

EXPERT DECISION

Novartis AG v. Larry Leroy Wolfe
Case No. DCH2022-0002

1. The Parties

The Claimant is Novartis AG, of Switzerland, represented by BrandIT GmbH, Switzerland.

The Respondent is Larry Leroy Wolfe, of United States of America (“United States”).¹

2. The Domain Name

The dispute concerns the following domain name <premiumnovartis.ch>.

3. Procedural History

The Request was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 22, 2022. On February 23, 2022, the Center transmitted by email to SWITCH, the “.ch” and “.li” registry, a request for verification in connection with the disputed domain name. On February 24, 2022, SWITCH transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name. The Center sent an email communication to the Claimant on February 24, 2022 providing the registrant and contact information disclosed by the Registry, and inviting the Claimant to submit an amendment to the Request. The Claimant filed an amended Request on March 1, 2022.

The Center verified that the Request together with the amendment to the Request satisfied the formal requirements of the Rules of procedure for dispute resolution procedures for “.ch” and “.li” domain names

¹ The Expert notes the Claimant’s contention that this case is identical to *Novartis AG v. L. L. W.*, WIPO Case No. [DCH2021-0021](#), where the expert found in favor of the Claimant ordering the transfer of the corresponding domain name <novartis-premium.ch> noting that “The Disputed Domain Name resolved to an active website with the general look and feel copied from the Claimant’s official website, and using the NOVARTIS logo in a prominent position. It is therefore very likely that Internet users will be misled to believe that this is an authorized/associated website of NOVARTIS and even may provide sensitive information in such belief when contacting the website owner”. The Expert also notes the similarities between the domain name <novartis-premium.ch> in *Novartis AG v. L. L. W.*, WIPO Case No. [DCH2021-0021](#), and the disputed domain name. In addition, the Expert finds that the initials for Larry Leroy Wolfe would be “L. L. W.”. For the foregoing reasons, the Expert finds that the Respondent’s name should be published, being essential in order to understand some of the discussions in this decision.

(the “Rules of Procedure”), adopted by SWITCH, on January 1, 2020.

In accordance with the Rules of Procedure, paragraph 14, the Center formally notified the Respondent of the Request, and the Dispute resolution procedure commenced on March 2, 2022. In accordance with the Rules of Procedure, paragraph 15(a), the due date for Response was March 22, 2022.

The Respondent has neither filed a Response nor expressed his readiness to participate in a Conciliation in accordance with paragraph 15(d) of the Rules of Procedure.

On March 23, 2022, the Center notified the Claimant accordingly, who on April 4, 2022 made an application for the continuation of the Dispute resolution proceedings in accordance with specified in paragraph 19 of the Rules of procedure and paid the required fees.

On April 12, 2022, the Center appointed Theda König Horowicz as Expert in this case. The Expert finds that it was properly appointed. In accordance with Rules of Procedure, paragraph 4, the above Expert has declared his independence of the parties.

4. Factual Background

The Claimant with headquarters in Switzerland is part of the Novartis Group which is one of the biggest global pharmaceuticals and healthcare groups in the world. The Claimant was founded in 1996 through a merger of Ciba-Geigy and Sandoz. It is the holding company of the Novartis Group.

The Claimant’s products are manufactured and sold in many regions worldwide. It notably has a strong presence in the United States.

The Claimant is the owner of the well-known NOVARTIS trademark which is registered worldwide both as a word and device mark in several classes. The Claimant’s trademark registrations notably include the Swiss trademark NOVARTIS No 2P-427370 of February 15, 1996.

The Claimant is also the owner of numerous domain names composed of its trademark NOVARTIS alone (for example <novartis.ch>, <novartis.us> or <novartis.com>) or in combination with other terms such as <novartispharma.com>. These domain names are used for Claimant’s official Internet presence. The Claimant also promotes its activity and products through social media.

The Respondent registered the disputed domain name on February 18, 2022. The disputed domain name was linked to a website reproducing the NOVARTIS trademark and logo. The website clearly gave the impression to be an official online presence of the Claimant by also using statements such as “Nous fêtons les 25 ans de Novartis !”.

5. Parties’ Contentions

A. The Claimant

The Claimant alleges to be the owner of Swiss trademark registrations for NOVARTIS. The Claimant states that the disputed domain name is confusingly similar to these trademark registrations, to its business name and to numerous domain names it owns.

