Decision for dispute CAC-UDRP-102441

Case number	CAC-UDRP-102441
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Domain names	boehringer-ingelhaim.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	Cloud DNS Ltd

OTHER LEGAL PROCEEDINGS

There are no other proceedings the Panel is aware of.

IDENTIFICATION OF RIGHTS

The Complainant owns a very large portfolio of registered trade marks including for the word mark “BOEHRINGER INGELHEIM” as well as many figurative marks which include that as the word element.

This is includes the international trade mark, BOEHRINGER INGELHEIM, no.221544, registered in 1959 and also an EUTM no. 2493195 being a word mark registered in 2003 in classes 1,3,5,9,10,16,30,31,41,42.

The Complainant owns multiple domain names which include the name and word mark, “BOEHRINGER INGELHEIM”, such as <boehringer-ingelheim.com> which it registered in 1995 and <boehringeringelheim.com> registered in 2004.

In jurisdictions that protect rights arising from use, the Complainant also has unregistered rights arising from its very substantial use in trade.

FACTUAL BACKGROUND

The Complainant is a German family-owned pharmaceutical group with roots going back to 1885, when it was founded by Albert Boehringer (1861-1939) in Ingelheim am Rhein.

From those early beginnings, the Complainant has become a global research-driven pharmaceuticals heavy-weigh with approximately 50,000 employees.

The three main business areas of the Complainant are: human pharmaceuticals, animal health and biopharmaceuticals.

In 2017, the Complainant achieved net sales of around 18.1 billion euros.

The disputed domain name <boehringer-ingelhaim.com> was registered on 10 April 2019.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

1. The disputed domain name is confusingly similar to the protected mark

The disputed domain name is confusingly similar to the protected mark due to the fact it is a misspelling and is therefore typosquatting. The disputed domain name <boehringer-ingelhaim.com> is confusingly similar to its trade mark BOEHRINGER-INGELHEIM and its various domain names, including the two ".com" variations noted above. Indeed, the Complainant contends the substitution of the letter "E" by the letter "A" in the trade mark BOEHRINGER-INGELHEIM, and the use of the gTLD ".COM" is not sufficient to escape the finding that the disputed domain name is confusingly similar to the Complainant's trade mark and it does not change the overall impression of the designation as being connected to the trade mark BOEHRINGER-INGELHEIM.

The disputed domain name includes a misspelled word from the Complainant's registered trade mark BOEHRINGER-INGELHEIM. Indeed, when the domain name is written in small letters, it is very difficult for internet users to differentiate the terms "BOEHRINGER-INGELHAIM" from the Complainant's trade mark BOEHRINGER-INGELHEIM" (in small letters "boehringer-ingelhaim.com" instead of "boehringer-ingelheim").

This is therefore a clear case of "typosquatting", i.e. the disputed domain name contains an obvious misspelling of the Complainant's trade mark. Previous panels have found that the slight spelling variations does not prevent a disputed domain name from being confusingly similar to the complainant's trade mark. Please see prior UDRP cases: CAC Case No. 102274, BOEHRINGER INGELHEIM PHARMA GMBH & CO.KG v. Karen Liles <boehrlnger-lngelhelm.com>; WIPO Case No. DCO2018-0034, BOEHRINGER INGELHEIM PHARMA GMBH & CO. KG. v. Privacy Protect, LLC (PrivacyProtect.org) / jhon spenser, boehringer lngelheim-17.457220 <boehringer-lngelheim.co>; CAC Case No. 102191, Boehringer Ingelheim Pharma GmbH & Co.KG v. kapin kerry <boehringer-ingelhim.com>.

Moreover, past Panels commonly stated that the gTLD is not relevant in the appreciation of confusing similarity. Please see WIPO Case No. D2006-0451, F. Hoffmann-La Roche AG v. Macalve e-dominios S.A. ("It is also well established that the specific top level of a domain name such as ".com", ".org" or ".net" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar"). Thus, the disputed domain name is confusingly similar to the Complainant's trade mark.

2. The Respondent does not have any rights or legitimate interest in the disputed domain name

Here, there is an inactive website and non-use or passive holding.

According to the WIPO Case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd., a Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent fails to

do so, the complainant is deemed to have satisfied paragraph 4(a) (ii) of the Policy.

The Respondent is not known by the disputed domain name. Past panels have held that a Respondent was not commonly known by a disputed domain name if the WHOIS information was not similar to the disputed domain name. Please see for instance Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group ("Here, the WHOIS information of record identifies Respondent as "Chad Moston / Elite Media Group." The Panel therefore finds under Policy paragraph 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy paragraph 4(c)(ii).").

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the domain name <boehringer-ingelhaim.com> and 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. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trade mark, or apply for registration of the disputed domain name.

Again, the Complainant says the disputed domain name is a typosquatted version of the trade mark, BOEHRINGER-INGELHEIM. Typosquatting is the practice of registering a domain name in an attempt to take advantage of Internet users' typographical errors and can be evidence that a respondent lacks rights and legitimate interests in the domain name. Please see: Forum Case No. 1765498, Spotify AB v. The LINE The Line / The Line ("The Panel finds that Respondent's registration of the domain name is typosquatting and indicates it lacks rights and legitimate interests in the domain name per Policy paragraph 4(a)(ii).") and Forum Case No. 1597465, The Hackett Group, Inc. v. Brian Herns / The Hackett Group ("The Panel agrees that typosquatting is occurring, and finds this is additional evidence that Respondent has no rights or legitimate interests under Policy paragraph 4(a)(ii)."). Furthermore, the disputed domain name is inactive since its registration. Therefore, the Complainant contends that Respondent did not make any use of disputed domain name since its registration, and this shows the Respondent has no demonstrable plan to use the disputed domain name. It demonstrates a lack of legitimate interests in the disputed domain name. Thus, the Complainant contends that the Respondent has no rights or legitimate interest in the disputed domain name.

