Decision for dispute CAC-UDRP-102765

Case number	CAC-UDRP-102765
Time of filing	2019-11-04 10:09:02
Domain names	boheringer-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	Fundacion Comercio Electronico

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

In this proceeding, the Complainant relies on the word trademark BOHERINGER-INGELHEIM, international registration No. 221544 of July 2, 1959, covering goods in classes 1, 2, 3, 4, 5, 6, 16, 17, 19, 29, 30 and 32 and designating several European and non-European countries.

FACTUAL BACKGROUND

The Complainant is a German family-owned pharmaceutical group of companies with origins dating back to 1885, when it was founded by Albert Boehringer in Ingelheim am Rhein. Ever since, the Complainant has become a global research-driven pharmaceutical enterprise and has today approximately 50,000 employees. The three main activity areas of the Complainant are "human pharmaceuticals", "animal health" and "biopharmaceuticals". In 2018, the Complainant's net sales amounted to around 17,5 billion Euros.

The Complainant owns a large portfolio of trademarks including the wording "BOEHRINGER INGELHEIM" such as the international registration No. 221544 dating back to 1959, mentioned above. Moreover, the Complainant owns multiple domain names consisting in the wording <boehringer ingelheim>, among which <boehringer-ingelheim.com>, registered on September 1, 1995, and <boehringeringelheim.com> registered on July 4, 2004.

The disputed domain name <boheringer-ingelheim.com> was registered on October 29, 2019 and redirects to a parking page with commercial links.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Complainant contends that the disputed domain name is confusingly similar to its BOEHRINGER INGELHEIM trademark. Indeed, the reversal of the letters "e" and "h" and the use of the gTLD "com", are not sufficient to escape the confusing similarity with the Complainant's trademark. The disputed domain name is a misspelled word of the Complainant's registered trademark. Therefore, the disputed domain name is a typosquatting version of the Complainant's trademark. Moreover the gTLD ".com" is not relevant in the appreciation of confusing similarity.

The Complainant contends that the Respondent lacks rights and legitimate interests in the disputed domain name. According to the Complainant, the Respondent is not identified in the Whois database as the disputed domain name. Furthermore the Respondent has no relation whatsoever with the Complainant and does not carry out any activity for, nor has any business with, the Respondent. The Complainant never licensed its trademark to the Respondent, nor authorized the Respondent to make use of its trademark or to apply for the registration of the disputed domain name. The fact that the disputed domain name is a typosquatted version of the Complainant's trademark demonstrates the Respondent's attempt to take advantage of Internet users' typographical errors.

The Complainant further points out that the disputed domain name redirects to a parking page with commercial links, both related and unrelated to the Complainant and its activities. This kind of use does not amount to a bona fide offering of goods and services, or to a legitimate non-commercial or fair use of the disputed domain name.

With respect to the registration and use of the disputed domain name in bad faith, the Complainant contends that given the distinctiveness of the Complainant's trademark and its reputation it is reasonable to infer that the Respondent registered and used the domain name with full knowledge of the Complainant's trademark. According to the Complainant, the Respondent intentionally registered a misspelled version of the Complainant's trademark in order to take advantage of the confusing similarity with the Complainant's trademark, which is evidence of bad faith.

Regarding use in bad faith, the Complainant recalls that the disputed domain name redirects to a parking page containing commercial links, both related and unrelated to the Complainant's trademark.

As a further support of the Respondent's bad faith, the Complainant points out that the Respondent has already been involved in many other UDRP cases involving third parties' trademarks.

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

I. CONFUSING SIMILARITY

The Panel is satisfied that the disputed domain name is confusingly similar to the Complainant's trademark. The disputed domain name consists of the second level domain name "boheringer-ingelheim", which is practically identical to the Complainant's trademark BOEHRINGER-INGELHEIM, followed by the gTLD ".com". The only differences between the disputed domain name and the Complainant's trademark lie in the fact that the order of the letters "h" and "e" in the two signs is reversed, and in the addition of the gTLD ".com". The latter, is a mere technical requirement and therefore has not impact on the assessment of confusing similarity under paragraph 4(a)(i) of the Policy. With respect to the reversed order of the letters "h" and "e", this is minimal difference, that is hardly perceivable, especially by the non-German public, but also in general. Therefore, Internet users searching for the Complainant would most likely be confused when encountering the disputed domain name.

