Decision for dispute CAC-UDRP-102088

Case number	CAC-UDRP-102088
Time of filing	2018-07-13 09:33:21
Domain names	spiolto.online

Case administrator

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

Complainant

Organization	Boehringer Ingelheim International GmbH

Complainant representative

Organization	Nameshield (Daria Baskova)

Respondent

Name	RODRIGO QUEZADA ZAMBRANO

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that relate to the Disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the registrant of the international trademark registration No. 1117164, "SPIOLTO", registered on March 26, 2012, for goods and services in class 5.

The Disputed domain name was registered by the Respondent on June 15, 2018.

FACTUAL BACKGROUND

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

The Complainant states that it is a member of a German pharmaceutical group of companies. This group was founded by Albert Boehringer in Ingelheim am Rhein in 1885. The Complainant explains that today the group has become a global pharmaceutical enterprise with about 140 affiliated companies and approximately 50,000 employees.

The Complainant submits that SPIOLTO is the trademark and the trade name for a medical product produced by the Complainant, indicated as a maintenance bronchodilator treatment to relieve symptoms in adult patients with chronic obstructive pulmonary disease.

The Complainant underlines that it is the owner of an international trademark registration for the word "SPIOLTO", registered in several countries. The Complainant adds that it is also the owner of the domain name <spiolto.com> registered on October 24, 2011.

The Complainant observes that the Disputed domain name was registered by the Respondent on June 15, 2018.

The Complainant considers that, taking into account the factual circumstances set out below, the Respondent has no rights or legitimate interests in respect of the Disputed domain name.

The Complainant states that on June 27, 2018, a cease-and-desist letter was sent by e-mail to the Respondent and that the Respondent has not given any response to this cease-and-desist letter.

The Complainant points out that the information regarding the Respondent is restricted in order to protect the Respondent's privacy.

The Complainant argues that, due to the restriction of information on the Respondent published on the Whois, it is highly unlikely that the Respondent is known as "SPIOLTO".

The Complainant states that the Respondent is not related in any way with the Complainant.

The Complainant submits that it does not carry out any activity for, nor has any business with the Respondent.

The Complainant declares that neither license nor authorization has been granted to the Respondent to make any use of the Complainant’s trademark "SPIOLTO".

The Complainant adds that it has not given any authorization to the Respondent to apply for registration of the Disputed domain name.

The Complainant notes that the Disputed domain name resolves to a parking page with pay-per-click links.

The Complainant considers that, taking into account the arguments set out below, the Respondent has registered and is using the Disputed domain name in bad faith.

The Complainant considers that the Disputed domain name is identical to the Complainant’s trademark "SPIOLTO".

The Complainant observes that the trademark "SPIOLTO" is registered in the Trademark Clearinghouse since July 27, 2015.

The Complainant declares that a Google search for the term “SPIOLTO” in the geographical zone of the Respondent results in multiple search results linked to the Complainant.

The Complainant takes the view that, given the reputation and fame of the Complainant and its trademark, as well as the prior registration of an almost identical official domain name by the Complainant, the Respondent was aware of the existence of the prior rights of the Complainant at the time of the registration of the Disputed domain name.

The Complainant argues that the choice of the new gTLD “.online” is even likely to increase the likelihood of confusion with the Complainant’s trademark, since it suggests that the Disputed domain names leads to the official website or online marketplace for this particular product marketed by the Complainant.

The Complainant points out that the Disputed domain name does not resolve to any active website, but to a parking page with pay-per-click links and considers that this constitutes bad faith use of the domain name under the doctrine of passive holding.

The Complainant submits that, by registering and using the Disputed domain name, it seems clear that the Respondent has registered the Disputed domain name in order to prevent the Complainant to register its trademark as domain name in the ".online" extension.

The Compainant adds that, by failing to reply to the cease-and-desist letter, the Respondent has not provided a response to justify that the Disputed domain name is registered and used in good faith.

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

In accordance with paragraph 4(a) of the Policy, in order to obtain the transfer of the Disputed domain name, the Complainant has to demonstrate that:

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

(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.

IDENTICAL OR CONFUSINGLY SIMILAR

The first requirement that the Complainant must establish is that the Disputed domain name is identical with, or confusingly similar to, the Complainant’s trademark or service mark.

There are two elements of this test: the Complainant must demonstrate that it has rights in a trademark or service mark and, if so, the Disputed domain name must be shown to be identical or confusingly similar to the trademark or service mark.

The Complainant has proven ownership of the registered trademark "SPIOLTO", identified in section "Identification of rights" above.

On the question of identity or confusing similarity, what is required is simply a comparison and assessment of the Disputed

domain name itself to the Complainant’s trademark.

The Disputed domain name differs from the Complainant’s trademark only by the addition of the top-level domain ".online".

It is well established that merely adding a top-level domain to a trademark is not sufficient to distinguish a domain name from a trademark (see, for example, CAC Case No. 100831).