3. The disputed domain name has been registered and is being used in bad faith

Here there is the registration of a well-known/famous trade mark by misspelling/typosquatting plus an inactive website and non-use of the disputed domain name. The Complainant states that the disputed domain name is confusingly similar to its trade mark BOEHRINGER-INGELHEIM. Given the distinctiveness of the Complainant's trade mark and its reputation, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trade mark. See WIPO Case No. D2019-0208, Boehringer Ingelheim Pharma GmbH & Co. KG v. Marius Graur ("Because of the very distinctive nature of the Complainant's trade mark [BOEHRINGER-INGELHEIM] and its widespread and longstanding use and reputation in the relevant field, it is inconceivable that the Respondent registered the disputed domain name without being aware of the Complainant's legal rights.") and see CAC Case No. 102274, BOEHRINGER INGELHEIM PHARMA GMBH & CO.KG v. Karen Liles ("In the absence of a response from Karen Liles and given the reputation of the Complainant and its trademark (see, among others, WIPO Case No. D2016-0021, Boehringer Ingelheim Pharma GmbH & Co.KG v. Kate Middleton), the Panel infers that the Respondent had the Complainant's trademarks BOEHRINGER-INGELHEIM in mind when registering the disputed domain name."). Therefore, by registering the domain name <boehringer-ingelhaim.com> with the misspelling of the trademark BOEHRINGER INGELHEIM, the Complainant says this was done intentionally to be confusingly similar to the Complainant's trade mark. Previous UDRP panels have seen such actions as evidence of bad faith, see WIPO Case No. D2016-1546, Boehringer Ingelheim Pharma GmbH & Co. KG v. Martin Hughes <boehringer-ingalheim.com> ("the registration of the Domain Name which contains obvious misspelling of the Complainant's BOEHRINGER INGELHEIM trademark and which is virtually identical to the Complainant's <boehringer-ingelheim.com> domain name constitutes registration and use bad faith.")

Furthermore, the disputed domain name is inactive. The Complainant contends that the Respondent has not demonstrated any activity in respect of the disputed domain name, and it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, as passing off, or an

infringement of consumer protection legislation, or an infringement of the Complainant's rights in trade mark law. As prior WIPO UDRP panels have held, the incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use. Please see for instance: WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows and WIPO Case No. D2000-0400, CBS Broadcasting, Inc. v. Dennis Toeppen.

Therefore, the Complainant says the Respondent has registered and is using the disputed domain name in bad faith, see prior UDRP cases: CAC Case No. 102274, BOEHRINGER INGELHEIM PHARMA GMBH & CO.KG v. Karen Liles <boehrlnger-lngelhelm.com>; WIPO Case No. DCO2018-0034, BOEHRINGER INGELHEIM PHARMA GMBH & CO. KG. v. Privacy Protect, LLC (PrivacyProtect.org) / jhon spenser, boehringer lngelheim-17.457220 <boehringer-lngelheim.co> and CAC Case No. 102191, Boehringer Ingelheim Pharma GmbH & Co.KG v. kapin kerry <boehringer-ingelhim.com>. Please see also: Forum Case No. 1765498, Spotify AB v. The LINE The Line / The Line ("The Panel finds that Respondent's registration of the domain name is typosquatting and indicates it lacks rights and legitimate interests in the domain name per Policy paragraph 4(a)(ii).") and Forum Case No. 1597465, The Hackett Group, Inc. v. Brian Herns / The Hackett Group ("The Panel agrees that typosquatting is occurring, and finds this is additional evidence that Respondent has no rights or legitimate interests under Policy paragraph 4(a)(ii)."). Please see: WIPO Case No. D2019-0208, Boehringer Ingelheim Pharma GmbH & Co. KG v. Marius Graur ("Because of the very distinctive nature of the Complainant's trade mark [BOEHRINGER-INGELHEIM] and its widespread and longstanding use and reputation in the relevant field, it is inconceivable that the Respondent registered the disputed domain name without being aware of the Complainant's legal rights.") and CAC Case No. 102274, BOEHRINGER INGELHEIM PHARMA GMBH & CO.KG v. Karen Liles ("In the absence of a response from Karen Liles and given the reputation of the Complainant and its trademark (see, among others, WIPO Case No. D2016-0021, Boehringer Ingelheim Pharma GmbH & Co.KG v. Kate Middleton), the Panel infers that the Respondent had the Complainant's trade marks BOEHRINGER-INGELHEIM in mind when registering the disputed domain name.").

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RESPONDENT:

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

The Complainant, and its name and mark, are World famous. It is a well-known mark.

There is only one-character that is different between the Complainant's name and EUTM word mark, No. F00326309, and its <boehringeringelheim.com> domain and the disputed domain name. The "e "in "heim" is an "a" in the disputed domain name. This is a blatant and obvious case of typosquatting.

Further, while failure to use a domain name is not inherently bad faith; where a domain name includes a famous trade mark, there is no use of the domain name (and so no overt legitimate right or interest) and a respondent has not come forward with any explanation for his selection of the name --or indeed, any answer, then a finding of bad faith is fair, as are the appropriate inferences against the respondent. See Nominet Case DRS0658 (chivasbrothers.co.uk) and see WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows and - WIPO Case No. D2000-0400, CBS Broadcasting, Inc. v. Dennis Toeppen.

The Complainant has discharged its burden under the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	**Victoria McEvedy**

DATE OF PANEL DECISION 2019-06-05

Publish the Decision