

DISPUTE RESOLUTION SERVICE

D00018787

Decision of Independent Expert

Novartis AG

and

Zhao Ke

1. The Parties:

Complainant: Novartis AG
Lichtstr. 35
Basel
4056
Switzerland

Respondent: Zhao Ke
Weihai Rd. 655
Shanghai
200041
China

2. The Domain Name:

<myfortic.co.uk> (“the Domain Name”)

3. Procedural History:

18 April 2017 16:17 Dispute received
20 April 2017 08:46 Complaint validated
20 April 2017 08:49 Notification of complaint sent to parties
10 May 2017 02:30 Response reminder sent
15 May 2017 11:10 No Response Received
15 May 2017 11:10 Notification of no response sent to parties
26 May 2017 02:30 Summary/full fee reminder sent
31 May 2017 09:44 Expert decision payment received

I can confirm that I, the undersigned Expert, am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of a such a nature as to call into question my independence in the eyes of either of the parties.

4. Factual Background

The Complainant is well-known worldwide as a leading pharmaceutical company. The unchallenged evidence of the Complainant is that it was created in 1996¹ through a merger of two other well-known players in the chemical and pharmaceutical fields, namely Ciba-Geigy and Sandoz. In 2016 the Complainant had net sales of 48.5 billion US dollars.

One of the Complainant's products is an enteric-coated immunosuppressant used in combination with other drugs to treat acute rejection of kidney transplants. It is sold under the brand name Myfortic.

MYFORTIC is a registered trade mark of the Complainant. The Complainant produces evidence of one such registration, namely European Union trade mark registration no. 002553931 in class 5 for pharmaceutical preparations. The application was filed on 29 January, 2002 and the trade mark was registered on 21 February, 2003.

The Complainant is the registered proprietor of the domain name, <myfortic.com>, which it registered on 17 August, 2000 and uses that domain name for its operating website in relation to its Myfortic product.

The Domain Name was registered on 7 February, 2017 and is connected to a parking page featuring pay-per-click links to various other websites. The other websites are mainly (if not exclusively) medicines-related websites and appear for the most part to

¹ The Complaint states that the merger took place in 1966, but the Expert prefers to rely upon the date given in the exhibited promotional material of the Complainant, Annex 3 (Novartis Company History).

have little if any association with the Complainant.

On 24 February, 2017 the Complainant's representatives sent a letter to the Respondent drawing to the Respondent's attention the Complainant's trade mark rights, objecting to the use being made of the Domain Name by the Respondent and seeking transfer of the Domain Name to the Complainant.

On the same day the Respondent responded in the following terms : "I registered this domain for my website means My Fortic, anyway if your client is interesting of it, I can transfer it to your client at the cost 3500 US\$. Please let me know if we can start the transfer now. Thanks!"

5. Parties' Contentions

The Respondent has not responded to the Complaint.

6. Discussions and Findings

General

Pursuant to paragraph 2.1 of the Policy, for the Complainant to succeed in this Complaint it must prove to the Expert on the balance of probabilities that:

- I. it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- II. the Domain Name, in the hands of the Respondent, is an Abusive Registration.

Paragraph 2.2 of the Policy provides that the Complainant is required to prove that both the above elements are present on the balance of probabilities.

"Abusive Registration" is defined in paragraph 1 of the Policy as a domain name which either:

- i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or
- ii. is being used or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

Rights

The Complainant has demonstrated that it has registered trade mark rights in respect

of its Myfortic brand. Myfortic is identical to the Domain Name save for the “.co.uk” country code Top Level Domain (“ccTLD”) identifier. Generally, as in this case, the ccTLD identifier serves no purpose other than a purely technical one and is excluded from consideration for the purposes of the assessment of identity or similarity under paragraph 2.1 of the Policy.

The Expert finds that the Complainant has rights in respect of a name or mark which is identical to the Domain Name.

Abusive Registration

Myfortic is an unusual made-up name. It is not a descriptive or dictionary word. The Complainant, a very well-known pharmaceutical company, uses the name for one of its pharmaceutical products. The Respondent uses the same name in the Domain Name and uses the Domain Name to connect to a pay-per-click parking page featuring mainly if not exclusively commercial links to other websites offering for sale medicines or other medical treatments.

