

Decision for dispute CAC-UDRP-104981

Case number	CAC-UDRP-104981
Time of filing	2022-11-09 09:46:32
Domain names	novartispharma-us.com, novartispharm-us.com

Case administrator

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

Organization	Novartis AG
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Complainant representative

Organization	BRANDIT GmbH
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Respondents

Organization	Roy Schonberg (Novartis Pharmaceuticals)
Organization	Novartis Pharmaceuticals

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 names.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of numerous registrations for the trademark "NOVARTIS", including the US trademark No 4986124, registered on June 28, 2016, for goods and services in classes 5, 9, 10, 41, 42 and 44.

The disputed domain names were registered by the Respondent on September 20, 2022 and on October 7, 2022.

FACTUAL BACKGROUND

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

The Complainant states that it is one of the biggest global pharmaceutical and healthcare groups and provides solutions to address the evolving needs of patients worldwide by developing and delivering innovative medical treatments and drugs.

The Complainant submits that its products are manufactured and sold in many regions worldwide.

The Complainant underlines that it has a strong presence in the USA where the Respondent is located. The Complainant points out that it has been playing an active role on the local market and in the USA society.

The Complainant points out that the majority of its trademark registrations predate the registration of the disputed domain names.

The Complainant notes that previous UDRP panels have stated that the NOVARTIS trademark is well-known.

The Complainant submits that it has registered several domain names containing the term "NOVARTIS", for example, <novartis.com> (registered in 1996) and <novartispharma.com> (registered in 1999).

The Complainant clarifies that it uses these domain names to connect to a website through which it informs potential customers about its "NOVARTIS" trademark and its products and services.

The Complainant adds that it enjoys a strong presence online via its official social media platforms.

The Complainant points out that the NOVARTIS trademark is clearly recognizable within the disputed domain names and that the mere addition of a descriptive term would not prevent a finding of confusing similarity to a trademark.

The Complainant considers that the addition of the top-level domain ".COM" does not add any distinctiveness to the disputed domain names.

The Complainant submits that the disputed domain names should be considered as confusingly similar to the trademark "NOVARTIS".

The Complainant notes that:

- it has never had any previous relationships with the Respondent;
- it has never granted the Respondent any rights to use the NOVARTIS trademark in any form, including the disputed domain names;
- the Respondent is not commonly known by the disputed domain names;
- when searched for "novartispharma-us.com" or "novartispharm-us.com" in the Google search engine, the search results all pointed to the Complainant and its business activities;
- when searching for the Respondents' names as revealed by the Registrar Verification along with the terms contained in the disputed domain names there are no relevant results showing that the Respondent is known by the disputed domain names;
- the WHOIS records show that the Respondent appears as "Novartis Pharmaceuticals" with two different addresses in the US and there are no such organizations in the locations listed;
- it has numerous entities in the US operating under the name "Novartis Pharmaceuticals Corporation" located in New Jersey, Texas, Illinois, California and New York;
- it sent "cease-and-desist" letters:
 - In relation to <novartispharma-us.com> on September 28, 2022;
 - In relation to <novartispharm-us.com> on October 14, 2022;

and did not receive any response;

- at the time of sending the "cease-and-desist" letters and at least until the date of filing the complaint, both disputed domain names did not resolve to any active pages;
- there is no evidence that the Respondent engages in, or has engaged in any activity or work, i.e., legitimate or fair use of the disputed domain names, that demonstrates a legitimate interest in the disputed domain names.

The Complainant observes that the Respondent, who should have performed a simple online search before registering the disputed domain names, has chosen to incorporate the distinctive well-known trademark NOVARTIS in the disputed domain names in its entirety without any authorization.

The Complainant argues that it is inconceivable that the Respondent was unaware of the existence of the Complainant when it registered the disputed domain names, also using the names "Novartis Pharmaceuticals" in the corresponding registration requests.

The Complainant submits that the Respondent registered the disputed domain names incorporating the trademark NOVARTIS intentionally in order to take advantage of the reputation of the trademark NOVARTIS and of its goodwill.

