Decision for dispute CAC-UDRP-102871

Case number	CAC-UDRP-102871
Time of filing	2020-01-22 09:45:19
Domain names	boehringeringlheimpetrebates.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 Complainant has declared that there are no other legal proceedings, pending or decided, which relate to the disputed domain name. The Panel is not aware of any such proceedings.

IDENTIFICATION OF RIGHTS

The Complainant is the proprietor of various marks, including a trade mark 'BOEHRINGER-INGELHEIM' registered under the Madrid international system in respect of various territories (221544, first registered 2 July 1959, last renewed in 2019) in classes including 5 (pharmaceutical products for humans and animals).

FACTUAL BACKGROUND

The Complainant is a company with its seat in Ingelheim, Germany, was founded in the 19th century and now carries out activities, in multiple territories and at a significant scale (e.g. employing c. 50,000 people), in the pharmaceutical and animal health industries. It is the Registrant of various domain names of its own, used for websites, such as <BOEHRINGER-INGELHEIM.COM> first registered in 1995, and (of particular relevance to the present proceedings) <BOEHRINGERINGELHEIMPETREBATES.COM> first registered on 13 August 2019.

The Respondent, a legal person (foundation), with its seat in Panama City, Panama, registered the disputed domain name on 15 January 2020.

PARTIES CONTENTIONS

No administratively compliant Response has been filed. Neither the written notice of the Complaint nor the advice of delivery thereof was returned to the Czech Arbitration Court; an e-mail sent to the address provided by the Respondent was successfully relayed. The Respondent never accessed the online platform.

The Complainant contends that the disputed domain name was registered and is being used in bad faith, relying in particular upon the presence of commercial links on a website operated by the Respondent, as well as the confusing similarities between the disputed domain name and its mark, and the lack of any justification provided by the Respondent. The Complainant emphasises the distinctiveness of its mark, a pattern of conduct on the part of the Respondent, and its own specific activities at its own website <BOEHRINGERINGELHEIMPETREBATES.COM>. It requests that the disputed domain name be transferred to it.

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).

The disputed domain name differs from the mark in which the Complainant has rights in three respects (disregarding, in accordance with UDRP practice, the generic TLD .com). The first is the omission of the hyphen in 'BOEHRINGER-INGELHEIM', and the second is the difference between 'INGELHEIM' (in the mark) and 'INGLHEIM' (in the disputed domain name). Thirdly, the string 'PETREBATES' is included in the disputed domain name, but not in any of the Complainant's marks. The Panel is therefore required to consider whether the disputed domain name is confusingly similar to a mark in which the Complainant has rights.

Considering the hyphen first, the Panel notes that the presence or absence of a hyphen might be relevant in very rare circumstances, but (as in this case) does not take away from the possibility of one string being confusingly similar to another.

Considering the distinction between 'INGELHEIM' (in the mark) and 'INGLHEIM' (in the disputed domain name), the Panel finds that the minor difference (the omission of the letter E in the latter) also means that the disputed domain name is confusingly similar to the mark, especially as the overall impression on the user may be of close similarity at first glance.

Considering finally the string 'PETREBATES', the Panel notes that the most likely interpretation of this string - which has no dictionary meaning of its own - is as the English-language term 'pet rebates'. As the Complainant is active in manufacturing and distributing animal health products, and indeed operates a website at the domain name <BOEHRINGERINGELHEIMPETREBATES.COM>, prior to the registration of the disputed domain name, through which it offers rebates (retrospective discounts) to customers who have bought animal (pet) health products, it is not difficult to find that the additional text is 'descriptive' of activities associated with the Complainant including those carried out under its trade marks. Of course, there may be situations where the use of a mark plus a descriptive term or terms is appropriate within the scope of the Policy, though this is more appropriately considered in respect of the assessment of rights/legitimate interests and/or bad faith.

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).

The Complainant contends that the Respondent is not affiliated with nor authorised by the Complainant in any way, and that the Complainant does not carry out any activity for, nor has any business with the Respondent. Moreover, the Complainant declares that it has neither licensed nor authorised the Respondent to make use of its mark.

