Decision for dispute CAC-UDRP-102931

Case number	CAC-UDRP-102931
Time of filing	2020-02-21 08:53:05
Domain names	boehringeringelheipetrebates.com, boehringeringelhimpetrebates.com, boehringeringleheimpetrebates.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

Name	Zhichao Yang

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 names.

IDENTIFICATION OF RIGHTS

In this proceeding, the Complainant states that it is the owner of “a large portfolio of trademarks including the terms ‘BOEHRINGER’ and ‘INGELHEIM’ in several countries”, and specifically refers to the international trademarks BOEHRINGER-INGELHEIM No. 221544 registered since July 2, 1959 and BOEHRINGER INGELHEIM No. 568844 registered since March 22, 1991.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

THE DISPUTED DOMAIN NAMES ARE IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

The Complainant claims that it 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 INGELHEIM has become a global research-driven pharmaceutical enterprise and has today about roughly 50,000 employees. The three business areas of BOEHRINGER INGELHEIM are human pharmaceuticals, animal health and biopharmaceuticals. In 2018, net sales of the BOEHRINGER INGELHEIM group amounted to about EUR 17.5 billion.

The Complainant owns a large portfolio of trademarks including the terms “BOEHRINGER” and “INGELHEIM” in several countries, including the trademarks mentioned above.

Furthermore, the Complainant owns multiple domain names consisting in the wording “BOEHRINGER INGELHEIM”, such as <boehringer-ingelheim.com> since September 1, 1995 and <boehringeringelheim.com> registered since July 4, 2004.

The disputed domain names have been registered on February 16, 2020 and redirect to a parking page with commercial links.

The Complainant states that the disputed domain names are confusingly similar to its trademark since the disputed domain names include the mark in its entirety, merely misspelling it by changing or removing a single letter, and adds the “.com” gTLD. The substitution, deletion or addition of letters in the disputed domain name consisting of misspellings of trademarks is not sufficient to avoid the likelihood of confusion with the Complainant.

The addition of the generic terms “PET REBATES” worsens the likelihood of confusion, as it directly refers to the Complainant’s website www.boehringeringelheimpetrebates.com/.

The Complainant contends that the addition of the generic Top-Level Domain suffix “.COM” does not change the overall impression of the designations as being connected to the trademark. The Complainant refers to a similar CAC case No. 102854.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAMES

The Complainant asserts that the Respondent is not identified in the Whois database as the disputed domain names, not affiliated with nor authorized by the Complainant in any way and 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 trademarks, or apply for registration of the disputed domain names by the Complainant.

The Complainant adds that the disputed domain names redirect to a parking page with commercial links and past panels have found it is not a bona fide offering of goods or services or legitimate non-commercial or fair use.

THE DISPUTED DOMAIN NAMES WERE REGISTERED AND BEING USED IN BAD FAITH

The Complainant’s trademarks BOEHRINGER-INGELHEIM are distinctive and well-known and past Panels have confirmed the notoriety of the Complainant’s trademarks.

The Complainant contends that the Respondent choose to register the disputed domain names to create a confusion with the domain name <boehringeringelheimpetrebates.com>, used by the Complainant to offer rebates on pet health products and given the distinctiveness of the Complainant's trademarks and its reputation, it is reasonable to infer that the Respondent has registered and used the disputed domain names with full knowledge of the Complainant's trademark.

The disputed domain names redirect to a parking page with commercial links. The Complainant contends the Respondent

has attempt to attract Internet users for commercial gain to his own website thanks to the Complainant's trademarks for its own commercial gain, which is an evidence of bad faith.

The Complainant also claims that the Respondent is known in a pattern of bad faith domain names registration and use that is confirmed by previous UDRP panels.

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 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 have 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

A. Identical or confusingly similar with Complainant's trademark

The Complainant owns "BOEHRINGER INGELHEIM" trademark registrations effective in various jurisdictions.

As confirmed by WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition("WIPO Overview 3.0"), see paragraph 1.2.1: "Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case".

The disputed domain names incorporate the Complainant's trademark with some misspelling by changing or removing a single letter and with the addition of the descriptive element "PET REBATES".

As stated in WIPO Overview 3.0 "where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element" (see par. 1.8).

WIPO Overview 3.0 also states that a domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element (see par. 1.9).

In the present case, the Complainant's trademark is clearly recognizable in the disputed domain names, a misspelling in all the disputed domain names is obvious and the addition of the generic "PET REBATES" element only increases confusion given the use of these generic terms by the Complainant.

The .com domain zone shall be disregarded under the identity or the confusing similarity test as it does not add anything to the distinctiveness of the disputed domain names.

Therefore, the Panel finds that the first requirement of the Policy has been satisfied.

B. Rights or Legitimate Interests

The general rule is the following:

(i) a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests; and

(ii) once such prima facie case is made, the burden shifts to the respondent who has to demonstrate his rights or legitimate interests in respect of the domain name under paragraph 4 (c) of the Policy.

