

Decision for dispute CAC-UDRP-104740

Case number **CAC-UDRP-104740**

Time of filing **2022-07-29 09:16:45**

Domain names **novartisindia ltd.com**

Case administrator

Organization **Denisa Bilík (CAC) (Case admin)**

Complainant

Organization **Novartis AG**

Complainant representative

Organization **BRANDIT GmbH**

Respondent

Name **Vinay Kumar**

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 owns numerous trademarks NOVARTIS registered in numerous jurisdictions which were registered many years before the registration of the disputed domain name on May 18, 2022, such as but not limited to:

- The Swiss trademark NOVARTIS No. 2P-427370, registered on July 1, 1996, in classes 1, 2, 3, 4, 5, 7, 8, 9, 10, 14, 16, 17, 20, 28, 29, 30, 31, 32, 40 and 42;
- The International trademark NOVARTIS No. 663765, registered on July 1, 1996, in classes 1, 2, 3, 4, 5, 7, 8, 9, 10, 14, 16, 17, 20, 22, 28, 29, 30, 31, 32, 40 and 42;
- The India trademark NOVARTIS No. 700020, registered on February 28, 1996, in class 5; and
- The United States trademark NOVARTIS No. 4986124, registered on June 28, 2016, in class 5, 9, 10, 41, 42 and 44.

FACTUAL BACKGROUND

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. The Complainant's products are manufactured and sold in many countries worldwide including in India, country where it has an active presence

through its subsidiaries and associated companies such as Novartis India Limited (based in Mumbai).

The disputed domain name was registered after most of the trademark registrations of the Complainant. The domain resolves to a Pay-Per-Click page ("PPC page"). PPC pages generate revenues when Internet users click on the links displayed on the page. The PPC page associated to the domain name <novartisindia ltd.com> displays relevant sponsored links entitled "Biopharmaceutical Company" and "Pharmaceutical Company" which refer to the Complainant and its business activity. The Complainant has attempted to contact the Respondent to inform of the Complainant's rights regarding the NOVARTIS trademark, to which the Respondent did not reply.

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). The domain name <novartisindia ltd.com> (hereinafter referred to as the "disputed domain name") incorporates in its first level-portion the Complainant's well-known trademark NOVARTIS in its entirety and the country name "India" as well as the term "ltd" which is an abbreviation of the word "limited" used to refer to a company form. The addition of the geographical term "India" and descriptive term "ltd" would not prevent a finding of confusing similarity to the trademark (see *RooFoods Ltd v. Domain Privacy Service FBO Registrant, The Endurance International Group, Inc. / Mustapha Ait Oumejjoud*, WIPO Case No. D2021-0571; *Compagnie Générale des Etablissements Michelin v. yinghui () / Zhang Hang ()*, WIPO Case No. D2021-2020; and *3Shape A/S v. Sparta Polis Hosting, CAC Case No. 102173*; see also *Minerva S.A. c. Domain Administrator, Fast Serv Inc. d.b.a. QHoster.com*, WIPO Case No. D2019-2767).

The presence of the generic Top-Level Domain ("gTLD") extension ".com" in the first level portion of the disputed domain name is a standard registration requirement and may be disregarded when assessing whether the disputed domain name is confusingly similar to the trademark in which the Complainant has rights (see *Rollerblade, Inc. v. Chris McCrady*, WIPO Case No. D2000-0429; *Can Pro Pet Products LTD. v. Matthew Dweck*, WIPO Case No. D2020-0615; *Sanofi v. Aamir Hitawala*, WIPO Case No. D2021-1781).

The disputed domain name is therefore confusingly similar to the Complainant's trademark NOVARTIS.

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).

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.

There is no evidence that the Respondent is known by the disputed domain name or owns any corresponding registered trademarks.

- When conducting online trademark databases searches, no information is found in relation with trademarks corresponding to the terms "novartisindia ltd.com", "novartisindia ltd" or "novartis india ltd".
- Moreover, when searching on popular Internet search engines, such as Google.com, for the terms "novartis", alone or in combination with the terms "india" and "ltd", the vast majority of the results directly relate to the Novartis group, the Complainant as well as its website, its social medias accounts or related topics.
- The Respondent also used a privacy shield service, masking its identity on the publicly available Registrar's WhoIs. It appears that the Respondent has aimed at hiding its true identity rather than being known by the disputed domain name.

