Decision for dispute CAC-UDRP-103320

Case number	CAC-UDRP-103320
Time of filing	2020-09-30 10:55:40
Domain names	boehringeringelheimpetrrebates.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

Name	Carolina Rodrigues

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other proceedings.

IDENTIFICATION OF RIGHTS

The Complainant owns a large portfolio of national registered trademarks including the terms “BOEHRINGER INGELHEIM,” in many classes including particular the international trademarks:

- No. 221544, registered since 2 July 1959; and

- No. 568844 registered since 22 March 1991.

Furthermore, the Complainant owns multiple domain names consisting in the wording “BOEHRINGER INGELHEIM” including the .com.

It also has <boehringeringelheimpetrebates.com> registered and used since 14 August 2019.

Further, the Complainant has rights arising from use in those countries that recognize unregistered rights.

FACTUAL BACKGROUND

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

The Complainant is a family-owned pharmaceutical group, which has grown from a business established as long ago as 1885, when it was founded by Albert Boehringer in Ingelheim am Rhein.

Since then, BOEHRINGER INGELHEIM has become a global research-driven pharmaceutical enterprise and today has around 50,000 employees worldwide.

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 approximately EUR 18,997 million. Its main online presence is at the .com.

It operates a loyalty or rebate scheme whereby purchasers of its pet products get a benefit from scanning their receipts. This has been at <boehringeringelheimpetrebates.com> since 14 August 2019.

The disputed domain name <boehringeringelheimpetrrebates.com> was registered on 25 September 2020 and resolves to a parking page with commercial links.

The Panel visited it on 5 November 2020 and those links tend to include in each case the Complainant's name and say careers or jobs that then take one through to a second layer of links that are about jobs or careers generally. So it is more sophisticated than your average generic parking page but it is still a parking page.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

Rights Similar and Identical

The Complainant says that the disputed domain name <boehringeringtheimpetrebates.com> is confusingly similar to its trademark BOEHRINGER-INGELHEIM and also its unregistered mark, boehringeringelheimpetrebates.com.

Indeed, the misspelling in the trademark BOEHRINGER-INGELHEIM, i.e. the substitution of the letters "E" and "L" by the letter "T" and the deletion of the hyphen, does not prevent the whole from being confusingly similar to its trademarks. It does not change the overall impression. There is a likelihood of confusion between the disputed domain name and the Complainant, its trademarks and names.

Besides, the addition of the terms "PET REBATES" compounds the likelihood of confusion, as it directly refers to the Complainant's domain and website https://www.boehringeringelheimpetrebates.com/.

Moreover, the Complainant says that the addition of the generic Top-Level Domain suffix ".COM" increases the overall impression that the designation is connected to the trademark BOEHRINGER-INGELHEIM. See WIPO Case No. D2006-0451, F. Hoffmann-La Roche AG v. Macalve e-dominios S.A. Consequently, the disputed domain name is confusingly similar to the Complainant's trademark.

Legitimate interests

According to the WIPO Case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd., 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 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 Policy.

The Complainant says the Respondent is not identified in the Whois database as the disputed domain name. 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. See the 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.>.

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 name. 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 trademarks or apply for registration of the disputed domain name by the Complainant.

Furthermore, the disputed domain name resolves to a parking page with commercial links.

Past panels have found this is not a bona fide offering of goods or services or legitimate non-commercial or fair use. See: The Forum 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. The Complainant says that the Respondent has no rights or legitimate interest in respect of the disputed domain name.

Bad Faith

The Complainant's trademark is highly distinctive and also well-known.

Past panels have confirmed this in relation to the Complainant's trademarks. See 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.") and see 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.").

The Complainant says the Respondent selected the disputed domain name to create confusion with the domain name <boehringeringelheimpetrebates.com>, used by the Complainant to offer rebates on pet health products.

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

Furthermore, the disputed domain name resolves to a parking page with commercial links. The Complainant contends the Respondent has attempt 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. See WIPO Case No. D2018-0497, StudioCanal v. Registration Private, Domains By Proxy, LLC / Sudjam Admin, Sudjam LLC See also 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).") and 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.").

The Respondent has registered and is using the disputed domain name in bad faith. See The 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> and The 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 non-commercial 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).

The Complainant also relies on 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.

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

This is a simple case. There is no question as to the Rights of the Complainant in its name and registered marks.

It is a well-known and famous mark with a large portfolio of registered marks. The Complainant also has unregistered rights including from its use in trade of its domain name https://www.boehringeringelheimpetrebates.com/.

The disputed domain name is unquestionably similar and this is clearly deliberate, from the typo and the mirroring of the rebate domain so precisely.

There can also be no other reason for selecting the unique string in light of the fame of the Complainant. It does not mean anything in common usage. The Respondent is not a reseller and in fact sells nothing at all. There is no genuine legitimate reason on the face of the case. Nor has Respondent come forward with any explanation.

While parking and pay per click does not always constitute bad faith under the policy – it does so in this case.

This Panel finds the disputed domain name was selected, registered and is used, all in order to free-ride on the goodwill and reputation of the Complainant and earn revenue from the confusion.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOEHRINGERINGELHEIMPETRREBATES.COM**: Transferred

PANELLISTS

Name	**Victoria McEvedy**

DATE OF PANEL DECISION 2020-11-05

Publish the Decision