

Decision for dispute CAC-UDRP-104375

Case number	CAC-UDRP-104375
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Time of filing	2022-02-24 08:52:01
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Domain names	Novar-Tis.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	BRANDIT GmbH
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Respondent

Name	Leo Naimo
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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 has evidenced to be the owner of numerous trademark registrations worldwide relating to its company name and brand "NOVARTIS", including the following with protection, inter alia, in Turkey where the Respondent apparently is domiciled:

- Word mark NOVARTIS, World Intellectual Property Organization (WIPO), Registration No.: 1349878, Registration Date: November 29, 2016, Status: active; and
- Word mark NOVARTIS, Türk Patent/Turkish Patent and Trademark Office, Registration No.: 2015/08359, Registration Date: October 21, 2015, Status: active.

Also, the Complainant has substantiated to own numerous domain names relating to its NOVARTIS trademark, inter alia, the domain name <novartis.com> which redirects to the Complainant's main website at "www.novartis.com", used since 1996 to promote the Complainant's products and related services in the pharmaceutical industry.

FACTUAL BACKGROUND

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

I. LANGUAGE OF PROCEEDINGS REQUEST:

According to the Registrar Verification, the language of the Registration Agreement is English. Should the Respondent request the language of the proceedings be a language other than English, the Complainant hereby requests that the language of the present administrative proceedings be English.

II. ABOUT COMPLAINANT AND THE BRAND NOVARTIS

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. Novartis AG (the "Complainant"), created in 1996 through a merger of two other companies Ciba-Geigy and Sandoz, is the holding company of the Novartis Group.

The Complainant's products are manufactured and sold in many regions worldwide. The Complainant has a strong presence in Turkey where the Respondent is located. The Complainant has been developing its business activities in Turkey for more than 60 years. Today it is already one of the leading companies in the sector and has 2,000 employees locally. In 2019, the Complainant's total export of Turkey was USD 136 million. Over the last decade, its exports have exceeded USD 1.6 billion in total. The Complainant also takes the lead in clinical research with more than 100 clinical trials in Turkey.

In 2020, Novartis Turkey was awarded the Top Employers Turkey and Top Employers Europe certification.

The Complainant is the owner of the well-known trademark NOVARTIS registered as both a word and device mark in several classes worldwide, including Turkey. The vast majority of the Complainant's trademark registrations significantly predates the registration of the Disputed Domain Name.

Moreover, previous UDRP Panels have stated that the NOVARTIS trademark is well-known (inter alia Novartis AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org, / Sergei Lir, WIPO Case No. D2016-1688).

The Complainant owns numerous domain names composed of either its trademark NOVARTIS alone, including <novartis.com.tr> (created on 5 November 1999) and <novartis.com> (created on 2 April 1996) or in combination with other terms, e.g. <novartispharma.com> (created on 27 October 1999). The Complainant uses these domain names to promote the NOVARTIS mark with related products and services.

The Complainant enjoys a strong presence online also via its official websites:

- General official website: <https://www.novartis.com/>.
- Local website for Turkey: <https://www.novartis.com.tr/>.
- And social media platforms.

LEGAL GROUNDS:

A. THE DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR

The domain name <Novar-Tis.com> (hereinafter referred to as the "Disputed Domain Name"), which was registered on 15 February 2022 according to the Registrar Verification, incorporates a typo of the Complainant's well-known, distinctive trademark NOVARTIS by merely inserting a symbol "-" between the letter "r" and the letter "t", which is visually and phonetically confusingly similar to the Complainant's Trademark NOVARTIS. The addition of the gTLD ".com" does not add any distinctiveness to the Disputed Domain Name. See as an example the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), paragraph 1.11. as well as the International Business Machines Corporation v. Sledge, Inc. / Frank Sledge WIPO Case No. D2014-0581 where the Panel stated the following:

“In addition, it is generally accepted that the addition of the top-level suffix in the domain name (e.g., “.com”) is to be disregarded under the confusing similarity test”.

The same reasoning should apply in the current case and the Disputed Domain Name should be considered as confusingly similar to the trademark NOVARTIS.

B. RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN RESPECT OF THE DOMAIN NAME

The Complainant and the Respondent have never had any previous relationships, nor has the Complainant ever granted the Respondent with any rights to use the NOVARTIS trademark in any forms, including the Disputed Domain Name.

The Complainant noted on 21 February 2022 that the Disputed Domain Name had been used to involve in fraudulent activities. The website associated to the Disputed Domain Name (“the Website”) displayed content that copied from Novartis’ official website for United Kingdom.

Obviously, the Respondent has been using the Disputed Domain Name for fraudulent purpose and therefore the use of the Disputed Domain Name can never be considered bona fide offering of goods or services. See *ArcelorMittal (Société Anonyme) v. Whois Privacy Protection Foundation / Sivian Menier*, WIPO Case No. D2021-0078, where the panel stated that:

“The Respondent’s attempt to pass off the disputed domain name as being affiliated with the Complainant, and in fact as being the Complainant, is, in and of itself, evidence of the fact that the Respondent does not have rights and legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy”.

Subsequently, the Complainant filed an abuse report to the registrar and to the hosting provider on 23 February 2022 and the Website was removed on the same day.

The Complainant has not found that the Respondent is commonly known by the Disputed Domain Name or that it has legitimate interest over the Disputed Domain Name.

From the Complainant’s perspective, the Respondent deliberately chose to use a typo of the well-known, distinctive trademark NOVARTIS as the body of the Disputed Domain Name and copied the Complainant’s official website, obviously with the intention to benefit from the Complainant’s worldwide renown and to confuse Internet users as to the source or sponsorship and therefore cannot be considered as a bona fide offering of goods or services.

For the foregoing reasons, it shall be concluded that the Respondent has no right nor legitimate interest in respect of the Disputed Domain Name, nor is it using the Disputed Domain Name for any bona fide offering of goods or services.

C. THE DOMAIN NAME WAS REGISTERED AND IS BEING USED IN BAD FAITH

i. THE DOMAIN NAME WAS REGISTERED IN BAD FAITH

Most of Complainant’s trademark registrations predate the registration of the Disputed Domain Name and the Respondent has never been authorized by the Complainant to register the Disputed Domain Name. Considering the renown of the Complainant and its trademark NOVARTIS, and the overall composition of the Disputed Domain Name, i.e. incorporating a typo of the Complainant’s well-known, distinctive trademark NOVARTIS by merely inserting a symbol “-” between the letter “r” and the letter “t”, which is visually and phonetically similar to the Complainant’s Trademark NOVARTIS, it follows that incorporating the well-known trademark NOVARTIS in the Disputed Domain Name is a deliberate and calculated attempt to improperly benefit from the Complainant’s rights and reputation.

Considering the facts that:

- The Respondent obviously knew about the Complainant and its trademark when it registered the Disputed Domain Name;
- The Complainant's trademark NOVARTIS is a distinctive, well-known trademark worldwide and in Turkey where the Respondent resides;
- The Respondent has failed in presenting a credible evidence-backed rationale for registering the Disputed Domain Name – to the contrary, it appeared that the registration of the Disputed Domain Name had been aiming at infringing the Complainant's rights,

the Disputed Domain Name shall be deemed as registered in bad faith, which is supported by WIPO Overview 3.0, para. 3.1.1.:

“If on the other hand circumstances indicate that the respondent's intent in registering the disputed domain name was in fact to profit in some fashion from or otherwise exploit the complainant's trademark, panels will find bad faith on the part of the respondent. While panel assessment remains fact-specific, generally speaking such circumstances, alone or together, include: (i) the respondent's likely knowledge of the complainant's rights, (ii) the distinctiveness of the complainant's mark, ... (vii) failure of a respondent to present a credible evidence-backed rationale for registering the domain name,...”

and para.3.1.4:

“Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.”

ii. THE DOMAIN NAME IS BEING USED IN BAD FAITH

As noted in the previous paragraphs, the Disputed Domain Name has been used to impersonate the Complainant's official website for UK. In the similar case No. D2021-0078 cited here-above, the panel deemed such use bad faith as it stated that:

“The Respondent's previous use of the disputed domain name to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the Complainant's mark qualifies as bad faith registration and use under paragraph 4(b)(iv) of the Policy because the Respondent's disputed domain name is confusingly similar to the Complainant's trademarks and the historical website at the disputed domain name was being used to impersonate the Complainant.”

