Decision for dispute CAC-UDRP-101008

Case number	**CAC-UDRP-101008**
Time of filing	**2015-06-17 15:25:03**
Domain names	**boehringeringelheim.science**

Case administrator

Name	**Lada Válková (Case admin)**

Complainant

Organization	**BOEHRINGER Ingelheim Pharma GmbH & Co. KG**

Complainant representative

Organization	**Nameshield (Laurent Becker)**

Respondent

Organization	**Recycle Node - Ky Jensen-Stewart**

OTHER LEGAL PROCEEDINGS

No other proceedings have been notified to the Panel.

IDENTIFICATION OF RIGHTS

Numerous trademarks under several Nice Classification categories are registered in favour of the Complainant in a range of jurisdictions. These marks include the name Boehringer Ingelheim in Classes 01, 02, 03, 04, 05, 06, 10, 16, 17, 19, 29, 30, 31, 35, 41, 42 and 44. The Complainant has furthermore offered proof of longstanding reputation associated with its brand and of being the holder of several domain name registrations of BOEHRINGER INGELHEIM in different forms under .com and other generic TLDs corresponding to its brand.

The rights identified relate in part to pharmaceutical products which have been marketed on the basis of the notoriety the Boehringer Ingelheim brand has won in the human and veterinary services pharmaceuticals sectors worldwide. But they also relate to numerous areas such as medical equipment and services, food supplements, publications and the production of teaching material. Nice Class 42 specifically covers scientific and technological services and research.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

Prior UDRP panels have confirmed the identical character between the trademark BOEHRINGER INGELHEIM and domain

names, such as:
CAC N° 100923 Boehringer Ingelheim Pharma GmbH & Co. KG vs. Republica LLC
D2013-0116 Boehringer Ingelheim Pharma GmbH & Co. KG vs. Whois Privacy Services Pty Ltd / Dzone Inc., Yeonju Hong
D2012-0890 Boehringer Ingelheim Pharma GmbH & Co. KG vs. Name Redacted
D2012-0462 Boehringer Ingelheim Pharma GmbH & Co. KG vs. Ren Hua
D2006-1594 Boehringer Ingelheim Pharma GmbH & Co. KG vs. Philana Dhimkana

Prior UDRP panels have also held that the incorporation of a notorious mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use, such as:
WIPO D2000-0003 Telstra Corporation Limited v. Nuclear Marshmallows
WIPO D2000-0400 CBS Broadcasting, Inc. v. Dennis Toeppen

PARTIES CONTENTIONS

The Complainant relies on the above-mentioned trademarks certification evidence it has produced along with the notice effected under the ICANN Trademark Clearinghouse procedure and evidence of being the domain name holder for "BOEHRINGERINGELHEIM" under several other generic Top Level Domains. It also produced evidence of a cease-and-desist letter it sent three months after the Respondent's registration of the disputed domain name in regard of which the Complainant stated that it had received no response.

It relies too upon no administratively compliant Response having been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the 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 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 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

1. The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to issue a decision.

2. The Panel remarks that it is incumbent on a Complainant to refer, in a UDRP proceeding with respect to a relatively new TLD, to the contractual nexus that must always exist for an alternative dispute resolution provider to be seized with a particular case. In the present case, this nexus can be presumed by the Panel on the basis of the publicly available terms and conditions of the .SCIENCE registry. Being a presumption, it may hence be subject to review before a competent court.

PRINCIPAL REASONS FOR THE DECISION

The Complainant is a well-known pharmaceuticals group with activities in several other fields. These include medical equipment and services and scientific and technological publications and services. In terms of scientific papers, the Complainant's staff have published widely on subjects ranging from cardiovascular research to virology. There can thus be no doubt that acquisition of a .SCIENCE domain name containing the brand name might come into question for such a

company and that its rights could, correspondingly, be infringed by its unauthorized registration and use by another.

The Complainant's brand is, indeed, protected extensively in different countries under trademarks across numerous classes of goods and services. It has taken out several domain names under other generic Top Level Domains. And it has availed itself of the Trademark Clearinghouse facility established by ICANN in order to allow easy discovery of protected names by potential registrants.

The Complainant has hence established both a legitimate interest and rights in the disputed domain name.

For its part, the Respondent has failed to respond to the Complaint, has no apparent legitimate interest in a trademark-protected name that is unmistakeably the same as that of the Complainant and has earlier failed to respond to a cease-and-desist letter sent by the Complainant's representative. The Respondent further appears to have no connection to the scientific world. But this becomes in any case of marginal relevance where the disputed .SCIENCE name incorporates in its entirety and without authorization that of a brand distinguished by a unique combination of a natural person name and a town name.

The facts of this case furthermore disclose nothing new to set apart the association of a protected name with the generic Top Level Domain .SCIENCE from that with other generic Top Level Domains. The Panel thus takes due note of the decisions of other UDRP Panels which have found in favour of the Complainant under comparable circumstances.

In the absence of any response from the Respondent, the Panel finds, as the Complainant contends, that it is improbable that the Respondent's registration of the disputed domain name could have occurred without knowledge of the existence of the Complainant's well-known brand. This is, however, not a proven fact; it is an inference. The Complainant further argues that such registration coupled with an inactive website may be evidence of bad faith registration and use. It cites the WIPO Telstra Corporation Limited v. Nuclear Marshmallows and CBS Broadcasting Inc. v. Dennis Toeppen cases in support of this proposition. The Complainant omits, however, to mention that the Telstra case, which was relied on in the CBS case, makes it clear that an inactive site should be considered as a potential factor indicating bad faith only by reference to the specific circumstances of each case and not in the abstract.

For the present case, the most pertinent part of the reasoning in the Telstra case is that it was "not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law". The present Panel endorses this reasoning in inferring bad faith on the part of the Respondent since it is very hard to conceive of the disputed domain name being used by it in a way that would not be illegitimate on one of the grounds just cited. To the contrary, this inference is supported by the very fact that no response was submitted by the Respondent either to the cease-and-desist letter or to the Complaint.

The Panel is thus entitled to conclude that, had there been a legitimate purpose to the Respondent's registration and use of the disputed domain name, the burden passed in these circumstances to the Respondent to provide some indication of it, which it plainly failed to do. In reaching this conclusion the Panel, however, stresses that its drawing an inference based on specific facts is not intended to be the same as applying an abstract principle and should not be confused with one.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **BOEHRINGERINGELHEIM.SCIENCE**: Transferred

PANELLISTS

Name	**Kevin J. Madders**

2015-07-26

DATE OF PANEL DECISION 2015-07-26

Publish the Decision