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NATIONAL INTERNET EXCHANGE OF INDIA

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Novartis AG, 4002 Basel vs. Jack M, Godsmak, Vashi, Navi Mumbai
INDRP Case no. 1495
Arbitrator: Mr. P.K.Agrawal

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AWARD

1. The Parties

The Complainant is M/s Novartis AG, 4002 Basel, Switzerland.

The Respondent is Mr. Jack M, Godsmak, Vashi, Navi Mumbai Sector- 17, Mumbai, Maharashtra - 400705 (India).

2. The Domain Name and Registrar

The disputed domain name is <NOVARTIS-PHARMA.CO.IN>. The said domain name is registered with the Registrar – GoDaddy.com, LLC (IANA ID: 146).

The details of registration of the disputed domain name (as per Annexure attached to the Complaint) are as follows:

- a. Domain ROID: D2A64B171147E430EA4CC423984605DBF-IN
- b. Date of creation: April 22, 2021
- c. Expiry date: April 22, 2023

3. Procedural History

(a) A Complaint dated 17th January, 2022 (amended complaint on 31.1.2022) has been filed with the National Internet Exchange of India (NIXI). The Complainant has made the registrar verification in connection with the domain name at issue. The print outs confirmed that the Respondent is listed as the registrant and provided the contact details for the administrative, billing, and technical contact. The Exchange verified that the Complaint satisfied the formal requirements of the Indian Domain Name Dispute Resolution Policy (INDRP) (the "Policy") and the Rules framed thereunder.

(b) The Exchange appointed the undersigned Mr. P.K.Agrawal, Advocate and former Addl. Director General in the Government of India, as the sole Arbitrator in this matter. The Arbitrator finds that he has been properly appointed. The Arbitrator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Exchange.



- (c) In accordance with the Policy and the Rules, the copies of complaint with annexures were served by the National Internet Exchange of India on 24.1.2022 (amended complaint on 31.1.2022) by email. The Arbitrator served the Notice under Rule 5(C) of INDRP Rules of procedure along-with copies of complaint and annexures to the parties through email on 25.1.2022. The Respondent was given 14 days for reply to the complaint. The Complainant sent the physical copies of complaint & annexures by Blue Dart Courier to the Respondent on 31.1.2022, after he was instructed to do so. In view of this, the Complaint and its annexures may be deemed to have been served to the Respondents as per Arbitration and Conciliation Act, 1996 and INDRP rules. The Respondent has responded without submitting his detailed reply and has requested for closure of the case through his email dated 31.1.2022 saying that domain was created mistakenly and the matter may be closed, this email was followed by another email dt. 3.2.2022 on similar lines. Since the Respondent has accepted his fault and has not presented any grounds in his defence, the present proceedings have to be conducted accordingly as per the Arbitration and Conciliation Act, 1996 and the .IN Domain Name Dispute Resolution Policy and the Rules of Procedures framed there under.

4. Factual Background

The Complainant in this arbitration proceedings is Novartis AG, a Company incorporated under the Laws of Switzerland, having its registered office at 4002 Basel, Switzerland. This is a global healthcare Company which provides solutions to address the evolving needs of patients worldwide. It was created in 1996 through a merger of Ciba-Geigy and Sandoz. Novartis and its predecessor companies trace roots back more than 250 years. The Company's products are available in more than 150 countries. In 2020, the Group achieved net sales of USD 48.7 billion.

In the year 1997, Novartis Healthcare Private Limited was incorporated on 13. 10. 1997 in India. According to the Complainant, the word NOVARTIS is a coined word, having no dictionary meaning and is entitled to the highest degree of protection. The Complainant has been using the corporate name NOVARTIS and also using the same as trade mark/ house mark/ domain name for all its activities and Services internationally as well as in India.

