Decision for dispute CAC-UDRP-102872

Case number	CAC-UDRP-102872
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Domain names	boehringeringelheimrebates.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

Organization	Fundacion Comercio Electronico

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

The Complainant owns a large portfolio of trademarks including the wording “BOEHRINGER INGELHEIM” in several countries, such as the international trademark BOEHRINGER-INGELHEIM® n°221544, registered since July 2, 1959 and duly renewed.

The Complainant also owns multiple domain names consisting of the wording “BOEHRINGER INGELHEIM”, such as <boehringer-ingelheim.com> since 1995.

FACTUAL BACKGROUND

The Complainant is a 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 business areas of Boehringer are human pharmaceuticals, animal health and biopharmaceuticals. In 2018, net sales of the Boehringer group amounted to about EUR 17.5 billion.

The disputed domain name <boehringeringelheimrebates.com> has been registered on January 15, 2020 and redirects to a parking page with commercial links both related and unrelated to the Complainant.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant's contentions can be summarised as follows:

The disputed domain name <boehringeringelheimrebates.com> is confusingly similar to its trademark BOEHRINGER-INGELHEIM® as the trademark BOEHRINGER-INGELHEIM® is reproduced in its entirety with a hyphen between the two words of the mark.

The addition of the generic term "REBATES" is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark BOEHRINGER-INGELHEIM®. It does not change the overall impression of the designation as being connected to the Complainant's trademark BOEHRINGER-INGELHEIM®. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant or its trademark and domain names.

Indeed, it is well-established that "a domain name that wholly incorporates a Complainant's registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP". WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin.

In fact, the addition of the term "REBATES" worsens the likelihood of confusion, as it directly refers to the Complainant's website www.boehringeringelheimpetrebates.com/.

The addition of the generic Top-Level Domain suffix ".COM" does not change the overall impression of the designation as being connected to the trademark BOEHRINGER-INGELHEIM®. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant or its trademark and its domain names. 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.").

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

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, the 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 Complainant asserts that the Respondent is not identified in the Whois database as 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. Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com> ("Here, the WHOIS information of record identifies Respondent as "Chad Moston / Elite Media Group." The Panel therefore finds under Policy 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy 4(c)(ii).").

The Respondent is not affiliated with nor authorized by the Complainant in any way. 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 trademark BOEHRINGER-INGELHEIM® or apply for registration of the disputed domain name by the Complainant.

The disputed domain name redirects to a parking page with commercial links. Past panels have found this is not a bona fide offering of goods or services or legitimate non-commercial or fair use.

- Forum Case No. FA 970871, Vance Int'l, Inc. v. Abend (concluding that the operation of a pay-per-click website at a confusingly similar domain name does not represent a bona fide offering of goods or services or a legitimate non-commercial or fair use, regardless of whether or not the links resolve to competing or unrelated websites or if the respondent is itself commercially profiting from the click-through fees);

- WIPO Case No. D2007-1695, Mayflower Transit LLC v. Domains by Proxy Inc./Yariv Moshe ("Respondent's use of a domain name confusingly similar to Complainant's trademark for the purpose of offering sponsored links does not of itself qualify as a bona fide use.").

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

The Complainant's trademark BOEHRINGER-INGELHEIM® is a distinctive and well-known trademark. Past Panels have confirmed the notoriety of the trademark BOEHRINGER-INGELHEIM® in the following cases:

- WIPO Case No. D2019-0208, Boehringer Ingelheim Pharma GmbH & Co. KG v. Marius Graur ("Because of the very distinctive nature of the Complainant's trademark [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.");

- 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.").

The Respondent chose to register the domain name <boehringeringelheimrebates.com> to create confusion with the domain name <boehringeringelheimpetrebates.com> which is used by the Complainant to offer rebates on pet health products.

The Respondent has already registered another domain name comprising the trademark BOEHRINGER-INGELHEIM®. Please see CAC Case No. 102765, Boehringer Ingelheim Pharma GmbH & Co.KG v. Fundacion Comercio Electronico <boheringer-ingelheim.com>.

Consequently, given the distinctiveness of the Complainant's trademark and its reputation, it is reasonable to infer that the Respondent has registered and used the domain name with full knowledge of the Complainant's trademark.

The disputed domain name redirects to a parking page with commercial links. The Respondent has attempt to attract Internet users for commercial gain to his own website thanks to the Complainant's trademark for its own commercial gain, which is an evidence of bad faith. WIPO Case No. D2018-0497, StudioCanal v. Registration Private, Domains By Proxy, LLC / Sudjam Admin, Sudjam LLC ("In that circumstance, whether the commercial gain from misled Internet users is gained by the Respondent or by the Registrar (or by another third party), it remains that the Respondent controls and cannot (absent some special circumstance) disclaim responsibility for, the content appearing on the website to which the disputed domain name resolve […] so the Panel presumes that the Respondent has allowed the disputed domain name to be used with the intent to attract Internet users for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, affiliation, or endorsement of the Respondent's website to which the disputed domain name resolves. Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith.").

Finally, the Respondent in this proceedings has been involved in numerous UDRP cases involving third parties' trademarks, which evidences bad faith. For instance Forum Case No. 1873874, Enterprise Holdings, Inc. v. Carolina Rodrigues / Fundacion Comercio Electronico; CAC Case No. 102696, AMUNDI ASSET MANAGEMENT v. Fundacion Comercio Electronico; CAC Case No. 102688, Novartis AG v. Fundacion Comercio Electronico.

On these bases, the Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith.

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 disputed domain name registered in 2020 is confusingly similar to the Complainant's trade mark BOEHRINGER INGELHEIM (registered as an international trademark since 1959) adding only the generic term 'rebates' and the gTLD .com, none of which additions prevents confusing similarity between the disputed domain name and the Complainant's trade mark which is still recognisable in the disputed domain name.

The Respondent does not have rights or legitimate interests in the disputed domain name, is not commonly known by it and is not authorised by the Complainant. The disputed domain name has been used for pay per click links which is not a bona fide offering of goods and services or a legitimate non-commercial fair use.

The evidence of use for pay per click links is registration and use in bad faith being a deliberate attempt to divert Internet users for commercial gain under Policy 4 (b)(iv) and disrupting the Complainant's business under Policy 4 (b)(iii).

The Respondent has also been engaged in a pattern of conduct of registering domain names containing the marks of others including the Complainant's mark. The Respondent has also been the subject of adverse decisions under the Policy involving third party trademarks. Accordingly there are also grounds for transfer under Policy 4 (b)(ii).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOEHRINGERINGELHEIMREBATES.COM**: Transferred

PANELLISTS

Name	**Dawn Osborne**

DATE OF PANEL DECISION 2020-02-19

Publish the Decision