

## **ADMINISTRATIVE PANEL DECISION**

Novartis AG v. Privacy service provided by Withheld for Privacy ehf /  
Anti Social

Case No. DCO2022-0057

### **1. The Parties**

The Complainant is Novartis AG, Switzerland, represented by BrandIT GmbH, Switzerland.

The Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / Anti Social, United States of America (“United States” or “USA”).

### **2. The Domain Name and Registrar**

The disputed domain name <novartls.co> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 28, 2022. On July 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 28, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on July 29, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on August 3, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on August 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 30, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 31, 2022.

The Center appointed Kateryna Oliinyk as the sole panelist in this matter on September 7, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### 4. Factual Background

The Complainant is a major global pharmaceutical and healthcare group, created in 1996 through a merger of two other companies Ciba-Geigy and Sandoz, and is the holding company of the Novartis Group. The Complainant has its headquarter in Switzerland and presence around the world, including the United States, where the Respondent is located. The Complainant has several subsidiaries and associated companies based in the USA and has been playing an active role on the local market. In the USA, the Novartis Group has nearly 16,000 full-time equivalent employees in skilled positions, including more than 5,500 scientist, physicians and other R&D professionals.

The Complainant provides solutions to address the evolving needs of patients worldwide by developing and delivering innovative medical treatments and drugs.

The Complainant has provided evidence that it is the registered owner of numerous trademarks worldwide relating to its company name and the NOVARTIS trademark, including the following trademark registrations valid in Iceland and the USA, just to name the few:

- International Trademark Registration No. 1349878 for NOVARTIS, registered on November 29, 2016, for goods of International Classes 09 and 10, and services of International Classes 41, 42, 44, and 45;
- United States Trademark Registration No. 4986124 for NOVARTIS, registered on June 28, 2016, for goods of International Classes 05, 09, and 10, and services of International Classes 41, 42, and 44;
- United States Trademark Registration No. 2997235 for NOVARTIS, registered on September 20, 2005, for goods of International Class 05.

Previous UDRP Panels have stated that the NOVARTIS trademark is well known.

The Complainant operates numerous domain names composed of either the NOVARTIS trademark alone, including <novartis.us> (created on April 19, 2002) and <novartis.com> (created on April 2, 1996) or in combination with other terms, e.g. <novartispharma.com> (created on October 27, 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 social media platforms.

The disputed domain name <novartls.co> was created on June 6, 2022, and used to resolve to a website showing a parking page containing various commercial or sponsored pay-per-click ("PPC") links to third party websites. At the time on filing of the amended complaint on August 3, 2022, the disputed domain name was passively held.

The Complainant tried to reach the Respondent by a notice sent on June 14, 2022, via abuse contact of the Registrar, however, there was no response from the Respondent.

## 5. Parties' Contentions

### A. Complainant

#### Identical or Confusingly Similar

The Complainant contends that the disputed domain name and the NOVARTIS trademark are confusingly similar.

According to the Complainant's contentions, the disputed domain name incorporates a typo of the Complainant's NOVARTIS trademark by merely replacing the letter "i[I]" with the letter "I", which is visually confusingly similar to the Complainant's NOVARTIS trademark.

The addition of the country code Top-Level Domain ("ccTLD") ".co" does not add any distinctiveness to the disputed domain name.

#### No rights or legitimate Interests

The Complainant claims that it has no connection with the Respondent.

The Complainant contends that the Respondent is not commonly known by the disputed domain name. Nor is the Respondent otherwise associated with it, or any similar name, whether through a family name, business activity, or other legitimate activity.

The Complainant further contends that the Respondent is not using nor preparing to use the disputed domain name in connection with a *bona fide* offering of goods or services and is not making a legitimate noncommercial or fair use of the disputed domain name. The disputed domain name resolved to a parking page with PPC advertisements, and such use of the disputed domain name by the Respondent does not constitute either *bona fide* use or a legitimate noncommercial or fair use of the disputed domain name.

#### Registered and used in bad faith

The Complainant submits that the Respondent must have been aware of the Complainant's NOVARTIS trademark upon registration of the disputed domain name. The Complainant contends that the disputed domain name is used with the view of attracting Internet users for commercial gain by creating a likelihood of confusion with the Complainant's NOVARTIS trademark.

