Decision for dispute CAC-UDRP-107677

Case number	CAC-UDRP-107677
Time of filing	2025-06-25 07:53:49
Domain names	novartis-rus.com

Case administrator

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

Complainant

Organization	Novartis AG

Complainant representative

Organization	Abion GmbH

Respondent

Organization	Nice IT Services Group Inc.

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 is the owner of the registered well-known trademark NOVARTIS in numerous jurisdictions all over the world, including in Russia, such as but not limited to:

1. International trademark, designating Russia: NOVARTIS, Reg. No. 663765, Registration Date: 1 July 1996
2. International trademark, designating Russia: NOVARTIS, Reg. No. 1544148, Registration Date: 29 June 2020
3. International trademark, designating Russia: NOVARTIS, Reg. No. 1349878, Registration Date: 29 November 2016
4. International trademark, designating Russia: NOVARTIS, Reg. No. 666218, Registration Date: 31 October 1996
5. US trademark: NOVARTIS, Reg No. 4986124, Registration Date: 28 June 2016
6. US trademark: NOVARTIS, Reg. No. 6990442, Registration Date: 28 February 2023
7. EUTM: NOVARTIS, Reg. No. 000304857, Registration Date: 25 June 1999
8. EUTM, NOVARTIS, Reg. No. 013393641, Registration Date: 17 March 2015 A non-exhaustive list of all of the Complainant’s trademarks was submitted in evidence.

Moreover, 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 Complainant owns numerous domain names which include its trademark NOVARTIS including (created on 2 April 1996), (created on 19 April 2002), (created on 1 June 2000) or in combination with other

terms, such as (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 also enjoys a strong presence online via its official social media platforms.

FACTUAL BACKGROUND

The Novartis Group is one of the biggest global pharmaceutical and healthcare groups in the world. It has headquarters in Switzerland, and was created in 1996 through a merger of two other companies Ciba-Geigy and Sandoz, is the holding company of the Novartis Group Novartis AG (the "Complainant")/the Novartis group achieved net sales of USD 50.3 billion, and total net income of USD 11.9 billion in 2024 and employed approximately 76 000 people. The Complainant's products are manufactured and sold in many countries worldwide including in Russia, 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, was registered on 13 May 2025. Nothing is known of the Respondent except that it is called the Nice IT Services Group Inc. and it is based in the Dominican Republic. The Complainant sent a cease-and-desist letter to it on 16 and 26 May and a follow up on 2 June and there was no response.

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. The Panel accepts the request that the decision be in English.

PRINCIPAL REASONS FOR THE DECISION

Under paragraph 4(a) of the UDRP, the Policy, a complainant can only succeed in administrative proceedings if the panel finds:

(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 domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith. A complainant must prove that each of these three elements are present.

In this case, the Complainant, and its name and mark, are world famous due to long use in trade. It is also a highly distinctive mark.

There is no question that the Complainant has Rights in the name and mark, NOVARTIS. The test for identity is strict and they are not identical. But incorporation of the trademark combined only with a dictionary or other generic word may mean the domain name is confusingly similar to the complainant's registered mark. E.g., Hoffmann-La Roche Inc. v. Hightech Industries, Andrew Browne, WIPO Case No. D2010-0240. The disputed domain name is the word mark, together with a geographic term which is ignored in the similarity analysis. Adding a generic term, in front – or indeed after, a well-known name and mark does not prevent a finding of confusing similarity. Here, the Complainant's registered trademark is reproduced in full in the disputed domain name with the geographic term for Russia as abbreviated. The addition of the country name abbreviated as, RUS, for Russia, in fact it gives the impression that it is an official local or geographical representative or branch of the Complainant. That and the .com convey the impression that the site is official and compound impersonation and confusion.

So, while the suffix is the .com and although that is strictly irrelevant to the similarity analysis at the first limb of the UDRP or Policy, it is relevant to the others and can convey the impression that a domain is official, particularly where it is a .com. The Panel finds the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights. The case is really about the second limb. As to the second factor, the disputed domain name does not currently resolve to an active website and there is no evidence that it ever did.

To demonstrate rights or legitimate interests in a domain name, under the UDRP paragraph 4(c) include the following:

(i) before any notice of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the 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 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 domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. As to the second limb, a complainant is only required to make out a prima facie case that a respondent lacks rights or legitimate interests and then the burden shifts to the respondent to show it has rights or legitimate interests in the domain name. If it fails to do so, the complainant is deemed to have satisfied the limb in paragraph 4(a) (ii). See WIPO Case No. D2003-0455, Croatia Airlines d. d. v. Modern Empire Internet Ltd. Past 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. See the Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group. The Respondent is not known by the disputed domain name. Here, there is no use as such to be bona fide use at the second factor. While passive holding is not Bad Faith per se, it is fact sensitive. And so there is no evidence whatsoever of any genuine resales or other fair or legitimate use. The Complainant has only to make out a prima facie case and the evidential burden shifts. But the Respondent has not come forward and so the Complainant has discharged its burden. In relation to the third limb of the Policy, if there is unfair and illegitimate use, there will often be bad faith. The Panel finds the Respondent could not have been unaware of the Complainant's world-famous trademark in light of the Complainant's reputation. The passive holding test from the ruling in Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003 is apposite. This is sometimes known as the passive Bad Faith test. Where a famous or well-known mark is incorporated into a domain name without any legitimate reason or explanation, Bad Faith can often be inferred. The Respondent did not come forward to explain the reasons for the selection of the disputed domain names and why there is no Bad Faith.

So, as there is no use of the domain name (and so no overt legitimate right or interest) and this Respondent has not come forward with any explanation for the selection of the name - or indeed, any answer, then a finding of bad faith is fair, as are the appropriate inferences against the Respondent. The Complainant also says that the Respondent is a repeat offender and has six earlier decisions against it at WIPO alone. It also says that false contact details were likely provided on a number of occasions. This Panel makes no finding on those points. The Complainant has discharged its burden and made out all three limbs of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **novartis-rus.com**: Transferred

PANELLISTS

Name	**Victoria McEvedy**

DATE OF PANEL DECISION 2025-08-01

Publish the Decision