Moreover, the structure of the disputed domain name reveals that Respondent's initial intention in registering the disputed domain name was to refer to the Complainant, its trademark and business activities. The disputed domain name indeed

incorporates the Complainant's trademark NOVARTIS with the addition of the country name "India" and the term "ltd". Such association of terms within the disputed domain name directly refers to the Complainant, its business presence as well as activity of its operations in India, especially through its subsidiaries and associated companies such as Novartis India Limited). In this regard, previous UDRP panels have constantly held that where a domain name consists of a trademark plus an additional term (at the second- or top-level), such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, section 2.5.1). It has been, for instance, held that when a domain name which incorporates "the Complainant's DELIVEROO trademark and adds the geographical term 'france', which can be easily linked to the Complainant or its affiliate Deliveroo France SAS [...] the Disputed Domain Name carries a risk of implied affiliation with the Complainant and cannot constitute fair use" (see RooFoods Ltd v. Domain Privacy Service FBO Registrant, The Endurance International Group, Inc. / Mustapha Ait Oumejjoud, WIPO Case D2021-0571). As the disputed domain name incorporates the Complainant's trademark NOVARTIS and the geographical term "India" as well as the descriptive term "ltd", its structure clearly suggests that the disputed domain name is directly related to the Complainant and its affiliated companies which have established business presence in India. Therefore, such composition of terms within the structure of the disputed domain name cannot constitute fair use.

The Complainant's products are manufactured and sold in many countries worldwide including in India, country where it has an active presence through its subsidiaries and associated companies such as Novartis India Limited (based in Mumbai) The PPC page associated to the domain name <novartisindia.com> displays relevant sponsored links entitled "Biopharmaceutical Company" and "Pharmaceutical Company" which clearly refer to the Complainant and its business activity. The Respondent is obtaining a financial benefit when Internet users are clicking on the aforementioned links. Such use of the disputed domain name aims at attracting Internet users for commercial gain by creating a likelihood of confusion with the Complainant's NOVARTIS trademark as to the sources, sponsorship, affiliation, or endorsement of the aforementioned PPC page. When "the business model in this case, was for the Respondent to passively collect click-through revenue generated solely from the Complainant's goodwill and Internet users' inaccurate guessing of the correct domain name associated with the Complainant's RENAULT financial services", it has been held that the "[e]xploitation of the reputation of a trademark to obtain click-through commissions from the diversion of Internet users is a common example of use in bad faith as referred to in paragraph 4(b)(iv) of the Policy and identified in many previous UDRP decisions" (see Renault SAS v. Domain Administrator, See PrivacyGuardian.org / Simon Pan, WIPO Case No. D2019-3208). Moreover, when the use of the disputed domain name was in connection with "a parking page displaying PPC links, from which Respondent derived click-through revenue", the UDRP panel considered that such use "signals a further attempt on the part of Respondent to take unauthorized commercial advantage of Complainant's trademarks in bad faith" (see Amazon Technologies, Inc. and Amazon Europe Core S.à.r.l. v. Hei Ze Shang Zi, WIPO Case No. D2020-3012).

It therefore appears that the Respondent deliberately chose to use the well-known trademark NOVARTIS as the main part of the disputed domain name to benefit from the Complainant's worldwide renown trademark 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 nor a legitimate non-commercial or fair use of the disputed domain name.

For the foregoing reasons, the Respondent has no rights or legitimate interests in respect of the disputed domain name, within the meaning of the Paragraphs 4(a)(ii) and (4)(c) 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).

It should be highlighted that most of the 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. The Respondent registered the disputed domain name many years after the registrations of the Complainant's NOVARTIS trademarks. The NOVARTIS trademark is a widely known trademark registered in many countries and the Complainant enjoys a strong online presence. The Complainant is very active on social media to promote its mark, products and services (See, Laboratoires M&L v. Zhaoxingming, CAC Case No. 102277). By conducting a simple online search regarding the name "Novartis" alone or in combination with the terms "india" and "ltd" on popular search engines, the Respondent would have inevitably learnt about the Complainant, its trademark and business (see Intesa Sanpaolo S.p.A. v. Abayomi Ajileye, CAC Case

No. 102396).