The lack of the response from the Respondent to the notice sent by the Complainant prior to filing the UDRP complaint also infers bad faith.

### B. Respondent

The Respondent did not reply to the Complainant's contentions.

## 6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Considering that the Respondent did not reply to the Complainant's contentions, in order to determine whether the Complainant has met its burden as stated in paragraph 4(a) of the Policy, the Panel bases its Decision on the statements and documents submitted and in accordance with the Policy and the Rules. Under paragraph 14(b) of the Rules, where a Party does not comply with any provision of the Rules, the

Panel “shall draw such inferences therefrom as it considers appropriate”.

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following: (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and (iii) that the disputed domain name has been registered and is being used in bad faith.

### **A. Identical or Confusingly Similar**

Ownership of a nationally or regionally registered trademark serves as a *prima facie* evidence that the Complainant has trademark rights for the purposes of standing to file this Complaint. See section 1.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). The Complainant submitted evidence that the NOVARTIS trademark enjoys protection under international and national trademark registrations. Thus, the Panel finds that the Complainant has proved that it has rights in the NOVARTIS trademark.

The disputed domain name <novartls.co> consists of misspelling of the Complainant’s NOVARTIS trademark by substitution of the letter “i” by the letter “l” which uppercase letters look identical.

According to section 1.9. of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) a domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element. Examples of such typos include (i) adjacent keyboard letters, (ii) substitution of similar-appearing characters (e.g., upper vs lower-case letters or numbers used to look like letters), (iii) the use of different letters that appear similar in different fonts, (iv) the use of non-Latin internationalized or accented characters, (v) the inversion of letters and numbers, or (vi) the addition or interspersing of other terms or numbers.

Under section 1.7 of the [WIPO Overview 3.0](#), while each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant’s trademark and the disputed domain name. This test typically involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

According to section 1.11.1 of the [WIPO Overview 3.0](#), the applicable Top Level Domain (“TLD”) in a domain name is viewed as a standard registration requirement and as such should be disregarded under the first element confusingly similar test.

The Panel finds that the disputed domain name <novartls.co> is confusingly similar to the Complainant’s NOVARTIS trademark and that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

### **B. Rights or Legitimate Interests**

Under paragraph 4(a)(ii) of the Policy, a complainant must make at least a *prima facie* showing that a respondent possesses no rights or legitimate interests in a disputed domain name. See, e.g., *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#). Once a complainant makes such a *prima facie* showing, the burden of production shifts to the respondent, though the burden of proof always remains on the complainant. If the respondent fails to come forward with evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.

Based on the Complainant's contentions, the Respondent is not a licensee of, or otherwise affiliated with, the Complainant, and has not been authorized by the Complainant to use its NOVARTIS trademark.

Based on the case records, the Panel finds that there is no evidence that the Respondent has been commonly known by the disputed domain name, and there is no similarity or association between the name of the Respondent and the disputed domain name, which could demonstrate rights or legitimate interests of the Respondent. See, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones TheDotCafe*, WIPO Case No. [D2008-0642](#).

By the time the Complainant found out about the disputed domain name it used to resolve to parked page stating the following: "The Sponsored Listings displayed above are served automatically by a third party. Neither Parkingcrew nor the domain owner maintain any relationship with the advertisers."

By the time the Complainant prepared this Complaint on July 28, 2022, the disputed domain name resolves to the parking page with the commercial PPC links such as "Technology", "Shop", "Global Employment Company", "Payroll Services Provider" and alike.

At the time on filing of the amended complaint on August 3, 2022, the disputed domain name was passively held by the Respondent.

According to section 2.9. of the [WIPO Overview 3.0](#), applying UDRP paragraph 4(c), panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users.

Thus, based on the evidences submitted, the Panel has established that the disputed domain name used to resolve to a parking page with various headings and commercial links generated automatically. Now the disputed domain name is passively held by the Respondent.

