Decision for dispute CAC-UDRP-102995

Case number	CAC-UDRP-102995
Time of filing	2020-03-27 10:40:23
Domain names	boehringeringeimpetrebates.com, boehringeringelheimpetebates.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 pending or decided legal proceedings that relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

The Complainant submitted evidence that it is the registered owner of the international trademark registrations No. 221544 for "Boehringer-Ingelheim" (word), registered since 2 July 1959 for the classes 01, 02, 03, 04, 05, 06, 16, 17, 19, 29, 30 and 32, designated for numerous countries and No. 568844 for "Boehringer Ingelheim" (word), registered since 22 March 1991 for the classes 01, 02, 03, 04, 05, 09, 10, 16, 30 and 31, designated for numerous countries.

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 is the registered holder of the domain name <boehringer-ingelheim.com> since 1 September 1995 and the

domain name <boehringeringelheim.com> since 4 July 2004. The Complainant has been using the domain name <boehringeringelheimpetrebates.com> to offer rebates on pet health products.

The disputed domain names <boehringeringeimpetrebates.com> and <boehringeringelheimpetebates.com> were registered on 23 March 2020 and resolve to a parking page with commercial links.

The Registrar confirmed that the Respondent is the current registrant of the disputed domain names and that the language of the registration agreement for the disputed domain names is English.

The Respondent has not filed a Response.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Complainant made the following contentions:

The Complainant states that the disputed domain names are confusingly similar to its trademark "BOEHRINGER-INGELHEIM". The disputed domain names incorporate the Complainant's trademark with some misspelling by changing or removing letters and with the addition of the descriptive element "PET REBATES". It does not change the overall impression of the designation as being connected to the Complainant's trademark "BOEHRINGER-INGELHEIM". It does not prevent the likelihood of confusion between the disputed domain names and the Complainant, its trademark and domain names associated.

Besides, the addition of the terms "PET REBATES" worsens the likelihood of confusion, as it directly refers to the Complainant's website https://www.boehringeringelheimpetrebates.com/ .

Moreover, the Complainant asserts that the addition of the generic Top-Level Domain suffix ".COM" does not change the overall impression of the designation as being connected to the trademark "BOEHRINGER-INGELHEIM". It does not prevent the likelihood of confusion between the disputed domain names and the Complainant, its trademark and its domain names associated.

The Complainant also refers the earlier decisions in similar cases, for example CAC Case No. 102854 involving both the Complainant and the Respondent concerning the domain name <boehringerringelheimpetrebates.com> which confirmed the Complainant's rights.

Thus, the Complainant believes that the disputed domain names are confusingly similar to the Complainant's trademark.

Regarding Respondent's rights or legitimate interests, the Complainant points to the decision in the WIPO case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd., according to which 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 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.

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 names by the Complainant.

Furthermore, the disputed domain names resolve to a parking page with commercial links. According to the Complainant, past UDRP panels have found that it is not a bona fide offering of goods or services or legitimate non-commercial or fair use (e.g. Forum No. FA 970871 and WIPO No. D2007-1695).

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.

Turning to the bad faith argument, the Complainant asserts that the disputed domain names are confusingly similar to its trademark "BOEHRINGER-INGELHEIM" and that it is one of the world's 20 leading pharmaceutical companies, with roughly 50,000 employees worldwide and 17,5 million euros in net sales. The Complainant's trademarks "BOEHRINGER-INGELHEIM" are distinctive and well-known. The Complainant states that past UDRP panels have confirmed the notoriety of the trademarks "BOEHRINGER-INGELHEIM" in cases CAC Case No. 102274 and WIPO Case No. D2016-0021.

The Complainant also contends that the Respondent chose to register the disputed domain names to create confusion with the domain name <boehringeringelheimpetrebates.com> used by the Complainant to offer rebates on pet health products.

Consequently, given the distinctiveness of the Complainant's trademarks and its reputation, the Complainant considers it reasonable to infer that the Respondent has registered and used the disputed domain names with full knowledge of the Complainant's trademark.

Furthermore, the Complainant remarks that the disputed domain names resolve to a parking page with commercial links. The Complainant contends the Respondent has attempted 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 pursuant to previous UDRP case law (e.g. CAC Case No. 102872 and CAC Case No. 102854, involving both the Complainant and the Respondent).

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

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 notes that due to the COVID-19 pandemic the written notice of the Complaint was not sent by the CAC because the destination country of the Respondent does not provide delivery services at the moment. According to the CAC, such a procedure was preapproved by ICANN. The Rules for Uniform Domain Name Dispute Resolution Policy require that the Provider employs "reasonably available means calculated to achieve actual notice to Respondent". The Panel believes that if the CAC sent the Complaint only by all means anticipated by Paragraph 2(a)(ii) of the Rules, particularly to the e-mail address identified by the Respondent when registering the disputed domain names, because physical delivery anticipated by Paragraph 2(a)(i) of the Rules is objectively not available at the moment, then the CAC employed "reasonably available means" and satisfied the requirement of the Rules relating to the forwarding of the Complaint to the Respondent.

Therefore, 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

This is a mandatory administrative proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") and the CAC Supplemental Rules.

Paragraph 15 of the Rules provides that the Panel shall decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

According to Paragraph 4(a) of the Policy, a complainant must prove each of the following: (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; (ii) the respondent has no rights or legitimate interests in respect of the domain name; (iii) the domain name has been registered and is being used in bad faith.