The trade mark NOVARTIS is a registered trade mark

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internationally as well as in India. The earliest international registration of the trade mark NOVARTIS dates back to 15.02.1996 in Switzerland. The said trade mark is registered in over 70 countries. The trade mark NOVARTIS and its formative marks are registered trademarks in India since the year 1996 as follows:

S. No.	Trade Mark	Application No.	Class (es)	Date of Application
1.	NOVARTIS	700020	05	28.02.1996
2.	NOVARTIS	3574875	09,10,41, 42,44, 45	29.11.2016
3.	NOVARTIS	1953515IRDI- 3050272	01,03,05, 09, 10, 16 29, 30, 31, 32,35, 40, 41, 42, 44	28.04.2015
4.	NOVARTIS	702108	09	18.03.1996

The trade mark NOVARTIS is a valid and subsisting trade mark in India and the Complainant is a lawful proprietor thereof.

In view of the above, the Complainant contends that he has the exclusive statutory right to use the trade mark NOVARTIS in India and internationally.

It is evident from the list of domain names provided by the Complainant that the Company name/ trade name/ trade mark/ house mark NOVARTIS is forming part of domain name in a large number of countries in the world for carrying on business activities of the Complainant. The Complainant has extensively used the mark NOVARTIS as part of Company name/ trade name/ trade mark/ house mark/ domain name internationally as well as in India in the field of pharmaceutical industries. As a consequence of the same, considerable reputation and goodwill has built into the Complainant's said mark NOVARTIS forming part of Company name/ trade name/ trade mark/ house mark/ domain name and the Complainant has acquired common law rights in the said trade mark to the exclusion of all others

Respondent's Identity and Activities

The Respondent's activities are not known. The Respondent has responded to the Notice and complaint through his email dated 3.2.2022 which is extracted below-

"Dear Concerned,



I acknowledge the receipt of your mail and the notice.

I request that this matter be settled as soon as possible and closed due to the following reasons

1. The domain was created in error
2. The domain was never used and as matter of fact, we don't even have access to the account in GoDaddy under which these domains were created

I request for a peaceful amendment and closure on the above complaint and hereby do state on the record that the domain has not and will not go live. There has been no usage of this domain.

Kind Regards.

Response to the email on complaint on
3- Feb-2022"

5. Parties Contentions

A. Complainant

The Complainant contends that each of the elements specified in the Policy are applicable to this dispute.

In relation to **element (i)**, the Complainant contends that the disputed domain name <NOVARTIS-PHARMA.CO.IN> is confusingly similar to its trademark NOVARTIS. The Complainant submits that the disputed domain name also gives rise to enormous confusion and deception qua its origin because the disputed domain name is using the Complainant's trade mark NOVARTIS as a whole being phonetically, visually and structurally identical to Complainant's trade mark NOVARTIS. They incorporate the Complainant's NOVARTIS mark, combined with a generic term "pharma", ".co" representing company, and ".in" representing the country India.

The Complainant has several domain names registered which incorporate the trade name NOVARTIS, as mentioned above. The disputed domain name will lead to confusion qua the Complainant's mark as search engines are likely to turn up hits for Respondent's website

based on searches for NOVARTIS. The adoption of the disputed domain name which is identical to the Complainant's trade mark NOVARTIS as well as the Complainant's websites is misappropriation of the Complainant's goodwill and reputation and constitutes acts of misrepresentation to the members of public at large that the Respondent's disputed domain name is associated with the Complainant, amounting to infringement/ passing off/ unfair competition, etc.

Therefore, the Complainant contends that the disputed domain name <NOVARTIS-PHARMA.CO.IN> is confusingly similar to its trademarks.

In relation to **element (ii)**, the Complainant contends that the Respondent does not have any legitimate interest in using the disputed domain name. Based on the Complainant's reputation, there is no believable or realistic reason for registration or use of the Disputed Domain Name other than to take advantage of the Complainant's rights.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the domain name and he is not related in any way with the Complainant. To the best of their knowledge, the Respondent has never legitimately been known as 'NOVARTIS' at any point in time. These facts lead the Complainant to conclude that the only reason why the Respondent registered the Disputed Domain Name was to take advantage of the Complainant's goodwill and valuable reputation and make a financial gain for themselves.