Therefore, based on the case records, the Panel finds that the service of pay-per-click advertisements through the disputed domain name attempted to trade off the goodwill of Complainant and accordingly such use of the disputed domain name could not constitute any *bona fide* offering of goods or services using the disputed domain name. [WIPO Overview 3.0](#), section 2.9 (Unless "genuinely related to the dictionary meaning" of the disputed domain, "[pay-per-click] links do not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of Complainant's mark or otherwise mislead Internet users".) See, e.g., *Volkswagen AG v. Privacy Protection Services*, WIPO Case No. [D2012-2066](#) ("use of a domain name in connection with a web page that 'only contains advertisements as sponsored links' is "for presumed commercial gain"); *Zions Bancorporation v. Domain Administrator, Fundacion Private Whois*, WIPO Case No. [D2014-0465](#) ("a parking website containing sponsored links... cannot be considered either a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the Domain Name as the Respondent is unduly profiting from the Complainant's goodwill by misleading Internet users to its website"); and *Canyon Bicycles GmbH v. Domains By Proxy, LLC / Rob van Eck*, WIPO Case No. [D2014-0206](#) (a disputed domain name "pointing to a website featuring PPC [pay-per-click] links... could not be construed as a *bona fide* or legitimate noncommercial or fair use").

The disputed domain name does not resolve to an active website now. Prior UDRP panels have found that the passive holding of a disputed domain name is neither a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use. See, by way of example, *Skyscanner Limited v. WhoisGuard Protected, WhoisGuard, Inc. / petrov petya*, WIPO Case No. [DCC2020-0003](#), *Instagram, LLC v. Zafer Demir, Yok*, WIPO Case No. [D2019-1072](#), "The passive holding of the disputed domain name does not amount to use or preparations to use it in connection with a *bona fide* offering of goods and services. Nor is there any evidence which indicates that the Respondent is commonly known by the disputed domain name. Nor does a passive holding of the disputed domain name comprise a legitimate noncommercial or fair use of it.).

The Panel concurs with this approach.

In the Panel's view, neither the past nor the current use of the disputed domain name by the Respondent constitutes a *bona fide* use or a legitimate noncommercial or fair use of the disputed domain name.

By not submitting a Response, the Respondent has failed to invoke any circumstances which could demonstrate any rights or legitimate interests in the disputed domain name. Under such circumstances the Panel draws adverse inferences from this failure, where appropriate, in accordance with the Rules, paragraph 14(b).

Accordingly and absent specific allegations of the Respondent, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

### **C. Registered and Used in Bad Faith**

There are several ways that a complainant can demonstrate that a domain name was registered and used in bad faith. For example, paragraph 4(b)(iv) of the Policy states that bad faith can be shown where "by using the domain name [respondent has] intentionally attempted to attract, for commercial gain, Internet users to [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 [respondent's] website or location or of a product or service on [the] web site or location".

According to section 3.1.1. of the [WIPO Overview 3.0](#) the circumstances which may 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 include, alone or together: (i) the respondent's likely knowledge of the complainant's rights, (ii) the distinctiveness of the complainant's mark, (iii) a pattern of abusive registrations by the respondent, (iv) website content targeting the complainant's trademark, e.g., through links to the complainant's competitors, (v) threats to point or actually pointing the domain name to trademark-abusive content, (vi) threats to "sell to the highest bidder" or otherwise transfer the domain name to a third party, (vii) failure of a respondent to present a credible evidence-backed rationale for registering the domain name, (viii) a respondent's request for goods or services in exchange for the domain name, (ix) a respondent's attempt to force the complainant into an unwanted business arrangement, (x) a respondent's past conduct or business dealings, or (xi) a respondent's registration of additional domain names corresponding to the complainant's mark subsequent to being put on notice of its potentially abusive activity.

Under section 3.1.4. of the [WIPO Overview 3.0](#) 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.

The Complainant's NOVARTIS trademark is well known as it has been recognized by previous decisions under the Policy (see case, *Novartis AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org*, / *Sergei Lir*, WIPO Case No. [D2016-1688](#)).

Based on the evidence submitted by the Complainant, the Panel shares the view of previous UDRP panels and also finds that the Complainant's NOVARTIS trademark is inherently distinctive and the Complainant has provided evidences of its repute.

