Decision for dispute CAC-UDRP-103009

Case number	CAC-UDRP-103009
Time of filing	2020-04-09 10:33:05
Domain names	boehringeringheimpetrebates.com, boehringerlinglheimequinerebates.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 legal proceedings which are pending or decided and which relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following trademark registrations for the sign BOEHRINGER INGELHEIM (the "BOEHRINGER INGELHEIM trademark"):

- the International trademark BOEHRINGER-INGELHEIM with registration No. 221544, registered on July 2, 1959 for goods in International Classes 1, 2, 3, 4, 5, 6, 16, 17, 19, 29, 30 and 32; and

- the International trademark BOEHRINGER INGELHEIM with registration No. 568844, registered on March 22, 1991 for goods in International Classes 1, 2, 3, 4, 5, 9, 10, 16, 30 and 31.

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, the Complainant has become a global research-driven

pharmaceutical enterprise and today is one of the world's 20 leading pharmaceutical companies with about 50,000 employees. Its three business areas are human pharmaceuticals, animal health and biopharmaceuticals. In 2018, the net sales of the BOEHRINGER INGELHEIM group amounted to about EUR 17.5 billion.

The Complainant maintains official websites at the domain names <boehringer-ingelheim.com> and <boehringeringelheim.com>.

The disputed domain names were registered on April 3, 2020 and resolve to parking pages with commercial pay-per-click links.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant states that the disputed domain names are confusingly similar to its BOEHRINGER INGELHEIM trademark, as they incorporate the trademark with some misspelling by changing or removing letters and with the addition of the descriptive elements "pet rebates" or "equine rebates", which do not change the overall impression of the disputed domain names as being connected to the Complainant's BOEHRINGER INGELHEIM trademark and do not prevent the likelihood of confusion between the disputed domain names and the Complainant, its trademarks and domain names. The addition of the terms "pet rebates" worsens the likelihood of confusion, as it directly refers to the Complainant's website at www.boehringeringelheimpetrebates.com.

The Complainant contends that the Respondent has no right or legitimate interest in respect of the disputed domain names, because the Respondent is not commonly known by the disputed domain names and is not affiliated with the Complainant, and the Complainant has not authorized the Respondent to use the Complainant's BOEHRINGER INGELHEIM trademark or to register the disputed domain names. According to the Complainant, the disputed domain names resolve to parking pages with commercial links, which is not a bona fide offering of goods or services or legitimate non-commercial or fair use.

The Complainant contends that the disputed domain names were registered and are being used in bad faith. According to the Complainant, the Respondent chose to register the disputed domain names to create a confusion with the Complainant's domain name <boehringeringelheimpetrebates.com>, used by the latter to offer rebates on pet health products. Given the distinctiveness of the BOEHRINGER INGELHEIM trademark and its reputation, it is reasonable to infer that the Respondent has registered and used the disputed domain names with full knowledge of the trademark. The disputed domain names resolve to parking pages with commercial links, and the Respondent is involved in a pattern of conduct by which it attempts to attract Internet users for commercial gain to its own website exploiting the reputation of the Complainant and its BOEHRINGER INGELHEIM trademark for commercial gain. The Complainant points out that a similar conduct of the Respondent against the Complainant was found in CAC Case No.102872, Boehringer Ingelheim Pharma GmbH & Co.KG v. Fundacion Comercio Electronico, and in CAC Case No.102854, Boehringer Ingelheim Pharma GmbH & Co.KG v. Fundacion Comercio Electronico.

RESPONDENT:

The Respondent did not reply to the Complainant's contentions and did not submit any arguments or evidence in its defence.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 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

Pursuant to the Policy, paragraph 4(a), a complainant must prove each of the following to justify the transfer of a domain name:
(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; and
(iii) the respondent has registered and is using the domain name in bad faith.

In this case, the Provider has employed the required measures to achieve actual notice of the Complaint to the Respondent, and the Respondent was given a fair opportunity to present its case.

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: "[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name …"

In this proceeding, the Respondent has not used the opportunity provided to it under the Rules and has not submitted a substantive Response addressing the contentions of the Complainant and the evidence submitted by it.

