Decision for dispute CAC-UDRP-102988

Case number	CAC-UDRP-102988
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Domain names	boehringergelheimpetrebates.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 legal proceedings.

IDENTIFICATION OF RIGHTS

Complainant is Boehringer Ingelheim Pharma GmbH & Co.KG, a family-owned pharmaceutical group of companies, founded in 1885. Complainant became a global research-driven pharmaceutical enterprise with around 50 000 employees, around the world. Its main fields of activity are related to human pharmaceuticals, animal health and biopharmaceuticals.

Complainant owned several registered trademarks over the world, under the BOEHRINGER-INGELHEIM sign , including:
- The international trademark BOEHRINGER-INGELHEIM n°221544, of July 2, 1959 and duly renewed since then;
- The international trademark BOEHRINGER INGELHEIM n°568844, of March 22, 1991 and duly renewed since then.

Complainant also registered several domain names, such as:
- <boehringer-ingelheim.com> registered on September 1, 1995;
- <boehringeringelheim.com> registered on July 4, 2004.

Respondent did not respond to Complainant’s contentions.

The disputed domain name is <boehringergelheimpetrebates.com> which was registered on March 20, 2020.

FACTUAL BACKGROUND

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

Past Panels have confirmed the Complainant's rights in similar case. Please see CAC Case No. 102854, Boehringer Ingelheim Pharma GmbH & Co.KG v. Fundacion Comercio Electronico <boehringerringelheimpetrebates.com>. ("The domain name is confusingly similar to the protected trademark as a result of : 1. Misspelling/Typosquatting (boehringerringelheimpetrebates.com) with a double r at the end of Boehringer and before Ingelheim; 2. Mark combined with generic term. PET REBATES is a generic term also used by Complainant in its own domain name www.boehringeringelheimpetrebates.com to inform visitors of the website about offers for Pet medicines. On top it also worsens likelihood of confusion, because the addition of the terms "PET REBATES" directly refers to the Complainant's website www.boehringeringelheimpetrebates.com/").

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 paragraph 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy paragraph 4(c)(ii).").

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 noncommercial 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.").

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.").

CAC Case No. 102872, Boehringer Ingelheim Pharma GmbH & Co.KG v. Fundacion Comercio Electronico ("The evidence of use for pay per click links is registration and use in bad faith being a deliberate attempt to divert Internet users for commercial gain under Policy 4 (b)(iv) and disrupting the Complainant's business under Policy 4 (b)(iii).");

CAC Case No. 102854, Boehringer Ingelheim Pharma GmbH & Co.KG v. Fundacion Comercio Electronico ("The Panel has reasons to presume 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.

PARTIES' CONTENTIONS:

COMPLAINANT:

Firstly, Complainant alleges that the disputed domain name is confusingly similar to its BOEHRINGER-INGELHEIM

trademarks. It argues that the deletion of the letters “in” in the term ”ingelheim” is not sufficient to prevent the risk of confusion nor the overall impression of the designation as being linked to Complainant’s trademarks.

It alleges that the addition of the terms “pet rebates” directly refers to its activity and does not prevent the likelihood of confusion. Complainant refers to its website www.boehringeringelheimpetrebates.com, which is similar and prior to the disputed one. Furthermore, the addition of the gTLD “.com” does not change the overall impression of being connected to Complainant.

Secondly, Complainant alleges that Respondent has no rights or legitimate interest in the disputed domain name. It argues that Respondent is not identified as the disputed domain name in the Whois database. It adds that Respondent has not been authorized by nor affiliated to Complainant. In fact, Complainant did not grant any license nor authorization to Respondent.

Furthermore, Complainant points out the fact that the disputed domain name resolves to a parking page with commercial links, that is considered not to be a bona fide offering of goods or services nor a legitimate non-commercial or fair use.

Thirdly, the Complainant considers that the disputed domain name has been registered and is being used in bad faith. It alleges that it is one of the world’s 20 leading pharmaceutical companies and that its BOEHRINGER-INGELHEIM trademarks are distinctive and well-known.

Therefore, it alleges that Respondent chose to register the disputed domain name to create a risk of confusion with Complainant’s website that offers rebates on pet health products. It argues that Respondent registered the domain name with the full knowledge of Complainant’s trademarks.

Complainant also alleges that Respondent attempted to attract customers for commercial gain on its own website, benefiting from Complainant’s reputation, since the disputed domain name points to a website offering commercial links.

RESPONDENT:

Respondent did not reply to Complainant’s contentions.

