Decision for dispute CAC-UDRP-101250

Case number	CAC-UDRP-101250
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Domain names	pradaxa.xyz

Case administrator

Name	Nikola Balaš (Case admin)

Complainant

Organization	Boehringer Ingelheim Pharma GmbH & Co. KG

Complainant representative

Organization	Nameshield (Laurent Becker)

Respondent

Name	Huang ChaoQiong

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the owner of different trademark and domain name registrations. In particular Boehringer Ingelheim Pharma GmbH & Co. Kg owns:

- International Registration for "PRADAXA" no. 807503 registered on July 9, 2003 for class 5 with designation in multiple countries;

- International Registration for "PRADAXA" no. 991238 registered on October 29, 2008 for class 5 with designation in multiple countries ;

- domain name <pradaxa.biz> registered on November 23, 2006;

- domain name <pradaxa.com> registered on March 7, 2003;

- domain name <pradaxa.net> registered on November 23, 2006;

The disputed domain name was registered on June 30, 2016.

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. The Complainant has become a global research-driven pharmaceutical enterprise and has today about 140 affiliated companies world-wide with roughly 46,000 employees. The two main business areas of the Complainant are: Human Pharmaceuticals and Animal Health. In 2013, net sales of the Complainant's group of companies amounted to about EUR 14.1 billion.

The Complainant uses the trademark "PRADAXA" in the pharmaceutical sector and more specifically for an oral anticoagulant from the class of the direct thrombin inhibitors.

The Complainant assumes that the disputed domain name is identical to its registered trademark "PRADAXA" as the disputed domain name contains the Complainant's trademark in its entirety. The mere addition of the suffix ".xyz" does not alter the overall impression of a clear connection between <pradaxa.xyz> and the Complainant's trademark.

Furthermore, in the Complainant's view, the Respondent lacks rights or legitimate interest in the domain name in dispute. Actually, according to the Complainant's statement, the Respondent is not related in any way with the Complainant and 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 of the Complianant's trademark "PRADAXA", or apply for registration of the disputed domain name by the Complainant. In addition, the Complainant underlines that the website related to <pradaxa.xyz> merely displays a blank page and therefore the Respondent has made no use of the disputed domain name to date and he has not provided any evidence to support that he intends to make a legitimate non-commercial or fair use of the domain name in dispute.

The Complainant also contends that given the fame of the Complainant's trademark and the fact that "PRADAXA" has no dictionary meaning, except as referring to the Complainant's trademark, the insertion of "PRADAXA" in the disputed domain name gives rise to the inference that the Respondent ought to have registered the disputed domain name for its trademark value. In addition, the Complainant notes that when the Respondent registered <pradaxa.xyz> he was necessarily advised of the registered trademark "PRADAXA" by Trademark Clearing House (TMCH). This in consideration of the fact that the trademark "PRADAXA" is registered in the TMCH since April 16, 2014 and therefore when the Respondent registered the domain name in dispute, on June 30, 2016, he was advised of the existance of the Complainant's trademark. Finally the Complainant argues that the website in relation with the disputed domain names <pradaxa.xyz> only display a blank page (passive holding).

In the Complainant's view the awareness of the Respondent regarding the trademark "PRADAXA" at the time of the disputed domain name registration and the passive holding of the domain name by the Respondent can evidence bad faith in registering and using the domain name <pradaxa.xyz>.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

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 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

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

Paragraph 4(a) of the Policy provides that to obtain the transfer of the disputed domain name, the Complainant must prove that each of the following elements is present:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

Ad (i) The Complainant has established he has rights in the trademark "PRADAXA". The Panel notes that "PRADAXA" is a well-known trademark as per the Google search filed by The Complainant and additional Internet searches made by the Panel. The only difference between the disputed domain name and the Complainant's trademark is the gTLD ".xyz". The Panel finds that the disputed domain name is identical to the Complainant's mark as "PRADAXA" is incorporated in its entirety in the disputed domain name and it is a well-established principle that suffixes (TLDs) such as ".com", "org" or, in this case, ".xyz", may be disregarded when determining if there is identity or confusing similarity (see e.g. Playboy Enterprises International, Inc. v. John Taxiarchos, WIPO Case No. D2006-0561; Burberry Limited v. Carlos Lim, WIPO Case No. D2011-0344; Magnum Piercing, Inc. v. The Mudjackers and Garwood S. Wilson, Sr., WIPO Case No. D2000-1525). The Panel therefore finds that paragraph 4(a)(i) of the Policy has been established.

Ad (ii) The Complainant has long standing rights in the trademark "PRADAXA". The Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain name as it is not commonly known under the disputed domain name and as the Respondent was never authorized or licensed or otherwise permitted by the Complainant to use the disputed domain name. The Respondent, in the absence of any response, has not shown any facts or elements to justify legitimate rights or interests in the disputed domain name. Therefore, on the basis of the evidences submitted and in the absence of a response the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name. Accordingly, the Panel finds that the Complainant has satisfied also paragraph 4(a)(ii) of the Policy.

Ad (iii) Taking into account the reputation and fame of the "PRADAXA" trademark and the fact that this trademark has been incorporated in its entirety in the disputed domain name, the Panel concludes that the Respondent must have known of the "PRADAXA" trademark when he registered the disputed domain name. The adoption of a well-known trademark into a domain name by someone with no apparent connection with the name suggests opportunistic bad faith (see The Gap, Inc. v. Deng Youqian, WIPO Case No. D2009-0113; SembCorp Industries Limited v. Hu Huan Xin, WIPO Case No. D2001-1092; Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co., WIPO Case No. D2000-0163). Moreover, as pointed out by the Complainant, the Respondent would have been apprised by the TMCH of the Complainant's rights in the "PRADAXA" trademark when he registered the disputed domain name; notwithstanding this, he persisted with the registration which clearly confirm the bad faith of Respondent in registering <pradaxa.xyz> (see Volkswagen AG v. Song Hai Tao, WIPO Case no. D2015-0006). The webiste linked to the disputed domain name <pradaxa.xyz> displays a mere blank page (passive holding). The Panel finds that in this case said Respondent's passive holding of the domain names in dispute is sufficient to demonstrate bad faith use, in particular because of the reputation of the Complainant's trademark and the fact that it is not possible to conceive of any plausible good faith use of such domain names by anyone other than the

Complainant (see Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003). The Respondent did not respond and in the absence of any evidence by the Respondent or a satisfactory and credible explanation of how the registration and use of the disputed domain name which incorporates the well-known "PRADAXA" trademark have not been in bad faith, the Panel finds that paragraph 4(a)(iii) of the Policy has also been satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **PRADAXA.XYZ**: Transferred

PANELLISTS

Name	**Avv. Guido Maffei**

DATE OF PANEL DECISION 2016-09-09

Publish the Decision