Decision for dispute CAC-UDRP-102786

Case number	CAC-UDRP-102786
Time of filing	2019-11-22 11:14:12
Domain names	boehringer-ingelheirm.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Boehringer Ingelheim Pharma GmbH & Co.KG

Complainant representative

Organization	Nameshield (Laurent Becker)

Respondent

Name	Janet Scroggs

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the owner of a large portfolio of trademarks. In particular, BOEHRINGER INGELHEIM owns the International Registration No. 221544 "BOEHRINGER-INGELHEIM" registered on July 2, 1959 (and duly renewed) for classes 1, 2, 3, 4, 5, 6, 16, 17, 19, 29, 30 and 32. The above trademark is protected in several countries.

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 Ingelheim am Rhein. Ever since, Boehringer has become a global research-driven pharmaceutical enterprise and has today about roughly 50,000 employees. The three main business areas of BOEHRINGER INGELHEIM are: human pharmaceuticals, animal health and biopharmaceuticals. In 2017, BOEHRINGER INGELHEIM achieved net sales of around 18.1 billion euros. The Complainant owns a large portfolio of trademarks including the wording BOEHRINGER-INGELHEIM in several countries, as well as many domain names consisting in the wording BOEHRINGER-INGELHEIM, such as <boehringer-ingelheim.com> and <boehringeringelheim.com>. The disputed domain name <boehringer-ingelheirm.com> was registered on November 14, 2019 and it is inactive since its registration.

The Complainant states that the disputed domain name <boehringer-ingelheirm.com> is confusingly similar to its trademark "BOEHRINGER-INGELHEIM". In particular, the Complainant contends that the addition of one single letter (r) and of the gTLD (.com) is not sufficient to escape the finding that the domain name <boehringer-ingelheirm.com> is confusingly similar to the Complainant's trademark. In the Complainant's view, this is a typical case of "typosquatting" in which the disputed domain name contains an obvious misspelling of the Complainant's trademark.

The Complainant also contends that the Respondent is not known as the disputed domain name and that the same Respondent has no rights or legitimate interests in respect of the domain name <boehringer-ingelheirm.com>. In addition, the Complainant informs that (i) the Respondent is not related in any way with BOEHRINGER INGELHEIM and (ii) neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademark "BOEHRINGER-INGELHEIM" or apply for registration of the disputed domain name by the Complainant.

In the Complainant's view, it appears obvious that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark "BOEHRINGER-INGELHEIM". According to the Complainant, this practical was intentionally designed to be confusingly similar with the Complainant's trademark.

Finally, the Complainant notes that the disputed domain name is inactive but that it is configured with MX records that allow it to be used to send e-mails that Internet users could well assume were sent by the Complainant. In the Complainant's view the Respondent's likely use of the disputed domain name to send confusing e-mails constitutes strong evidence of bad faith.

PARTIES CONTENTIONS

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

According to paragraph 4(a) of the Policy the Complainant is required to prove each of the following three elements to obtain the transfer of the disputed domain name:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

1) The Complainant has established that it has rights in the trademark "BOEHRINGER-INGELHEIM" at least since 1959. The Complainant's trademark was registered well before the registration of the disputed domain name and is widely well-known. The Panel notes that the consensus view in previous UDRP panel decisions is that in determining confusing similarity under paragraph 4(a) of the Policy, the generic Top-Level Domain ("gTLD") suffix (".com" in this particular instance) should be disregarded. Therefore the comparison has to be made between the signs BOEHRINGER-INGELHEIM and BOEHRINGER-INGELHEIRM. The only difference between the signs is the inclusion of the additional letter "r" in the disputed domain name. The Panel notes that the signs to be compared are respectively composed of nineteen and twenty letters and that the differences in long signs are more difficultly detected by the consumers than differences in short signs. The Panel's view is that the disputed domain name contains many recognizable aspects of the mark and, as a consequence, that the signs result to be almost identical aurally and visually notwithstanding the above mentioned inclusion. Furthermore the Panel agrees with the Complainant that the disputed domain name represents a clear and intentional misspelling of the previous mark (typosquatting). This in line with previous cases very similar to the one at hand in which the disputed domain name was considered as typosquatting of BOEHRINGER-INGELHEIM (for instance <boheringer-ingelheim.com> in CAC Case No. 102765; <bohringer-ingelheim.com> in CAC Case No. 102582; <beohringer-ingelheim.com> in CAC Case No. 102518; <boehringer-jngelheim.com> in CAC Case No. 102491; <boeihringer-inge1heim.com> in CAC Case No. 102489; <boehringer-ingelcheim.com> in CAC Case No. 102460). The Complainant therefore succeeds on the first element of the Policy.

2) The Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain name as it is not commonly known under the disputed domain name and was never authorized to use it by the Complainant. The Respondent, in the absence of any substantial response, has not shown any facts or element to justify prior rights or legitimate interests in the disputed domain name. The Complainant therefore succeeds also on the second element of the Policy.

3) The Complainant's trademark "BOEHRINGER-INGELHEIM" is distinctive and well-known in many countries. It is uncontroverted that Complainant's worldwide use and registration of the "BOEHRINGER-INGELHEIM" mark largely precede the registration date of the disputed domain name. The fact that the Respondent has registered a domain name that is almost identical to it clearly indicates that the Respondent had knowledge of the Complainant's trademark at the time of registration of the disputed domain name. This is a clear evidence of registration of the domain name in bad faith. The Complainant has demonstrated that the disputed domain name is merely directed to an error page and therefore it is clear that the disputed domain name is not used for any bona fide offerings since it is not connected to any website. The fact that the Respondent effectively passively holds the disputed domain name cannot prevent a finding of use in bad faith (see Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003). The Panel wishes to stress that the disputed domain name holds no Internet content; it means that customers searching for information on the Complainant and the Complainant's service may come to the conclusion that there are problems at the Complainant's site, that the Complainant's web information and services are no longer in active use. Such 'non-use' by the Respondent can have the same negative result on the Complainant as active use of a disputed domain name, and amounts to bad faith use" (FIL Limited v. George Dyle, WIPO Case No. D2014-1418). Furthermore, the Complainant has provided evidence that the Respondent has set up "MX-records" for the disputed domain name. This entails that the Respondent can send e-mails through the e-mail address "@boehringer-ingelheirm.com". The Respondent can therefore use (or may already have used) the disputed domain name to send fraudulent e-mails such as messages containing spam and/or phishing attempts that Internet users could well assume were sent by the Complainant. (See also Conféderation Nationale du Crédit Mutuel, Crédit Industriel et Commercial v. Khodor Dimassi, WIPO Case No. D2016-1980; Paris Saint-Germain Football v. MHP Private, WIPO Case No. D2019-0036). Albeit that there are no concrete examples of such use, it seems inconceivable that the Respondent will be able to make any good faith use of the disputed domain name as part of an e-mail address. The Panel finds that the mere conduct of making preparation for sending emails which are very likely to confuse the recipient of such e-mails as to their origin, is without justification and is inconsistent with the Complainant's exclusive rights in the "BOEHRINGER-INGELHEIM" trademark (see Accenture Global Services Limited v. Registration Private, Domains by Proxy, LLC / Richa Sharma, Name Redacted, WIPO Case No. D2019-2453). As a result of the above, the Panel finds that the disputed domain name was registered and is being used in bad faith. The Complainant therefore succeeds also on the third element of the

Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	**Avv. Guido Maffei**

DATE OF PANEL DECISION 2019-12-23

Publish the Decision