A. Identical or confusingly similar

The Complainant demonstrated that it owns the asserted international trademark registrations for the word marks "Boehringer-Ingelheim" and "Boehringer Ingelheim" that were registered long time before the registration of the disputed domain names. It is well established that a nationally or regionally registered trademark confers on its owner sufficient rights to satisfy the requirement of having trademark rights for the purposes of standing to file a UDRP case. Therefore, the Panel finds that the Complainant has established such rights.

It is also well established that the generic top-level suffix .com may be disregarded when considering whether a domain name is identical or confusingly similar to a trademark in which the complainant has rights, as it is a necessary technical requirement of a domain name.

The disputed domain name <boehringeringelheimpetebates.com> incorporates the Complainant's trademark "Boehringer-Ingelheim" in its entirety, whereas the disputed domain name <boehringeringeimpetrebates.com> contains such trademark except that the word Ingelheim is misspelled as the letters "-elh-" (respectively "-lhe-") are missing. In view of the Panel, such misspelling has no effect on finding confusing similarity of the domain name with the respective trademark.

The adding of the terms “PETREBATES” (or its misspelled version "PETEBATES") must be considered as insufficient to prevent or diminish confusing similarity. The Panel agrees with the Complainant that such addition does not change the overall impression of the designation as being connected to the Complainant’s trademarks "Boehringer-Ingelheim" and "Boehringer Ingelheim", particularly given the descriptiveness of the added terms "PET REBATES" and connection with the website for animal product offers of the Complainant. Therefore, such addition cannot prevent the likelihood of confusion between the disputed domain names and the Complainant, its trademark and its associated domain names.

The Panel, therefore, finds that the disputed domain names are confusingly similar to the trademark in which the Complainant has rights.

B. Lack of rights or legitimate interests

The Respondent has not filed a Response and has neither provided any other information that would oppose the Complainant's allegations. Therefore, the Panel holds that the Complainant successfully presented its prima facie case that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

In particular, the Respondent is not in any way connected with the Complainant nor is it authorized to use the Complainant’s trademark for its commercial activities. In addition, the Respondent is not commonly known by the disputed domain names pursuant to Paragraph 4(c)(ii) of the Policy. Furthermore, it was demonstrated by evidence submitted by the Complainant that the disputed domain names have not been used for a bona fide offering of goods or services or a legitimate non-commercial or fair use, particularly because they resolve to parking pages with commercial links (at least at the time of

making the Complaint).

The Panel, therefore, finds that the Respondent has no rights or legitimate interest in the disputed domain names.

C. Registration and use of the disputed domain names in bad faith

With respect to the bad faith argument, the Complainant states, in summary, that the disputed domain names are confusingly similar to its well-known trademarks; that the Respondent had actual knowledge of the Complainant's rights in the trademarks because it chose the disputed domain names to create a confusion with the domain name <boehringeringelheimpetrebates.com> which the Complainant uses to offer rebates on pet health products; and that the disputed domain names resolve to a parking page with commercial links.

The Panel has already found that the disputed domain names are confusingly similar to the Complainant's trademark "Boehringer-Ingelheim" (and "Boehringer Ingelheim"). The Panel believes that the Complainant submitted evidence that sufficiently demonstrates the Respondent must have been aware of the existence of the Complainant, its trademark and its <boehringer-ingelheim.com> and <boehringeringelheimpetrebates.com> domain names. The evidence submitted by the Complainant also shows that, at least upon filing the complaint, the disputed domain names were directed to parking pages with commercial links.

It is well established that mere registration of a domain name that is confusingly similar to a trademark by an unaffiliated entity can lead to the presumption of bad faith. Furthermore, typical circumstances demonstrating respondent's bad faith include a situation where the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location (see Paragraph 4(b)(iv) of the Policy). In view of the Panel, it is beyond any doubt that the disputed domain names are intentionally composed in such manner so that visitors to the Complainant website at <boehringeringelheimpetrebates.com> who misspell the address are redirected to the commercial links at the disputed domain names, ultimately to the commercial gain of the Respondent.

Furthermore, based on its own earlier decision making, the Panel has taken notice of other UDRP cases involving the Complainant and the Respondent that relate to very similar domain names: CAC Cases No. 102959, 102945, 102950, 102940, 102929, 102862, 102875, 102871, 102872, 102854 and 102765 which relate to the total of 24 domain names registered by the Respondent, all of which being a misspelled version of the Complainant's domain name <boehringeringelheimpetrebates.com>. The Panel concludes that the Respondent has clearly been engaged in a pattern of conduct of registering domain names containing the marks of the Complainant.

Taking into account the above-described facts and evidence submitted by the Complainant, the Panel is satisfied that not one but several signs of bad faith in registering and use of the disputed domain names by the Respondent can be found in this case. Therefore, the Panel finds that the disputed domain names have been registered and have been used by the Respondent in bad faith.

In conclusion, the Panel finds that all three elements required by Paragraph 4(a) of the Policy were met and makes the following decision.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOEHRINGERINGEIMPETREBATES.COM**: Transferred
2. **BOEHRINGERINGELHEIMPETEBATES.COM**: Transferred

PANELLISTS

Name	**Mgr. Vojtěch Chloupek**

DATE OF PANEL DECISION 2020-04-21

Publish the Decision