Decision for dispute CAC-UDRP-102067

Case number	CAC-UDRP-102067
Time of filing	2018-06-22 08:59:38
Domain names	glyxambimet.com

Case administrator

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

Complainant

Organization	BOEHRINGER INGELHEIM INTERNATIONAL GMBH

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Organization	Domain Admin / This Domain is For Sale

OTHER LEGAL PROCEEDINGS

No other legal proceedings are known by the Panel.

IDENTIFICATION OF RIGHTS

The Complainant Boehringer Ingelheim International GmbH Ltd has fully proved to be the owner of the International Registration No. 1158911 for GLYXAMBI registered on March 20, 2013 and protected in numerous countries.

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 Albert Boehringer (1861-1939) in Ingelheim am Rhein. Ever since, Boehringer has become a global research-driven pharmaceutical enterprise and one of the pharmaceutical industry's top 20 companies with roughly 50,000 employees. Its three business areas are human pharmaceuticals, animal health and biopharmaceuticals. In 2017 alone, net sales of the Boehringer Group amounted to about EUR 18.1 billions .

GLYXAMBI is a prescription medication containing two medicines, empagliflozin and linagliptin. It can be used along with

diet and exercise to lower blood sugar in adults with type 2 diabetes, and can be used in adults with type 2 diabetes who have known cardiovascular diseases when both empagliflozin and linagliptin are appropriate and empagliflozin is needed to reduce the risk of cardiovascular death.

The Complainant states that the disputed domain name <glyxambimet.com> is confusingly similar to its registered trademark GLYXAMBI and domain name associated.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the domain name and that the Respondent is not related in any way with the Complainant. The Complainant informs that Boehringer Group does not carry out any activity for, nor has any business with the Respondent.

The Complainant informs that the disputed domain name was registered on May 11, 2018 by the Respondent and that it points to a parked page in which said domain name is available for sale and offered for 990 USD.

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.

1) The Complainant has established that he has rights in the trademark "GLYXAMBI" since March 2013. The Complainant's trademark is registered well before with respect to the registration of the disputed domain name (May 11, 2018). The Panel finds that the disputed domain name is confusingly similar to the Complainant trademark "GLYXAMBI" as it includes the trademark "GLYXAMBI" in its entirety with the addition of the term "met" as well as of the Top-Level domain ".com". In the Complainant's view the term "met" is a shortened form for metformin which is a medication for the treatment of type 2

diabetes. In the absence of any observation by the Respondent the Panel accepts the Complainant finding on the significance of the term "met". Therefore the Panel considers that the term “met” clearly points to the Complainant’s business in the field of diabetes treatment. Previous Panels have held that when the disputed domain name incorporates the Complainant's mark only adding additional terms referring to the Complainant's business a finding of confusing similarity between the contested domain name and the Complainant's mark is pertinent (see BOLLORE v. Ethan Wilson - CAC Case No. 102044 and Emphasis Services Limited v. Gritapat Setachanatip - CAC Case No. 101701). Therefore, in the Panel's view the term "met" is not capable to dispel the confusing similarity arising from the Complainant’s trademark incorporation in the disputed domain name. Furthermore, in accordance with the consensus view of past UDRP panels, the Panel finds that the Top-Level domain ".com" is not sufficient to exclude the likelihood of confusion. The Complainant therefore succeeds on the first element of the Policy.

2) 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 was never authorized to use it by the Complainant. The Respondent, in the absence of any Response, has not shown any facts or element to justify prior rights or legitimate interests in the disputed domain name. The Complainant therefore succeeds on the second element of the Policy.

3) Paragraph 4(b) of the Policy provides four, non-exclusive, circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of the disputed domain name in bad faith pursuant to Paragraph 4(a)(iii) of the Policy:

(i) circumstances indicating that the Respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting or otherwise transferring the disputed domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the disputed domain name; or

(ii) the Respondent has registered the disputed 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 Respondent has engaged in a pattern of such conduct; or

(iii) the Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 Respondent’s website or location or of a product or service on the Respondent’s website or location.

The Complainant has shown that the website linked to the domain name in dispute resolved in a page in which the same disputed domain name was offered for sale for USD 990. The Panel's note that the domain name in dispute was used in connection with a Respondent’s public offer of the disputed domain name for sale for a price exceeding the registration cost of a domain name. Recently, previous Panel noted that a Respondent’s public offer of the disputed domain name for sale does not fall within the example of evidence of bad faith in paragraph 4(b)(i) of the Policy since it requires a direct offer to the complainant or one of its competitors. However the same Panels have also noted that a general offer for sale of the disputed domain name is sufficient evidence of bad faith (see Intesa San Paolo S.p.A. v. Domain Administrator, See PrivacyGuardian/Vildan Erdogan, WIPO Case No. D2018-0824 and Intesa San Paolo S.p.A. v. Domain Administrator, See PrivacyGuardian/Mesut Erdogan, WIPO Case No. D2018-0570). In general, it is a clear practice of the Panels, to consider bad faith registration and use in cases in which the disputed domain name is offered for sale to the broad public on web pages or via reseller and internet auctions (see Easyjet Airline Company Ltd v. Andrew Steggles, WIPO Case No. D 2000-0024; EMI PLC v. JASON MACE, WIPO Case No. D2000-0712; The Avenue, Inc. and Retail Incorporated v. Chris Guirguis doing business as Lighthouse Web Design and/or Cannibal and Sam Guirguis, WIPO Case No. D2000-0013; 3636275 Canada, dba eResolution v. eResolution.com, WIPO Case No. D2000-0110; Louis Vuitton Malletier v. J.N. Prade WIPO Case No. D2000-1115). The Panel shares the opinion expressed in the above mentioned decisions. In particular, in the Panel's view, the

Respondent's general offer to sell the domain name consitutes a clear evidence of bad faith registration and use since it unequivocally shows that the Respondent knew or should have known that someone with rights in the "GLYXAMBI" mark would have an interest in the domain name. Therefore, the Panel concludes that the registration and offering for sale to the general public for USD 990 of the disputed domain name constitutes bad faith registration and use of the domain name and that therefore the Complainant has satisfied also 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. **GLYXAMBIMET.COM**: Transferred

PANELLISTS

Name	**Avv. Guido Maffei**

DATE OF PANEL DECISION 2018-07-27

Publish the Decision