Decision for dispute CAC-UDRP-102959

Case number	CAC-UDRP-102959
Time of filing	2020-03-10 14:00:29
Domain names	boehringeringrlheimpetrebates.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	Boehringer Ingelheim Pharma GmbH & Co.KG

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Organization	Fundacion Comercio Electronico

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided legal proceedings relating to the disputed domain names.

IDENTIFICATION OF RIGHTS

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 since July 2, 1959 and duly renewed, designating several countries and claiming protection for goods in classes 1, 2, 3, 4, 5, 6, 16, 17, 19, 29, 30 and 32.

FACTUAL BACKGROUND

The Complainant is a German family-owned pharmaceutical group of companies with origins dating back to 1885, when it was founded by Albert Boehringer in Ingelheim am Rhein.

Ever since, the Complainant has become a global research-driven pharmaceutical enterprise and has today about 140 affiliated companies worldwide, with approximately 50,000 employees. Its three business areas are "human pharmaceuticals", "animal health" and “biopharmaceuticals”. In 2018, net sales of the Boehringer group of companies amounted to around 17,5 billion Euros.

The Complainant owns multiple domain names including the wording "BOEHRINGER INGELHEIM", among which <boehringer-ingelheim.com>, registered on September 1, 1995, and <boehringeringelheim.com> registered on July 4, 2004.

The disputed domain name has been registered on March 2, 2020 and redirects to a parking page with commercial links.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Complainant contends that the disputed domain name is confusingly similar to its trademark BOEHRINGER-INGELHEIM as the addition of the generic terms "pet rebates" and the substitution of the letter "e" by the letter "r" are insufficient to escape the finding that the disputed domain name is confusingly similar to the Complainant's trademark.

Moreover, the addition of the terms “pet rebates” to the Complainant’s trademark worsens the likelihood of confusion as they directly refer to the Complainant’s website.

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

First, the Respondent is not identified in the Whois database as the disputed domain name.

Second, the Respondent is not affiliated with, nor authorized by, the Complainant in any way. The Complainant does not perform any activity for, nor has any business with the Respondent. The Complainant has not granted a license or authorization to the Respondent to make use of the trademark BOEHRINGER-INGELHEIM, or to apply for the registration of the disputed domain name.

Third, the disputed domain name redirects to a parking page with commercial links; this kind of use cannot amount to a bona fide offering of goods and services, or to a legitimate non-commercial or fair use of the disputed domain name.

Lastly, the Complainant contends that the disputed domain name was registered and is being used in bad faith.

The Complainant’s trademark is distinctive and well known. The Respondent chose to register the disputed domain name to create confusion with the domain name <boehringeringelheimpetrebates.com> used by the Complainant to offer rebates on pet health products.

In light of the foregoing, it is reasonable to infer that the Respondent 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 therefore contends that the Respondent has attempted to attract Internet users to its own website for commercial gain, which is an evidence of 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

1.
The Panel agrees that the disputed domain name is confusingly similar to the Complainant's trademark BOEHRINGER-INGELHEIM. As a matter of fact, the disputed domain name consists of a misspelling of the Complainant's trademark followed by the wording "petrebates" and the gTLD ".com". Despite the misspelling, the Complainant's trademark is fully recognizable within the disputed domain name. The substitution of one letter is certainly not sufficient to exclude similarity, also due to the fact that the Complainant's trademark consists in a long wording. Thus, changing one letter does not affect the overall appearance of the Complainant's trademark. Furthermore, the Complainant's trademark enjoys reputation and is immediately recognizable even with a misspelling.

As far as the addition of the wording "petrebates" is concerned, this addition does not diminish the confusing similarity with the Complainant's trademark. Indeed, this wording merely conveys the meaning that the Internet user may find rebates of pet products on the relevant website. The Complainant has shown that it also operates in the "animal health" field and that one of the companies belonging to its group runs a website under the domain name <boehringeringelheimpetrebates.com>. This website contains rebates on pet health products. Therefore, the addition of the wording "petrebates", rather than diminishing the confusing similarity with the Complainant's trademark enhances it.

As to the gTLD ".com", it is a mere technical requirement and therefore should not be considered in the assessment of confusing similarity.

