Decision for dispute CAC-UDRP-101517

Case number	CAC-UDRP-101517
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Domain names	boehringeringelhein.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Boehringer Ingelheim Pharma GmbH & Co.KG

Complainant representative

Organization	Nameshield (Maxime Benoist)

Respondent

Name	Raju Khan

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the owner, among others, of the following registrations for the trademarks:

“BOEHRINGER INGELHEIM” registered with EUIPO (Reg. No. 2,493,195, May 20, 2003); and “BOEHRINGER INGELHEIM” registered with WIPO as international registration (Reg. No. 568,844, March 22, 1991).

FACTUAL BACKGROUND

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

The Complainant is a German family-owned pharmaceutical group of companies with roots going back to 1885, when it was founded by Albert Boehringer (1861-1939) in Ingelheim am Rhein. Ever since, Boehringer 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 Boehringer are: Human Pharmaceuticals and Animal Health. In 2013 alone, net sales of the Boehringer group of companies amounted to about EUR 14.1 billion.

The Complainant owns a large portfolio of trademarks including the wording “BOEHRINGER INGELHEIM” in several

countries, such as the BOHERINGER INGELHEIM® international registration number 221544 since July 2, 1959. Furthermore, the Complainant owns multiple domain names consisting in the wording “Boehringer Ingelheim”, such as <boehringer-ingelheim.com> since September 1, 1995 and <boehringeringelheim.com> since July 4, 2004.

The disputed domain name <boehringeringelhein.com> was registered on April 7, 2017 by the Respondent identified as “Raju Khan”.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

The Complainant’s contentions in the Complaint are summarized as follows:

i) The disputed domain name <boehringeringelhein.com> is confusingly similar to the trademark “BOEHRINGER INGELHEIM” owned by the Complainant, which may cause confusion;

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

iii) The Respondent registered and used the disputed domain name in bad faith.

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.

The Complaint was filed with the Czech Arbitration Court ("CAC") on April 11, 2017, seeking for a transfer of the disputed domain name. On April 11, 2017, the CAC sent an email to 1&1 Internet SE asking for the detailed data of the Registrant. The Registrar has not provided the verification requested, so the CAC reported this lack of cooperation to ICANN on April 19, 2017.

The CAC verified that the Complaint satisfied the formal requirements of the Policy, the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the CAC’s Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

The proceedings commenced on April 28, 2017. In accordance with the Rules, the CAC formally notified the Respondent of the Complaint, setting a deadline of May 18, 2017 by which Respondent could file a Response to the Complaint, via e-mail to all entities and persons listed on Respondent's registration as technical, administrative, and billing contacts.

Having received no response from the Respondent, on May 19, 2017 the CAC transmitted to the parties a Notification of

Respondent Default.

On May 26, 2017, the CAC appointed Ho Hyun Nahm, Esq., as the Sole Panelist in the administrative proceeding and with the consent for the appointment, impartiality and independence declared and confirmed by the Panellist, the CAC, in accordance with paragraph 7 of the Rules, organized the Panel of this case in a legitimate way.

Having reviewed the communications records, the Panel finds that the CAC has discharged its responsibility under Paragraph 2(a) of the Rules "to employ reasonably available means calculated to achieve actual notice to Respondent" through submission of Electronic and Written Notices, as defined in Rule 1 and Rule 2. Therefore, the Panel may issue its decision based on the documents submitted and in accordance with the ICANN Policy, ICANN Rules, the CAC'S Supplemental Rules and any rules and principles of law that the Panel deems applicable.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following three elements to obtain an order that the disputed domain name should be cancelled or transferred:

(1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and

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

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

In view of the Respondent's failure to submit a Response, the Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to Paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. See Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc., FA 95095 (FORUM July 31, 2000) (holding that the respondent’s failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); see also Talk City, Inc. v. Robertson, D2000-0009 (WIPO Feb. 29, 2000) (“In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.”).

i) 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).

The Complainant contends that it owns a large portfolio of trademarks including the wording “BOEHRINGER INGELHEIM” in several countries, such as the BOHERINGER INGELHEIM® international registration number 221544 since July 2, 1959. The Panel has verified by the Complainant's submitted evidence that it registered “BOEHRINGER INGELHEIM” with EUIPO (Reg. 2,493,195, May 20, 2003) and it also registered the same mark with WIPO as international registration (Reg. No. 568,844, March 22, 1991). Such a trademark registration with a trademark registration authorities confers rights in a mark. See T-Mobile USA, Inc. dba MetroPCS v. Ryan G Foo / PPA Media Services, FA 1627542 (FORUM Aug. 9, 2015) (finding that Complainant has rights in the METROPCS mark through its registration with the United States Patent and Trademark Office). Thus, the Panel finds that Complainant has rights in the BOHERINGER INGELHEIM mark under Policy 4(a)(i).

