Decision for dispute CAC-UDRP-102937

Case number	CAC-UDRP-102937
Time of filing	2020-02-25 11:00:01
Domain names	boehringeringelhaimpetrebates.com, boehringeringelheimpet.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Boehringer Ingelheim Pharma GmbH & Co.KG

Complainant representative

Organization	Nameshield (Laurent Becker)

Respondent

Name	Zhichao Yang

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is a member of a group of companies engaged in the business of producing and selling human pharmaceuticals, animal health and biopharmaceuticals, with roots going back to 1885. Today the group has approximately 50,000 employees with net sales of approximately EUR 17.5 billion in 2018.

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 on July 1959 in classes 1, 2, 3, 4, 5, 6, 16, 17, 19, 29, 30, 32 presently designating Austria, Benelux, Switzerland, Germany, Egypt, Spain, France, Hungary, Italy, Liechenstein, Morocco, Monaco, Montenegro, Portugal, Serbia, San Marino.

FACTUAL BACKGROUND

Complainant relies on its rights in the BOHRINGER-INGELHEIM protected trademark described herein and its rights in the mark acquired by its extensive use by Complainant which claims to be one of the world’s 20 leading pharmaceutical companies, with roughly 50,000 employees worldwide and 17.5 million euros in net sales.
The Complainant asserts that the disputed domain name is confusingly similar to the BOEHRINGER-INGELHEIM trademark.

The Complainant submits that the disputed domain name is a misspelling of its trademark and that the Respondent is engaged in typosquatting, arguing that the substitution of the letter “e” in Complainant’s trademark with the letter “a” and the addition of the generic terms “PET REBATES” in the disputed domain name <boehringeringelhaimpetrebates.com> ; and the addition of the generic term “PET” in the disputed domain name <boehringeringelheimpet.com>. The Complainant alleges that these additional elements do not change the overall impression of the designation as being connected to the Complainant’s trademark BOEHRINGER-INGELHEIM, do not prevent the likelihood of confusion between the disputed domain names and the Complainant, its trademark and associated domain names are not sufficient to escape the finding that the disputed domain names are confusingly similar to the trademark BOEHRINGER-INGELHEIM.

Moreover, the Complainant submits that the addition of the terms “PET REBATES” or “PET”’ to the trademark BOEHRINGER-INGELHEIM in the disputed domain names increases the likelihood of confusion, as they directly refer to the Complainant’s website https://www.boehringeringelheimpetrebates.com./

The Complainant adds that the addition of the generic Top-Level Domain (gTLD) <.com> suffix does not change the overall impression of the designations as being connected to the Complainant’s BOEHRINGER-INGELHEIM trademark. See F. Hoffmann-La Roche AG v. Macalve e-dominios S.A. WIPO Case No. D2006-0451, (“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 Complainant alleges that the Respondent does not have any rights or legitimate interest in the disputed domain names and submits that a Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests; that once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name; and if the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP. See Croatia Airlines d.d. v. Modern Empire Internet Ltd. WIPO Case no. D2003-0455.,

The Complainant asserts that the Respondent is not identified in the Whois database as the disputed domain names. 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. Please see for instance NAF 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 ¶ paragraph 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy paragraph¶ 4(c)(ii).”).

Furthermore, the Complainant asserts that its name and mark are well known as Complainant owns multiple domain names incorporating the BOEHRINGER INGELHEIM mark, including <boehringer-ingelheim.com> since 1 September 1995 and <boehringeringelheim.com> registered since 4 July 2004.

Each of the disputed domain names <boehringeringelhaimpetrebates.com> and <boehringeringelheimpet.com> were registered on 18 February 2020 and redirect to almost identical parking pages with commercial links, some of which are related to the Complainant.

The Complainant adds that Respondent has neither licensed nor authorized the Respondent to make any use of the Complainant’s trademark BOEHRINGER-INGELHEIM, or to apply for registration of the disputed domain names.
The Complainant adds that 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.

Furthermore Complainant refers to screenshots of the web pages to which the disputed domain names redirect which illustrates that each resolves to a parking page with commercial links. Complainant submits that past panels have found that such use is not a bona fide offering of goods or services or legitimate non-commercial or fair use. See Vance Int’l, Inc. v. Abend NAF Forum Case No. FA 970871, (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 noncommercial 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).

