Decision for dispute CAC-UDRP-103010

Case number	CAC-UDRP-103010
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Domain names	boehringeringelheimpetrebatrs.com

Case administrator

Name	Šárka Glasslová (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 other proceedings related to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant (Boehringer Ingelheim Pharma GmbH & Co.KG) is the owner of several registered trademarks for the term “BOEHRINGER INGELHEIM” including the international trademark no 221544 “BOEHRINGER INGELHEIM” registered since 1959. The Complainant further owns the domain names <boehringer-ingelheim.com> since 1995 and <boehringeringelheim.com> registered since 2004.

The disputed domain name <boehringeringelheimpetrebatrs.com> was registered on 6 April 2020.

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.

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 2nd, 1959 and duly renewed.

Furthermore, the Complainant owns multiple domain names consisting in the wording “BOEHRINGER INGELHEIM”, such as <boehringer-ingelheim.com> since 1995 and <boehringeringelheim.com> registered since 2004.

The disputed domain name was registered on April 6th, 2020 and redirects to a parking page with commercial links both related and unrelated to the Complainant.

I. Domain name is confusingly similar to the protected mark

The Complainant states that the disputed domain name is confusingly similar to its trademark BOEHRINGER-INGELHEIM®. Indeed, the disputed domain name includes the trademark BOEHRINGER-INGELHEIM® in its entirety and adds the “.com” gTLD. 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.

On the contrary, 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 contends 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 name and the Complainant, its trademark and its domain names associated.

Thus, the disputed domain name is confusingly similar to the Complainant’s trademark.

II. The Respondent does not have any rights or legitimate interest in the domain name(s)

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 UDRP.

The Complainant asserts that the Respondent is not identified in the Whois database as the disputed domain name owner. 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 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 name 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.

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

III. The domain name(s) has been registered and is being used in bad faith

The Complainant 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 trademark BOEHRINGER-INGELHEIM® is distinctive and well-known. Past Panels have confirmed the notoriety of the Complainant's trademarks in several UDRP cases.

Besides, the Complainant contends that the Respondent choose to register the disputed domain name to create a confusion with domain name <boehringeringelheimpetrebates.com>, used by the Complainant to offer rebates on pet health products.

Consequently, given the distinctiveness of the Complainant's trademark and its reputation, it is reasonable to infer that the Respondent has registered and used the 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 contends the Respondent has attempted to attract Internet users to his own website thanks to the Complainant's trademark for its own commercial gain, which is an evidence of bad faith.

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

The Complainant therefore requests the disputed domain name to be transferred to the Complainant.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.

The Complainant has established the fact that it has valid rights for the international trademark No 221544 "BOEHRINGER-INGELHEIM" registered since 1959, and that it uses domain names <boehringer-ingelheim.com> and <boehringeringelheim.com> that include the trademark "BOEHRINGER-INGELHEIM". The disputed domain name has been registered on 6 April 2020, i.e. more than 60 years after the trademark registration.

The first element of the disputed domain name (BOEHRINGER-INGELHEIM) fully corresponds to the Complainant's trademark. Two words of the trademark are divided by the hyphen while the hyphen is not present in the disputed domain name. However, the hyphen from the trademark is often deleted when the designation is going to be used in domain name and the absence of the hyphen, therefore, does not distinguish the disputed domain name from the Complainant's trademark.

The second element of the disputed domain name ("PETREBATRS") is not presented within the Complainant's trademark. The Panel is not aware of any reasonable meaning of this term, but the Complainant's possible explanation that this term corresponds to PET REBATES used within the Complainant's domain name <boehringeringelheimpetrebates.com> could be accepted. The addition of the meaningless term "PETREBATRS" does not change the overall impression of the designation as being connected to the Complainant and its trademark and more likely strengthens the likelihood of confusion between the disputed domain name and Complainant's trademark or its service granting the rebates as promoted on the domain name <boehringeringelheimpetrebates.com>. Furthermore, the addition of the generic top level domain ".COM" does not change the overall impression of the designation as being connected to Complainant's trademark.

