Decision for dispute CAC-UDRP-103132

Case number	CAC-UDRP-103132
Time of filing	2020-06-23 11:02:59
Domain names	boehringerheimpetrebates.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (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 unaware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

US TM Registration No. 0641166 BOERHRINGER-INGELHEIM for various medicinal preparations in class 18 with a priority date of 11 January 1956.

EU TM Registration No. 002932853 BOEHRINGER for various goods (including veterinary preparations) and services in classes 1, 3, 5, 10, 16, 30, 31, 41, 42 and 44 with a priority date of 13 November 2002.

FACTUAL BACKGROUND

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

The Complainant is part of a family-owned pharmaceutical group of companies founded by Albert Boehringer in Ingelheim am Rhein in 1885. This group has traded as BOEHRINGER INGELHEIM since this time and has become a global research-driven pharmaceutical enterprise that today employs approximately 50,000 people. The three business areas of BOEHRINGER INGELHEIM are human pharmaceuticals, animal health and biopharmaceuticals. In 2019, net sales of the BOEHRINGER INGELHEIM group amounted to about EUR 18,997 million.

The Complainant asserts, and it is not contested, that it owns a large portfolio of trade marks including the terms BOEHRINGER and BOEHRINGER-INGELHEIM. This includes the EU TM Registration mentioned above. However save for that EU TM Registration and extracts evidencing Madrid filings it does not provide documentary evidence of any national registrations to support its claim. Nevertheless, as set out below, such omission has not affected the Panel's decision.

The Complainant also owns multiple domain names. Notably, this includes the domain name <boehringeringelheimpetrebates.com> that has been registered and used since 14 August 2019. That domain name resolves to a website operated by the Complainant in which it offers "rebates" on "pet" or veterinary products produced by it. The Complainant provided evidence of this website.

The disputed domain name <boehringerheimpetrebates.com> was registered on 15 June 2020 and resolves to what appears to be a parking page with pay-per-click links. The first heading on the page is titled "Boehringer Ingelheim" in plain text.

The disputed domain name was originally registered in the name of a privacy service. However on 18 June 2020 the Registrar of the disputed domain name informed the Czech Arbitration Court that the true registrant had provided their name as Carolina Rodrigues of Fundacion Comercio Electronico.

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

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

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:

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

2) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

3) the disputed domain name has been registered and is being used in bad faith.

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

RIGHTS IN AN IDENTICAL OR CONFUSINGLY SIMILAR TRADEMARK

As mentioned above the Complainant asserts it has a number of trademark registrations consisting of the words BOERHRINGER-INGELHEIM. At least one of these registrations predates the registration date of the disputed domain name by over a 60 years.

To satisfy paragraph 4(a)(i) of the Policy it is enough that the Panel is satisfied that the Complainant has registered rights in a trademark that predates the registration of the disputed domain name in a single jurisdiction (even if that single jurisdiction is not one in which the Respondent resides or operates) (Koninklijke KPN N.V. v. Telepathy, Inc D2001-0217 (WIPO May 7, 2001); see also WIPO Case Nos. D2012-0141 and D2011-1436). The Complainant has clearly satisfied such in relation to the trademark BOERHRINGER-INGELHEIM.

It is noted that the above mentioned US trademark registration was not specifically evidenced in the annexures to the Complaint. However the Complaint did have sufficient uncontested claims of registrations in multiple jurisdictions to make it proper for the Panel to review the USPTO database, which it did in exercising its powers under Rule 10(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules").

The next question is whether the disputed domain name is confusingly similar to the BOERHRINGER-INGELHEIM trademark.

The Panel disregards the gTLD suffix ".com" for the purpose of this comparison. It is of no brand significance and it is likely to be totally ignored by web users. Such web users are likely to focus entirely on the only distinctive element in the disputed domain name, being the BOEHRINGERHEIMPETREBATES element.

This BOEHRINGERHEIMPETREBATES element differs only from the BOERHRINGER-INGELHEIM trademark by way of the absence of a hyphen, the absence of INGEL, and the addition of the descriptive words PETREBATES. It is further noted that the INGEL element is located in the middle of the trademark. Its absence is less noticeable that the if it were located at the beginning or end of the domain name. Hence there is a very high degree of similarity between BOEHRINGERHEIMPETREBATES and BOERHRINGER-INGELHEIM.

The disputed domain name is therefore confusingly similar to the BOERHRINGER-INGELHEIM trademark.

NO RIGHTS OR LEGITIMATE INTERESTS

The Respondent's name according to information provided by the registrar for the disputed domain name is "Carolina Rodrigues" from the organisation "Fundacion Comercio Electronico". This name bears no resemblance to "BOEHRINGERHEIMPETREBATES". Further, the website to which the disputed domain name resolves has no content which would indicate any right or legitimate interest in the disputed domain name.

The Respondent has no rights or interests in the disputed domain name.

BAD FAITH

The Panel notes that the domain name directs to what appears to be a parking page with pay per click links. One of the links lists the Complainant's trademark. Although the mere generation of revenue from domain name parking activities is not by itself necessarily a bad faith activity (See Fundacao CPqD - Centro de Pesquisa e Desenvolvimento em Telecomunicacoes v. Gary Lam WIPO Case No. D2009-1403) the inclusion of the Complainant's trademark is of concern.

However, it is not the just mere use of a parking page that is of most concern in this matter. It is clear that the Complainant's BOERHRINGER-INGELHEIM trademark is a well known mark in many jurisdictions. And it is clear the Complainant operates a

website using a strikingly similar domain name ending with PETREBATES. It seems highly unlikely that the Respondent would not have known of such a well known and unique trade mark when he sort to register the disputed domain name. The Panel finds that the Respondent had such prior knowledge at the time of registering the disputed domain name and therefore her only purpose in registering the disputed domain name was to opportunistically profit from such confusing similarity. The Respondent clearly targeted the Complainant's well known domain name for this purpose. Such opportunism has been recognised as bad faith by numerous panels, the Panel refers to the commentary of the learned Gerald M Levine, Domain Name Arbitration, Legal Corner Press, 1st ed. 2015, pp. 258 to 259.

Therefore in consideration of all the circumstances the disputed domain name has been registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOEHRINGERHEIMPETREBATES.COM**: Transferred

PANELLISTS

Name	**Mr Andrew Norman Sykes**

DATE OF PANEL DECISION 2020-07-16

Publish the Decision