Next, the Complainant contends that the disputed domain name is confusingly similar to its trademark BOEHRINGER INGELHEIM by stating that the disputed domain name constitutes a misspelled word of the Complainant’s registered trademark BOEHRINGER INGELHEIM; the substitution of the letter “M” by the letter “N” at the end of the word INGELHEIM; and the use of the gTLD “.COM” is not sufficient to escape the finding that the disputed domain name is confusingly similar to the Complainant’s trademark; and it does not change the overall impression of the designation as being connected to the

Complainant's trademark BOEHRINGER INGELHEIM. The Complainant further contends that this is a clear case of "typosquatting", i.e. the disputed domain name contains an obvious misspelling of the Complainant's trademark, and thus the disputed domain name is confusingly similar to the Complainant's trademark. Previous Panels have found that the slight spelling variations does not prevent a disputed domain name from being confusing similar to the Complainant's trademark. The Complainant cites prior UDRP cases: CAC Case n° 101449, Boehringer Ingelheim International GMBH v. Tia Seki (<boehringer-inqelheim.com>); WIPO Case No. D2016-1546 BOEHRINGER Ingelheim Pharma GmbH & Co. KG of Ingelheim v. Martin Hughes (<boehringer-ingalheim.com>); CAC Case no. 101436 Boehringer Ingelheim Pharma GMBH & CO.KG v. "Jackie Uding", (<boehringer-ingl1heim.com>); and CAC Case no. 101200 Boehringer Ingelheim Pharma GMBH & CO.KG v. Ruthann Halay (<boehringer-ingelhein.com>).

As the Panel fully agree with the Complainant, it finds that the disputed domain name is confusingly similar to the Complainant's mark. The Panel therefore finds Policy 4(a)(i) satisfied.

ii) 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).

The Complainant must first make a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy 4(a)(ii), and then the burden shifts to the Respondent to show it does have rights or legitimate interests. See Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO D2003-0455 (a 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, Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the Policy); see also Hanna-Barbera Prods., Inc. v. Entm't Commentaries, FA741828 (Forum Aug. 18, 2006) (holding that the complainant must first make a prima facie case that the respondent lacks rights and legitimate interests in the disputed domain name under Policy 4(a)(ii) before the burden shifts to the respondent to show that it does have rights or legitimate interests in a domain name).

The Complainant asserts that the Respondent has no rights or legitimate interests in the disputed domain name. First of all, the Complainant contends that the Respondent is identified as "Raju Khan", and thus the Respondent is not known by the disputed domain name. The Panel is of the view that WHOIS information can be used to support a finding under Policy 4(c)(ii) that the Respondent is not commonly known by the disputed domain name. See Chevron Intellectual Property LLC v. Fred Wallace, FA1626022 (FORUM July 27, 2015) (finding that the respondent was not commonly known by the <chevron-europe.com> domain name under Policy 4(c)(ii), as the WHOIS information named "Fred Wallace" as registrant of the disputed domain name). The Panel notes that the WHOIS information of the disputed domain name lists "Raju Khan" as the Registrant. Therefore, the Panel holds the Respondent is not commonly known by the disputed domain name. As such, the Panel concludes that Respondent has no rights or legitimate interests in respect of the disputed domain name pursuant to paragraph 4(c) of the Policy.

The Complainant submits that the Respondent is not affiliated with him nor authorized by him in any way and that neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademark, or apply for registration of the disputed domain name by the Complainant. The Complainant claims that it does not carry out any activity for, nor has any business with the Respondent. Previous Panels find that a lack of contradicting evidence in the record that the Respondent was authorized to use the Complainant's mark in a domain name can be evidence of a lack of rights and legitimate interests. See Navistar International Corporation v. N Rahmany, FA1620789 (FORUM June 8, 2015) (finding that the respondent was not commonly known by the disputed domain name where the complainant had never authorized the respondent to incorporate its NAVISTAR mark in any domain name registration).

