

Decision for dispute CAC-UDRP-103713

Case number	CAC-UDRP-103713
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Time of filing	2021-04-28 09:37:16
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Domain names	novartis-finance.com
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Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	Novartis AG
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Complainant representative

Organization	MSA IP - Milojevic Sekulic & Associates
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Respondent

Organization	See PrivacyGuardian.org
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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 bases its Complaint on the following trademark registrations:

- International Registration No. 663765, "NOVARTIS", registered on July 1, 1996, 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. 666218, "NOVARTIS", registered on October 31, 1996, for services in classes 41 and 42;
- International Registration No. 1349878, "NOVARTIS", registered on November 29, 2016, for goods and services in classes 9, 10, 41, 42, 44, and 45;
- International Registration No. 1544148, "NOVARTIS", registered on June 29, 2020, for goods and services in classes 9, 35, 38, and 42;
- US Registration No. 4986124, "NOVARTIS", registered on June 28, 2016, for goods and services in classes 5, 9, 10, 41, 42, and 44;
- US Registration No. 5420583, "NOVARTIS", registered on March 13, 2018, for goods and services in classes 9, 10, 41, 42, 44, and 45;
- US Registration No. 2336960, "NOVARTIS", registered on April 4, 2000, for goods and services in classes 1, 5, 9, 10, 29, 30,

31, 32 and 42; and

- US Registration No. 2997235, "NOVARTIS", registered on September 20, 2005, for goods and services in class 5.

In addition, the Complainant holds the following domain names:

- <novartis.com> registered on April 2, 1996;
 - <novartis.us> registered on April 19, 2002;
 - <novartis-group.com> registered on June 18, 2019;
 - <novartisgroups.com> registered on October 27, 2019; and
 - <novartis-groups.com> registered on October 8, 2019.
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FACTUAL BACKGROUND

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

The Complainant was created in 1996 through a merger of Ciba-Geigy and Sandoz. The Complainant and its predecessor companies trace their roots back more than 250 years, with a rich history of developing innovative products. Currently, the Complainant is a world pharmaceutical leader based in Switzerland that provides innovative healthcare solutions to address the evolving needs of patients and societies worldwide.

The Complainant's global pharmaceuticals portfolio includes more than 50 key marketed products, many of which are innovative leaders in their therapeutic areas, such as cardiometabolic indications, dermatology, immunology, neuroscience, oncology, ophthalmology and pulmonology. The Complainant's products are available in more than 155 countries around the world and they have reached 769 million patients globally.

In 2020, the Complainant achieved net sales from continuing operations of USD 48.7 billion, while net income from continuing operations amounted to USD 10.2 billion and total net income to USD 8.1 billion. Companies from the Novartis Group employ more than 110,000 full-time equivalent associates as of December 31, 2020. With net sales of USD 48.7 billion, the Complainant has been rated 4th on the list of pharmaceutical companies with the highest revenue in 2020 by the Pharmaceutical Technology magazine.

The complex corporate structure of Novartis Group includes two major divisions - Innovative Medicines, and Sandoz, which are supported by functional organizations on a global scale. The Innovative Medicines division commercializes innovative patented medicines to enhance health outcomes for patients and healthcare professionals, and is made up of two business units – Novartis Pharmaceuticals which includes Novartis Gene Therapies, and Novartis Oncology. Sandoz division is the global leader in generic pharmaceuticals and biosimilars that pioneers novel approaches to help people around the world access high-quality medicines.

One of the companies that belong to the Novartis Group is the company Novartis Finance S.A. from Luxembourg with its registered address at 20, Rue Eugène Ruppert, L - 2453 Luxembourg. The principal business activity of this company is financing activities for the Novartis Group mainly through acquisition of participations in Luxembourg or abroad, in any companies or enterprises in any form whatsoever, including the management of such participations through the issuing of bonds, notes and any kind of promissory notes, as well as debt and equity securities.

Since the inception of the COVID-19 global health crisis in early 2020, the Complainant, along with other major companies from the pharmaceutical sector, is witnessing increased cybersquatting activities related to its company name and a significant increase of abusive domain name registrations.

The Complainant owns around 1.500 NOVARTIS trademark registrations around the world, which are considered to be well-known in the field of pharmaceutical products and healthcare services.

In addition, the Complainant is the registrant of over 6,000 domain names, many of which incorporate its NOVARTIS trademark.

Numerous previous panels have considered the Complainant's trademark NOVARTIS as a well-known trademark that has reputation.