The Complainant highlights that under the doctrine of passive holding, which should apply to this case, "the non-use of a domain would not prevent a finding of bad faith".

The Complainant adds that the Respondent's decision not to reply to the "cease-and-desist" letters is a further evidence of 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 names are 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 names (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 names have been registered and are 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

In accordance with paragraph 4(a) of the Policy, in order to obtain the transfer of a domain name, the complainant has to demonstrate that:

- (i) The 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 domain name has been registered and is being used in bad faith.

IDENTICAL OR CONFUSINGLY SIMILAR

The first requirement that the Complainant must establish is that the disputed domain names are identical with, or confusingly similar to, the Complainant's trademark.

There are two elements of this test: for each domain name, the Complainant must demonstrate that it has rights in a trademark or service mark and, if so, the disputed domain names must be shown to be identical or confusingly similar to the trademark or service mark.

The Complainant has proven ownership of the registered trademark "NOVARTIS", identified in section "Identification of rights" above.

The Panel observes that the registration of the Complainant's trademark predates the registration of the disputed domain names.

On the question of identity or confusing similarity, what is required is simply a comparison and assessment of the disputed domain names to the Complainant's trademark.

The disputed domain names differ from the Complainant's trademark "NOVARTIS" only by the addition of the word "PHARMA" (in <novartispharma-us.com>) and "PHARM" (in <novartispharm-us.com>), followed by a hyphen, by the word "US" (which can be considered as abbreviation of the geographical term "United States") and by the top-level domain ".COM".

It is well accepted that the hyphen is not relevant in the confusing similarity test (see, for example, WIPO case No. D2016-0676).

It is a common view that where a trademark is the distinctive part of a domain name, the domain name is considered to be confusingly similar to the trademark (see, for example, WIPO case No. D2017-1266).

In the present case the terms "PHARMA" or "PHARM" and "US" after the hyphen have no impact on the distinctive part "NOVARTIS". It is well established that, where the relevant trademark is recognizable within the domain name, the addition of other terms would not be sufficient to prevent a finding of confusing similarity (see, for example, CAC case No. 104755).

The Panel observes that it is well established that the top-level domain may generally be disregarded in the confusing similarity test (see, for example, WIPO case No. D2016-2547).

Therefore, the Panel considers that the disputed domain names are confusingly similar to the Complainant's trademarks.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

The second requirement that the Complainant must prove is that the Respondent has no rights or legitimate interests in each of the disputed domain names.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the respondent has rights or legitimate interests in a domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] 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 consumers or to tarnish the trademark or service mark at issue.

This is a non-exhaustive list of circumstances in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement falls on the Complainant. UDRP panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative".

Accordingly, it is usually sufficient for a complainant to raise a prima facie case against the respondent and the burden of proof on this requirement shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in a domain name.

The Panel finds that the Complainant has made out a prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain names.

In particular, the Complainant states that:

- it has never had any previous relationships with the Respondent;
- it has never granted the Respondent any rights to use the NOVARTIS trademark in any form, including the disputed domain name;
- the Respondent is not commonly known by the disputed domain name;
- when searched for "novartispharma-us.com" or "novartispharm-us.com" in the Google search engine, the search results all pointed to the Complainant and its business activities;
- when searching for the Respondents' names as revealed by the Registrar Verification along with the terms contained in the disputed domain names there are no relevant results showing that the Respondent is known by the disputed domain names;
- the WHOIS records show that the Respondent appears as "Novartis Pharmaceuticals" with two different addresses in the US and there are no such organizations in the locations listed;
- it has numerous entities in the US operating under the name "Novartis Pharmaceuticals Corporation" located in New Jersey, Texas, Illinois, California and New York;
- it sent "cease-and-desist" letters:
 - In relation to <novartispharma-us.com> on September 28, 2022;
 - In relation to <novartispharm-us.com> on October 14, 2022;

and did not receive any response;

- at the time of sending the "cease-and-desist" letters and at least until the date of filing the complaint, both disputed domain names did not resolve to any active pages;
- there is no evidence that the Respondent engages in, or has engaged in any activity or work, i.e., legitimate or fair use of the disputed domain names, that demonstrates a legitimate interest in the disputed domain names.