Finally, the complainant has contended that the Respondent deliberately chose to use the Complainant's well-known and distinctive NOVARTIS mark within the disputed domain name with the likely intention of benefitting from the Complainant's worldwide renown and to confuse Internet users as to its source or sponsorship. It cannot be considered to be making a bona fide offering of goods or Services. The registration of the Complainant's marks pre-dates the registration of the disputed domain names and the Complainant did not authorize the Respondent to register the disputed domain names. The combination of the well-known NOVARTIS mark with the term "pharma" can only be a deliberate and calculated attempt to benefit improperly from the Complainant's rights and to deceive consumers. The Respondent very likely knew about the Complainant and its mark, which is distinctive and well-known both worldwide and in India.



Based on the above-mentioned arguments, the Complainant argues that the Respondent has no rights or legitimate interests in the disputed domain name.

Regarding the **element (iii)**, the Complainant contends that the bad faith is implicit in the registration of the Disputed Domain Name. The NOVARTIS brand is established worldwide. Thus, given the distinctiveness of the Complainant's trademarks and reputation, it is inconceivable that the Respondent could have registered the disputed domain name <NOVARTIS-PHARMA.CO.IN> without actual knowledge of Complainant's rights in the trademark, which evidences bad faith.

The Complainant submits that the Respondent has registered the Disputed Domain Name in bad faith by intentionally attempting to attract Internet users to their website or other online location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location.

Furthermore, the illegality in the registration of the disputed domain name arises from the fact that domain names today are part and parcel of corporate identity. A domain name acts as the address of the Company on the Internet and can be termed as a web address or a web mark just like a trade mark or Service mark. It is also the internet address of a company. The domain name of the Complainant with "pharma" conveys a corporate identity and exclusive domain name maintained for "pharmaceutical department", which is the primary operational sector of the Complainant and if misused would entail huge legal obligations. The Pharmaceutical department of a Company is regulated by several laws and if breached consequential civil and criminal liabilities can be attributed to the Company.

The Complainant has pointed out that it is settled law, as held in WIPO Case No. D 2017-2232 that where a domain name incorporates a sufficiently well-known trade mark, and the Respondent knew, or ought to have known, of the trade mark's existence, and the Respondent has no legitimate rights or interests in it, the domain name is considered to have been registered in bad faith. In the present case, the Respondent is well aware of the immense goodwill and reputation of the Complainant's



well-known trade mark "NOVARTIS", one of the biggest pharmaceutical companies in the world.

On these facts, the Complainant contends that the Respondent has registered the disputed domain name and is using it in bad faith.

B. Respondent

The Respondent did not submit any evidence or argument indicating his relation with the disputed domain name <NOVARTIS-PHARMA.CO.IN> or any trademark right, domain name right or contractual right. He has accepted his faults straight-forward and requested for closure of case as per his email dt.3.2.2022.

6. Discussion and Findings

The Rules instruct this arbitrator as to the principles to be used in rendering its decision. It says that, "a panel shall decide a complaint on the basis of the statements and documents submitted by the parties in accordance with the Policy, the Arbitration and Conciliation Act, 1996, the Rules and any rules and principles of law that it deems applicable".

According to the Policy, the Complainant must prove that:

- (i) The Registrant's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;
- (ii) The Registrant's has no rights or legitimate interests in respect of the domain name that is the subject of Complaint; and
- (iii) The Registrant's domain name has been registered or is being used in bad faith.

Although Respondent has not offered any arguments to defend himself on this complaint, the default does not automatically result in a decision in favour of the Complainant. The burden remains with Complainant to establish the three elements of the Policy by a preponderance of the evidence.



A. Identical or Confusingly Similar

The disputed domain name <NOVARTIS-PHARMA.CO.IN> was registered by the Respondent on April 22, 2021.

The Complainant is an owner of the registered trademark "NOVARTIS" for the last many years. The Complainant is also the owner of the several other similar domains as referred to in the Complaint. These domain names and the trademarks have been created by the Complainant much before the date of creation of the disputed domain name by the Respondent. In the present case the disputed domain name is <NOVARTIS-PHARMA.CO.IN>. Thus, the disputed domain name is very much similar to the name, activities and the trademark of the Complainant.