The disputed domain name <novartis-finance.com> was registered on March 25, 2021 through a privacy shield.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

The Complainant's contentions are the following:

The disputed domain name novartis-finance.com is confusingly similar to the Complainant's earlier NOVARTIS trademarks as such reproduces the Complainant's well-known trademark NOVARTIS in combination with the generic term "finance", separated by a hyphen.

Furthermore, the Complainant contends that the addition of the gTLD ".com" is irrelevant as it is well established that the generic top-level domain is insufficient to avoid a finding of confusing similarity

Accordingly, the disputed domain name creates a clear likelihood of confusion with the Complainant's trademark. It is likely that this domain name could mislead Internet users into thinking that it is, in some way, associated with the Complainant. Furthermore, the use of the generic or dictionary term "finance" in combination with the Complainant's trademark suggests a connection with the Complainant's business (and existing business entity), consequently increasing the risk of confusion.

The Complainant further contends that the Respondent lacks rights or legitimate interests in the disputed domain name for a number of reasons.

First, the Complainant further asserts that the Respondent is not affiliated with the Complainant in any way and has not been authorized by the Complainant to use and register its trademark or to seek registration of any domain name incorporating said mark.

Further, the Complainant asserts that the Respondent did not demonstrate use of, or demonstrable preparation to use, the disputed domain name in connection with a bona fide offering of goods or services. The Complainant asserts that the disputed domain name resolves a website that is misrepresented as being the official website of the company Novartis Finance S.A. from Luxembourg, which is owned by the Complainant. Moreover, the website displays the e-mail address contact@novartis-finance.com which, in combination with the false affiliation with the company Novartis Finance S.A., creates a severe risk of fraud and phishing. The website displays the information that "Your Website is Always a Work in Progress", creating the false impression that it is a genuine website, which is currently under construction, owned by the company Novartis Finance S.A. from Luxembourg. The Complainant asserts that it has also noticed that e-mail servers were configured in respect of the domain name <novartis-finance.com>. Thus, there is a real possibility that users are either emailing the above-mentioned email address provided on the website or receiving emails from the email address @novartis-finance.com, on the assumption that they are communicating directly with the company NOVARTIS and/or its subsidiary, Novartis Finance S.A. In so doing, the Complainant asserts there is a serious risk that their personal data or other sensitive information (especially data relating to financial and health information) is being elicited by the Respondent.

The Complainant's further asserts that the Respondent is evidently using the domain name for commercial gain and is misleadingly diverting consumers and tarnishing NOVARTIS' well-known trademark. That this is the case is clear from the intentional use of the NOVARTIS trademark in combination with the term "finance" in the domain name, and the nature of the services internet users would be expecting to access through the domain name as a result thereof.

The Complainant further asserts that the Respondent registered the disputed domain name with a privacy shield service in

order to hide his identity and to prevent the Complainant from contacting him. Thus, in the Complainant's view such behaviour highlights the fact that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant further mentions that the disputed domain name <novartis-finance.com> completely corresponds to the name of the Complainant's subsidiary, Novartis Finance S.A. from Luxembourg, meaning that the Respondent has registered this domain name with the intention of blocking the Complainant from registering a domain name that corresponds to the company name of its subsidiary and preventing the Complainant from using its NOVARTIS trademark. This type of behaviour indicates in the Complainant's view the lack of rights or legitimate interests to use the disputed domain name.

The Complainant further argues that the disputed domain name has been registered and is been used in bad faith.

The Complainant's asserts that it is implausible that the Respondent was unaware of the Complainant when he registered the disputed domain name considering that the Complainant is well-known throughout the world, including in the Respondent's (presumed) home country – USA. Also, the Complainant asserts that in numerous decisions, previous panels have considered that the Complainant's NOVARTIS trademark is widely-known worldwide.

The Complainant also asserts that the Respondent registered the disputed domain name through the use of a privacy shield service to hide his identity in order to prevent the Complainant from contacting him.

The choice of the disputed domain name including the Complainant's trademark and the generic term "finance" corresponding to the Complainant's corporate structure (i.e., corresponding to the company name of Complainant's subsidiary) suggests in the Complainant's view that the Respondent was perfectly aware of the Complainant and its trademark.

The Complainant also asserts that the Respondent registered the domain name to prevent the Complainant from using its NOVARTIS trademarks in the disputed domain name and especially to prevent the Complainant from registering a domain name corresponding to the company name of its subsidiary, Novartis Finance S.A.

The Complainant further asserts that the Respondent has been using the disputed domain name to mislead consumers into believing that they are accessing the services of NOVARTIS and/or its subsidiary, Novartis Finance S.A. Moreover, the provision of an email address on the website which is purportedly linked to NOVARTIS, as well as the existence of email services linked to the domain name, creates a serious risk of fraud and phishing as internet users may provide their personal information when corresponding with whom they believe to be NOVARTIS.

