Decision for dispute CAC-UDRP-101588

Case number	CAC-UDRP-101588
Time of filing	2017-07-03 10:12:56
Domain names	boehrnger-ingelheim.com

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	Boehringer Ingelheim Pharma GmbH & Co.KG

Complainant representative

Organization	Nameshield (Maxime Benoist)

Respondent

Organization	Cimpress Schweiz GmbH

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant owns a large portfolio of trademarks including the wording “BOEHRINGER INGELHEIM” in several countries, such as the BOEHRINGER INGELHEIM® international registration number 221544 since July 2, 1959, and also the trademark BOEHRINGER INGELHEIM number 568844 covering Switzerland registered on March 22, 1991.

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.

FACTUAL BACKGROUND

Complainant states the following:

"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 BOEHRINGER INGELHEIM® international registration number 221544 since July 2nd 1959, and also the trademark BOEHRINGER INGELHEIM number 568844 covering Switzerland registered on 1991-03-22 (annex 2)

The disputed domain name <boehrnger-ingelheim.com> was registered on June 26, 2017, by the Respondent identified as the Company “Cimpress Schweiz GmbH”.

The Complainant contends that the disputed domain name is confusingly similar to its trademarks BOEHRINGER INGELHEIM®."

Complainant has provided, inter alia, the following legal grounds:

With respect to 4(a)(i): "The Complainant states that the disputed domain name <boehrnger-ingelheim.com> is confusingly similar to its trademarks BOEHRINGER INGELHEIM® and its domain names associated.

Indeed, the disputed domain name <boehrnger-ingelheim.com> constitutes a misspelled word of the Complainant’s registered trademark BOEHRINGER INGELHEIM®.

The Complainant contends the deletion of the letter “I” between the letters 'R' and 'N' in the word BOEHRINGER, and the use of the gTLD '.COM' is not sufficient to escape the finding that the domain name <boehrnger-ingelheim.com> is confusingly similar to the Complainant’s trademarks and it does not change the overall impression of the designation as being connected to the trademark BOEHRINGER INGELHEIM®.

This is thus a clear case of 'typosquatting', i.e. the disputed domain name contains an obvious misspelling of the Complainant’s trademark."

With respect to paragraph 4(a)(ii): "The Respondent is identified as Company 'Cimpress Schweiz GmbH'.

The Complainant states that the Respondent is not affiliated with him nor authorized by him in any way. 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 does not carry out any activity for, nor has any business with the Respondent.

The disputed domain name <boehrnger-ingelheim.com> is not linked with an active website, because it displays a Vistaprint’s webpage with the sentence: “Sorry, we couldn’t find that page”, and also a redirection to the website of Vistaprint via the button “go to dashboard”.

It demonstrates a lack of legitimate interests in respect of the domain name because it is not used....

Finally, given the distinctiveness and reputation of the BOEHRINGER INGELHEIM’s trademark, the Complainant contends that the Respondent “must have had the Complainant’s mark in mind when registering the Domain Name”."

With respect to paragraph 4(a)(iii): "[B]y registering the domain name <boehrnger-ingelheim.com> with the misspelling of the Trademark BOEHRINGER INGELHEIM, the Complainant can state that this practical was intentionally designed to be confusingly similar with the Complainant’s trademarks....

[G]iven the distinctiveness of the Complainant's trademark and reputation, it is reasonable to infer that the Respondent has registered the domain name with full knowledge of the Complainant's trademarks....

[T]he disputed domain name is not linked with an active website, because it displays a Vistaprint's webpage with the sentence: 'Sorry, we couldn't find that page', and also a redirection to the website of Vistaprint via the button 'go to dashboard'.

As prior UDRP panels have held, the incorporation of a famous mark into a domain name, coupled with a website which is not used, may be evidence of bad faith registration and use....

Therefore, the Respondent has registered and is using the domain name at issue in order to create a likelihood of confusion and intentionally divert traffic away from the Complainant's official website."

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

With respect to paragraph 4(a)(i): Based upon the trademark registrations cited by Complainant, it is apparent that Complainant has rights in and to the BOEHRINGER INGELHEIM trademark.

As to whether the disputed domain name is identical or confusingly similar to the BOEHRINGER INGELHEIM trademark, the relevant comparison to be made is with the second-level portion of the disputed domain name only (i.e., "boehrnger-ingelheim") because "[t]he applicable Top Level Domain ('TLD') in a domain name (e.g., '.com', '.club', '.nyc') is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test." WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 1.11.1.

Here, the disputed domain name contains the BOEHRINGER INGELHEIM trademark (and only the BOEHRINGER INGELHEIM trademark) in its entirety, with two minor differences: the deletion of the letter "i" and the addition of a hyphen, neither of which is sufficient to distinguish the disputed domain name from the trademark.

Accordingly, the Panel finds that Complainant has proven the first element of the Policy.

With respect to paragraph 4(a)(ii): WIPO Overview 3.0, section 2.1, states, "While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of 'proving a negative', requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the

respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element."

The Panel finds that Complainant has established its prima facie case and without any evidence from Respondent to the contrary, the Panel is satisfied that Complainant has satisfied the second element of the Policy.

With respect to paragraph 4(a)(ii): Whether a domain name is registered and used in bad faith for purposes of the Policy may be determined by evaluating four (non-exhaustive) factors set forth in the Policy: (i) circumstances indicating that the registrant has registered or the registrant has 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 the registrant's documented out-of-pocket costs directly related to the domain name; or (ii) the registrant has 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 the registrant has engaged in a pattern of such conduct; or (iii) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant's website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the registrant's website or location or of a product or service on the registrant's website or location. Policy, paragraph 4(b).

Here, the Panel agrees with Complainant that, for the reasons set forth in Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, "the incorporation of a famous mark into a domain name, coupled with a website which is not used, may be evidence of bad faith registration and use."

Accordingly, the Panel finds that Complainant has proven the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOEHRNGER-INGELHEIM.COM**: Transferred

PANELLISTS

Name	**Douglas M. Isenberg**

DATE OF PANEL DECISION 2017-08-11

Publish the Decision