It is inconceivable to the Expert that the Respondent could have selected the Domain Name and be using it for the purpose for which he is using it without being well aware of the existence of the Complainant and the Complainant’s Myfortic product.

If it were a coincidence and/or if the Respondent had any justification for having adopted the name, he had ample opportunity to provide an explanation in response to the Complainant’s representative’s letter dated 24 February, 2017. Instead, the Respondent provided the lamest of explanations (: “I registered this domain for my website means My Fortic ...”) and then in the same sentence went on to offer the Domain Name for sale to the Complainant for US\$ 3,500.

The Complainant contends that the Respondent registered the Domain Name with the intention of exploiting it commercially on the back of the Complainant’s MYFORTIC trade mark. The Expert agrees. The Expert believes it probable that the Respondent registered the Domain Name for the purpose of attracting Internet users to his pay-per-click website, confident that the Domain Name would attract in visitors looking for the Complainant’s website and then taking in such revenue to be derived from those users’ clicks. He is likely also to have anticipated that his site would be discovered by the Complainant and was ready to demand a substantial sum for transfer of the Domain Name on being approached by the Complainant.

The Complainant has produced evidence to show that the Respondent is not new to this process. The Complainant has produced evidence² to show that the Respondent has behaved in near identical fashion in relation to certain other well-known brand names in registering and the domain names <asurion.co.uk>,

² Two WIPO decisions under the Uniform Domain Name Dispute Resolution Policy and one Nominet DRS decision against the Respondent.

<sncfinternational.com>, <sncfinternational.com> and <lagarderepublicitte.com>. As with this complaint, the Respondent did not provide a response to any of those complaints.

Paragraph 24.8 of the Policy provides: “If, in the absence of exceptional circumstances, a Party does not comply with any provision in this Policy the Expert will draw such inferences from the Party’s non-compliance as he or she considers appropriate.” In the circumstances of this case the Expert infers from the lack of a Response that the Respondent has no answer to the Complainant’s allegations.

Paragraph 5 of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration for the purposes of the Policy. Those which appear to be applicable on the facts of this case as set out above are the following:

- (a) 5.1.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;
- (b) 5.1.2 Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;
- (c) 5.1.6 The Domain Name is an exact match (within the limitations of the character set permissible in domain names) for the name or mark in which the Complainant has Rights, the Complainant’s mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name.

The evidence suggests that the Respondent is an experienced dealer in domain names. The Expert believes it likely that the Respondent registered the Domain Name for the purpose for which he is using it, namely to connect to a pay-per-click parking page featuring commercial links to medicines-related websites. The Expert is satisfied on the evidence that the Respondent is seeking to attract commercial visitors to the website, who, because the Domain Name features the Complainant’s MYFORTIC trade mark without adornment, are likely to believe that they are visiting an official website of or authorized by the Complainant. The website has nothing to do with the Complainant and the pay-per-click links lead to a number of businesses active in the pharmaceutical field having no obvious connection with the Complainant. Thus the Respondent is using the Domain Name in a way which is likely to confuse people or businesses that the Domain Name is registered to, operated or authorized by, or otherwise connected with the Complainant.

The manner of the Respondent's response to the Complainant's warning letter strongly suggests to the Expert that the Respondent anticipated receiving an approach from the Complainant and registered the Domain Name with a view to selling it to the Complainant at a profit in the event that such an approach was made.

The Expert has already found that the Domain Name (absent the ccTLD identifier) is identical to the Complainant's trade mark. The Expert is satisfied also that the Complainant's trade mark has a reputation and it is a fact that the Respondent has provided no reasonable justification for having registered the Domain Name.

Paragraph 8 of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration. The Expert has reviewed the list, but none of them is applicable. The Respondent is not known by the Domain Name or any name remotely close to it. An online business attracting in customers by deceit by unauthorized use of the trade mark of another cannot on any view be regarded as a genuine offering of goods and services, nor can it be regarded as legitimate or fair.

For all the above reasons and in the absence of any justification from the Respondent for having adopted the Domain Name, the Expert finds that the Domain Name is an Abusive Registration as defined in paragraph 1 of the Policy and within the meaning of paragraphs 5.1.1.1, 5.1.2 and 5.1.6 of the Policy.

7. Decision

The Expert directs that the Domain Name be transferred to the Complainant.

Signed Tony Willoughby

Dated