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

In consideration of the Factual Background, the Parties’ Contentions stated above and its own web searches, the Panel comes to the following conclusions:

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 10 (a) of the Rules provides that the Panel “shall conduct the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and these Rules.“

A. The domain name is identical or confusingly similar to Complainant’s trademarks

Paragraph 4(a)(i) of the Policy requires that the Complainant shows that the disputed domain name is identical or confusingly similar to a name in respect of which a right is recognized or established by the national law of a Member State and/or European Union law.

Complainant has duly shown its registered trademark rights for the “BOEHRINGER-INGELHEIM” mark, as well as its ownership of several domain names incorporating this mark.

Firstly, the disputed domain name reproduces the BOEHRINGER-INGELHEIM trademark almost identically. It only deletes the letters “in” at the beginning of the term “ingelheim”. This removal does not dismiss the risk of confusion.

Furthermore, the disputed domain name adds to Complainant’s BOEHRINGER-INGELHEIM trademark the terms “pet rebates” which directly refer to one of the main Complainant’s area of activity.

Secondly, it is commonly established that the addition of a gTLD <.com> does not prevent any likelihood of confusion but has to be considered as a technical element, which has to be disregarded. See for example CAC Case No. 102395 “the generic Top-Level Domain (“gTLD”) suffix (“.com” in this particular instance) should be totally disregarded”.

Therefore, the Panel finds the disputed domain name to be confusingly similar to Complainant’s trademarks.

To the satisfaction of the Panel, Complainant has shown that the disputed domain name is confusingly similar to a trademark or service trademark in which it has rights. The requirement of Paragraph 4(a)(i) of the Policy is therefore met.

B. The domain name has been registered without rights or legitimate interests in the name

Pursuant Paragraph 4(a)(ii) of the Policy, the Complainant is required to prove that the disputed domain name has been registered without rights or legitimate interests in the name.
Complainant is required to make a prima facie case showing that Respondent lacks the rights and legitimate interests in the disputed domain name. If the prima facie case is successful, then the burden of proof shifts to the Respondent.

Complainant has duly shown that it did not provide any license nor authorization to Respondent, to use its trademarks and to register the disputed domain name. Furthermore, Respondent is not known by the disputed domain name. It, therefore, had no rights or legitimate interests in the disputed domain name.

The Panel finds that Complainant has made a prima facie case showing that Respondent has no right or legitimate interests in the “BOEHRINGER-INGELHEIM” sign,

Furthermore, the fact that Respondent did not answer to Complainant’s contentions is commonly considered as an evidence of this second required condition. In fact, if Respondent had rights or legitimate interests in Complainant’s trademarks, it would have at least tried to convince the Panel. See for example CAC Case No. 102988 that used this argument to establish the second requirement, “The Respondent has not come forward to rebut the Complainant’s assertion in this regard.”.

To the satisfaction of the Panel, Complainant has proven that Respondent has no rights or legitimate interests in respect of the disputed domain name. The requirement of Paragraph 4(a)(ii) of the Policy is therefore met.

C. Bad faith

Pursuant Paragraph 4(a)(iii) of the Policy, the Complainant is required to prove that the disputed domain name has been registered or that is being used in bad faith.

Firstly, Complainant has duly shown the global reputation of its trademarks. Complainant registered its official domain name and its trademarks many years before Respondent registered the disputed domain name.

Panel considers that Respondent could not have ignored Complainant when registering the disputed domain name. A simple internet search on the sign “BOEHRINGER-INGELHEIM” gives many results related to Complainant. Furthermore, even an Internet research on the terms “boehringer gelheim” also points to Complainant.

Therefore, it is clear that Respondent registered the domain name in bad faith, being fully aware of Complainant’s existence and Complainant’s trademarks.

Secondly, Complainant has duly proven that Respondent is using the disputed domain name in bad faith. In fact, Respondent reproduces Complainant’s trademark in a similar way in the disputed domain name with the addition of terms related to Complainant’s activity. Panel thus considers Respondent tried to benefit from Complainant’s reputation.

Furthermore, the disputed domain name points to a parking website with commercial links. This is clear that it is using the domain name in bad faith and with the intention to disturb Internet users and Complainant’s customers for commercial gain. See for example, CAC Case No. 102374 : “Respondent’s use of the disputed domain name for a parking page is in itself sufficient to support a finding of bad faith use as Respondent is intentionally attempting to attract Internet users to its website for commercial gain, and is thus creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of Respondent’s website, in accordance with paragraph 4(b)(iv) of the Policy”.

To the satisfaction of the Panel, Complainant has proven that the disputed domain name was registered and is being used in bad faith. The requirement of Paragraph 4(a)(iii) of the Policy is therefore met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOEHRINGERGELHEIMPETREBATES.COM**: Transferred

PANELLISTS

Name	**Nathalie Dreyfus**

DATE OF PANEL DECISION 2020-04-29

Publish the Decision