The Complainant underlines that the configuration of e-mail servers in respect of a disputed domain name constitutes use in bad faith since it represents a real risk that the Respondent may be engaged in a phishing scheme aimed at deceiving Internet users into believing that they are dealing with the Complainant.

Furthermore, the use of a well-known trademark to attract Internet users to a website for commercial gain constitutes use in bad faith.

In the Complainant's view, the Respondent is trying to benefit from the fame of the Complainant's marks. In that sense, it seems likely that the Respondent's primary motive in registering and using the disputed domain name was to capitalize on, or otherwise take advantage of, the Complainant's trademark rights by intentionally registering a domain name which creates a likelihood of confusion with the Complainant's trademarks and related companies.

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

I. Identity/confusing similarity

The Panel agrees that the disputed domain name incorporates the Complainant's earlier NOVARTIS trademark and that the addition of the term "finance", separated by a hyphen is insufficient to avoid a finding of identity / confusing similarity.

The addition of the extension ".com" is not to be taken into consideration when examining the identity / confusing similarity between the Complainant's trademarks and the disputed domain name (WIPO Case No. D2005-0016, Accor v. Noldc Inc.). The mere adjunction of a gTLD such as ".com" is irrelevant as it is well established that the generic Top-Level Domain is insufficient to avoid a finding of identity / confusing similarity (WIPO Case No. 2013-0820, L'Oréal v Tina Smith, WIPO Case No. D2008-0820 Titoni AG v Runxin Wang and WIPO Case No. D2009-0877, Alstom v. Itete Peru S.A.).

Therefore, the Panel is satisfied that the first condition under the Policy is met.

II. Lack of Respondent's rights or legitimate interests

The Complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of proof shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

Based on the available evidence, the Respondent does not appear to be known by the disputed domain name. The Respondent is not a licensee of, nor has any kind of relationship with, the Complainant. The Complainant has never authorised the Respondent to make use of its trademark, nor of a confusingly similar trademark in the disputed domain name.

Also, based on the available evidence, the Respondent did not demonstrate use of, or demonstrable preparation to use, the disputed domain name in connection with a bona fide offering of goods or services.

The disputed domain name has been registered with a privacy shield service which leads to the assumption that it was made in order to hide his identity and also to prevent the Complainant from contacting him.

The disputed domain name corresponds to the name of the Complainant's subsidiary, Novartis Finance S.A. from Luxembourg, meaning that the Respondent has registered this domain name with the intention of blocking the Complainant from registering a domain name that corresponds to the company name of its subsidiary and preventing the Complainant from using its NOVARTIS trademark.

The above does not amount to a bona fide offering of goods or services, or to a legitimate non-commercial or fair use of the disputed domain name.

The Panel notes that the Respondent had an opportunity to comment on the Complaint's allegations by filing a Response, which the Respondent failed to do.

Thus, the Panel is satisfied that the Complainant has at least established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. Accordingly, the Panel takes the view that also the second requirement under the Policy is met.

III. Bad Faith

The Complainant's trademark is a well-known one as recognized also by past panel and the disputed domain name is incorporating in its entirety the Complainant's trademark. Therefore, the Panel concludes that at the time of registration of the disputed domain name, the Respondent was well aware of the Complainant's trademark and has intentionally registered one in order to benefit from the reputation of the Complainant's trademark.

In the present case, the following factors should be considered:

- (i) the Complainant's trademark is a well-known one, being also highly distinctive;
- (ii) the disputed domain name corresponds to the company name of Complainant's subsidiary, Novartis Finance S.A. from Luxembourg;
- (iii) the Respondent failed to submit any response and has not provided any evidence of actual or contemplated good faith use of the disputed domain name;
- (iv) the Respondent registered the disputed domain name containing in its entirety a well-known trademark; and
- (v) any good faith use of the disputed domain name would be implausible, as the trademark NOVARTIS is univocally linked to the Complainant and the Respondent has no business relationship with the Complainant, nor was ever authorised to use a domain name identical to the Complainant's trademark;
- (vi) the Respondent registered the disputed domain name through the use of a privacy shield service to hide his identity in order to prevent the Complainant from contacting him.

In light of the foregoing, the Panel concludes that the Respondent has registered and has been using the disputed domain name in bad faith. Thus, also the third and last condition under the Policy is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTIS-FINANCE.COM**: Transferred

PANELLISTS

Name	Delia-Mihaela Belciu
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DATE OF PANEL DECISION	2021-06-01
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Publish the Decision