Moreover, the Complainant and the Novartis group enjoy a strong reputation worldwide in the pharmaceutical field. The Novartis group has especially a strong presence in India, via its subsidiaries and associated companies, country where the Respondent is also based. Given the strong presence of the Complainant and its NOVARTIS trademark online as well as the fact that several of the Complainant's subsidiaries and associated companies are based in India, it is implausible that the Respondent did not know the Complainant and its NOVARTIS trademark when he registered the disputed domain name.

Therefore, the Respondent had knowledge of the Novartis group, the Complainant and the NOVARTIS trademark at the time of the registration of the disputed domain name.

The structure of the disputed domain name aims at making Internet users believe it is connected the Complainant and its business activity. The disputed domain name entirely comprises the Complaint's well known trademark NOVARTIS with the highly relevant terms "India" and "Ltd". In similar circumstances, it has been held that given the high degree of distinctiveness of the mark, the "incorporation of this mark in the disputed domain name cannot therefore have been accidental". It has been also stated "by adding the geographic abbreviation 'be' for Belgium to the Complainant's mark, the Respondent appears to have been aiming at confusion of Internet users, considering the Complainant's location in neighboring France. Since no legitimate interest of the Respondent could be identified, and considering the nature of the disputed domain name and current commercial use, the Panel cannot conceive of any plausible good-faith use to which the disputed domain name may be put" (see *Sodexo v. Withheld for Privacy Purposes*, Privacy Service Provided by Withheld / Morel Nicolas, WIPO Case No. D2021-3842).

The disputed domain name resolves to a PPC page which is likely to generate revenues when Internet users click on the links displayed therein. The Respondent is obtaining a financial benefit when Internet users are clicking on the aforementioned links. Such use of the disputed domain name aims at attracting Internet users for commercial gain by creating a likelihood of confusion with the Complainant's NOVARTIS trademark as to the sources, sponsorship, affiliation, or endorsement of the aforementioned PPC page. When "the business model in this case, was for the Respondent to passively collect click-through revenue generated solely from the Complainant's goodwill and Internet users' inaccurate guessing of the correct domain name associated with the Complainant's RENAULT financial services", it has been held that the "[e]xploitation of the reputation of a trademark to obtain click-through commissions from the diversion of Internet users is a common example of use in bad faith as referred to in paragraph 4(b)(iv) of the Policy and identified in many previous UDRP decisions" (see *Renault SAS v. Domain Administrator*, See *PrivacyGuardian.org / Simon Pan*, supra). Moreover, when the use of the disputed domain name was in connection with "a parking page displaying PPC links, from which Respondent derived click-through revenue", the UDRP Panel considered that such use "signals a further attempt on the part of Respondent to take unauthorized commercial advantage of Complainant's trademarks in bad faith" (see *Amazon Technologies, Inc. and Amazon Europe Core S.à.r.l. v. Hei Ze Shang Zi*, supra).

Moreover, the Complainant has attempted to contact the Respondent to inform of the Complainant's rights regarding the NOVARTIS trademark, to which the Respondent did not reply. Such behavior infers bad faith (see *NetBet Enterprises Ltd v. Global Domain Privacy Services Inc. / Tilok Nokar*, WIPO Case No. D2020-0048).

Furthermore, it is likely that the Respondent is trying to conceal its identity regarding the ownership of the disputed domain name – as his name and contact details were until very recently covered by a privacy shield in the corresponding Whois record – which is further evidence of bad faith (*Instagram, LLC v. Registration Private, Domains By Proxy, LLC / Murat Sander*, WIPO Case No. D2021-0526).

The aforementioned facts demonstrate that the Respondent has been using the disputed domain name in bad faith.

The overall described circumstances are clear demonstration of the registration and use of the disputed domain name are in bad faith.

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 structure of the disputed domain name aims at making Internet users believe it is connected the Complainant and its business activity. The disputed domain name entirely comprises the Complaint's well known trademark NOVARTIS with the highly relevant terms "India" and "Ltd". The disputed domain name resolves to a PPC page which is likely to generate revenues when Internet users click on the links displayed therein. The Respondent is obtaining a financial benefit when Internet users are clicking on the aforementioned links. Such use of the disputed domain name aims at attracting Internet users for commercial gain by creating a likelihood of confusion with the Complainant's NOVARTIS trademark as to the sources, sponsorship, affiliation, or endorsement of the aforementioned PPC page.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **NOVARTISINDIALTD.COM**: Transferred

PANELLISTS

Name	Thomas Hoeren
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DATE OF PANEL DECISION 2022-09-02

Publish the Decision