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

The second requirement that the Complainant must prove is that the Respondent has no rights or legitimate interests in the Disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in the Disputed domain name:

(i) before any notice to [the Respondent] of the dispute, [the Respondent’s] use of, or demonstrable preparations to use, the [Disputed] domain name or a name corresponding to the [Disputed] domain name in connection with a bona fide offering of goods or services; or

(ii) [the Respondent] (as an individual, business, or other organization) [has] been commonly known by the [Disputed] domain name, even if [the Respondent] [has] acquired no trademark or service mark rights; or

(iii) [the Respondent] [is] making a legitimate noncommercial or fair use of the [Disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

This is a non-exhaustive list of circumstances in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement falls on the Complainant. UDRP panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”.

Accordingly, it is usually sufficient for a complainant to raise a prima facie case against the respondent and the burden of proof on this requirement shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name.

The Panel finds that the Complainant has made out a prima facie case that the Respondent does not have rights or legitimate interests in the Disputed domain name.

In particular, the Complainant states that:

- the Respondent is not related in any way with the Complainant;

- the Complainant does not carry out any activity for, nor has any business with the Respondent;

- the Respondent has not been licensed nor authorized to make any use of the Complainant's trademark;

- the Complainant has not authorized the Respondent to apply for registration of the Disputed domain name;

- the Disputed domain name redirects the users to a parking webpage containing pay-per-click links;

- the Respondent has not responded to the cease-and-desist letter, in which he was required to transfer the Disputed domain name to the Complainant, unless he had any rights or legitimate interests on the Disputed domain name;

In the absence of a response, there is no indication in the present case that the Respondent is commonly known by the Disputed domain name.

The Respondent does not appear to be commonly known by the name "SPIOLTO" or by a similar name. Indeed, regardless the fact that the identity of the Respondent is not published for privacy reasons in the Whois, the Respondent's name appearing in the record is completely different from the Disputed domain name.

The Respondent does not appear to make any legitimate non-commercial or fair use of the Disputed domain name, nor any use in connection with a bona fide offering of goods or services.

Other UDRP panels have considered that the circumstance of using a domain name to redirect to webpages that contain sponsored pay-per-click links that are commercial in nature, strongly suggests that the Respondent's intention is to exploit the goodwill and reputation attached to the Complainant's trademark for its own or a third party's financial gain (see, for example, WIPO Case No. D2018-1159). The above-mentioned circumstance is, in the view of the Panel, a further element which indicates in the present case a lack of rights or legitimate interest.

Taking into account that the Respondent has no connection or business relationship with the Complainant, that the Complainant has not authorized the Respondent to register the Disputed domain name or to use the Complainant's trademark, as well as the use of the Disputed domain name in a webpage containing pay-per-click links, the Panel cannot imagine any possible legitimate justification for this use, and the Respondent has not come forward with any explanation that demonstrates any rights or legitimate interests in the Disputed domain name.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

REGISTERED AND USED IN BAD FAITH

Under the third requirement of the Policy, the Complainant must establish that the Disputed domain name has been both registered and used in bad faith by the Respondent.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, including:

(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 that complainant, for valuable consideration in excess of [the Respondent's] 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 [the Respondent's] web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the Respondent's] web site or location or of a product or service on [the Respondent's] web site or location.

The Panel, on the basis of the evidence presented, agrees with the Complainant's contentions that the Disputed domain name was registered in bad faith and that it has been used in bad faith.

Indeed, it is inconceivable that the Respondent was not aware of the Complainant's rights in the trademark "SPIOLTO" when registering the Disputed domain name, in particular because this trademark is registered in the Trademark Clearinghouse since July 25, 2015. Therefore, the Respondent should have been given a trademark claims notice of the Complainant's rights in the "SPIOLTO" trademark.

The Panel observes that the Complainant's trademark predates the registration of the Disputed domain names, and is highly distinctive. The Panel finds that the timing of the Respondent's registration and use of the Disputed domain name indicates that the Respondent acted in bad faith (see, for example, WIPO Case No. D2018-1159).

Other UDRP panels have considered that the choice of generic top-level domains is even likely to increase the likelihood of confusion because it may induce Internet users to believe that there is an association between the domain name and the trademark owner, as it suggests that the domain name leads to the official website or online marketplace for a particular product marketed by the trademark owner (see, for example, WIPO Case No. D2018-0562). The Panel shares this view and considers that the use of the ".online" top-level domain in the present case is a further element of bad faith.

Moreover, it is well established that the use of parking pages containing pay-per-click sponsored links based on the trademark value of the domain names, as well as the failure to reply to cease-and-desist letters constitute evidence of bad faith (see, for example, WIPO Case No. D2018-1159).

Accordingly, the Panel finds that the Disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SPIOLTO.ONLINE**: Transferred

PANELLISTS

Name	**Michele Antonini**

DATE OF PANEL DECISION 2018-08-17

Publish the Decision