Decision for dispute CAC-UDRP-103018

Case number	**CAC-UDRP-103018**
Time of filing	**2020-04-20 09:02:32**
Domain names	**boehringeringelheimprtrebates.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 proceedings, pending or decided, which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant owns a large portfolio of trademarks including the terms “BOEHRINGER” and “INGELHEIM” in several countries, such as the international trademarks BOEHRINGER-INGELHEIM no. 221544, registered since July 02, 1959 and BOEHRINGER INGELHEIM, registered since March 22, 1991.

The Complainant also owns domain names consisting of the words “BOEHRINGER INGELHEIM”, such as <boehringeringelheim.com> registered since July 04, 2004, and <boehringeringelheimpetrebates.com>.

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 2019, net sales of the Boehringer group amounted to about EUR €18,997 million.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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

Administrative Deficiencies

By notification dated April 20, 2020 and in accordance with Paragraph 4(d) of the Rules, the CAC notified the Complainant that it was administratively deficient in that it had not sufficiently identified the Respondent.

The CAC directed the Complainant to have regard to the Registrar's verification available in the online case file in the form of a non-standard communication regarding the appropriate identification of the domain name holder.

The CAC requested the Complainant correct the administrative deficiency and submit an Amended Complainant.

On April 20, 2020 the Complainant filed an Amended Complaint and the CAC determined that the Complaint could proceed by way of Administrative Proceeding.

The Panel considers that the administrative deficiency has now been corrected with the identification of the domain name holder as the proper Respondent.

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 and accordingly, this matter can proceed to be considered by the Panel in accordance with the Policy and the Rules.

PRINCIPAL REASONS FOR THE DECISION

A. Introduction

This is a Mandatory Administrative Proceeding under paragraph 4 of the Uniform Domain Name Dispute Policy (Policy or UDRP) of the Internet Corporation for Assigned Names and Numbers (ICANN), and the Procedural Rules for Uniform Domain Dispute Resolution (Rules) including the Czech Arbitration Centre (CAC) UDRP Supplementary Rules.

B. Substantive Matters

The Complainant has filed a complaint with supporting evidence disputing the registration of the domain name <boehringeringelheimprtrebates.com> (the disputed domain name) by the Respondent.

The disputed domain name was registered on April 14, 2020, and redirects to a parking page with commercial links.

The Respondent has not filed any administratively compliant response or any materials in response to the Complaint by the deadline set out under the Rules.

Paragraph 15(a) of the Rules provides:

A Panel shall decide a complaint based on the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

Accordingly, the Complainant carries the onus to prove its case.

Paragraph 4(a) of the Policy lists three elements that the Complainant must prove to merit a finding that the disputed domain name registered by the Respondent be transferred to the Complainant:

(i) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) The Respondent has no right or legitimate interests in respect of the disputed domain name; and

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

The Panel is satisfied the Complainant has satisfied all three elements for the principal reasons set out below.

Taking each of these elements in turn:

PARAGRAPH 4(a)(i) - RIGHTS IN AN IDENTICAL OR CONFUSINGLY SIMILAR TRADEMARK

To prove this element, the Complainant must have trademark rights and the disputed domain name must be identical or confusingly similar to the Complainant's trademarks.

The Complainant has adduced evidence that it is the owner of the relevant trademarks and domain name set out in the Identification of Rights section above.

The Panel notes that the Complainant's trademarks and domain names predate the registration of the disputed domain name. In particular, the Complainant's trademark BOEHRINGER-INGELHEIM has been registered for over 60 years.

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's trademarks as the disputed domain name <BOEHRINGERINGELHEIMPRTREBATES.COM> is reproduced in its entirety with the Complainant's well-known trademark 'BOEHRINGER-INGELHEIM' (except for the punctuation mark, the 'dash') with the mere addition of generic terms 'PRT REBATES'.

The Complainant contends the addition of the generic terms:

- does not change the overall impression of the designation as being connected to the Complainant's trademark BOEHRINGER-INGELHEIM.
- does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademarks and domain names associated with it.

The Panel considers that the addition of the terms 'PRT REBATES' does not distinguish the disputed domain name from the Complainant's 'BOEHRINGER-INGELHEIM' trademark. The Panel accepts that these mere additions do not alter the underlying meaning of a domain name and therefore accepts the Complainant's contention.

The Complainant further contends that the addition of the terms 'PRT REBATES' worsens the likelihood of confusion, as it directly refers to the Complainant's website <boehringeringelheimpetrebates.com>.

The Panel also considers that when a domain name wholly incorporates a complainant's registered trademark, it is sufficient to establish identity or confusing similarity for the purposes of the Policy. See Oki Data Americas, Inc. v. ASD, Inc, WIPO Case No. D2001-0902; Dr. Ing. h.c. F. Porsche AG v Vasiliy Terkin, WIPO Case No D2003-003-0888.

Additionally, the Panel considers the suffix '.COM' to be irrelevant when assessing whether a domain name is identical or confusingly similar to a trademark. This is because gTLDs are only required for the functionality of a website.