Identical or confusingly similar

The Complainant has provided evidence and has thus established its rights in the BOEHRINGER INGELHEIM trademark.

The Panel notes that a common practice has emerged under the Policy to disregard in appropriate circumstances the general Top-Level Domain ("gTLD") section of domain names for the purposes of the comparison under the Policy, paragraph 4(a)(i). The Panel sees no reason not to follow the same approach here, so it will disregard the ".com" gTLD section of the disputed domain names.

The relevant parts of the disputed domain names are therefore the sequences "boehringeringheimpetrebates" and "boehringerlinglheimequinerebates". As pointed out by the Complainant, these sequences reproduce a mistyping of the BOEHRINGER INGELHEIM trademark in combination with the dictionary words "pet", "rebates" and "equine". The BOEHRINGER INGELHEIM trademark is easily recognized in each of the disputed domain names, and the addition of the dictionary terms mentioned above does not preclude a finding of confusing similarity between the BOEHRINGER INGELHEIM trademark and the disputed domain names.

Taking all the above into account, the Panel finds that the disputed domain names are confusingly similar to the BOEHRINGER INGELHEIM trademark in which the Complainant has rights.

Rights and legitimate interests

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of "proving a

negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain names, because it is not commonly known by the disputed domain names, is not associated to the Complainant and has not been authorized by the Complainant to use the BOEHRINGER INGELHEIM trademark. According to the Complainant, the Respondent is not using the disputed domain names in connection with a bona fide offering of goods or services, but for websites containing commercial pay-per-click links. Thus, the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names.

The Respondent has not submitted a Response and has not alleged that it has rights and legitimate interests in the disputed domain names; it has not disputed the Complainant's allegations and evidence in this proceeding.
The disputed domain names are confusingly similar to the Complainant's BOEHRINGER INGELHEIM trademark. As submitted by the Complainant, they contain dictionary words that may mislead Internet users to believe that the disputed domain names refer to websites authorized by the Complainant and make them confusingly similar to the Complainant's domain name <boehringeringelheimpetrebates.com>, used by the latter to offer rebates on pet health products. The Respondent has not provided any plausible explanation why it has chosen and registered the disputed domain names and has then associated them with websites that feature commercial pay-per-click links.

All the above leads the Panel to the conclusion that it is more likely than not that the Respondent, being aware of the goodwill of the Complainant an of the BOEHRINGER INGELHEIM trademark, has registered the disputed domain names in an attempt to exploit this trademark's goodwill for financial gain. In the Panel's view, such activity is not legitimate and does not give rise to rights and legitimate interests in the disputed domain names.

Therefore, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain names.

Bad faith

Paragraph 4(b) of the Policy lists four illustrative alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

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

(ii) you have registered the 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location."

As discussed above, the disputed domain names are confusingly similar to the BOEHRINGER INGELHEIM trademark and have resolved to commercial websites that feature third party commercial pay-per-click links.

As submitted by the Complainant, the Parties have already been involved in two other proceedings under the Policy where

the Respondent has been found to have registered and used in bad faith other domain names confusingly similar to the BOEHRINGER INGELHEIM trademark.

Taking the above into account, the Panel accepts that the Respondent has registered the disputed domain names with knowledge of the Complainant and targeting the BOEHRINGER INGELHEIM trademark in an attempt to extract commercial gain by misleading Internet users that these websites have been authorized by the Complainant and by exposing them to third party commercial pay-per-click links. In addition, the evidence shows that the Respondent has been involved in a pattern of conduct targeting the Complainant and its BOEHRINGER INGELHEIM trademark in bad faith. This satisfies the Panel that the Complainant has established that the Respondent has registered and used the disputed domain names in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOEHRINGERINGHEIMPETREBATES.COM**: Transferred
2. **BOEHRINGERLINGLHEIMEQUINEREBATES.COM**: Transferred

PANELLISTS

Name	**Assen Alexiev**

DATE OF PANEL DECISION 2020-06-02

Publish the Decision