For the reasons mentioned above, the Panel finds that the Complainant has successfully proved the fulfilment of the first requirement set forth by paragraph 4(a)(i) of the Policy.

II. THE RESPONDENT’S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAME

While the overall burden of proof under the UDRP proceedings rests on the Complainant, it is generally recognized that in order to prove the respondent’s lack of rights or legitimate interest in a domain name it is sufficient for the complainant to make out a prima facie case in order to shift the burden of proof to the respondent. This is so because proving a third party’s negative fact, such as the respondent’s lack of rights or legitimate interest, would otherwise result in an almost impossible task for the complainant.

In the instant case, the Complainant maintains that the Respondent is not known by the disputed domain name and that the Complainant is not linked to the Respondent by any kind of relationship. Furthermore, the Complainant never licensed its trademark to the Respondent, nor granted any authorization to the Respondent to register the disputed domain name. The disputed domain name leads to a parking page containing commercial links, both related and unrelated to the Complainant. This practice cannot amount to a bona fide offering of goods and services, nor to a non-commercial or fair use of the disputed domain name.

According to the Panel, the aforementioned circumstances are sufficient to establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. In order to rebut the Complainant's arguments, the Respondent had the possibility to make his own defense. However, the Respondent chose not to file a Response.

In view of the foregoing, the Panel is satisfied that also the second condition under the Policy is met.

III. THE REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME IN BAD FAITH

The Complainant asserts that it is highly unlikely that the Respondent was not aware of the Complainant’s trademark at the time of the registration of the disputed domain name. The Panel agrees with the Complainant's contention. First, because the Complainant's trademark is quite distinctive and unique. Thus, it is practically impossible that the Respondent chose the disputed domain name by chance. Moreover, the disputed domain name is a misspelled version of the Complainant's trademark, which indisputably shows that the Respondent registered the domain name at issue with actual knowledge of the Complainant's trademark.

Prior panels deciding under the Policy have held that actual and constructive knowledge of a complainant's right at the time

of registration of a domain name constitutes strong evidence of bad faith. See among many: Accenture Global Services Limited v. Stexpress, Stex Logistics, WIPO Case No. D2015-0899; Research in Motion Limited v. International Domain Names Inc. / Moniker Privacy Services, WIPO Case No. D2008-0780; ArcelorMittal (SA) / Sanchez Juan Carlos, CAC Case No. 102291, etc.

In view of the foregoing, the Panel concludes that the Respondent registered the disputed domain name in bad faith.

As far as use in bad faith is concerned, the Complainant provided evidence of the fact that the disputed domain name leads to a parking page containing sponsored links related and unrelated to the Complainant and its activity. The Respondent is likely to derive some kind of profit from each click that an Internet user makes on one of the displayed links. Therefore, the Respondent is using the disputed domain name to take an undue economic advantage from the distinctive character and reputation of the Complainant's trademark. This kind of use, amounts to use in bad faith. The fact that the sponsored links are "served automatically by a third party", does not render the Respondent's use of the disputed domain name legitimate. As clearly stated in paragraph 3.5 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0"), "a respondent cannot disclaim responsibility for content appearing on the website associated with its domain name (nor would such links ipso facto vest the respondent with rights or legitimate interests). Neither the fact that such links are generated by a third party such as a registrar or auction platform (or their affiliate), nor the fact that the respondent itself may not have directly profited, would by itself prevent a finding of bad faith".

It is also worth mentioning that the Respondent has been already involved in many other UDRP proceedings for having registered domain names containing third parties' trademarks, which is further demonstration of bad faith.

In view of the foregoing, the Panel finds that the Respondent has used the disputed domain name to attract, for commercial gain, Internet users to a website by creating confusion in the minds of the public as to an association between the website and the Complainant.

Accordingly, the Panel is satisfied that also the third and last requirement under the Policy is met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	**Angelica Lodigiani**

DATE OF PANEL DECISION 2019-12-09

Publish the Decision