The Hon'ble Supreme Court of India has held that the domain name has become a business identifier. A domain name helps identify the subject of trade or service that an entity seeks to provide to its potential customers. Further that, there is a strong likelihood that a web browser looking for "NOVARTIS" products would mistake the disputed domain name as of the Complainant.

In the case of *Wal Mart Stores, Inc. v. Richard MacLeod*, (WIPO Case No. D2000-0662) it has been held that "When the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name" it is identical or confusingly similar for purposes of the Policy.

Therefore, I hold that the domain name <NOVARTIS-PHARMA.CO.IN> is phonetically, visually and conceptually identical or confusingly similar to the trademark of the Complainant.

B. Rights or Legitimate Interests

The Respondent may demonstrate its rights to or legitimate interest in the domain name by proving any of the following circumstances:

- (i) before any notice to the Registrant of the dispute, the Registrant's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the Registrant (as an individual, business or other organization) has been commonly known by the domain name, even if the

Registrant has acquired no trademark or service mark rights; or

- (iii) The Registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

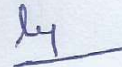
In Case No. INDRP/776, *Amundi v. GaoGou*, the arbitration panel found that the Complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests. Once such *prima facie* case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4 (II) of the INDRP Policy.

The Respondent has accepted his default in this case. There is also no evidence to suggest that the Respondent has become known by the disputed domain name anywhere in the world. The name of the Registrant / Respondent is Jack M as given in Whois details. Based on the evidence adduced by the Complainant, it is concluded that the above circumstances do not exist in this case and that the Respondent has no rights or legitimate interests in the disputed domain name.

Further, the Complainant has not consented, licensed or otherwise permitted the Respondent to use its name or trademark "NOVARTIS" or to apply for or use the domain name incorporating said trademark. The domain name bears no relationship with the Registrant. Further that, the Registrant has nothing to do remotely with the business of the Complainant.

As has been contended by the Complainant, the Respondent is not making a legitimate, fair or bona fide use of the said domain name for offering goods and services. The Respondent registered the domain name for the sole purpose of creating confusion and misleading the general public.

I, therefore, find that the Respondent has no rights or legitimate interests in the domain name <NOVARTIS-PHARMA.CO.IN> under INDRP Policy, Paragraph 4(ii).



C. Registered and Used in Bad Faith

Any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration or use of the domain name in bad faith:

- (i) circumstances indicating that the Registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who bears the name or is the owner of the trademark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Registrant's documented out of pocket costs directly related to the domain name; or
- (ii) the Registrant has registered the 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 Registrant has engaged in a pattern of such conduct; or
- (iv) by using the domain name, the Registrant has intentionally attempted to attract the internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.

The contention of the Complainant is that the present case is covered by the circumstances mentioned herein above. There are circumstances indicating that the Respondent has intentionally attempted to attract, for commercial gain, internet users to its web site, by creating a likelihood of confusion with the Complainant's mark. It may also lead to deceiving and confusing the trade and the public.

In WIPO Case No. D2007-1695, Mayflower Transit LLC v. Domains by Proxy Inc./Yariv Moshe - "Respondent's use of a domain name confusingly similar to Complainant's trademark for the purpose of offering sponsored links does not of itself qualify as a bona fide use."

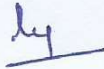
The circumstances as evident from the foregoing paragraphs lead to the conclusion that the domain name in dispute was registered and used

by the Respondent in bad faith.

7. Decision

In light of the foregoing findings, namely, that the domain name is confusingly similar to the trademark in which the Complainant has rights, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the domain name was registered in bad faith and is being used in bad faith, it is clear beyond doubt that the Respondent has violated the provisions of Rule-3 of the Policy. Therefore, in accordance with the Policy and the Rules, the Arbitrator orders that the domain name <NOVARTIS-PHARMA.CO.IN> be transferred to the Complainant.

No order to the costs.



Prabodha K. Agrawal

Sole Arbitrator

Dated: 7th February, 2022