Decision for dispute CAC-UDRP-102108

Case number	CAC-UDRP-102108
Time of filing	2018-07-26 09:29:27
Domain names	boehriinger-ingelheim.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	Laca

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, inter alia, a registered owner of the following trademark containing word elements "BOEHRINGER" and "INGELHEIM":

(i) BOEHRINGER-INGELHEIM (word), International (WIPO) Trademark, registration date 2 July 1959, trademark no. 221544, registered for goods in classes 1, 2, 3, 4, 5, 6, 16, 17, 29, 29, 30 and 32.

Besides other trademarks consisting of the "BOEHRINGER" or "INGELHEIM" denominations (collectively referred to as "Complainant's trademarks").

The Complainant has also registered a number of domain names under generic Top-Level Domains ("gTLD") and country-code Top-Level Domains ("ccTLD") containing the term “BOEHRINGER“ and „INGELHEIM”.

FACTUAL BACKGROUND

The Complainant is 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.

The disputed domain name was registered on 22 July 2018 and is held by the Respondent.

The domain name website (i.e. website available under internet address containing the disputed domain name) is not genuinely used and merely redirects to a third party reseller parking page.

The Complainant seeks transfer of the disputed domain name to Complainant.

PARTIES CONTENTIONS

The Parties' contentions are the following:

COMPLAINANT:

CONFUSING SIMILARITY

The Complainant states that:

- The disputed domain name contains “BOEHRIINGER” and “INGELHEIM” word elements, and it is thus almost identical (i.e. confusingly similar) to Complainant’s trademarks.

- The addition of the extra letter “I” into the word BOEHRINGER (i.e. forming BOEHRIINGER) is not sufficient to escape confusing similarity between the disputed domain name and Complainant’s trademarks.

- The disputed domain name represents a clear case of so called “typosquatting” which means that the disputed domain name is based on an obvious misspelling of the Complainant’s trademark: BOEHRIINGER-INGELHEIM instead of a correct form BOEHRINGER-INGELHEIM.

Thus, according to the Complainant the confusing similarity between Complainant’s trademarks and the disputed domain name is clearly established.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant states that:

- The Respondent has not been commonly known by the disputed domain name.

- The Complainant has not authorized, permitted or licensed the Respondent to use Complainant’s trademarks in any manner. The Respondent has no connection or affiliation with the Complainant whatsoever. On this record, Respondent has not been commonly known by the disputed domain name.

- Furthermore, the disputed domain name links to a reseller parking page. Therefore, the Complainant contends that Respondent has not made any genuine use of the disputed domain name since its registration, and it confirms that Respondent has no demonstrable plan to use the disputed domain name.

- The Complainant refers to previous domain name decisions in this regard.

BAD FAITH REGISTRATION AND USE

The Complainant states that:

- Seniority of the Complainant's trademarks predates the disputed domain name registration and such trademarks are well-known in relevant business circles. The Respondent can be considered to be aware of the Complainant's trademark when

registering the disputed domain name due to well-known character thereof, which should have been checked by the Respondent by performing a simple internet search.

- The disputed domain name (at the time of filing of the complaint) resolves to a mere parking site with no genuine content. In the light of the foregoing, the Complainant asserts that the disputed domain name was registered and used with the sole purpose of selling the disputed domain name to the Complainant.

- It is well-founded that registration of the disputed domain name that is confusingly similar to the Complainant's trademarks which enjoys strong reputation, plus other facts, such as above described non-use of the disputed domain name and Respondent's engagement in typosquatting, are sufficient to establish bad faith under paragraph 4(a)(iii) of the Policy.

- The Complainant refers to previous domain name decisions contending that registering a domain name (i) incorporating trademarks that enjoy high level of notoriety and well-known character and at the same time (ii) abusing typosquatting, constitute prima facie registration in bad faith, despite a fact that such domain names are not genuinely used.

The Complainant presents the following evidence which has been assessed by the Panel:

- Information about the Complainant and its business;
- Excerpts from trademark database regarding Complainant's trademarks;
- Excerpts from WHOIS database regarding Complainant's domain names;
- Excerpt from WHOIS database regarding disputed domain name;
- Screenshots of the disputed domain name website (evidencing non genuine use of the same);

RESPONDENT:

The Respondent has not provided any response to the complaint.

