Decision for dispute CAC-UDRP-103221

Case number	CAC-UDRP-103221
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Domain names	boehringeringeleheimequinerebates.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	Domains By Proxy, LLC

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings related to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is a family-owned pharmaceutical group of companies founded by Albert Boehringer (1861-1939) in Ingelheim am Rhein. BOEHRINGER INGELHEIM has become a global research-driven pharmaceutical enterprise and has today about roughly 50,000 employees. 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 further states and provides evidence to support, that it is the owner, among others, of multiple trademark registrations including the terms “BOEHRINGER INGELHEIM” in several countries:

- the international trademark BOEHRINGER-INGELHEIM® n°221544, registered since July 2, 1959; and

- the international trademark BOEHRINGER INGELHEIM® n°568844 registered since March 22, 1991.

Furthermore, the Complainant owns multiple domain names consisting in the wording “BOEHRINGER INGELHEIM”, such as

<boehringeringelheimequinerebates.com> registered and used since August 13, 2019.

The disputed domain name or "Disputed Name" <boehringeringeleheimequinerebates.com> was registered on August 3, 2020.

FACTUAL BACKGROUND

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

The Complainant refers to several panel decisions:

WIPO Case No. D2006-0451, F. Hoffmann-La Roche AG v. Macalve e-dominios S.A. (“It is also well established that the specific top level of a domain name such as “.com”, “.org” or “.net” does not affect the domain name for the purpose of determining whether it is identical or confusingly similar.”).

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

- WIPO Case No. D2019-0208, Boehringer Ingelheim Pharma GmbH & Co. KG v. Marius Graur (“Because of the very distinctive nature of the Complainant’s trademark [BOEHRINGER-INGELHEIM] and its widespread and longstanding use and reputation in the relevant field, it is inconceivable that the Respondent registered the disputed domain name without being aware of the Complainant’s legal rights.”);

- 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.”).

WIPO Case No. D2018-0497, StudioCanal v. Registration Private, Domains By Proxy, LLC / Sudjam Admin, Sudjam LLC (“In that circumstance, whether the commercial gain from misled Internet users is gained by the Respondent or by the Registrar (or by another third party), it remains that the Respondent controls and cannot (absent some special circumstance) disclaim responsibility for, the content appearing on the website to which the disputed domain name resolve […] so the Panel presumes 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.”).

- 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

PARTIES' CONTENTIONS:

COMPLAINANT:

• The disputed domain name is confusingly similar to the protected mark

According to the Complainant, the Respondent's registered Domain Name is confusingly similar to the Complainant's trademark "BOEHRINGER INGELHEIM". Essentially, the Respondent has appropriated the trademark "BOEHRINGER INGELHEIM" with the mere addition of the letter "E" to lead consumers to believe that it is affiliated with the Complainant. It does not change the overall impression of the designation as being connected to the Complainant's trademarks. Furthermore, it does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademarks and domain names associated.

According to the Complainant, the addition of the terms "EQUINE REBATES" worsens the likelihood of confusion, as it directly refers to the Complainant's website https://www.boehringeringelheimequinerebates.com/.

• Respondent does not have any rights or legitimate interest in the disputed domain name

The Complainant argues that the Respondent has no rights to the disputed domain name, and any use of the trademark "BOEHRINGER-INGELHEIM" has to be authorized by the Complainant. The Complainant contends that the Respondent is not affiliated with nor authorized by the Complainant in any way. 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 name by the Complainant.

The Complainant also provides that the disputed domain name resolves to a parking page with commercial links.

• The disputed domain name has been registered and is being used in bad faith

The Complainant states that the Complainant's trademark BOEHRINGER-INGELHEIM is distinctive and well-known. Past panels have confirmed the notoriety of the Complainant's trademark.

The Complainant further contends that the Respondent registered the disputed domain name to create a confusion with the domain name <boehringeringelheimequinerebates.com>, used by the Complainant to offer rebates on equine health products.

Consequently, given the distinctiveness of the Complainant's trademarks and its reputation, it is reasonable to infer that the Respondent has registered and used the disputed domain name with full knowledge of the Complainant's trademark.

The disputed domain name resolves to a parking page with commercial links. The Complainant contends the Respondent has attempted to attract Internet users for commercial gain to his own website thanks to the Complainant's trademarks for its own commercial gain, which is an evidence of bad faith.

RESPONDENT:

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

The UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY of the Internet Corporation for Assigned Names and Numbers (ICANN) (the “Policy”) provides that a complainant must prove each of the following to obtain transfer or cancellation of a domain name:

1. that respondent’s domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights; and

2. that respondent has no rights or legitimate interests in respect of the domain name; and

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

1) The disputed domain name is confusingly similar to a trademark in which the Complainant has rights (Para.4(a)(i) of the Policy).