Furthermore, the Respondent has been using privacy shield to conceal its identity, which adds up to the finding of bad faith in the given context.

Therefore, the Complainant concludes that the Respondent has registered and used the Disputed Domain Name in bad faith.

PARTIES CONTENTIONS

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

The Panel finds that the Disputed Domain Name <novar-tis.com> is confusingly similar to the Complainant's NOVARTIS trademark, since the Disputed Domain Name incorporates the latter in its entirety, simply added by a hyphen which constitutes an obvious misspelling of Complainant's NOVARTIS trademark. Numerous UDRP panels have recognized that incorporating a trademark in its entirety can be sufficient to establish that the Disputed Domain Name is at least confusingly similar to a registered trademark. Moreover, it has been held in many UDRP decisions and has meanwhile become a consensus view among UDRP panels that a domain name which consists of a common, obvious or intentional misspelling of the complainant's trademark (i.e. a typo-squatting) is still considered to be confusingly similar to the relevant trademark for purposes of the first element under the UDRP. Accordingly, the fact that the Disputed Domain Name includes a hyphen which constitutes an obvious misspelling of the Complainant's NOVARTIS trademark is not at all inconsistent with the finding of confusing similarity, especially given the fact that the Complainant's trademark is still easily recognizable within the Disputed Domain Name.

Therefore, the Complainant has established the first element under the Policy as set forth by paragraph 4(a)(i).

Also, the Complainant contends, and the Respondent has not objected to these contentions, that the Respondent has neither made use of, or demonstrable preparations to use, the Disputed Domain Name in connection with a bona fide offering of goods or services, nor is the Respondent commonly known under the Disputed Domain Name, nor is the Respondent making a legitimate non-commercial or fair use of the Disputed Domain Name without intent for commercial gain. On the contrary, the Complainant has provided evidence that on February 22, 2022, the Disputed Domain Name resolved to a website at "www.novar-tis.com" that displayed content copied from the Complainant's official website for the United Kingdom with no authorization to do so. Such making use of the Disputed Domain Name obviously in a fraudulent manner neither qualifies as a bona fide nor as a legitimate non-commercial or fair use of the Disputed Domain Name under the UDRP.

Therefore, the Complainant has also satisfied paragraph 4(a)(ii) and, thus, the second element of the Policy.

Finally, the Panel holds that the Disputed Domain Name was registered and is being used by the Respondent in bad faith. It is obvious from the circumstances to this case that the Respondent was well aware of the Complainant's rights in the NOVARTIS trademark when registering the Disputed Domain Name, and that the latter is directly targeting the Complainant's trademark. Moreover, carrying out unlawful activities under the Disputed Domain Name, which is confusingly similar to the Complainant's well-known NOVARTIS trademark, by displaying content copied from the Complainant's official website for the United Kingdom with no authorization to do so, leaves no doubts that the Respondent, by registering and making use of the Disputed Domain Name, had the intention to somehow unjustifiably profit from the undisputed reputation attached to the Complainant's NOVARTIS trademark, and, thus, the Respondent intentionally attempted to attract, for commercial gain, Internet users to its own website by creating a likelihood of confusion with the Complainant's NOVARTIS trademark as to the source, sponsorship, affiliation or endorsement of the Respondent's website. Such circumstances are evidence of registration and use of the Disputed Domain Name in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

Therefore, the Complainant has also satisfied the third element under the Policy as set forth by paragraph 4(a)(iii).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVAR-TIS.COM:** Transferred
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PANELLISTS

Name **Stephanie G. Hartung, LL.M.**

DATE OF PANEL DECISION 2022-03-30

Publish the Decision