Decision for dispute CAC-UDRP-107140

Case number	CAC-UDRP-107140
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Domain names	novartisfarmaceutica.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Novartis AG

Complainant representative

Organization	Abion GmbH

Respondent

Organization	farmaceutica novartis

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's trademark registrations include in particular the following earlier rights for NOVARTIS:

- International Registration Reg. No. 663765 Registration Date: 1 July 1996;
- International Trademark, designating Mexico: NOVARTIS Reg. no: 1349878 Reg. date: 29 November 2016;
- International Registration for NOVARTIS, designating Mexico Reg. No.: 1544148 Reg. date: 29 June 2020;
- Mexican trademark Reg. No.: 1872123 Reg. date: 16 April 2018;
- US trademark Reg No. 4986124 Registration Date: 28 June 2016;
- US trademark Reg. No. 6990442 Registration Date: 28 February 2023;
- EU trademark Reg. No. 304857 Registration Date: 25 June 1999.

The Complainant owns numerous domain names composed of either its trademark NOVARTIS alone, including <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). 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 disputed domain name <NOVARTISFARMACEUTICA.COM> was registered on 4 November 2024 by the Respondent and the domain name does not resolve presenting a landing page "error page".

FACTUAL BACKGROUND

The Complainant declares to be one of the biggest pharmaceutical and healthcare groups worldwide. It provides solutions to address the evolving needs of patients worldwide by developing and delivering innovative medical treatments and drugs. The Complainant, with headquarters 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 has duly proved to be the owner of the registered trademark "NOVARTIS" in several classes and in numerous countries all over the world and that these trademark registrations long predate the registration of the disputed domain name which was created only on 4 November 2024.

In the Complainant's view, due to extensive use, advertising and revenue associated with its trademarks worldwide, the Complainant enjoys a high degree of renown around the world, including South America and notably Mexico or again in Spain. The Complainant has previously successfully challenged several domain names including the word "NOVARTIS" through UDRP processes.

The Complainant outlines that in the WIPO Case No. D2020-3203 Novartis AG v. Amartya Sinha, Global Webs Link, Novartis RO, the Panel confirmed that "NOVARTIS" is a well-known trademark.

The Complainant has registered a number of domain names under generic Top-Level Domains ("gTLD") and country-code Top-Level Domains ("ccTLD") containing the term "NOVARTIS", for example, <novartis.com> (created on April 2, 1996), <novartis.in> (created on February 15, 2005) and Novartis.us (created on April 19, 2002). The Complainant uses these domain names to connect to a website through which it informs potential customers about its "NOVARTIS" mark and its products and services.

According to the Complainant, the disputed domain name is similar to its "NOVARTIS" trademark since the disputed domain name is composed the "NOVARTIS" mark along with the generic term “farmaceutica” (Spanish for Pharmaceutical). Moreover, the Complainant indicates that the whois information are false information i.e. registrant “farmaceutica novartis” when the Complainant subsidiary in Mexico is Novartis Farmacéutica SA de CV increasing a case of an attempt to impersonate.

The Complainant has never granted the Respondent with any rights to use the "NOVARTIS" trademark.

Furthermore, the Complainant outlines that the disputed domain name <novartisfarmaceutica.com>, via the e-mail function, may have been used to conduct email phishing scheme considering an active MX records associated to the Disputed Domain Name with a risk of existing fraudulent email addresses be used such as “[...]@novartisfarmaceutica.com”.

The Complainant sent a cease and desist letter in mid-November 2024 and a reminder early December 2024 through the contact form of the Registrar which remains unanswered.

In the Complainant's view, by using the disputed domain name <novartisfarmaceutica.com> the Respondent has clearly and intentionally passively held the domain and attempted an impersonation of the Complainant

An issue arose concerning the language of the proceedings as the Registrar mentioned that the language of the registration agreement is Spanish. The Complaint argued that despite the indicated language of the agreement, English language should be the one of proceedings as provided in the Complainant’s Annex 1 (Registration Agreement) and also having regard to all circumstances, and to help ensure fairness, and maintain an inexpensive and expeditious avenue for resolving domain disputes. The Panel note that article 9.4 of the restoration agreement provided by the Complainant indicates that:

"9.4. Translation. This DRA was originally written in English. We may translate this Agreement into other languages. In the event of a conflict between a translated version and the English version, the English version will control except where prohibited by applicable law."

Considering that the Spanish version appears to be a mere translation for easy reference and that the English version should prevail.

PARTIES CONTENTIONS

The Complainant submits that the requirements of the Policy have been met and that the disputed domain name should be transferred to it. The Complainant makes a number of legal arguments (referenced below) and also supplies a set of annexes providing evidence of its activities and of the Respondent's use of the disputed domain names.

No administratively compliant Response has been filed by either Respondents. It ought to be indicated that the Centre sent of the complaint but nor the advice of delivery thereof was returned to the Czech Arbitration Court. The notice of the Commencement of the administrative proceeding was therefore only sent by e-mail. Yet, the e-mail notice sent to <postmaster@novartisfarmaceutica.com> was returned back undelivered as the e-mail addresses had permanent fatal errors. The e-mail notices were also sent to <lic.danielrivera_@outlook.com>, but the CAC never received any proof of delivery or notification of undelivery. No further e-mail addresses could be found on the disputed sites.

