Decision for dispute CAC-UDRP-102940

Case number	CAC-UDRP-102940
Time of filing	2020-02-25 14:29:27
Domain names	boehringerIngelheimequinerebates.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 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 Complainant owns a 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.

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

FACTUAL BACKGROUND

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

The disputed domain name has been registered on February 18, 2020 and redirects to a parking page with commercial links.

The Complainant states that the disputed domain name is confusingly similar to its trademark BOEHRINGER-INGELHEIM.

The disputed domain name includes the trademark BOEHRINGER-INGELHEIM 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.

Moreover, a misspelling variant to the trademark BOEHRINGER-INGELHEIM in the view of Complainant worsens the likelihood of confusion, as it directly refers to the Complainant's website www.boehringeringelheimpetrebates.com.

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

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.

The Complainant contends that the Respondent is not affiliated with nor authorized by the Complainant in any way. The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. 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.

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

Thus, in accordance with the foregoing, the Complainant contends that the Respondent has no right or legitimate interest in respect of the disputed domain name.

The Complainant states that the disputed domain name is confusingly similar to its trademark BOEHRINGER-INGELHEIM.

The Complainant is one of the world's 20 leading pharmaceutical companies, with roughly 50,000 employees worldwide and 17.5 billion euros in net sales.

The Complainant's trademark BOEHRINGER-INGELHEIM is a distinctive and well-known trademark. Past panels have confirmed the notoriety of the trademark BOEHRINGER-INGELHEIM.

Besides, the Complainant contends that the Respondent choose to register the domain name to create a confusion with domain name <boehringeringelheimpetrebates.com>, used by the Complainant to offer rebates on pet health products.

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 names with full knowledge of the Complainant's trademark.

Furthermore, the disputed domain name redirects 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 trademark for its own commercial gain, which is an evidence of bad faith.

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

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 name incorporates the entire Complainant’s trademark with misspelling of the single letter "L" instead of "I" in the middle of the long domain name and with the addition of the descriptive element “EQUINEREBATES".

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 name, a misspelling in the disputed domain name is obvious and the addition of the generic “EQUINE 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 name.

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

B. Rights or Legitimate Interests

The Respondent did not respond.

When a respondent remains completely silent in the face of a prima facie case that it lacks any rights or legitimate interests in respect of a domain name, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy. Here the Complainant has presented an abundance of evidence to show that the Respondent has no plausible right or legitimate interest in respect of the disputed domain name and the Panel so finds.

The disputed domain name redirects 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 domain names are registered and used in bad faith.

The disputed domain name redirects 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 name and adding generic terms “EQUINE 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).

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 disputed domain name with full knowledge of the Complainant's trademark.

Besides, the Complainant contends that the Respondent choose to register the domain names to create a confusion with domain name <boehringeringelheimpetrebates.com>, used by the Complainant to offer rebates on pet health products. The

Panel agrees with Complainant.

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. **BOEHRINGERLNGELHEIMEQUINEREBATES.COM**: Transferred

PANELLISTS

Name	**Jan Christian Schnedler, LL.M.**

DATE OF PANEL DECISION 2020-03-25

Publish the Decision