Decision for dispute CAC-UDRP-101195

Case number	**CAC-UDRP-101195**
Time of filing	**2016-03-22 09:54:06**
Domain names	**zantac.top**

Case administrator

Name	**Lada Válková (Case admin)**

Complainant

Organization	**Boehringer Ingelheim Pharmaceuticals Inc.**

Complainant representative

Organization	**Nameshield (Laurent Becker)**

Respondent

Name	**N/A Bryan**

IDENTIFICATION OF RIGHTS

The Complainant is the owner of trademark rights on the ZANTAC signs, including the following trademarks:
- US trademark ZANTAC No. 1220525, registered since December 21, 1982, duly renewed and covering goods in class 5,
- US semi-figurative trademark ZANTAC No. 1685021, registered since May 5, 1992, duly renewed and covering goods in class 5,
- US trademark ZANTAC No. 1965943, registered since April 2, 1996, duly renewed and covering goods in class 5,
- US trademark ZANTAC No. 1967301, registered since April 9, 1996, duly renewed and covering goods in class 5.

FACTUAL BACKGROUND

The Complainant, Boehringer Ingelheim Pharmaceuticals Inc., is a global family-owned research-driven pharmaceutical group founded in 1885.

The Complainant owns several trademark registrations consisting of the ZANTAC sign. The Complainant especially owns the ZANTAC trademark No. 1220525, registered in the United-States since December 21, 1982, and covering goods in class 5 (namely “pharmaceutical preparations for human use being gastric fluid inhibitors”).

The Complainant’s trademark registrations precede for years the registration of the dispute domain name, which was registered on February 3, 2016.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

A. Complainant

Firstly, the Complainant contends that the domain name is identical to its prior rights in the ZANTAC sign.

Secondly, regarding the criterion of rights or legitimate interests in respect of the disputed domain name, the Complainant argues that the Respondent is not related to the Complainant and that both parties have no business relationship together. The Complainant adds that it has neither granted any licence nor any authorization to the Respondent and that the latter is not known under the ZANTAC sign. In this regard, the Complainant mentions that previous panels have already held that a Respondent was not commonly known by a disputed domain name if the Whois information is not similar to the disputed domain name.

Thirdly, the Complainant affirms that the domain name redirects to an inactive page that demonstrates a lack of use in good faith. The Complainant argues that prior panels have stated that when a famous trademark is incorporated in a domain name, coupled with an inactive website, this may be evidence of bad faith registration and use.

B. Respondent

On April 19, 2016, the Registrant has filed a response to the complaint. This response contains only a list of decisions and annexes including Whois information on domain names registered by the Complainant’s representative.

However, the Panel cannot construe these elements without any explanation from the Respondent on their relevance in the present proceedings.

RIGHTS

The Complainant has established that it has prior rights on the ZANTAC sign, including for instance its US trademark ZANTAC No. 1220525, registered since December 21, 1982, and covering goods in class 5. This trademark was registered more than 30 years before the registration of the disputed domain name.

Besides, the disputed domain name is identical to the Complainant’s ZANTAC trademark. Previous panels have held that “the incorporation of a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to the Complainant’s registered mark” (WIPO Case No. D2001-0505, Brittania Building Society v. Britannia Fraud Prevention).

Finally, the mere addition of the gTLD <.top> in the disputed domain name has no impact, in the present case, in the evaluation of the identity or confusing similarity between the disputed domain name and the Complainant’s earlier rights. Indeed, the use of a gTLD is technically necessary to operate a domain name and does not serve to identify the source of the goods and services provided by its registrant (WIPO case No. D2015-2281, Kaufland Warenhandel GmbH & Co. KH v. Zhao Kun).

Therefore, the Complainant has, to the satisfaction of the Panel, shown the disputed 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 must establish a prima facie case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Once this case is made, the Respondent may establish a right or legitimate interest by demonstrating one of the following options set by paragraph 4(c) of the Policy:
a) that before any notice to the respondent of the dispute, he or she used or made 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;

b) that the respondent is commonly known by the domain name, even if he or she has not acquired any trademark rights; or
c) that the respondent 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.

In the present case, the Complainant has shown a prima facie case. Indeed, the Respondent is not related to the Complainant. He does not benefit neither from a licence nor from an authorization to use the ZANTAC trademark. Furthermore, he is not commonly known under the ZANTAC sign.

Besides, the Respondent's reply in the present proceeding, lacking any development on his views on the complaint submitted to the Center, cannot permit to conclude that he has any right or legitimate interest in the disputed domain name.

Consequently, the Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:
(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
(ii) you have 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 you have engaged in a pattern of such conduct; or
(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your web site or location or of a product or service on your web site or location.

Regarding registration in bad faith, the disputed domain name was registered more than 30 years after the registration of the Complainant's above-mentioned ZANTAC trademark. Although the trademarks submitted by the Complainant are registered in the United States whereas the Respondent is located in the United Kingdom, several factors tend to show that the Respondent had knowledge of the ZANTAC trademark at the time of registration of the disputed domain name, namely:
- The domain name is identical to the Complainant's ZANTAC trademark,
- A previous UDRP panel has recognized that the Complainant is "a leading global research-driven pharmaceutical enterprise and has about 140 affiliated companies worldwide" (WIPO Case No. D2016-0055, Boehringer Ingelheim Pharmaceuticals Inc. v. JimmyX),
- The ZANTAC sign has no meaning in English – which is the language of both the Complainant and the Respondent – and is therefore highly distinctive.

In respect to use in bad faith, the Panel notes that the domain name is not being used. Nonetheless, under certain circumstances, passive holding may constitute use in bad faith. Indeed, as discussed in Telstra Corporation Limited v. Nuclear Marshmallows (WIPO Case No. d2000-003, "the relevant issue is not whether the Respondent is undertaking a positive action in bad faith in relation to the domain name, but instead whether, in all the circumstances of the case, it can be said that the Respondent is acting in bad faith. The distinction between undertaking a positive action in bad faith and acting in bad faith may seem a rather fine distinction, but it is an important one. The significance of the distinction is that the concept of a domain name 'being used in bad faith' is not limited to positive action; inaction is within the concept. That is to say, it is possible, in certain circumstances, for inactivity by the Respondent to amount to the domain name being used in bad faith").

Presently, the Respondent has provided a response to the complaint. However, he does not explain for which reasons or intend he registered the domain name.

Thus, based on the evidence presented to the Panel including the lack of rights or legitimate interests of the Respondent in the disputed domain name, it appears that the disputed domain is also being used in bad faith.

Hence, the Complainant has, to the satisfaction of the Panel, shown the disputed 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

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

PRINCIPAL REASONS FOR THE DECISION

The Panel finds that the disputed domain name <zantac.top> is identical to the Complainant's trademark.

Besides, the Complainant has made a prima facie case that the Respondent lacks rights or legitimate interests in respect to the disputed domain name, especially since the Respondent has not provided any element tending to show the contrary, even if he submitted a response to the Center.

Considering the facts that the Complainant is a global enterprise which has trademark rights on the ZANTAC sign since 1982 whereas the domain name was registered in February 2016, that the Respondent has not indicated his interest in the domain name, and that the domain name is inactive, the Panel concludes that the disputed domain name was registered and is used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ZANTAC.TOP**: Transferred

PANELLISTS

Name	**Nathalie Dreyfus**

DATE OF PANEL DECISION 2016-05-20

Publish the Decision