Decision for dispute CAC-UDRP-102943

Case number	CAC-UDRP-102943
Time of filing	2020-02-25 09:49:57
Domain names	tas-boehringertaleo.net

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

Organization	Anonymize, Inc.

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other pending or decided legal proceedings, which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant bases its Complaint on the International verbal trademark registration “BOEHRINGER”, no. 799761, registered since December 2, 2002, protected for goods and services in classes 01, 03, 05, 10, 16, 30, 31, 35, 41, 42 and 44, designating several countries for protection and also the European Union trademark “BOEHRINGER”, no. 002932853, filed on November 13, 2002, registered on March 2, 2005, for goods and services in classes 1, 3, 5, 10, 16, 30, 31, 41, 42, 44.

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 owns a portfolio of trademarks including the International verbal trademark registration “BOEHRINGER”, no. 799761, registered since December 2, 2002 and the European Union trademark “BOEHRINGER”, no. 002932853, registered since March 2, 2005.

The Complainant’s trademark BOEHRINGER® is distinctive and well-known. Past panels have confirmed the notoriety of the Complainant’s trademark. Please see for instance CAC Case No. 101199, BOEHRINGER INGELHEIM PHARMA GMBH & CO.KG v. Cameron David Jackson <boehringer.xyz> (“Given the notoriety of the Complainant's trademark [BOEHRINGER], it seems impossible for the Respondent to use the domain name in good faith”).

Furthermore, the Complainant is the owner of a numerous portfolio of domain names including the domain name <boehringer-ingelheim.com> registered since September 1, 1995 and <boehringeringelheim.com> registered since July 4, 2004.

The disputed domain name <tas-boehringertaleo.net> has been registered on February 15, 2020 and 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. Please see for instance:

- NAF 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.").

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.”).

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Complainant's contentions are the following:

The disputed domain name <tas-boehringertaleo.net> is confusingly similar to the Complainant's earlier trademark BOEHRINGER. The trademark BOEHRINGER® is reproduced in its entirety.

The Complainant sustains that the addition of the terms TAS” (for “Talent Acquisition & Staffing”) and “TALEO” and a hyphen is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark BOEHRINGER and that, according to other UDRP panels, “a domain name that wholly incorporates a Complainant’s registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP” (WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin).

The Complainant further sustains that, the addition of the terms TAS” (for “Talent Acquisition & Staffing”) and “TALEO”

worsens the likelihood of confusion, as it directly refers to the Complainant's website https://tas-boehringer.taleo.net/ the cloud-based HR platform used by the Complainant for its recruitment.

Moreover, the Complainant contends that the addition of the generic Top-Level Domain suffix ".NET" does not change the overall impression of the designation as being connected to the trademark BOEHRINGER. The Complainant sustains that this does not prevent the likelihood of confusion between the disputed domain name and the Complainant and its trademark.

The Complainant further contends that the Respondent lacks rights or legitimate interests in the disputed domain name for a number of reasons.

First, 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.

Further, the Complainant asserts 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. The Respondent is not a Complainant's licensee, nor has ever been authorised to make use of the Complainant's trademark or to apply for the registration of the disputed domain name.

Lastly, the Complainant points out that the disputed domain name redirects to a parking page with commercial links, which is further evidence of the Respondent's lack of rights or legitimate interests.

The Complainant further argues that the disputed domain name has been registered, and is being used in bad faith.

The Complainant's maintains that its BOEHRINGER trademark is distinctive and well-known trademark, that the Respondent choose to register the domain names to create a confusion with the website https://tas-boehringer.taleo.net/ the cloud-based HR platform used by the Complainant for its recruitment and therefore, that the Respondent has registered and used the disputed domain name with full knowledge of the Complainant's trademark.

Furthermore, the disputed domain name redirects to a parking page with commercial links. The Complainant sustains that 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.

On these bases, the Complainant sustains that the Respondent has registered and is using the disputed domain name in bad faith.

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

I. Confusing Similarity

The Panel agrees that the disputed domain name incorporates the Complainant's earlier BOEHRINGER trademark, that the addition of the terms TAS" (for "Talent Acquisition & Staffing") and "TALEO" and a hyphen is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark BOEHRINGER and that, according to other UDRP panels, "a domain name that wholly incorporates a Complainant's registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP" (WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin).

The Panel agrees that the addition of the terms TAS" (for "Talent Acquisition & Staffing") and "TALEO" worsens the likelihood of confusion, as it directly refers to the Complainant's website https://tas-boehringer.taleo.net/ the cloud-based HR platform used by the Complainant for its recruitment.

Moreover, the extension ".net" is not to be taken into consideration when examining the similarity between the Complainant's trademark and the disputed domain name (WIPO Case No. D2005-0016, Accor v. Noldc Inc.). The mere adjunction of a gTLD such as ".net" is irrelevant as it is well established that the generic Top Level Domain is insufficient to avoid a finding of confusing similarity (WIPO Case No. 2013-0820, L'Oréal v Tina Smith, WIPO Case No. D2008-0820 Titoni AG v Runxin Wang and WIPO Case No. D2009-0877, Alstom v. Itete Peru S.A.).

Therefore, the Panel is satisfied that the first condition under the Policy is met.

II. Lack of Respondent's rights or legitimate interests

The 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 burden of proof shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy.

Based on the available evidence, the Respondent does not appear to be known by the disputed domain name. The Respondent is not a licensee of, nor has any kind of relationship with, the Complainant. The Complainant has never authorised the Respondent to make use of its trademark, nor of a confusingly similar trademark in the disputed domain name.

The disputed domain resolves to redirects to a parking page with commercial links. Such use does not amount to a bona fide offering of goods or services, or to a legitimate non-commercial or fair use of the disputed domain name, as other UDRP panels have found.

The Panel notes that the Respondent had an opportunity to comment on the Complaint's allegations by filing a Response, which the Respondent failed to do.

Thus, the Panel is satisfied that the Complainant has at least established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. Accordingly, the Panel takes the view that also the second requirement under the Policy is met.

III. Bad Faith

The Complainant's trademark is a well-known one as recognized also by past panel and the disputed domain name is incorporating in its entirety the Complainant’s trademark. The Respondent choose to register the domain names to create a confusion with the website https://tas-boehringer.taleo.net/ the cloud-based HR platform used by the Complainant for its recruitment. Therefore, the Panel concludes that at the time of registration of the disputed domain name, the Respondent was well aware of the Complainant’s trademark and has intentionally registered one in order to benefit from the reputation of the Complainant’s trademark.

In the present case, the following factors should be considered:

(i) the Complainant's trademark is a well-known one, being also highly distinctive;

(ii) the Respondent failed to submit any reponse and has not provided any evidence of actual or contemplated good faith use of the disputed domain name;

(iii) the Respondent registered the disputed domain name containing in its entirety a well-know trademark;

(iv) the Respondent has no business relationship with the Complainant, nor was ever authorised to use a domain name similar to the Complainant's trademark; and

(v) the disputed domain name redirects to a parking page with commercial links in order 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.

In light of the foregoing, the Panel concludes that the Respondent has registered and has been using the disputed domain name in bad faith. Thus, also the third and last condition under the Policy is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **TAS-BOEHRINGERTALEO.NET**: Transferred

PANELLISTS

Name	**Delia-Mihaela Belciu**

DATE OF PANEL DECISION 2020-04-09

Publish the Decision