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is confusingly similar to the Complainant's trademark "BOEHRINGER-INGELHEIM" in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that (ii) the respondent has no rights or legitimate interests in respect of the domain name.

The Complainant has established a prima facie case (not challenged by the Respondent who did not filed any response to the complaint) that the Respondent has no rights or legitimate interests in the disputed domain name, since the Respondent is not related in any way with the Complainant and there is no indication that the Respondent is commonly known by the term "BOEHRINGER-INGELHEIM" or that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services.

The Respondent used the proxy service (Domains By Proxy, LLC) to hide its identity in the WHOIS service and even after the disclosure its identity (Fundacion Comercio Electronico) during this ADR proceedings, there is no indication that the Respondent is commonly known by the term "BOEHRINGER-INGELHEIM".

Moreover, the disputed domain name resolves to a parking web page with the commercial links and the disputed domain name, therefore, does not constitute a bona fide offering of goods and services or a legitimate noncommercial fair use.

The Panel therefore considers that 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

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that (iii) the domain name has been registered and is being used in bad faith.

The Respondent has registered the disputed domain name which consists the full content of the Complainant's trademark "BOEHRINGER-INGELHEIM" and misspelled words "PETREBATRS" that refers to the term "PET REBATES" used by the Complainant in one of his domain names. The Complainant's trademark is highly distinctive, corresponds to the name of the Complainant and is widely known for tens of years as proved by the Complainant.

As the Complainant is active in manufacturing and distributing animal health products, and indeed operates a website at the domain name <boehringeringelheimpetrebates.com> through which it offers rebates (retrospective discounts) to customers who have bought animal (pet) health products, it is not difficult to find that the misspelled text "PETREBATRS" refers to the "PET REBATES" used by the Complainant together with its trademark (see similar case CAC No. 102871 Boehringer Ingelheim Pharma GmbH & Co.KG v. Fundacion Comercio Electronico <boehringeringlheimpetrebates.com>).

It could be therefore concluded that the Respondent had or should have the Complainant and its trademark in mind when registering the disputed domain name.

Furthermore, the disputed domain name redirects to a parking page with commercial links and the Respondent, therefore, use the disputed domain name to attract the internet users to such parking page for commercial gain by creating a likelihood of confusion with the Complainant's trademark (paragraph 4(b)(iv) of the Policy).

Moreover, the Respondent (Fundacion Comercio Electronico) has been involved in several other attempts to disrupt the Complainant's activities. The Panel explicitly refers to the above mentioned CAC case No. 102871 and further CAC Cases No. 102854,102862, 102872,102875, 102929, 102940, 102945, 102950, 102959, 102969, 102988 and 102995 with the disputed domain names containing the terms BOEHRINGER INGELHEIM and PET REBATES or theirs misspelled variants.

The Respondent has therefore been engaged in a pattern of conduct of registering domain names containing the Complainants mark and such activities of the Respondent meet the requirements set out in paragraph 4(b)(ii) of the Policy (registering a domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the Respondent has] engaged in a pattern of such conduct).

Considering the (i) similarity between the Complainant's trademark and the disputed domain name, (ii) resolving of the

disputed domain name to the parking webpage only, (iii) distinctiveness of the Complainant's trademark, (iv) the failure of the Respondent to submit a response or to provide any evidence of good faith use and (v) several other attempts to disrupt the Complainant's activities, the Panel finds that the disputed domain name has been registered and is being used in bad faith.

Thus 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

The Panel considers that the Complainant has shown that the disputed domain name <boehringeringelheimpetrebatrs.com> is confusingly similar to a trademark in which the Complainant has rights, the Respondent has no rights or legitimate interests in respect of the disputed domain name and the disputed domain name has been registered and is being used in bad faith. The Complainant has thus established all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOEHRINGERINGELHEIMPETREBATRS.COM**: Transferred

PANELLISTS

Name	**JUDr. Petr Hostaš**

DATE OF PANEL DECISION 2020-05-12

Publish the Decision