Decision for dispute CAC-UDRP-102942

Case number	CAC-UDRP-102942
Time of filing	2020-02-25 10:06:31
Domain names	boehringerengelheimpetrebates.com, boehringeringeleheimpetrebates.com, boehringeringelgeimpetrebates.com, boehringeringelheimpetrebstes.com, boehringeringerlheimpetrebates.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	Super Privacy Service LTD c/o Dynadot

OTHER LEGAL PROCEEDINGS

The Panel is unaware of other legal proceedings, pending or otherwise, which relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

The Complainant owns a large portfolio of trademarks including the wording “BOEHRINGER” in several countries, such as the BOHERINGER® international registration number 799761 since December 2, 2002.

Furthermore, the Complainant owns multiple domain names consisting in the wording “Boehringer”, such as <boehringer.com> since January, 12, 2000.

FACTUAL BACKGROUND

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

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'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 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. See Am. Online, Inc. v. David, FA 104980 (Forum April 10, 2002) ("The misspelling of a famous mark does not diminish the confusingly similar nature between the marks and the disputed domain names."), Trip Network Inc. v. Alviera, FA 914943 (Forum March 27, 2007) (concluding that the affixation of a gTLD to a domain name is irrelevant to a Policy 4(a)(i) analysis).

Past panels have found it 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.").

- 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.").

The Complainant argues that the Respondent does not have any rights or legitimate interest in the disputed domain names:

The categories of issues involved are:

- Domain parking
- Use of privacy or proxy registration services
- Misspelling/Typosquatting

ADDITIONAL EXPLANATIONS:

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 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.

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 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 names. 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 names by the Complainant.

Furthermore, the disputed domain names redirect 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:

- 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); and

- 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.").

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

The domain name has been registered and is being used in bad faith as it involves:

- Registration of a well-known/famous trade mark;
- Use of privacy or proxy registration services;
- Misspelling/Typosquatting;
- Attracting internet users for commercial gain by creating a likelihood of confusion with the Complainant.

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

According to Paragraph 4(a) of the Policy, the complainant is required to prove each of the following three elements to obtain an order that a domain name should be transferred or cancelled:

(i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(ii) the respondent has no rights or legitimate interests in respect of the domain name; and

(iii) the domain name has been registered and is being used in bad faith.

The Panel has examined the evidence available to it and has come to the following conclusion concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

CONFUSING SIMILARITY WITH EARLIER RIGHTS

The Complainant has stated that the disputed domain names <BOEHRINGERENGELHEIMPETREBATES.COM>, <BOEHRINGERINGELEHEIMPETREBATES.COM>, <BOEHRINGERINGELGEIMPETREBATES.COM>, <BOEHRINGERINGELHEIMPETREBSTES.COM> and <BOEHRINGERINGERLHEIMPETREBATES.COM> are confusingly similar to its registered trademark BOEHRINGER and BOEHRINGER INGELHEIM and the company name BOEHRINGER INGELHEIM. The disputed domain names contain the Complainant's trademark almost identically.

By registering the disputed domain names with misspellings and the generic addition "pet rebates" also subjected to misspellings, the Respondent has intentionally registered domain names which are confusingly similar to the Complainant’s trademarks. Previous UDRP panels have seen such actions as evidence of bad faith. See for instance Forum case no. FA 877979, Microsoft Corp. v. Domain Registration Philippines: finding bad faith registration and use of the <microssoft.com> domain name as it merely misspelled the complainant’s MICROSOFT mark.

Given the distinctiveness of the Complainant's trademark and its reputation as a globally active company, it is reasonable to infer that the Respondent has registered the disputed domain names with full knowledge of the Complainant's trademarks. It would be an almost unimaginable coincidence if a group of domain names almost identical to the Complainant's trademarks and company name would be registered without such knowledge.

The disputed domain names are confusingly similar to the Complainant’s Trademark, company name and domain. This finding is based on the settled practice in evaluating the existence of a likelihood of confusion of:

a) disregarding the top-level suffix in the domain name (i.e. “.com”);

b) not finding that the exchange of one single letter in a complex word would be sufficient to distinguish a domain name from a trademark, in particular if these letters are themselves highly similar, as in this case where the original letter "I" was

replaced by the letter "E". The difference is almost too small to be noticed; and

c) Disregarding purely generic elements of the disputed domain names such as the word "Pet Rebates" with our without typographical errors in the finding of a likelihood of confusion.

Therefore, the Panel comes to the conclusion that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The onus to make out a prima facie case that the Respondent lacks rights or legitimate interests is placed on the Complainant. However, once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain names. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (see e.g. WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

In this case, the Complainant has stated that the Respondent is not affiliated with him nor authorized by him in any way. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademark, or apply for registration of the disputed domain names by the Complainant. The Complainant does not carry out any activity for, nor has any business with the Respondent.

The Respondent failed to provide any information and evidence whatsoever that could have shown that it has relevant rights or legitimate interests in respect of the disputed domain names (within the meaning of paragraph 4(a) (ii) of the Policy).

Therefore, the Panel concludes that the Respondent did not establish any right or legitimate interest to the disputed domain names (within the meaning of paragraph 4(a)(ii) of the Policy) and comes to the conclusion that the Complainant has satisfied the requirement under paragraph 4(a)(ii) of the Policy.

BAD FAITH

The disputed domain names redirect to a parking page with commercial links. The Respondent has clearly attempted to attract Internet users for commercial gain to his own websites relying on the Complainant’s trademark for its own commercial gain, which is considered evidence of bad faith. (Please see for instance 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.”).

The disputed domain names have been registered and are being used in bad faith as they consist of the registration of a well-known/famous trade mark and a generic term. There is use of privacy or proxy registration services concerning a misspelling respectively typosquatting. The websites are used to attract internet users for commercial gain by creating a likelihood of confusion with the Complainant.

On these grounds it is concluded that bad faith registration within the meaning of paragraph 4(b) of the Policy is established in the present case for the following reasons:

- the Respondent's choice of the term "boehrinqeringelheim" for the disputed domain names, a meaningless term very close to the Complainant's well-known BOEHRINGER INGELHEIM trademarks and company name, was not merely coincidental but was deliberate and in full knowledge of the Complainant's trademarks and company name;

The Respondent is not commonly known by the disputed domain names. Neither is the Respondent in any way related to the Complainant. Nor has the Respondent been granted an authorization or license to use the disputed domain names by the Complainant. This has not been contested by the Respondent.

Therefore, the Panel concludes that the Respondent has registered and is using the disputed domain names in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy). The Complainant has therefore also satisfied the requirement under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOEHRINGERENGELHEIMPETREBATES.COM**: Transferred
2. **BOEHRINGERINGELEHEIMPETREBATES.COM**: Transferred
3. **BOEHRINGERINGELGEIMPETREBATES.COM**: Transferred
4. **BOEHRINGERINGELHEIMPETREBSTES.COM**: Transferred
5. **BOEHRINGERINGERLHEIMPETREBATES.COM**: Transferred

PANELLISTS

Name	**Udo Pfleghar**

DATE OF PANEL DECISION 2020-04-07

Publish the Decision