Decision for dispute CAC-UDRP-102405

Case number	**CAC-UDRP-102405**
Time of filing	**2019-03-29 11:57:12**
Domain names	**jardiance.app**

Case administrator

Name	**Šárka Glasslová (Case admin)**

Complainant

Organization	**Boehringer Ingelheim International GmbH**

Complainant representative

Organization	**Nameshield (Enora Millocheau)**

Respondent

Organization	**smartpatient 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

Complainant is the owner of the international trademark “JARDIANCE” (Reg No. 981336 registered in Germany on September 3, 2008), designating countries including Australia, Japan, Korea, and the United States.

The Complainant also owns various domain names including <jardiance.com>, registered on April 30, 2008.

FACTUAL BACKGROUND

The Complainant, Boehringer Ingelheim International GmbH,is a German family-owned pharmaceutical group of companies that was founded in 1885 by Albert Boehringer in Ingelheim am Rhein. It has grown into a global research-driven pharmaceutical enterprise with roughly 50,000 employees. The three business areas of the Complainant are human pharmaceuticals, animal health, and biopharmaceuticals. In 2017 alone, net sales of the BOEHRINGER group of companies amounted to about EUR 18.1 billion.

JARDIANCE (Empagliflozin) is a prescription medicine used along with diet and exercise to lower blood sugar in adults with type 2 diabetes, and also to reduce the risk of cardiovascular death in adults with type 2 diabetes who have known

cardiovascular disease.

The disputed domain name was registered on March 7, 2019, and presently resolves to an empty inactive page.

The Respondent filed a Response on April 2, 2019.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:
Complainant argues that the disputed domain name is identical to the JARDIANCE mark because it contains its entire mark and that the registration of the trademark predates the registration of the disputed domain name.

Complainant also argues that Respondent does not have rights or legitimate interests in the disputed domain name. Respondent is not commonly known as the domain name or in possession of licensing rights.

Complainant further argues that the disputed domain name was registered and is being used in bad faith. Complainant argues that Respondent possessed actual notice and knowledge of its JARDIANCE mark due to its fame and Respondent had acted in bad faith by registering the disputed domain name and using it in bad faith. Complainant also argues that by failing to demonstrate any activity in respect of the disputed domain name, it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would be legitimate. Complainant also argues that the Respondent is attempting to disrupt the Complainant’s business.

RESPONDENT:
The Respondent argues that the JARDIANCE mark is registered under class 5 for "pharmaceutical preparations“ that is unrelated to its software business.

Respondent contends that its intention of using the disputed domain name was to redirect app users who consume medication, such as JARDIANCE, to its website.

Respondent also contends that the Complainant had locked the disputed domain less than a month after its registration and the Respondent, therefore, could not use the disputed domain or redirect it to its intended website.

The Respondent also argues that it is in the business of making websites and software and never intended to infringe upon the Complainant’s intellectual property rights as it was under the impression that the JARDIANCE trademark applied in the field of medication, not websites and apps.

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 has provided evidence of its trademark registration of the JARDIANCE mark.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. The disputed domain name <jardiance.app> integrates the Complainant's JARDIANCE trademark in its entirety (see Wal-Mart Stores, Inc. v. Kuchora, Kal, WIPO Case No. D2006-0033; Hoffmann-La Roche Inc. v. Andrew Miller, WIPO Case No. D2008-1345).

B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires the Complainant to show that the Respondent has no rights or interests in respect of the domain name.

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 3.0, paragraph 2.1).

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

The Complainant has provided evidence that Respondent, identified as "smartpatient gmbh " in the Whois register, is not commonly known as the disputed domain name, nor is Respondent authorized or licensed to use the JARDIANCE mark in any manner. See M. Shanken Commc'ns v. WORLDTRAVELERSONLINE.COM, FA 740335 (Nat. Arb. Forum Aug. 3, 2006) (finding that the respondent was not commonly known by the <cigaraficionada.com> domain name under Policy 4(c)(ii) based on the WHOIS information and other evidence in the record).

The Respondent has submitted a response however it has failed to provide any evidence to show any rights or legitimate interests in the disputed domain name to rebut the Complainant's prima facie case. In fact, the Respondent acknowledged the Complainant has rights in the JARDIANCE mark.

The Panel is therefore of the view that the Respondent has no rights or legitimate interests in respect of the disputed domain name and accordingly, paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires the Complainant to show that its domain name has been registered and is being used in bad faith. Paragraph 4(b) of the Policy provides circumstances that may evidence bad faith under paragraph 4(a)(iii) of the Policy.

The Complainant has submitted evidence that the Respondent registered the disputed domain name long after the Complainant registered its trademarks. The Complainant's evidence has shown that it owned the trademark since 2008

whereas the disputed domain name was only registered in March 2019. Under these circumstances, the Complainant's prior registered trademark is suggestive of the Respondent's bad faith (see Sanofi-Aventis v. Abigail Wallace, WIPO Case No. D2009-0735).

The Complainant argued and the Respondent confirmed that it 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 Panel has considered the Respondent's argument that it „could not put [the disputed domain name] to use / direct it to the intended website" due to the Complainant's blocking of the disputed domain and takes the view that if not for the Complainant, the Respondent would have gone ahead to use the disputed domain name to redirect unsuspecting Internet users to its own website as the Respondent stated that this was its intent. Such intentions cannot be construed in good faith as it demonstrates that the Respondent was indeed aware of the Complainant's trademark and reputation prior to registration of the disputed domain name. It is with such knowledge that the Respondent had registered the disputed domain name in order to attempt to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the product or service on the Respondent's website or location.

The Panel notes that the Respondent also appears to be in the medical technology industry, in the business of providing smart technology support to patients in adhering to their treatment plans. It is therefore highly likely that the Respondent has heard of or is aware of the Complainant and/or its trademark. Moreover, given that JARDIANCE is a distinctive mark which is a made-up word that does not have any meaning the Respondent's behavior is clear evidence of bad faith registration and use of the disputed domain name. The use of the disputed domain name by the Respondent would have in all likelihood lead Internet users to associate the Respondent with the Complainant. Finally, the Respondent suggested that it is willing to transfer the disputed domain name to the Complainant, though such transfer did not take place prior to the rendering of this decision.

Based on the evidence presented to the Panel, including the registration of the disputed domain name long after the registration of the Complainant's mark, the confusing similarity between the disputed domain name and the Complainant's mark, the Respondent's statements and intended use of the disputed domain name, the Respondent's failure to present any credible rationale for registering the disputed domain name, and the fact that is no plausible good faith use that the Respondent can put the disputed domain name to, the Panel finds that the disputed domain name was registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **JARDIANCE.APP**: Transferred

PANELLISTS

Name	**Mr. Jonathan Agmon**

DATE OF PANEL DECISION 2019-05-06

Publish the Decision