The Complainant has provided evidence and proved to be the owner of several "BOEHRINGER-INGELHEIM” trademarks in various jurisdictions. Essentially, the Respondent has appropriated the trademark "BOEHRINGER-INGELHEIM” with the mere addition of the letter “E” to lead consumers to believe that it is affiliated with the Complainant. The disputed domain name thus incorporates almost the entirety of the well-known BOEHRINGER-INGELHEIM trademark as its distinctive element.

The Panel finds that the Respondent’s registered Domain Name is confusingly similar to the Complainant’s trademark "BOEHRINGER-INGELHEIM” since the mere addition of the letter “E” does not eliminate any confusing similarity. This is especially true where, as here, the trademark is “the dominant portion of the domain name,” LEGO Juris A/S v. Domain Tech Enterprises, WIPO Case No. D2011-2286, or where the trademark in the domain name represents “the most prominent part of the disputed domain name[] which will attract consumers’ attention.” Kabushiki Kaisha Toshiba dba Toshiba Corporation v. WUFACAI, WIPO Case No. D2006-0768.

Also, it is well established that typosquatting can constitute a finding that the domain name is confusingly similar (Deutsche Bank Aktiengesellschaft v. New York TV Tickets Inc., WIPO Case No. D2001-1314, DaimlerChrysler Corporation v. Worshipping, Chrisler, and Chr, aka Dream Media and aka Peter Conover, WIPO Case No. D2000-1272 and Playboy

Enterprises v. Movie Name Company, WIPO Case No. D2001-1201). The Panel considers this to be a clear case of typosquatting.

The Panel agrees with the Complainant that the addition of the terms “EQUINE REBATES” worsens the likelihood of confusion, as it directly refers to the Complainant’s website https://www.boehringeringelheimequinerebates.com/.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark "BOEHRINGER-INGELHEIM”.

2) The Respondent lacks rights or legitimate interests in the disputed domain name (Para. 4(a)(ii) of the Policy).

Under the Policy, a 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 burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy (see WIPO Overview 2.0, paragraph 2.1).

According to the Complainant, the Respondent has no rights to the disputed domain name, and any use of the trademark "BOEHRINGER-INGELHEIM” has to be authorized by the Complainant. The Respondent has not been authorized or licensed by the above-mentioned pharmaceutical group to use the disputed domain name.

In a present case, the Respondent failed to file a Response in which it could have provided evidence in support of its rights or legitimate interests. Therefore, all these circumstances are sufficient to establish a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name.

The Panel thus takes the view that the Respondent lacks rights or legitimate interests in the disputed domain name.

3) The disputed domain name has been registered and is being used in bad faith (Paragraph 4(a)(iii) of the Policy).

The Panel agrees with the Complainant that its trademark "BOEHRINGER-INGELHEIM” is distinctive and well known. The fact that the Respondent has registered a domain name that is confusingly similar to the Complainant's trademark indicates and in the absence of any evidence contrary (or any administratively compliant response at all) being put forward by the Respondent, that the Respondent had knowledge of the Complainant’s trademark and that they had such knowledge before the registration and use of the disputed domain name. This finding also supports the fact that the addition of the terms “EQUINE REBATES” worsens the likelihood of confusion, as it directly refers to the Complainant’s website https://www.boehringeringelheimequinerebates.com/ used by the Complainant to offer rebates on equine health products.

The disputed domain name resolves to a parking page with commercial links. The Policy defines that one of the actions which constitute bad faith pursuant to paragraph 4(b)(iv) of the Policy is the use of the domain name to intentionally attempt to attract, for commercial gain, Internet users to respondent's web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of respondent's web site or location or of a product or service on respondent's web site or location.

The Panel believes it is likely that this was at least one of the reasons behind the Respondent’s registration and use of the disputed domain name.

Accordingly, the Panel finds that the Respondent has engaged in typosquatting to cause confusion with the Complainant’s trademark for their own commercial gain, and therefore the disputed domain name was registered and is being used in bad faith within the meaning of Paragraph 4(a)(iii) of the Policy.

For all reasons stated above, the Panel is satisfied that the Complainant has proven the third element of the Policy that is that the Respondent's registration and use of the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOEHRINGERINGELEHEIMEQUINEREBATES.COM**: Transferred

PANELLISTS

Name	**Mgr. Barbora Donathová, LL.M.**

DATE OF PANEL DECISION 2020-09-15

Publish the Decision