Decision for dispute CAC-UDRP-101950

Case number	CAC-UDRP-101950
Time of filing	2018-04-04 10:42:05
Domain names	boehringer-ingeihelm.com

Case administrator

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

Complainant

Organization	BOEHRINGER INGELHEIM PHARMA GMBH & CO.KG

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Organization	boehringer-ingeihelm

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 is the owner of the following trademark registrations:
- International Registration No. 221544 Boehringer-Ingelheim since July 2, 1959;
- EU registration No. 000084657 Boehringer Ingelheim since September 21, 1998; and
- US registration No. 2096339 Boehringer Ingelheim since September 19, 1997.

The Complainant is a holder of the multiple domain names consisting of its' trademark in its entirety such as <Boehringer-Ingelheim.com>, <Boehringer-IngelheimGmbh.com>, <Boehringer-Ingelheim.jobs>, <Boehringer-Ingelheim.asia> and others.

FACTUAL BACKGROUND

The Complainant is a German family-owned pharmaceutical group of companies founded in 1885 in Ingelheim am Rhein. Today Boehringer is a global research enterprise, with 140 affiliated companies worldwide.
Complainant contends that the Respondent is "typosquatting" in an attempt to benefit from it's trademark and reputation. It also argues that previous panels have found that the slight spelling variations does not prevent a disputed domain name from being confusingly similar to the complainant’s trademark.

The disputed domain name is inactive and used as a parking webpage. The Complainant contends that it is not legitimate non-commercial or fair use of the disputed domain name.
Given 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.

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

A. Identical or Confusingly Similar
Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.
A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. The Complainant is the owner of trademarks registrations including:
- International Registration No. 221544 Boehringer-Ingelheim since July 2, 1959;
- EU registration No. 000084657 Boehringer Ingelheim since September 21, 1998; and
- US registration No. 2096339 Boehringer Ingelheim since September 19, 1997.
Previous Panels have found that domain name which consists of common, obvious misspelling, or a small variation such as inversion of a letter or two of a trademark, also called typo-squatting, will be found confusingly similar to the trademark (See WIPO Overview 3.0, paragraph 1.9; Schneider Electric S.A. v. Domain Whois Protect Service / Cyber Domain Services Pvt. Ltd. WIPO Case No. D2015-2333; Sanofi, Genzyme Corporation v. Domain Privacy WIPO Case No. D2016-1193).
The disputed domain name <Boehringer-ingeilhelm.com> consists of a misspelled word of the complainant's registered trademark. In fact the difference between the Complainants' trademark and the disputed domain name is an inversion of the letter "L" and the letter "I". This inversion alongside the addition of the gTLD ".com", is not sufficient to escape the conclusion that the disputed domain name is confusingly similar to its' trademark.
It is widely established that the addition of the gTLD “.com” to the disputed domain name does not avoid confusing similarity (see Accor v. Noldc Inc. WIPO Case No. D2005-0016; F. Hoffmann-La Roche AG v. Macalve e-dominios S.A., WIPO Case No. D2006-0451, and Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003; L’Oréal v Tina Smith, WIPO Case No. 2013-0820; Titoni AG v Runxin Wang, WIPO Case No. D2008-0820; and Alstom v. Itete Peru S.A. WIPO Case No. D2009-0877). Therefore, the gTLD “.com” is without significance in the present case since the use of a TLD is technically required to operate a domain name.

Hence, the panel finds that the disputed domain name is confusingly similar to the Complainants' trademark.

B. Rights or Legitimate Interests

Once the Complainant establishes a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name, the burden of production shifts to the Respondent to show that it has rights or legitimate interests in respect to the disputed domain name (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 3.0"), paragraph 2.1).

In the present case, the Complainant has demonstrated to the Panel that the Respondent lacks rights or legitimate interests in respect of the disputed domain name and the Respondent had failed to assert any such rights or legitimate interests.

The Panel finds that the Complainant has established a prima facie case in this regard, inter alia, since the Complainant has not licensed or otherwise permitted the Respondent to use its "Boehringer Ingelheim" trademark, or a variation thereof.

The Respondent is not commonly known by the disputed domain name. The Respondent has not submitted a response and did not provide any evidence to show any rights or legitimate interests in the disputed domain name that is sufficient to rebut the Complainant's prima facie case.

In the circumstances of this case and in light of the Respondent's lack of use of the disputed domain name, as described above, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. Registered and Used in Bad Faith

The Complainant must show that the Respondent registered and is using the disputed domain name in bad faith (paragraph 4(a)(iii) of the Policy). Paragraph 4(b) of the Policy provides circumstances that may evidence bad faith under paragraph 4(a)(iii) of the Policy.

The burden placed on the Complainant is to bring evidence showing circumstances that indicate that the Respondent registered and used the disputed domain name in bad faith.

A Panel will look into the totality of the circumstances in each case, and these can include evidence of the degree of distinctiveness or reputation of the mark, the failure of the Respondent to file a response and the implausibility of any good faith use to which the domain name may be put.

To show that the Respondent registered the disputed domain name in bad faith, the Complainant argued that the disputed domain name and the Complainant´s mark are similar, that the Respondent knew of the Respondent's trademark due to the Complainant's trademark and worldwide reputation and intended to take advantage of the Complainant's trademark. It emphasises that the misspelling of the trademark was intentional and designed to be confusingly similar to the trademark and is an indication to Respondents' bad faith.

The Complainant has submitted evidence, which shows that the Respondent registered the disputed domain name long after the Complainant registered its trademarks. According to the evidence filed by the Complainant, the Complainant has owned the trademark since the year 1997. The Complainant's prior registered trademarks are suggestive of the respondent's bad faith (see Sanofi-Aventis v. Abigail Wallace, WIPO Case No. D2009-0735).

In addition, while the disputed domain name is inactive, UDRP decisions have confirmed that the passive holding of a domain name coupled with other circumstances indicative of bad faith registration and use would suffice to establish the third element under the Policy (see, in this regard, Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, Jupiters Limited v. Aaron Hall, WIPO Case No. D2000-0574). Therefore, the passive holding of the disputed domain name may be consistent with a finding of bad faith registration and use of both disputed domain name.

In the present case, the apparent similarities between the Complainant's mark and the disputed domain name, and the fact that the Complainant's mark has a high degree of distinctiveness serve as additional evidence of bad faith registration and use of the disputed domain name. In the specific circumstances of this case, there is no conceivable use that the Respondent may make of the disputed domain name which would be in good faith.

Considering these facts, including the absence of a Response and in view of the facts described above, the Panel finds that the Respondent has registered the disputed domain name in bad faith and has used the disputed domain name to attract Internet users on its website by creating a likelihood of confusion with the Complainant's trademark as to source, affiliation or endorsement, in the meaning of paragraph 4(b)(iv) of the Policy, and thus acted in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOEHRINGER-INGEIHELM.COM**: Transferred

PANELLISTS

Name	**Mr. Jonathan Agmon**

DATE OF PANEL DECISION 2018-05-20

Publish the Decision