If the respondent fails to do so, the second element of the Policy is satisfied (see Julian Barnes v. Old Barn Studios, WIPO Case No. D2001-0121; Belupo d.d. v. WACHEM d.o.o., WIPO Case No. D2004-0110; Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO Case No. D2003-0455 and CAC Case No. 101284).

The Respondent did not respond.

While failure to respond does not per se demonstrate that the Respondent does not have rights or legitimate interests, it allows all reasonable inferences of fact in the allegations of the complaint to be deemed true (see paragraph 14(b) of the Rules and Forum Case No. FA0006000095095, Vertical Solutions Management, Inc. v. webnet-marketing, inc.).

The Complainant has made a prima facie case in respect of Respondent's lack of rights or legitimate interests, in particular absence of any affiliation, business relations or any authorization from the Complainant to use its trademarks in the disputed domain names, the fact that the Respondent is not known by the disputed domain names, misspelling of the Complainant's marks in all the disputed domain names and the addition of the generic terms indicating connection to the Complainant.

The disputed domain names redirect to a parking page with commercial links and previous panels have found it is not a bona fide offering of goods or services or legitimate non-commercial or fair use (see e.g. CAC Case No. 102862 and WIPO Case No. D2007-1695, Mayflower Transit LLC v. Domains by Proxy Inc./Yariv Moshe).

Therefore, the Panel finds that the Complainant has satisfied the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists non-exhaustive circumstances indicating registration and use in bad faith.

These circumstances are non-exhaustive and other factors can also be considered in deciding whether the disputed domain names are registered and used in bad faith.

The disputed domain names redirect to parking pages with commercial links.

The Complainant alleges that the Respondent has attempt to attract Internet users for commercial gain thanks to the Complainant's trademarks, which is an evidence of bad faith.

The Panel agrees with the Complainant.

All the circumstances of this dispute demonstrate that the Respondent targeted the Complainant by incorporating Complainant's trademark with a misspelling in the disputed domain names and adding generic terms "Pet Rebates" relating to the Complainant's activity (see CAC Case No. 102862: "the use of terms commonly associated with the activity of the Complainant are evidence that the Respondent was clearly aware of the Complainant and intended to benefit financially from the likelihood of confusion").

As stated by WIPO Overview 3.0 "Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith" (see par. 3.1.4).

The BOEHRINGER-INGELHEIM mark is distinctive and well-known as confirmed by previous UDRP panels (see e.g. WIPO Case No. D2016-0021, Boehringer Ingelheim Pharma GmbH & Co.KG v. Kate Middleton, CAC Case No.102274 and CAC Case No. 102560) and the BOEHRINGER-INGELHEIM mark has been frequently targeted by cybersquatters as confirmed in previous UDRP proceedings (see e.g. CAC Case No. 102862, CAC Case No.102924, CAC Case No. 102889, CAC Case No. 102871, Boehringer Ingelheim Pharma GMBH & CO. KG v. (Huang Jian), WIPO Case No. D2019-2733 and Boehringer Ingelheim Pharma GmbH & Co. KG v. Marius Graur, WIPO Case No. D2019-0208).

Besides, the Complainant also provided proof that the Respondent had been a party to many UDRP proceedings and registered domain names similar with third parties trademarks (see e.g. Forum Case No. FA1911001872103) and this is also confirmed by Panel's own findings (see e.g. Accenture Global Services Limited v. Moniker Privacy Services / Whois Agent, Domain Protection Services, Inc. / Zhichao Yang, WIPO Case No. D2019-2787; Andrey Ternovskiy dba Chatroulette v. Domain Administrator, See PrivacyGuardian.org / Zhichao Yang, WIPO Case No. D2019-0792 and National Grid Electricity Transmission PLC, Ngrid Intellectual Property Limited v. Zhichao Yang, WIPO Case No. D2015-2339).

The most recent CAC Case No. 102937 between the Complainant and the Respondent is another evidence of Respondent's bad faith ("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…").

This clearly demonstrates a pattern of conduct of the Respondent.

Based on the above, the Panel holds that the third requirement of the Policy has been satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOEHRINGERINGELHEIPETREBATES.COM**: Transferred
2. **BOEHRINGERIGELHEIMPETREBATES.COM**: Transferred
3. **BOEHRINGERINGELHIMPETREBATES.COM**: Transferred
4. **BOEHRINGERINGLEHEIMPETREBATES.COM**: Transferred
5. **BOEHRINGERINGELHEIMPETREBATS.COM**: Transferred
6. **BOEHRINGERINGELHIEMPETREBATES.COM**: Transferred
7. **BOEHRINGERLNGELHEIMPETREBATES.COM**: Transferred
8. **BOEHRINGERPETREBATES.COM**: Transferred

PANELLISTS

Name	**Igor Motsnyi**

DATE OF PANEL DECISION 2020-03-24