain name."). The WHOIS record for the disputed domain name lists the Registrant Name as "freibert peter" and the Registrant Organization as "Healthcare". These names bear no resemblance to the Complainant's trademark or to the disputed domain name and the Respondent has not submitted any claim or evidence that it is known otherwise. As such, the Panel

finds no evidence upon which to conclude that the Respondent is commonly known by the disputed domain name.

Next, under Paragraphs 4(c)(i) and 4(c)(iii) of the Policy the Panel considers whether the Respondent is using the disputed domain name to make a bona fide offering of goods or services or whether it is making a legitimate non-commercial or fair use of the disputed domain name. Failing to resolve a confusingly similar domain name to any web content or resolving it to a static parking page is typically not considered to be a bona fide use. See, Consorzio Vino Chianti Classico v. Fabio Baccilli, 104426 (CAC May 9, 2022) (no bona fide use found, in part, because the disputed domain name "does not resolve to an active website"). Here, the Complainant has submitted a screenshot of the website resolution for the disputed domain name which shows a registrar parking page displaying text such as "Happy to see your domain with Hostinger". The Respondent has not offered any explanation for its use of the disputed domain name and the Panel notes the distinctiveness and global reputation of the Complainant's trademark. Considering the available evidence, it is apparent to the Panel that the Respondent is not using the disputed domain name for a bona fide offering of goods or services or in connection with a legitimate non-commercial or fair use under Paragraphs 4(c)(i) and 4(c)(iii) of the Policy.

For all of the above-stated reasons, this Panel finds, by a preponderance of the evidence, that the Complainant has met its burden of proof and that the Respondent has not refuted this. Thus, the Panel determines that the Respondent has no rights or legitimate interests in respect to the disputed domain name under Paragraph 4(a)(ii) of the Policy.

3. The disputed domain name was registered and is being used in bad faith

Under paragraph 4(a)(iii) of the Policy, the Complainant must demonstrate both that the domain name was registered and is being used in bad faith. Further guidance on that requirement is found in paragraph 4(b) of the Policy, which sets out four examples of actions by a respondent that may satisfy this burden of proof.

A threshold question is whether, at the time that it registered the disputed domain name, the Respondent was aware of the Complainant's trademarks. The registration of the Complainant's trademarks preceded the creation of the disputed domain name by many years. Further, the Complainant asserts that "[t]he NOVARTIS trademark is a widely known trademark registered in many countries and the Complainant enjoys a strong online presence." In support of this claim the Complainant submits images from its own website as well as pages of its accounts on popular social media channels such as Facebook and Instagram. Also submitted are the results of a Google search for the terms "novartisglobl" and "freibert peter Novartis global" in which the results refer exclusively to the Complainant. Under such circumstances, the uniqueness and reputation of an asserted trademark may lead to a presumption that a disputed domain name was targeting the mark and was thus registered in bad faith. See Intesa Sanpaolo S.p.A. v. marano tu si, antonio di bartolomeo, 104690 (CAC August 8, 2022) ("UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trade mark can by itself create a presumption of bad faith (paragraph 3.1.4 of the WIPO Jurisprudential Overview 3.0), and the Panel accepts that the Complainant's trade mark is widely known in its field of business."). The evidence submitted in this case indicates a high likelihood that the Respondent had actual knowledge of the Complainant's trademark and leads to a presumption that the disputed domain name was registered in bad faith.

Next, attention is given to the Complainant's claim that the Respondent uses the disputed domain name in bad faith. Here, the disputed domain name was created on October 29, 2024, which is long after the issuance of the Complainant's cited trademark registrations. The disputed domain name resolves only to a registrar parking website with no substantive content. It has been held in many prior UDRP decisions that non-use of a domain name for website content, will not prevent a finding of bad faith under the doctrine of passive holding. Rather "panellists will look at the totality of the circumstances in each case, including: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put." 3Shape A/S v. Michael Nadeau, 102312 (CAC March 12, 2019), citing the seminal decision in Telstra Corporation Limited v. Nuclear Marshmallows, D2000-0003 (WIPO February 18, 2000). As noted above, the Complainant has submitted evidence of the uniqueness and reputation of its trademark; the Respondent has failed to submit a response or submit any evidence of good faith use; the WHOIS record for the disputed domain name, while it discloses a personal name for the Respondent only mentions "Healthcare" as its Organization; and the Panel finds no plausible good faith use to which the disputed domain name may be put given its use of a well-known trademark coupled with a generic word that directly relates to the geographic scope of the Complainant's business. In this case, the Respondent's failure to resolve the disputed domain name to any substantive web page, along with the totality of the circumstances, supports the Complainant's assertion that the disputed domain name is used in bad faith.

Further, the Complaint asserts that there are Mail Exchange (MX) records associated with the disputed domain name. Such activity has been held to demonstrate bad faith use of a domain name that is confusingly similar to a complainant's trade-mark. COMPAGNIE DE SAINT-GOBAIN v. tech sili (Techsili), UDRP-106449 (CAC May 28, 2024) ("Configuration of MX records for e-mail purposes is indicative of potential fraudulent use of the disputed domain name, such as spam and phishing, and can lead to the finding of bad faith, as established by previous panels (CAC Case No. 102827 and CAC Case No. 102380)."). The Complainant asserts that the Respondent may be seeking commercial gain based on confusion with the trademark and that the existence of MX records indicates that the Respondent may be engaging in e-mail phishing or other fraudulent impersonation activities. Based on the foregoing arguments and a preponderance of the submitted evidence, the Panel finds that the existence of MX records further supports its conclusion that the disputed domain name is mostly likely being used to seek commercial gain based on a likelihood of confusion with the Complainant's trademark under para-graph 4(b)(iv) of the Policy.

Finally, the Complainant notes that it sent a cease and desist letter to the Respondent identifying the NOVARTIS trademark but the Respondent did not reply. A respondent's failure to engage with a dispute can, after taking into account all the circumstances of a case, can lend support to a claim of bad faith. See Bloomberg Finance L.P. v. Usman Ik / Divers Marine Contracting LLC, FA 1820452 (FORUM January 10, 2019) ("Respondent did not reply or respond in any way to this [demand letter] communication. Again, in light of the nonexclusive nature of Policy ¶ 4(b), failure to respond to a cease and desist notice has been held to support a finding of bad faith"), citing Fareportal, Inc. v. Arun Meelyan, FA 1736954 (FORUM August 17, 2017) and Seiko Epson Corporation v. Asish Sen, FA 1702054 (FORUM December 12, 2016) (finding that failing to respond to a demand letter has been found to constitute bad faith). Under all of the circumstances of the present case, the Panel finds that the Respondent's failure to reply to the Complainant's cease and desist letter further supports the finding that the Respondent acted in bad faith when it registered and used the disputed domain name.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **novartisglobal.com**: Transferred

PANELLISTS

Name	**Steven Levy**

DATE OF PANEL DECISION 2024-12-27

Publish the Decision