# Decision for dispute CAC-UDRP-101231

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| Case number | CAC-UDRP-101231 |
| Time of filing | 2016-06-14 10:40:07 |
| Domain names | Dulcolax.top |

## Case administrator

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| Name | Lada Válková (Case admin) |

## Complainant

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| Organization | BOEHRINGER INGELHEIM PHARMA GMBH & CO.KG |

## Complainant representative

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| Organization | Nameshield (Maxime Benoist) |

## Respondent

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| Name | ayma |

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is, inter alia, registered owner of the following trademarks:

- DULCOLAX (word), International Trademark, registration date 10 December 1952, trademark no. 165781, registered for goods in class 1 (food preserving products) and class 5 (medicines, chemical products for medical and sanitary use, pharmaceutical drugs, plasters, surgical dressings, pesticides and herbicides, disinfectants.);

- seniority of which has been also claimed for the identical EU IPO trademark "DULCOLAX", application number 2382059;

(collectively referred to as "Complainant's trademarks").

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 Mr. Albert Boehringer in Ingelheim am Rhein, today Germany.

The Complainant has become a global research-driven pharmaceutical enterprise and with about 140 affiliated companies world-wide and roughly 46,000 employees.

The Complainant is the registered owner of various "DULCOLAX" trademarks, as indicated in more details above.

The disputed domain name <dulcolax.top> was registered on 18 April 2016 and is held by the Respondent.

The domain name website (i.e. website available under internet address containing the disputed domain name) is currently automatically redirected to third party's online shop available at http://safecanadianrx.com/products/stomach/dulcolax/order/ which encourages the visitors to purchase DULCOLAX medicines (likely not as original products of the Complainant but in its generic form as "bisacodyl").

The Complainant seeks transfer of the disputed domain name to Complainant.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

The Parties' contentions are the following:

COMPLAINANT:

PROTECTED RIGHTS RELIED UPON

The Complainant has extensive "DULCOLAX" trademark rights for goods in classes 1 and 5. For purposes of this proceeding, the Complainant relies on rights in various jurisdictions and refers to previous decisions where Panels have found that registration of a mark with a trademark authority, regardless of the location of the parties, is sufficient evidence of having rights in such mark. The Complainant further states that previous panel decisions have generally held that trademark registrations are valid and constitute prima facie evidence of ownership, validity and the exclusive right to their use.

IDENTITY

The Complainant claims that Complainant's trademarks are identical to the disputed domain name (save to the top-level suffix in the disputed domain name), which is clearly evident.

Furthermore, the Complainant argues that the ".TOP" suffix is not sufficient to escape the finding that the domain name is identical to the Complainant's trademarks and does not change the overall impression of the designation as being connected to such trademarks.

NO RIGHTS OR LEGITIMATE INTERESTS

The Respondent has not been commonly known by the disputed domain name. Neither the Complainant has been authorized, permitted or licensed the Respondent to use its trademarks in any manner. The Respondent has no connection or affiliation with the Complainant whatsoever. On this record, Respondent has not been commonly known by the disputed domain name so as to have acquired rights to or legitimate interests in it within the meaning of paragraph 4(c)(ii) of the Policy.

The Complainant refers to previous domain name decisions contending 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 burden shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name.

Domain name website redirects to the website named Canadian Pharmacy on the address (URL) http://safecanadianrx.com/ that offers to internet users Dulcolax pills, as in more detail described above. Such website also offers for sale many other pharmaceutical products, and so is attracting Internet users (through the fame of the Complainant's trademark) who are then offered a wide range of unrelated products.

BAD-FAITH REGISTRATION AND USE

Seniority of Complainant's trademarks predates the disputed domain name registration and such trademarks are well known in relevant business circles. The Respondent can be considered to be aware of the Complainant's trademark when registering the domain name, as also follows from the content presented on the disputed domain website and a fact, that the Complainant's trademarks have been registered in then the Trade Mark Clearing House (TMCH) on 16 April 2014.

The Respondent attempts to attract, for commercial gain, Internet users to its website or to the websites linked thereto, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of their websites and of the products promoted therein. Therefore, the requirement of bad faith registration and use of the disputed domain name pursuant to paragraph 4(a)(iii) of the Policy has been met.

The Complainant presents the following evidence which has been assessed by the Panel:

- Excerpts from WIPO and other databases regarding Complainant's trademarks;
- Excerpts on the disputed domain name from WHOIS database;
- Screenshots of the disputed domain name website with the Respondent's content.

RESPONDENT:

The Respondent has not provided any response to the complaint.

RIGHTS

The Panel concluded that the disputed domain name is identical to trademarks in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Uniform Domain Name Dispute Resolution Policy ("UDRP" or "Policy").

For details, see "Principal Reasons for the Decision".

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 disputed domain name within the meaning of paragraph 4(a)(ii) of the Policy.

For details, see "Principal Reasons for the Decision".

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.

For details, see "Principal Reasons for the Decision".

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

RIGHTS

The disputed domain name and the Complainant trademarks are identical.

For sake of completeness, the Panel asserts that the top-level suffix in the domain name (i.e. the ".top") must be disregarded under the identity test as it is a necessary technical requirement of registration.

NO RIGHTS OR LEGITIMATE INTERESTS

Based on general Internet search, the Respondent is not commonly known by the disputed domain name. Given the fact, that (i) the Respondent links the domain name website to third party's website that presents information (among others) about Complainant’s products and offers the same for sale and (ii) in the absence of the Respondent's response, the Panel concludes that there is no indication that the domain name was intended to be used in connection with a bona fide offering of goods or services as required by the Policy.

Consequently, the evidentiary burden shifts to the Respondent to show by concrete evidence that it does have rights or legitimate interests in that name. However, the Respondent failed to provide any information and evidence that it has relevant rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Panel finds it grounded that the Respondent registered and used the disputed domain name in bad faith, namely, by using the domain name the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the domain name website 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 the Respondent's website (or other location) or of a product or service on the Respondent's website (or other location).

For the reasons described above, the Panel contends, on the balance of probabilities, that the disputed domain name has been registered and is being used by the Respondent in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **DULCOLAX.TOP**: Transferred

## PANELLISTS

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| Name | **JUDr. Jiří Čermák** |

DATE OF PANEL DECISION 2016-07-26

Publish the Decision