On the evidence adduced by the Complainant as to the extensive use of its trademarks, the Complainant enjoys a high degree of reputation and notoriety worldwide.

Although no evidence of actual confusion has been provided by the Complainant, the Panel, having reviewed the evidence of reputation in support of the Complainant's case, is satisfied that the disputed domain name is likely to cause confusion amongst Internet users given the nature and wide use of the Complainant's trademarks in the classes of goods or services in which they are registered.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks and that paragraph 4(a)(i) of the Policy is satisfied.

PARAGRAPH 4(a)(ii) - NO RIGHTS OR LEGITIMATE INTERESTS

The burden of proof is on the Complainant to establish that the Respondent lacks rights or legitimate interests in the disputed domain name.

Under the Policy, if a prima facie case is established by the Complainant, then the burden of production of evidence shifts to the Respondent to demonstrate that it has rights or legitimate interests in the disputed domain name. See Document Technologies, Inc. v. International Electronic Communications Inc., WIPO Case No. D2000-0270; Belupo d.d. v. WACHEM d.o.o., WIPO Case No. D2004-0110; Croatia Airlines d. d. v. Modern Empire Internet Ltd, WIPO Case No. D2003-0455; Audi AG v. Dr. Alireza Fahimipour, WIPO Case No. DIR2006-0003.

The Complainant advances three contentions in support of this ground:

(a) The Respondent is not identified in the WHOIS database as the disputed domain name and relies on past panel decisions that a respondent was not commonly known by a disputed domain name if the WHOIS information was not similar to the disputed domain name. In support of this contention, the Complainant cited the panel decision in NAF Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com>;

(b) The Complainant has not granted the Respondent any authorization nor licence to make use of the Complainant's trademark BOEHRINGER-INGELHEIM;

(c) The Respondent is not making a legitimate non-commercial or fair use of the disputed domain name as it is redirected to a parking page with commercial links. In support of this contention, the Complainant cited the panel decisions in NAF Case No. FA 970871, Vance Int'l, Inc. v. Abend, and WIPO Case No. D2007-1695, Mayflower Transit LLC v. Domains by Proxy Inc./Yariv Moshe.

As the Respondent has failed to submit any administratively compliant response or attempt to demonstrate any rights or legitimate interests in the disputed domain name, the Panel accepts the Complainant's contentions.

Accordingly, the Panel draws an adverse inference from the Respondent's failure to respond, in accordance with paragraph 14(b) of the Rules.

The Panel finds that:

- In respect to (a) above, the Panel accepts the Complainant's contention that the Respondent is not commonly known by the disputed domain name.
- In respect to (b) above, the Panel accepts that the Complainant did not grant the Respondent any authorization nor licence to use the Complainant's trademarks in the disputed domain name.
- In respect to (c) above, the Panel accepts, on its face, the Respondent is not making a legitimate non-commercial or fair use of the disputed domain name.

By the lack of any administratively compliant response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of <boehringeringelheimprtrebates.com> and that paragraph 4(a)(ii) of the Policy is satisfied.

Accordingly, any use by the Respondent of the disputed domain name that incorporates the Complainant's trademark 'BOEHRINGER-INGELHEIM' or 'BOEHRINGER INGELHEIM' is not authorized and therefore likely to be an infringement of the Complainant's legal rights.

PARAGRAPH 4(a)(iii) - BAD FAITH

For the purposes of paragraph 4(a)(iii), paragraph 4(b) of the Policy states that any of the following circumstances shall be considered evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that the Respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the complainant who is the owner of the trademark or service mark to a competitor of that complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain name; or

(ii) the Respondent has registered the disputed 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; or

(iii) the Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's web site or other on-line location, by creating a likelihood of confusion with the complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent's web site or location or of a product or service on the Respondent's web site or location.

The Complainant advances two contentions in support of this ground:

(a) The disputed domain name was registered in bad faith with full knowledge of the Complainant's trademarks, which are distinctive, well-known, and have worldwide reputation and notoriety.

(b) The disputed domain name is being used in bad faith as it creates confusion with the Complainant's domain name <boehringeringelheimpetrebates.com> used by the Complainant to offer rebates on pet health products. This is evidenced

by the disputed domain name being redirected to a parking page with commercial links.

The Panel also considers that the addition of the terms ‘PRT REBATES’ by the Respondent is a play on the Complainant’s terms ‘PET REBATES’ that are added to its domain name incorporating its trademark. The subtle change of the alphabet ‘E’ to ‘R’ in a long domain name is likely to not only cause confusion with the Complainant’s trademarks but likely to create the impression to a user that the disputed domain name is referable to the Complainant's website or business.

Accordingly and in all the circumstances by reference to the evidence submitted by the Complainant and the inferences to be drawn from the Respondent’s failure to submit an administratively compliant response, the Panel considers that the registration and use of the disputed domain name were in bad faith, and paragraph 4(a)(iii) of 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. **BOEHRINGERINGELHEIMPRTREBATES.COM**: Transferred

PANELLISTS

Name	**Professor William Lye, OAM QC**

DATE OF PANEL DECISION 2020-05-21

Publish the Decision