The Panel has also established in this case that the disputed domain name includes the obvious misspelling of the Complainant's NOVARTIS trademark, and which trademark has been registered well before the disputed domain name.

It is therefore inconceivable that the Respondent was unaware of the existence of the Complainant and its NOVARTIS trademark when it registered the disputed domain name.

Given the reputation of the NOVARTIS trademark and the unlikelihood of the Respondent selecting the disputed domain name for registration by chance, the Panel infers that the registration of the disputed

domain name intended to draw income from the improper use of the connection to the Complainant was registration in bad faith. (see *LEGO Juris A/S v. Floyd Goddard/ Oneandone, Private Registration*, WIPO Case No. [D2010-0544](#), the panel stated: “The Panel, in accordance with previous decisions issued under the UDRP, is of the opinion that actual knowledge of the Complainant’s trademarks and activities at the time of the registration of the disputed domain may be considered an inference of bad faith.”)

Additionally, the act of registering a domain name that is a common misspelling of a mark in which a party has rights has often been recognized as evidence of bad faith registration *per se*. WIPO Overview, section 3.2.1 (“Particular circumstances UDRP panels take into account in assessing whether the respondent’s registration of a domain name is in bad faith include: (i) the nature of the domain name (e.g., a typo of a widely known mark ...”). See also *Paragon Gifts, Inc. v. Domain.Contact*, WIPO Case No. [D2004-0107](#) (citing *National Association of Professional Baseball Leagues, d/b/a Minor League Baseball v. John Zuccarini*, WIPO Case No. [D2002-1011](#)); and *ESPN, Inc. v. XC2*, WIPO Case No. [D2005-0444](#) (finding that the practice of “typosquatting”, of itself, is evidence of the bad faith registration of a domain name).

The Panel concurs with this approach. It is evident that Respondent registered and used the typosquatted disputed domain name to intentionally attract, for commercial gain, Internet users to the pay-per-click website linked to disputed domain name in a manner that confuses and misleads Internet users. Thus, the Panel infers Respondent’s bad faith based on the fact that the Respondent is trying to gain profit of typographical errors made by Internet users.

At the time of filing the amended complaint, the disputed domain name did not resolve to any active page and therefore it is passively held. Previous UDRP panels have found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding (see the [WIPO Overview 3.0](#), section 3.3).

Further, both the registration and use of the disputed domain name in bad faith can be found pursuant to Policy paragraph 4(b)(iv) in view of the following factors:

- (i) the absence of any response to the Complaint, failing thereby to invoke any circumstance which could demonstrate good faith in the registration or use of the disputed domain names;
- (ii) the absence of any response to the notice sent by the Complainant prior to filing the UDRP complaint;
- (iii) the lack of legitimate interests or rights in the disputed domain name;
- (iv) the implausibility of any good faith use to which the disputed domain name may be put.

For the sake of completeness, the Panel should add that the fact that links on the website to which the disputed domain name used to resolve might be automatically generated does not prevent a finding of bad faith under the Policy. As it is stated in [WIPO Overview 3.0](#), section 3.5, “Particularly with respect to “automatically” generated pay-per-click links, panels have held that a respondent cannot disclaim responsibility for content appearing on the website associated with its domain name (nor would such links ipso facto vest the respondent with rights or legitimate interests). Neither the fact that such links are generated by a third party such as a registrar or auction platform (or their affiliate), nor the fact that the respondent itself may not have directly profited, would by itself prevent a finding of bad faith.”, see also *SAP SE v. Domains by Proxy, LLC / Kamal Karmakar*, WIPO Case No. [D2016-2497](#)).

Thus, this Panel draws the inference from the conduct of the Respondent as to bad faith registration in this case.

Therefore, the Panel concludes that the disputed domain name was registered and is being used in bad faith. The Complainant has therefore made out the requirements of paragraph 4(a)(iii) of the Policy.

## 7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name, <novartls.co> be transferred to the Complainant.

*/Kateryna Oliinyk/*

**Kateryna Oliinyk**

Sole Panelist

Date: October 5, 2022