

Decision for dispute CAC-UDRP-105667

Case number **CAC-UDRP-105667**

Time of filing **2023-07-27 09:36:57**

Domain names **novartis-us.xyz**

Case administrator

Name **Olga Dvořáková (Case admin)**

Complainant

Organization **Novartis AG**

Complainant representative

Organization **BRANDIT GmbH**

Respondent

Organization **ExtraHostPro Webhosting Ikeja**

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 numerous registrations for the trademark "NOVARTIS", including the international trademark No 663765, 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.

The disputed domain name was registered by the Respondent on July 20, 2023.

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. Novartis AG, 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 an active presence in

Nigeria, where the Respondent is located.

The Complainant is the owner of the trademark NOVARTIS registered in several classes worldwide, including Nigeria.

The Complainant owns numerous domain names composed of either its trademark NOVARTIS alone, including <novartis.com> or in combination with other terms, e.g. <novartispharma.com>. 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 enjoys a strong presence online also via its official social media platforms.

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

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

The Complainant considers that the addition of the top-level domain 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.

The Complainant submits that the disputed domain name 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 in the disputed domain name;
- when searched for "novartis-us" or "novartis-us.xyz" in popular search engines, the search results all pointed to the Complainant and its social media accounts or related topics;
- when searching for the Respondents' name as revealed by the Registrar Verification along with the terms contained in the disputed domain name there are no relevant results showing that the Respondent is known by the disputed domain name;
- there are no returned results when searching for any trademarks owned by the Respondent;
- the disputed domain name resolved to an active page mimicking the official web-site of the Complainant <novartis.com> displaying trademarks of the Complainant, copyrighted imagery and creating general look and feel of the Complainant's official page by replicating it;
- the website associated with the disputed domain name displayed a banner at the very top of the page saying: "This is official website of Novartis";
- the website associated with the disputed domain name displayed a banner in bold red color "We are Recruiting at NOVARTIS" along with the button "Apply Now";
- the Complainant filed a takedown complaint with the hosting provider to stop the Respondent's contested activities, which has been accepted by the hosting provider.

The Complainant observes that the Respondent, who should have performed a simple online search before registering the disputed domain name, has chosen to incorporate the distinctive well-known trademark NOVARTIS in the disputed domain name 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 name.

The Complainant submits that the Respondent, by registering the disputed domain name incorporating the well-known NOVARTIS trademark and the term "us", clearly aimed at referring to the Novartis group.

The Complainant notes that it is likely that the Respondent has malicious intent, as active MX records are associated with the disputed domain name. This fact further increases the possibility that internet users are misdirected by phishing emails sent by email addresses connected to the disputed domain name.

PARTIES CONTENTIONS

Complainant's contentions are summarised above.

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

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 name is identical with, or confusingly similar to, the Complainant's trademark.

There are two elements of this test: the Complainant must demonstrate that it has rights in a trademark or service mark and, if so, the disputed domain name 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 name.

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

The disputed domain name differs from the Complainant's trademark "NOVARTIS" only by the addition of the hyphen, followed by the word "US" (which can be considered as abbreviation of the geographical term "United States"), and by the top-level domain ".XYZ".

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 term "US" after the hyphen has 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 name is confusingly similar to the Complainant's trademark.

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 the disputed domain name.

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 name.

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 in the disputed domain name;
- when searched for "novartis-us" or "novartis-us.xyz" in popular search engines, the search results all pointed to the Complainant and its social media accounts or related topics;
- when searching for the Respondents' name as revealed by the Registrar Verification along with the terms contained in the disputed domain name there are no relevant results showing that the Respondent is known by the disputed domain name;
- there are no returned results when searching for any trademarks owned by the Respondent;
- the disputed domain name resolved to an active page mimicking the official web-site of the Complainant <novartis.com> displaying trademarks of the Complainant, copyrighted imagery and creating general look and feel of the Complainant's official page by replicating the same;
- the website associated with the disputed domain name displayed a banner at the very top of the page saying: "This is official website of Novartis";
- the website associated with the disputed domain name displayed a banner in bold red color "We are Recruiting at NOVARTIS" along with the button "Apply Now";
- the Complainant filed a takedown complaint with the hosting provider to stop the Respondent's contested activities, which has been accepted by the hosting provider.

In the absence of a Response, there is no indication in the present case that the Respondent is commonly known by the disputed domain name.

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 name.

The Respondent does not appear to make any legitimate non-commercial or fair use of the disputed domain name, nor any use in connection with a bona fide offering of goods or services. Indeed, before the takedown complaint, the disputed domain name resolved to a webpage mimicking the official web-site of the Complainant <novartis.com>, which included misleading banners and which created a general look and feel of the Complainant's official page by replicating it.

The Panel considers that, on the balance of probability, the Respondent knew the Complainant's trademark and registered the disputed domain name 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 name. Under these circumstances, it cannot be concluded that the Respondent is making a "fair" use of the disputed domain name.

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 name, that the disputed domain name resolved to a webpage which replicated the Complainant's official website, 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 name.

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 name has 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 name was registered in bad faith and that it has 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 name.

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, in line with the view of other panels, that the fact of having taken design, content and logos from the Complainant's website supports a finding of bad faith (see CAC Case No. 101068).

Moreover, other panels considered that the risk that a domain name is used for the sending and receiving of phishing emails may exist where a domain name that is confusingly similar to the Complainant's well-known trademark has been created by the Respondent and is used for an impersonation website, and in the absence of the Respondent's explanation as regards the creation of the MX record (see CAC Case No. 104862). The Panel agrees with this view and considers that, in the present circumstances, the existence of a MX record for the disputed domain name supports a finding of bad faith.

The Panel observes that if the Respondent had legitimate purposes in registering and using the disputed domain name 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 name's registration, the fact that the disputed domain name resolved to a webpage which replicated the Complainant's official website, the existence of a MX record for the disputed domain name and the lack of reply to the complaint, considers that the disputed domain name was registered and is being used in bad faith.

Accordingly, the Panel finds that the disputed domain name was registered and is 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. **novartis-us.xyz** : Transferred

PANELLISTS

Name	Michele Antonini
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DATE OF PANEL DECISION 2023-09-03