The Complainant argues that the disputed domain name is not linked with an active website. It redirects to another domain name on the URL address http://www.ireneyewear.com/ . This address displays the sentence "coming soon" since its registration, and thus it demonstrates a lack of legitimate interests in respect of the disputed domain name because it was only used as a redirection to another domain name. The Panel is of the view that inactive use of a domain name is not a bona fide offering of goods or services under Policy 4(c)(i) and it is not a legitimate non-commercial or fair use of the disputed domain name pursuant to Policy 4(c)(iii). See Thermo Electron Corp. v. Xu, FA713851 (Forum July 12, 2006)

(finding that the respondent's non-use of the disputed domain names demonstrates that the respondent is not using the disputed domain names for a bona fide offering of goods or services under Policy 4(c)(i) or a legitimate noncommercial or fair use pursuant to Policy 4(c)(iii)); see also The Lincoln Electric Company v. David Vargo, FA1725364 (Forum May 10, 2017)(finding that inactive use of a domain name is not a bona fide offering of goods or services under Policy 4(c)(i) and it is not a legitimate noncommercial or fair use of the domain name pursuant to Policy 4(c)(iii)). The Complainant has attached screenshots of the Respondent's websites which do not contain any content. Therefore, the Panel holds that the Respondent lacks rights and legitimate interests under Policy 4(c)(i) and (iii).

As such, the Panel holds that the Complainant established a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name under Policy 4(a)(ii), and thus the burden shifts to the Respondent to show it does have rights or legitimate interests. In the absence of a Response by the Respondent, the Panel cannot find that the Respondent has satisfied to prove existence of any of other elements under Policy 4(c). The Panel therefore finds Policy 4(a)(ii) satisfied.

iii) 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).

The Complainant contends that the Respondent registered and used the disputed domain name in bad faith. First of all, the Complainant contends that its BOEHRINGER INGELHEIM trademark is distinctive and well-known by way of citing a UDRP precedent, i.e., Boehringer Ingelheim Pharma GmbH & Co.KG v. Kate Middleton, WIPO Case No. D2016-0021 (<boehringeringelheimltd.com>). The Complainant thus asserts it inconceivable that the Respondent happened to register the disputed domain name incorporating the Complainant's well-known BOEHRINGER INGELHEIM trademark. The Complainant asserts that the Respondent "must have had Complainant's mark in mind when registering the Domain Name", and the Respondent is therefore using the disputed domain name only to attract and divert internet users from the Complainant's official domain name "boehringeringelheim.com" by creating a likelihood of confusion with the Complainant's trademark: See Boehringer Ingelheim Pharma GmbH & Co.KG v. Kate Middleton, WIPO Case No. D2016-0021 (<boehringeringelheimltd.com>).

The Complainant contends that given the distinctiveness of the Complainant's trademark and reputation, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademarks. The Complainant cites previous UDRP typosquattings cases involving the Complainant: Boehringer Ingelheim International GMBH v. Tia Seki CAC Case no. 101449, (<boehringer-inqelheim.com>) (given the distinctiveness of the Complainant's trademarks and business name, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademarks and with the clear intention of taking advantage of the Complainant's marks and reputation.); and Boehringer Ingelheim Pharma GmbH & Co. KG v. Klinik Sari Padma, BAKTI HUSADA, WIPO Case no. D2014-0306 (panel finds it is highly unlikely that Respondent had no knowledge of Complainant's company name and legal rights to the trademark BOEHRINGER INGELHEIM […], considering its notorious status and success in the pharmaceutical field.).

In light of the total circumstances and UDRP precedents as stated above, this Panel notes that the Complainant and its trademark BOEHRINGER INGELHEIM were widely-known and enjoyed a good fame and reputation, long-predating the registration of the disputed domain name. This Panel infers, due to the fame and notoriety of the Complainant and its trademark BOEHRINGER INGELHEIM and the manner of registration and use of the disputed domain name by the Respondent that the Respondent had actual knowledge of the Complainant's rights in the Complainant's trademark prior to registering the disputed domain name and finds that actual knowledge is adequate evidence of bad faith under Policy 4(a)(iii). See Univision Comm'cns Inc. v. Norte, FA 1000079 (Forum Aug. 16, 2007) (rejecting the respondent's contention that it did not register the disputed domain name in bad faith since the panel found that the respondent had knowledge of the complainant's rights in the UNIVISION mark when registering the disputed domain name); see also The Toronto-Dominion Bank v. Emanuella Doucet, FA1714314 (Forum March 9, 2017) (inferring due to the fame and notoriety of Complainant's marks and the manner of use of the disputed domain names, however, that Respondent had actual knowledge of Complainant's rights in the Mark prior to registering the disputed domain names and finds that actual knowledge is adequate evidence of bad faith under Policy 4(a)(iii)).