For all the above-mentioned reasons, the Panel is satisfied that the first condition under the Policy is met.

2.
In assessing the Respondent's lack of rights or legitimate interests in the disputed domain name, the Panel must take into account that proving a negative fact for the Complainant is a difficult, if not almost impossible task. For this reason, it is generally accepted in UDRP proceedings that it is sufficient for the Complainant to establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names to shift the burden of proof to the Respondent.

In the case at issue, the Complainant has stated that it has never licensed its trademark to the Respondent, nor authorised in any other way the Respondent to use its trademark, including to register it (or a confusingly similar sign) as part of a domain name.

Moreover, the Respondent does not appear to have been commonly known by the disputed domain name. The Complainant has shown that at the time of the filing of the Complaint, the disputed domain name led to a parking page containing pay-per-click links. The Respondent is probably deriving some income from these links and this use of the disputed domain name 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 (for similar decisions, see among others, CAC's decision No. 102373, dated April 20, 2019, referring to the domain name <avastsupport.com>; CAC's decision No. 102393, dated April 12, 2019, referring to the domain name <amundi-hk.com>, etc.).

In view of the foregoing and in the absence of any contrary statement by the Respondent, the Panel is satisfied that the second condition under the Policy is met.

3.
In relation to the last condition set forth by the Policy, the Panel notes that the Complainant's trademark is certainly one that enjoys strong reputation, especially in the pharmaceutical field. The reputation of the BOEHRINGER-INGELHEIM trademark has been confirmed in several other prior UDRP decisions such as CAC's decision No. 02274 of January 24, 2019, referring to the domain name <boehrlnger-lngelhelm.com> and CAC's decision No. 102130 of October 2, 2018, referring to the domain

name <boehinger-ingelheim.com>.

The disputed domain name contains a misspelling of the Complainant's trademark and is almost identical to the domain name <boehringeringelheimpetrebates.com>, belonging to one of the companies of the Complainant's group. It is therefore hardly conceivable that the disputed domain name was registered without having in mind the Complainant's trademark.

Furthermore, this Panel has noted that the Respondent has been part of various prior UDRP cases involving the Complainant, for domain names confusingly similar to the Complainant's trademark (see, among others, CAC Cases No. 102945, 102950, 102940, 102929, 102875, 102871 and 102854, all between February and April 2020, and all referring to domain names including the Complainant's well-known trademark, or misspellings of said trademark, followed by the generic terms "petrebates", "rebates" or "equinerebates", while the first CAC case involving the same Respondent and Complainant dates back to 11 December 2019 and refers to a domain name that consisted in a misspelling of the Complainant's trademark).

It is therefore clear that the Respondent was well aware of the Complainant's trademark and acted in bad faith when it applied for the registration of the disputed domain name.

As far as use in bad faith is concerned, the disputed domain name leads to a parking page containing sponsored links, from which the Respondent most probably derives some kind of economic advantage. The Respondent is therefore exploiting a domain name confusingly similar to the Complainant's trademark (and almost identical to the domain name <boehringeringelheimpetrebates.com> belonging to the Complainant), to divert traffic intended for the Complainant’s website to its own, for commercial gain. Such kind of use amounts to use in bad faith even if the pay-per-click links appearing on the websites are "automatically" generated. Indeed, it is well established that a respondent cannot disclaim responsibility for any content appearing on the website associated with its domain name (see in this respect, para. 3.5 of the WIPO Jurisprudential Overview 3.0).

Further evidence of the Respondent's bad faith lies in the fact that this case is one of the many others involving the same parties and the same trademark. The Respondent has therefore targeted the Complainant's well-known trademark and its activity to intentionally attempt to attract, for commercial gain, Internet users to its on-line location, by creating a likelihood of confusion with the Complainant's mark.

For all the aforementioned reasons, the Panel finds that the Respondent registered and used the disputed domain name in bad faith, at least under paragraph 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOEHRINGERINGRLHEIMPETREBATES.COM**: Transferred

PANELLISTS

Name	**Angelica Lodigiani**

DATE OF PANEL DECISION 2020-04-14

Publish the Decision