Decision for dispute CAC-UDRP-107138

Case number	CAC-UDRP-107138
Time of filing	2024-12-11 09:15:16
Domain names	novartispk.com

Case administrator

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

Complainant

Organization	Novartis AG

Complainant representative

Organization	Abion GmbH

Respondent

Organization	NOVARTIS PAKISTAN

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 shown that it has rights in the following trademarks:

- International trademark Reg. No. 663765 “NOVARTIS”, registered on July 1, 1996;

- International trademark Reg. No. 1544148 “NOVARTIS”, registered on June 29, 2020;

- United States trademark Reg. No. 4986124 “NOVARTIS”, registered on June 28, 2016;

- United States stylized trademark Reg. No. 6990442 “NOVARTIS”, registered on February 28, 2023;

- EU trademark Reg. No. 000304857 “NOVARTIS”, registered on June 25, 1999;

- Pakistan trademark Reg. No. 134437 “NOVARTIS”, registered on February 27, 1996; and

- Pakistan trademark Reg. No. 135177 “NOVARTIS”, registered on April 9, 1996.

FACTUAL BACKGROUND

The Complainant, Novartis AG., based in Zürich, Switzerland, was created in 1996 through a merger of Ciba-Geigy and Sandoz. It is the holding company of the Novartis Group, one of the biggest global pharmaceutical and healthcare groups, providing solutions to address the evolving needs of patients worldwide by developing and delivering innovative medical treatments and drugs. The Complainant’s products are manufactured and sold in many countries worldwide, including in Pakistan, where it has an active presence through associated companies and where it has been playing an active role on the local markets and societies.

The disputed domain name <novartispk.com> was registered by the Respondent on November 11, 2024. It does not resolve to an active website. MX records are activated.

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

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

(1) the disputed domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in

which the Complainant has rights; and

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

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

In view of the Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences as it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations set forth in a complaint. However, the Panel may deny relief where a complaint contains mere conclusory or unsubstantiated arguments. See WIPO Jurisprudential Overview 3.0 at paragraph 4.3; see also eGalaxy Multimedia Inc. v. ON HOLD By Owner Ready To Expire, FA 157287 (Forum June 26, 2003) ("Because Complainant did not produce clear evidence to support its subjective allegations [. . .] the Panel finds it appropriate to dismiss the Complaint").

The Complainant, Novartis AG., based in Zürich, Switzerland, was created in 1996 through a merger of Ciba-Geigy and Sandoz. It is the holding company of the Novartis Group, one of the biggest global pharmaceutical and healthcare groups, providing solutions to address the evolving needs of patients worldwide by developing and delivering innovative medical treatments and drugs. The Complainant's products are manufactured and sold in many countries worldwide, including in Pakistan, where it has an active presence through associated companies and where it has been playing an active role on the local markets and societies.

As to the first element, the Complainant has shown that it has rights in the NOVARTIS mark through several registrations, including Pakistan trademark Reg. No. 135177, registered on April 9, 1996. Previous UDRP panels have stated that the NOVARTIS trademark is well-known (see Novartis AG v. Amartya Sinha, Global Webs Link, Novartis RO, WIPO Case No. D2020-3203).

The Panel finds the disputed domain name <novartispk.com> to be confusingly similar to the Complainant's NOVARTIS trademark because it incorporates the mark in its entirety and merely adds the geographic abbreviation for Pakistan "pk", which does nothing to distinguish the domain name from the mark, together with the inconsequential top-level domain ".com", which may be ignored.

The Complainant has established this element.

As to the second element, paragraph 4(c) of the Policy sets out three illustrative circumstances as examples which, if established by the Respondent, shall demonstrate rights to or legitimate interests in a disputed domain name for the purposes of paragraph 4(a)(ii) of the Policy, i.e.

(i) before any notice to the Respondent of the dispute, the use by the Respondent of, or demonstrable preparations to use, the domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services; or

(ii) the Respondent (as an individual, business or other organization) has been commonly known by the disputed domain name, even if the Respondent has acquired no trademark or service mark rights; or

(iii) the Respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service mark at issue.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the <novartispk.com> domain name. The Complainant 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. The Registrar verification revealed that the Respondent's alleged organization name is "Novartis Pakistan". To the best of the Complainant's knowledge, the Complainant and the Respondent have never had any previous relationship. This is a clear attempt to refer to the Complainant or one of its subsidiaries and may also be seen as an attempt to impersonate the same, which further demonstrates the fact that the Respondent knew that the NOVARTIS 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.

Furthermore, when searching for any trademarks incorporating the disputed domain name terms "novartispk" or "novartis pk" on online trademark search platforms, no registered trademarks are to be found. When searching for any trademarks in the alleged name of the Respondent "Usman Rasool", there are also no results related to the disputed domain name terms to be found.

The Complainant has shown that the disputed domain name resolves to a parking page and is thus being passively held. The Complainant contends that the structure of the disputed domain name directly refers to the Complainant and its trademarks, so it therefore appears that the Respondent deliberately chose to use the well-known trademark NOVARTIS in the disputed domain name to benefit from the Complainant's worldwide renowned trademark and to confuse Internet users as to the source of the disputed domain name. Such use cannot therefore be considered as a bona fide offering of goods or services nor as legitimate noncommercial or fair use.

The Panel notes that the disputed domain name <novartispk.com> was registered by the Respondent on November 11, 2024, many years after the Complainant registered its NOVARTIS marks in Pakistan. MX records are activated.

These circumstances, together with the Complainant's assertions, are sufficient to constitute a prima facie showing of absence of rights or legitimate interests in respect of the disputed domain name on the part of the Respondent. The evidentiary burden therefore shifts to the Respondent to show that it does have rights or legitimate interests in the <novartispk.com> domain name.

See JUUL Labs, Inc. v. Dryx Emerson / KMF Events LTD, FA1906001849706 (Forum July 17, 2019). The Respondent has made no attempt to do so.

The Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant has established this element.

As to the third element, Paragraph 4(b) of the Policy sets out some circumstances which shall be evidence of the registration and use of a domain name in bad faith for the purposes of paragraph 4(a)(iii) of the Policy. As noted in the WIPO Jurisprudential Overview 3.0, Section 3.1, those circumstances are not exclusive and a complainant may demonstrate bad faith under paragraph 4(a)(iii) by showing that a respondent seeks to take unfair advantage of, abuse, or otherwise engage in behaviour detrimental to the complainant's trademark.

In the absence of any Response, the circumstances set out above in relation to the second element satisfy the Panel that the Respondent was fully aware of the Complainant's well-known NOVARTIS mark when the Respondent registered the <novartispk.com> domain name and that the Respondent did so in bad faith with intent to take unfair advantage of the Complainant's mark.

Although the <novartispk.com> domain name does not resolve to an active website, as in the leading case of Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, there is no conceivable active use that could be made of the domain name that would not amount to an infringement of the Complainant's rights in its NOVARTIS mark. Accordingly, the Panel finds that the Respondent's passive use of the disputed domain name demonstrates registration and use in bad faith.

Further evidence of bad faith is the fact that MX records are activated. This enables the Respondent to use the disputed domain name to send e-mails purporting to emanate from the Complainant or its associated companies in Pakistan.

The Complainant has established this element.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **novartispk.com**: Transferred

PANELLISTS

Name	**Alan Limbury**

DATE OF PANEL DECISION 2025-01-13

Publish the Decision