Decision for dispute CAC-UDRP-101219

Case number	CAC-UDRP-101219
Time of filing	2016-06-06 13:33:48
Domain names	BOEHRINGERPHARMA.XYZ

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	BOEHRINGER INGELHEIM PHARMA GMBH & CO.KG

Complainant representative

Organization	Nameshield (Maxime Benoist)

Respondent

Name	Cameron David Jackson

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings pending or decided between the same parties and relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant owns a portfolio of trademarks including the word “BOEHRINGER” in many countries, including international trademark "BOEHRINGER" number 799761 registered on December 2, 2002 and designating amongst others Australia. This trademark is also registered in the Trademark Clearinghouse since April 17, 2014.

Furthermore, the Complainant is the owner of a numerous portfolio of domain names which incorporating the term “BOEHRINGER”.

FACTUAL BACKGROUND

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

The Complainant is a family-owned pharmaceutical group of companies with roots going back to 1885, when it was founded by Albert Boehringer (1861-1939) in the German city of Ingelheim am Rhein. Ever since, Boehringer has become a global pharmaceutical enterprise and has today about 140 affiliated companies world-wide with roughly 46,000 employees. In 2013 net sales of the Boehringer group amounted to about EUR 14.1 billion.

The Respondent registered the disputed domain name on March 31, 2016.

The Complainant sent a cease and desist letter to the Respondent on May 23, 2016. The same day, the Respondent answered to this letter by proposing the transfer of the disputed domain name first for 300 EUR and subsequently reduced this request to USD 200.

The Complainant rejected both proposals.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

1. The Complainant contends that the disputed domain name is confusingly similar to its prior trademarks.

It consists of the trademark “BOEHRINGER” and the term “PHARMA” without any hyphen. The addition of the new gTLD “.XYZ” is not sufficient to escape the finding that the domain name is confusingly similar to the Complainant’s trademarks and does not change the overall impression of the designation as being connected to the Complainant's trademarks.

2. Furthermore, the Complainant contends that Respondent has not legitimate interests in respect of the disputed domain name and is not related in any way with the Complainant.

The Complainant does not carry out any activity for, nor has any business with the Respondent. Neither licence nor authorization has been granted to the Respondent to make any use, or apply for registration of the disputed domain name by the Complainant. Moreover, the disputed domain name displays a Registrar parking page.

3. Finally, the Complainant contends that the domain name has been registered and being used in bad faith.

The disputed domain name is confusingly similar to the term “BOEHRINGER” registered by the Complainant as trademarks, domain names and in the trademark clearinghouse. In addition, the Complainant ascertains that the Respondent is a ‘‘domainer” known from previous UDRP-cases on other domain names containing third parties' trademarks. To that extent, the Complainant refers to six recent UDRP cases issued in 2016 respectively involving the Respondent. The Complainant further notes that the Respondent proposed to sell the disputed domain name to the Complainant for 300 EUR and subsequently for US$ 200 and therefore for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain name. Furthermore, the disputed domain name displays a Registrar parking page (“passive holding”) since its registration. The Complainant finally notes that given the notoriety of its trademarks, it seems impossible for the Respondent to use the domain names in good faith. Indeed, prior UDRP Panels stated that passive holding, under the appropriate circumstances, falls within the concept of the domain name being used in bad faith, particularly where the domain name in question contains a well-known trademark.

The Complainant therefore requests the transfer of the disputed domain name.

RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS 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

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

1. The Panel finds that the disputed domain name BOEHRINGERPHARMA.XYZ is confusingly similar to the Complainant's International Trademark no. 799761 (registered well before the disputed domain name has been created) since it consists of the trademark BOEHRINGER followed by the generic term "pharma" that is likely to increase the possibility of confusion amongst consumers since it refers to the Complainant's field of business. In accordance with the well-established precedent (see WIPO Overview 2.0 para. 1.2) the TLD suffix in a domain name will be generally disregarded under the confusing similarity test as it is a technical requirement of registration.

2. In lack of any Response from the Respondent, or any other information indicating the contrary, the Panel further holds that the Respondent has no rights or legitimate interests in respect of the disputed domain name. In particular, it results from the Complainant's undisputed allegations that the Respondent is not commonly known by the disputed domain name. Furthermore, in absence of any evidence to the contrary, the Panel can not affirm any use of, or demonstrable preparations to use the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services. All to the contrary, the Respondent is not using the disputed domain name at all but tried to sell it to the Complainant for EUR 300 first and then for US$ 200.

3. Finally, the Panel finds that the disputed domain name has also been registered and is being used in bad faith.

In fact, the Panel holds that the Respondent has registered the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed 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 related to the disputed domain name. In fact the Respondent tried to sell the disputed domain name, which fully includes the Complainant’s trademark "BOEHRINGER", to the Complainant for EUR 300 first and then for US$ 200 which clarly exceeds the out-of-pocket costs for such a domain name. In addition, the Respondent appears to be a ‘‘domainer” well aware of the UDRP and the consequences of bad faith domain name registrations as results from several UDRP-cases involving the Respondent of the present case. Finally, the disputed domain name directs to a registrar parking page (“passive holding”). In the light of these elements the Panel concludes that the disputed domain name has also been registered and is being 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. **BOEHRINGERPHARMA.XYZ**: Transferred

PANELLISTS

Name	**Dr. Tobias Malte Müller**

DATE OF PANEL DECISION 2016-07-14