The Complainant claims that therefore by registering the disputed domain name <boehringeringelhein.com> with the misspelling of the Complainant's trademark BOEHRINGER INGELHEIM, it was intentionally designed to be confusingly similar with the Complainant's trademark. The Complainant has cited previous UDRP precedents where panels have seen such actions as evidence of bad faith: Boehringer Ingelheim Pharma GmbH & Co. KG v. Martin Hughes, WIPO Case No. D2016-1546 (<boehringer-ingalheim.com>) (the registration of the Domain Name which contains obvious misspelling of the Complainant's BOEHRINGER INGELHEIM trademark and which is virtually identical to the Complainant's <boehringer-ingelheim.com> domain name constitutes registration and use bad faith.). The Panel finds that the Respondent's domain name consists of common misspellings of the BOEHRINGER INGELHEIM mark, and thus finds that the Respondent is typosquatting in bad faith under Policy 4(a)(iii); See BACCARAT SA v. Meyer & Partenaires, CAC Case. No. 100069 (the panel agrees with Complainant's view that typosquatting itself is inference of bad faith.).

The Complainant additionally claims that the disputed domain name is not linked with an active website. Indeed, it redirects to another domain name on the URL address http://www.ireneyewear.com/ . This address displays the sentence "coming soon" since its registration. This Panel notes that Panels tend to find that the Respondents show bad faith by failing to make use of disputed domain names under Policy 4(a)(iii). See VideoLink, Inc. v. Xantech Corporation, FA1608735 (FORUM May 12, 2015) ("failure to actively use a domain name is evidence of bad faith registration and use pursuant to Policy 4(a)(iii)."). The Panel agrees that the passive holding of the disputed domain name does not necessarily circumvent a finding that the disputed domain name is being used in bad faith within the requirements of Paragraph 4(a)(iii) of the Policy. See Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003 (finding that in considering whether the passive holding of a domain name, following a bad faith registration of it, satisfies the requirements of Paragraph 4(a)(iii), the panel must give close attention to all the circumstances of the respondent's behavior, and a remedy can be obtained under the Policy only if those circumstances show that the respondent's passive holding amounts to acting in bad faith.). See also DCI S.A. v. Link Commercial Corp., D2000-1232 (WIPO Dec. 7, 2000) (concluding that the respondent's [failure to make an active use] of the domain name satisfies the requirement of 4(a)(iii) of the Policy).

The particular circumstances of this case that this Panel has considered are:

i) As observed above, the Complainant's BOEHRINGER INGELHEIM mark had a good reputation and was widely-known, as evidenced by the fact that the Complainant had a long and well established reputation in connection with pharmaceuticals and animal health at the time of the Respondent's registration of the disputed domain name; and

ii) The Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the disputed domain name. As the Panel finds such a failure to make an active use here, the Panel finds that the Respondent uses the disputed domain in bad faith under Policy 4(a)(iii).

Taking into account all of the above, the Panel concludes that the Respondent's passive holding of the disputed domain name constitutes bad faith under Paragraph 4(a)(iii) of the Policy and that the Respondent is using the disputed domain name in bad faith.

Finally, the Complainant claims that UDRP panels have held, the incorporation of a famous mark into a domain name, coupled with a website which is not directly used, may be evidence of bad faith registration and use; See e.g., Telstra Corporation Limited v. Nuclear Marshmallows, WIPO case no. D2000-0003). The Panel agrees with the Complainant that the Respondent's awareness of the BOEHRINGER INGELHEIM trademark suggests opportunistic bad faith registration, due to the Respondent's familiarity with the Complainant coupled with the fact of a good fame and notoriety of both the Complainant itself and its trademark BOEHRINGER INGELHEIM. See Singapore Airlines Ltd. v. European Travel Network, D2000-0641 (WIPO Aug. 29, 2000) (where selection of disputed domain name is so obviously connected to complainant's well-known trademark, use by someone with no connection with complainant suggests opportunistic bad faith); see also Am. Online, Inc. v. Fu, D2000-1374 (WIPO Dec. 11, 2000) (finding that the ICQ mark is so obviously connected with the complainant and its products that the use of the domain names by the respondent, who has no connection with the complainant, suggests opportunistic bad faith).

The Panel therefore finds Policy 4(a)(iii) satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOEHRINGERINGELHEIN.COM**: Transferred

PANELLISTS

Name	**Mr. Ho-Hyun Nahm, Esq.**

DATE OF PANEL DECISION 2017-05-27

Publish the Decision