The Respondent is known as 'Fundacion Comercio Electronico' but has not participated in these proceedings, and so also provides no evidence of affiliation, rights, or legitimate interests. The Complainant's company name and trade marks are

manifestly derived from the name of the Complainant's founder (Boehringer) and its geographic location (the German city of Ingelheim). As such, the Panel cannot find any reason why the non-participating Respondent would choose to carry out its activities under this name.

The disputed domain name, at the time that the Complaint was filed, led Web users to a 'parking' page with what appear to be commercial links to various other providers of goods or services. This too does not sustain any argument that the Respondent is engaged in (e.g.) the bona fide offering of goods or services in a way that would constitute rights or legitimate interests for the purposes 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).

The Panel notes that other Panels have noted the well-known nature of the trade mark 'BOEHRINGER-INGELHEIM', to the extent that a Respondent can reasonably be assumed to have had it in mind when registering a disputed domain name containing the same or similar text (e.g. CAC Case No. 102275 Boeringer Ingelheim Pharma GmbH v Karen Liles; WIPO Case No. D2016-0021, Boeringer Ingelheim Pharma GmbH v Kate Middleton).

The Panel further notes that, at the time of the commencement of these proceedings, the disputed domain name pointed to a 'parking' page with what appear to be commercial links to various other providers of goods or services (including, it appears, the Complainant). While the CAC was subsequently attempting to contact the Respondent, it appears as if these links were no longer displayed (though the Panel's own attempt discloses that the disputed domain name redirects to a similar page of links at <ww1.boehringeringlheimpetrebates.com>). The Panel can safely conclude that, at least for a period of time, the Respondent 'intentionally attempted to attract, for commercial gain, Internet users to its website', by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's web site (paragraph 4(b)(iv) of the Policy).

The Respondent may have temporarily removed or made less obvious the links, but their presence for a period of time immediately after registration, the lack of any other information regarding the use of the disputed domain name, and indeed the Respondent's lack of participation in these proceedings, mean that the Panel remains certain that the requirements for a finding of bad faith under the Policy have been met. (Even in the absence of the evidence of commercial use, a Panel could have gone on to consider the possibility of 'passive holding', given the strength of the Complainant's case).

Finally, the Panel notes the Complainant's submission that the Respondent has been the Respondent in various other disputes to which the UDRP applied, such as CAC Case No. 102765, Boehringer Ingelheim Pharma GmbH vs Fundacion Comercio Electronico (concerning the same Complainant) and CAC Case No. 102696, Amundi Asset Management vs Fundacion Comercio Electronico (concerning an unrelated Complainant). The Panel notes, of its own motion, that other Panels have, within the last week, issued two further decisions concerning the activities of the Fundacion Comercio Electronico (and indeed the same Complainant) - CAC Case No. 102854 and CAC Case No. 102872. 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. As such, the Panel could also have found that the activities of the Respondent meet the requirements set out in paragraph 4(b)(ii) of the Policy (registering a domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the Respondent has] engaged in a pattern of such conduct).

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

In the absence of any Response from the Respondent, or any other information indicating the contrary, the Panel concludes

that the Respondent has no rights or legitimate interests in respect of the disputed domain name <BOEHRINGERINGLHEIMPETREBATES.COM>. On the other hand, it is clear that the Complainant has rights in respect of the trademark BOEHRINGER INGELHEIM (to which the disputed domain name is confusingly similar), and has carried out various online activities including a website dedicated to the provision of 'pet rebates'. In light of the evidence presented regarding the use of the disputed domain name by the Respondent (including the provision of commercial links), the Panel can find that the disputed domain name is being operated in bad faith. The requirements for the acceptance of a Complaint under paragraph 4 of the Policy have therefore been met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOEHRINGERINGLHEIMPETREBATES.COM**: Transferred

PANELLISTS

Name	**Prof Daithi Mac Sithigh**

DATE OF PANEL DECISION 2020-02-23

Publish the Decision