Decision for dispute CAC-UDRP-102460

Case number	CAC-UDRP-102460
Time of filing	2019-04-26 10:00:50
Domain names	boehringer-ingelcheim.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

The Panel is not aware of any other pending or decided legal proceedings which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant owns a large portfolio of trademarks incorporating the term “Boehringer-Ingelheim” in several countries, such as the international trademark registration no. 221544 “Boehringer-Ingelheim” (word), registered since July 2, 1959 for numerous goods in classes 01, 02, 03, 04, 05, 06, 16, 17, 19, 29, 30, and 32, and duly renewed since then.

In addition to these trademarks the Complainant owns and uses various domain names incorporating the term “Boehringer-Ingelheim”, including the domain name <boehringer-ingelheim.com>, which was registered in 1995 is currently used for the Complainant’s corporate website.

The disputed domain name was registered on April 19, 2019, i.e. the Complainant’s trademark registration cited above predates the registration of the disputed domain name.

FACTUAL BACKGROUND

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

The Complainant is a German family-owned pharmaceutical group of companies with roots going back to 1885, when it was

founded by Albert Boehringer (1861-1939) in the city of Ingelheim am Rhein. Since then, the Complainant has become a global research-driven pharmaceutical enterprise with today approximately 50,000 employees. The Complainant's three main business areas are human pharmaceuticals, animal health, and biopharmaceuticals. In 2017, the Complainant achieved net sales of approximately 18.1 billion Euro.

The Complainant has no business or other relationship with the Respondent. The Complainant has not granted a license (or any other authorization) to the Respondent to use the trademark "Boehringer-Ingelheim", or to apply for registration of the disputed domain name.

The Complainant contends that, given the distinctiveness and reputation of the Complainant's "Boehringer-Ingelheim" brand, it is inconceivable that the Respondent could have registered the disputed domain name without actual knowledge of the Complainant's trademark rights.

Since its registration the disputed domain name has not resolved to an active website.

PARTIES CONTENTIONS

On May 27, 2019 the Respondent submitted the following nonstandard communication to the CAC's case file:

"Hello,
As domain reseller, we cannot defend the customer's domain name.
We have informed him about this case, but there is no response on our side.
Please let us know if we can assist you with anything else?"

Other than that, 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. As the Whois-listed registrant the Respondent has accepted liability for the disputed domain name unless it timely discloses the contact information of any underlying beneficial registrant, cf. Section 4.4.6 of the WIPO Jurisprudential Overview 3.0. The Respondent's only communication of May 27, 2019 does not provide any such information.

PRINCIPAL REASONS FOR THE DECISION

The disputed domain name is confusingly similar to the Complainant's distinctive trademark "Boehringer-Ingelheim". Merely including an additional letter "C" in "Ingelheim" does not change the overall impression of the designation as being connected to the trademark "Boehringer-Ingelheim".

The Panel further finds that the Complainant successfully submitted prima facie evidence that the Respondent has neither

made any use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, nor is making a legitimate non-commercial or fair use of the disputed domain name, nor is commonly known under the disputed domain name. This prima facie evidence was not challenged by Respondent.

The Panel also finds that the Complainant successfully submitted prima facie evidence that the Respondent was aware of the Complainant's rights in the designation “Boehringer-Ingelheim” when registering the disputed domain name. Again, this prima facie evidence was not challenged by Respondent, which supports the conclusion that the disputed domain name was REGISTERED in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

Given the fact that the disputed domain name does not resolve to an active website the primary question of this proceeding is whether or not the Respondent has also USED the disputed domain name in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy). The Complainant's case regarding such bad faith use is that the Respondent is effectively engaged in “passive holding” of the disputed domain name within the terms originally established by Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003. The panel in Telstra noted that the question as to which circumstances of “passive holding” may constitute use in bad faith cannot be answered in the abstract. This question may only be determined on the basis of the particular facts of each case. A panel should give close attention to all the circumstances of the Respondent's behaviour, and a remedy can be obtained under the Policy only if those circumstances show that the Respondent's passive holding amounts to acting in bad faith (cf. Sanofi-aventis v. Gerard Scarretta, WIPO Case No. D2009-0229; Mount Gay Distilleries Limited v. shan gai gong zuo shi, CAC Case No. 100707; RueDuCommerce v. TOPNET, CAC Case No. 100617; INFRONT MOTOR SPORTS LICENCE S.r.l. v. VICTOR LEE, CAC Case No. 100385).

With this approach in mind, the Panel has identified the following circumstances as material to the issue in the present case:

(i) The underlying registrant of the disputed domain name has used the services of the Registrant as domain name reseller, thereby hiding the underlying registrant’s identity;

(ii) The Complainant's trademark is highly distinctive. Given the Complainant's size and market position its trademark is widely known and has a strong reputation;

(iii) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use of the disputed domain name, nor can the Panel conceive of any such good faith use;

(iv) the registration of domain names that are almost identical to the domain name which a trademark owner uses for its own website (in this case <boehringer-ingelheim.com>), where the only difference between the trademark owner’s legitimate domain name and the disputed domain name is a single additional letter, is a typical pattern used for abusive “typosquatting” registrations; and

(v) taking into account the nature of the disputed domain name the Panel cannot conceive of any plausible actual or contemplated active use of the domain name by the Respondent (or by the underlying registrant) that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law.

Given all of these circumstances the Panel finds that the manner in which the disputed domain name is being used constitutes use in bad faith. The requirements of paragraph 4(a)(iii) of the Policy are therefore met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	**Dr. Thomas Schafft**

DATE OF PANEL DECISION 2019-06-08

Publish the Decision