The Respondents never accessed the online platform.

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.

The issue of language of the proceedings is summarised in the Factual background part of the decision.

PRINCIPAL REASONS FOR THE DECISION

First, it has to be cast the issue of the language proceedings as the registrar's agreement would be in Spanish language as indicated by the Registrar "verification of data" communication.

In accordance with Paragraph 11 of the UDRP Rules unless otherwise agreed by the parties, the language of the proceeding is the language of the registration agreement, subject to the authority of the panel to determine otherwise, exercising its “discretion in the spirit of fairness to both parties, which pursuant to paragraph 10(b) of the Rules have to be treated with equality, taking into account all relevant circumstances of the case, including matters such as the parties’ ability to understand and use the proposed language, time and costs” (see Carrefour v. Contact Privacy Inc. Customer 1242379769 / Le Berre, WIPO Case No. D2018-1552).

The Complainant filed the Complaint in English language and provided evidence on this choice based on a copy of the registration agreement collected on the Registrar website.

The Panel went through the registration agreement provided and noted that in article 9.4 of said agreement one can read:

> "Translation. This DRA was originally written in English. We may translate this Agreement into other languages. In the event of a conflict between a translated version and the English version, the English version will control except where prohibited by applicable law."

Considering that the Spanish version appears to be a mere translation for easy reference and that the English version should prevail.

The Panel is satisfied with the arguments and evidence provided by the Complainant and confirms that use of English language would be fair for both parties, bearing in mind that the Respondent did not contest this.

Second, according to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that the disputed domain name should be transferred or cancelled:

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

The Panel has examined the evidence available to it and has come to the following conclusion concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

RIGHTS

The Complainant has established rights in the name NOVARTIS. The disputed domain name <novartisfarmaceutica.com> is found to be confusingly similar to the Complainant's trademark and company name. This finding is based on the settled practice in evaluating the existence of a likelihood of confusion of:

a) disregarding the top-level suffix in the domain names (i.e. ".com") in the comparison; and

b) finding that the simple combination of a trademark and a generic term i.e. "farmaceutica" (Spahnis for Pharmaceutical) would by no means be considered sufficient to distinguish a domain name from a trademark. It rather increases the risk of confusion as the generic term is directly in line with the activity of the complainant.

The disputed domain name is therefore found to be confusingly similar to the earlier rights in the name NOVARTIS and the Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The onus to make out a prima facie case that the Respondent lacks rights or legitimate interests is placed on the Complainant. However, once such a prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Respondent has no rights or legitimate interests in the disputed domain name. The Complainant and the Respondent have never had any previous relationship, nor has the Complainant ever granted the Respondent with any rights to use the NOVARTIS trademark in any form, including in the disputed domain name. The disputed domain name did not resolve to any active page/content. Therefore, the disputed domain name cannot be in use in connection with a bona fide offering of goods or services. 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, so that there is nothing that could be interpreted as rights or legitimate interests of the Respondent.

The Respondent was given an opportunity to present arguments relating to rights or legitimate interests in the disputed domain name but have failed to do so. This behavior, coupled with the absence of use of the disputed domain name in connection with a bona fide offering of goods and services, demonstrates the Respondents' absence of rights or legitimate interests in respect of the disputed domain name.

The Panel therefore concludes that the Respondent did not refute the Complainant's prima facie case and has not established any rights or legitimate interest in the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy). The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Panel finds that the Complainant has established that the disputed domain name was registered by the Respondent and is being used by the Respondent in bad faith.

The well-known nature of the NOVARTIS trademark has been confirmed in earlier decisions. The name is distinctive and well known in numerous countries including the Mexico and Spain for the products manufactured and sold by the Complainant.

The Respondent has copied the Complainant's trademark "NOVARTIS" and has combined it with a generic term referring to the main activity/products of the Complainant. Therefore, this registration can only be viewed as an attempt to exploit the goodwill vested in the trademark by attracting Internet users and confusing them to the extent that they would believe that a website or emails connected to the disputed domain name offers the services of an entity that is affiliated to the Complainant.

Furthermore, the MX servers are configured. Such making use of the disputed domain name, obviously in a potential fraudulent manner, neither qualifies as a bona fide nor as a legitimate noncommercial or fair use under the Policy and may not of itself confer rights or legitimate interests in the disputed domain name. The potential collection of personal data or passwords via phishing process being one possible fraudulent act (see CAC Case No. 104862).

The Respondent, for not responding to the complaint, has failed to demonstrate any activity in respect of the disputed domain names, and it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate, by passing off, infringement of consumer protection legislation, or infringement of the Complainant's rights under trademark law.

The Panel therefore concludes that the Respondent has registered and is using the disputed domain name in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy). The Complainant has therefore also satisfied the requirement under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **novartisfarmaceutica.com**: Transferred

PANELLISTS

Name	**David-Irving Tayer**

DATE OF PANEL DECISION 2025-01-05

Publish the Decision