The Claimant further states that the disputed domain name infringes Article 13 paragraph 1 of the Swiss Trademark Protection Act (TmPA) and Article 15 TmPA which provides protection for famous marks. In this frame, the Claimant indicates that the disputed domain name incorporates the trademark NOVARTIS in its entirety in combination with the descriptive term “premium”. It is thus confusingly similar to Claimant’s trademark. In addition, the Claimant underlines that the disputed domain name resolved at an active website

which displayed content that impersonated the Claimant's official website for Switzerland. The website copied the look and feel of Claimant's official website and also prominently used the NOVARTIS trademark, name and logo. Internet users will therefore be misled in believing that it is an authorized/associated website.

The Claimant further draws the panel's attention over the fact that the Respondent was already involved in a very similar case relating to the domain name <novartis-premium.ch>. In this case, the decision considered that the said domain name was clearly infringing the Claimant's rights over its trademarks and corporate name.

B. The Respondent

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

6. Discussion and Findings

According to the Rules of Procedure, paragraph 24(c), the Expert shall grant the request if the allocation or use of the domain name constitutes a clear infringement of a right in a distinctive sign which the Claimant owns under the law of Switzerland in disputes over a domain name under the country-code Top-Level Domain ("ccTLD") ".ch".

The Rules of Procedure, paragraph 24(d) specify that a clear infringement of an intellectual property right exists when;

- i. both the existence and the infringement of the claimed Right in a distinctive sign clearly result from the wording of the law or from an acknowledged interpretation of the law and from the presented facts and are proven by the evidence submitted;
- ii. the Respondent has not conclusively pleaded and proven any relevant grounds for defense; and
- iii. the infringement of the right justifies the transfer or revocation of the domain name, depending on the remedy requested in the request.

A. The Claimant has a right in a distinctive sign under the law of Switzerland

The Claimant has evidenced to be the owner in Switzerland of the trademark NOVARTIS which has been registered in Switzerland in 1996. NOVARTIS is also the registered company name of the Claimant in Switzerland.

The first condition under paragraph 24(d) of the Rules of Procedure is thus fulfilled.

B. The allocation or use of the domain name constitutes a clear infringement of a Right in a distinctive sign which the Claimant owns under the law of Switzerland

According to Article 3 combined with Article 13 paragraph 1 of the Swiss Trademark Act, a trademark right gives its owner the exclusive right to use a trademark in relation to the goods and services for which it has been registered.

Consistent Swiss case law further provided that very distinctive trademarks enjoy a higher level of protection than more ordinary trademarks and the risk of confusion must be admitted easier than for trademarks with an ordinary distinctiveness (ATF 122 III 382).

Article 15 of TmPA specifically refers to the protection of famous trademarks and indicates that the proprietor of a famous trademark may prohibit others from using his trademark for any type of goods or services if such use threatens the distinctiveness of the trademark or exploits or damages its reputation.

It is undisputed that NOVARTIS is a famous trademark in the sense of Article 15 TmPA.

The disputed domain name incorporates the famous trademark NOVARTIS in its entirety in combination with a descriptive term “premium”, which leads to an overall confusion with the Claimant’s trademark.

Furthermore, the disputed domain name resolved to an active website with the general look and feel copied from the Claimant’s official website, and using the NOVARTIS logo in a prominent position. It is therefore very likely that Internet users will be misled to believe that this is an authorized/associated website of NOVARTIS and even may provide sensitive information in such belief when contacting the website owner.

Such use clearly constitutes a trademark infringement under Swiss law.

The Expert also notes that the Respondent was already cited in another case for a very similar domain name <novartis-premium.ch> which was also linked to a scam website using the Claimants’ famous trademark and logo (*Novartis AG v. L. L. W.*, WIPO Case No. [DCH2021-0021](#)).

Such behaviour is also likely to constitute an infringement of the Swiss Unfair Competition Act.

In the light of all these elements, the Expert finds that the second condition of paragraph 24(d) of the Rules is fulfilled as well.

7. Expert Decision

For the above reasons, in accordance with paragraph 24 of the Rules of Procedure, the Expert orders that the disputed domain name <premiumnovartis.ch> be transferred to the Claimant.

Theda König Horowicz

Expert

Dated: May 4, 2022