The Complainant submits that the disputed domain names have been registered and is being used in bad faith, alleging that the Respondent choose to register the domain names to create a confusion with Complainant's domain name <boehringeringelheimpetrebates.com> and the website to which it resolves, used by the Complainant to offer rebates on pet health products. The Complainant adds that consequently it is reasonable to infer that the Respondent has registered and used the domain names with full knowledge of the Complainant's trademark.

The Complainant alleges that by using the disputed domain names in bad faith to redirect to a parking page with commercial links, Respondent is taking advantage of Complainant's trademark in an attempt to attract Internet users for commercial gain to his own website. See for instance StudioCanal v. Registration Private, Domains By Proxy, LLC / Sudjam Admin, Sudjam LLC, WIPO Case No. D2018-0497 ("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.").

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 names haves been registered and are 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 Complainant has provided uncontested evidence that has rights in the BOEHRINGER-INGELHEIM trademark acquired through its ownership of the abovementioned trademark registration and the goodwill that it has acquired through extensive use of the mark in its business, including on the Internet, for many years.

The first elements of the disputed domain name <boehringeringelhaimpetrebates.com> are almost identical to the Complainant's mark except for the substitution of the letter "e" in Complainant's trademark with the letter "a". These elements are followed by the generic words "pet rebates" and the gTLD <.com> extension. The reference to Complainant's mark is the only distinctive element of the disputed domain name. The generic wording and the gTLD <.com> extension may

be ignored as they do not reduce the confusingly similar character of the disputed domain name.
Similarly with the disputed domain name <boehringeringelheimpet.com>, the Complainant's trademark is the only dominant element. And the additional wording "pet" and the gTLD <.com> extension may be ignored when comparing the mark and domain name.

This Panel finds that the disputed domain names arend each of them confusingly similar to Complainant's BOEHRINGER-INGELHEIM trademark. Complainant has therefore succeeded in the first element of the test in Policy paragraph¶ 4(a)(i).

The Complainant has made out a prima facie case that the Respondent has no rights or legitimate interest in the disputed domain names arguing that the Respondent is not identified in the Whois database as the disputed domain names; that its name and mark are well known as Complainant owns multiple domain names incorporating the BOEHRINGER INGELHEIM mark, including <boehringer-ingelheim.com> since 1 September 1995 and <boehringeringelheim.com> registered since 4 July 2004; that Respondent has neither licensed nor authorized the Respondent to make any use of the Complainant's trademark BOEHRINGER-INGELHEIM, or to apply for registration of the disputed domain names; that 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; that the Respondent is not making a bona fide commercial use of the disputed domain names or a legitimate noncommercial or fair use of the disputed domain names because the disputed domain names resolve to parking pages with commercial links which does not constitute a bona fide use.

It is well established that if Complainant makes out a prima facie case, the burden of production shifts to Respondent to prove his rights or legitimate interests in the disputed domain name. Respondent has failed to file any response to the Complaint and so has not discharged the burden. In the circumstances this Panel must find that on the balance of probabilities Respondent has no rights or legitimate interests in the disputed domain name. Complainant has therefore succeeded in the second element of the test in Policy paragraph¶ 4(a)(ii).

Because of the Complainant's pre-existing and extensive reputation in the use of the BOEHRINGER INGELHEIM, it is reasonable to infer that the disputed domain names were registered in bad faith with full knowledge of the Complainant's trademark. The purpose of registering the disputed domain names was to refer to the Complainant and take predatory advantage of its reputation. Given the distinctive character of Complainant's mark and the similarity of the domain names, there is no other reasonable conclusion possible.

Because the Respondent is using the disputed domain names to redirect to a parking page with commercial links and thereby taking advantage of Complainant's trademark in an attempt to attract Internet users for commercial gain to his own website, this Panel must find that on the balance of probabilities by using the disputed domain names in this manner, Respondent has intentionally attempted to attract, for commercial gain, Internet users to his web site by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship , affiliation, or endorsement of his web site and is therefore using the disputed domain names in bad faith.

This Panel finds therefore that the disputed domain names were registered and are being used in bad faith.

Complainant has therefore succeeded in the third and final element of the test in Policy paragraph 4(a)(iii) it is entitled to succeed in its application for transfer of the disputed domain names.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOEHRINGERINGELHAIMPETREBATES.COM**: Transferred
2. **BOEHRINGERINGELHEIMPET.COM**: Transferred

PANELLISTS

Name	**Mr James Jude Bridgeman**

DATE OF PANEL DECISION 2020-03-18

Publish the Decision