In the absence of a Response, there is no indication in the present case that the Respondent is commonly known by the disputed domain names. The Panel observes that the company names used by the Respondent seem to be related to the Complainant, however in the light of the fact that the Complainant has no relationship with the Respondent, that no company "Novartis Pharmaceuticals" exists at the address declared in the records and that the e-mail addresses used by the Respondent have been created using a free online e-mail service and random English words, it is clear that the company names used do not correspond to the real registrant of the disputed domain names (see, for example, CAC case 104654).

Furthermore, the Respondent has failed to demonstrate any of the other non-exclusive circumstances evidencing rights or legitimate interests under paragraph 4(c) of the Policy or other evidence of rights or legitimate interests in the disputed domain names.

The Respondent does not appear to make any legitimate non-commercial or fair use of the disputed domain names, nor any use in connection with a bona fide offering of goods or services. Indeed, the disputed domain names did not resolve to any active pages.

The Panel considers that, on the balance of probability, the Respondent knew the Complainant's trademark and registered the disputed domain names with knowledge of the Complainant's rights. Indeed, it is not conceivable that the Respondent did not have the Complainant's trademark in mind, when registering and using the disputed domain names. Under these circumstances, it cannot be concluded that the Respondent is making a "fair" use of the disputed domain names.

Taking into account that the Complainant has never had any previous relationships with the Respondent and has never granted the Respondent any rights to use the NOVARTIS trademark in any form, that the Respondent is not commonly known by the disputed domain names, that no replies to the "cease-and-desist" letters were received, that the disputed domain names did not resolve to any active pages, the Panel cannot imagine any possible legitimate justification for this use, and the Respondent has not come forward with any explanation that demonstrates any rights or legitimate interests in the disputed domain names.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

REGISTERED AND USED IN BAD FAITH

Under the third requirement of the Policy, the Complainant must establish that the disputed domain names have been both registered and used in bad faith by the Respondent.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, including:

- (i) circumstances indicating that [the Respondent] [has] registered or [has] acquired the [disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the [disputed] domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of [the Respondent's] documented out-of-pocket costs directly related to the [disputed] domain name; or
- (ii) [the Respondent] [has] registered the [disputed] domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the Respondent] [has] engaged in a pattern of such conduct; or
- (iii) [the Respondent] [has] registered the [disputed] domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the [disputed] domain name, [the Respondent] [has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent's] web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the Respondent's] web site or location or of a product or service on [the Respondent's] web site or location.

The Panel, on the basis of the evidence presented, agrees with the Complainant's contentions that the disputed domain names were registered in bad faith and that they have been used in bad faith.

Taking into account the fact that the trademark "NOVARTIS" is distinctive and well-known, as also recognized by other panels (see CAC Case No.102685), the Panel agrees that it is inconceivable that the Respondent was not aware of the Complainant's rights in the Complainant's trademark when registering the disputed domain names.

Other panels considered that knowledge of a corresponding mark at the time of the domain name's registration can suggest bad faith (see WIPO Case No. D2017-0100). The Panel shares this view.

The Panel agrees also that the lack of reply to the "cease-and-desist" letters is evidence of bad faith (see CAC Case No. 102629).

The Panel observes that if the Respondent had legitimate purposes in registering and using the disputed domain names it would have filed a Response in this proceeding.

The Panel, having taken into account the Respondent's knowledge of the Complainant's trademarks at the time of the disputed domain names' registration, the non-use of the disputed domain names, the lack of reply to the "cease-and-desist" letters and to the complaint, considers that the disputed domain names were registered and are being used in bad faith.

Accordingly, the Panel finds that the disputed domain names were registered and are being used in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **novartispharma-us.com**: Transferred

2. novartispharm-us.com: Transferred

PANELLISTS

Name Michele Antonini

DATE OF PANEL DECISION 2022-12-31

Publish the Decision