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

RIGHTS

Since the disputed domain name and the Complainant's trademarks are not identical, the key element investigated and considered by the Panel is whether the disputed domain name consisting of a term "BOEHRIINGER-INGELHEIM.COM" is confusingly similar to the Complainant's trademarks.

The disputed domain name and the Complainant's trademarks are nearly identical since they differ only in one character -

letter “i” is replaced by double letter “i”; this, however, cannot prevent the association in the eyes of internet consumers between the disputed domain name and the Complainant’s trademarks and thus the likelihood of confusion still exists. Also addition of a non-distinctive hyphen “-“ cannot sufficiently distinguish the disputed domain name from the Complainant’s trademarks.

For sake of completeness, the Panel asserts that the top-level suffix in the domain name (i.e. the “.com”) must be disregarded under the identity and confusing similarity tests as it is a necessary technical requirement of registration.

Therefore, the Panel has decided that there is identity in this case, it also concludes that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant’s assertions that the Respondent is not commonly known by the disputed domain name and is not affiliated with nor authorised by the Complainant are sufficient to constitute a prima facie showing the absence of rights or legitimate interest in the disputed domain name on the part of the Respondent.

In addition, given the fact that (i) the disputed domain name has not been genuinely used and (ii) in the absence of the Respondent's response, the Panel concludes that there is no indication that the disputed domain name was intended to be used in connection with a bona fide offering of goods or services as required by UDRP.

Consequently, the evidentiary burden shifts to the Respondent to show by concrete evidence that it does have rights or legitimate interests in that name. However, the Respondent failed to provide any information and evidence that it has relevant 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 Respondent has not used the disputed domain name in any manner, however, the Panel concludes (as it has been ruled in many similar cases, as for example Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, <telstra.org>, Jupiters Limited v. Aaron Hall, WIPO Case No. D2000-0574, <jupiterscasino.com>, Ladbroke Group Plc v. Sonoma International LDC, WIPO Case No. D2002-0131, <ladbrokespoker.com>) that the apparent lack of so-called genuine active use (e.g. to resolve to a website) of the domain name(s) without any active attempt to sell or to contact the trademark holder (passive holding), does not as such prevent a finding of bad faith.

Examples of what may be cumulative circumstances found to be indicative of bad faith include cases in which (i) the Complainant has a well-known trademark and (ii) there is no genuine use (e.g. a mere "parking" or linking to a parking site) of the disputed domain name by the Respondent (irrespective of whether the latter should also result in the generation of incidental revenue from advertising referrals).

In addition, it is clear that by replacing a single letter from the Complainant trademark (letter “l” is replaced by double-letter “ll”) while all other characters of the disputed domain name are identical to the Complainant trademark, it was Respondent’s intention to target Internet users who incorrectly type a website address into their web browser, an illicit activity recognised as „typosquatting“. There are several different reasons for typosquatting, as for example:

- to try to sell the disputed domain name back to the Complainant;
- to monetize the disputed domain name through advertising revenues from direct navigation misspellings of the intended domain;
- to redirect the typo-traffic to Complainant’s competitor;
- as a phishing scheme to mimic the Complainant’s site, while intercepting passwords or other information which the visitor enters unsuspectingly;
- To install drive-by malware or revenue generating adware onto the visitors' devices;

- To harvest misaddressed e-mail messages mistakenly sent to the typo domain.

All of the activities above are considered as malicious activities.

For the reasons described above, since (i) there is only a remote chance that the Respondent has registered the disputed domain name just by a chance and without having a knowledge about the existence of the Complainant's rights and business (ii) there is no real use of the disputed domain name and (iii) the Respondent is engaged in typosquatting, the Panel contends, on the balance of probabilities, that the disputed domain name has been registered and is being used by the Respondent in bad faith.

Thus, the Panel has taken a view that 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).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	**JUDr. Jiří Čermák**

DATE OF PANEL DECISION 2018-11-05

Publish the Decision