Decision for dispute CAC-UDRP-103371

Case number	CAC-UDRP-103371
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Domain names	boehringeringelheimpetrewards.com

Case administrator

Organization	Denisa Bilík (CAC) (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 other legal proceedings, pending or otherwise, which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant owns a large portfolio of trademarks including the terms “BOEHRINGER INGELHEIM” in several countries, such as:

- International Registration No. 221544 BOEHRINGER-INGELHEIM, registered since July 2, 1959; and,
- International Registration No. 568844 BOEHRINGER INGELHEIM, registered since March 22, 1991.

Furthermore, the Complainant owns multiple domain names consisting in the wording “BOEHRINGER INGELHEIM”, such as <boehringeringelheimpetrebates.com> registered and in use since August 14, 2019.

FACTUAL BACKGROUND

THE 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, Germany. Since then BOEHRINGER INGELHEIM has become a global research-driven pharmaceutical enterprise which today has roughly 51,000 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 19 million.

The Complainant owns a large portfolio of trademarks including the terms “BOEHRINGER INGELHEIM” in several countries, as well as multiple domain names consisting in the wording “BOEHRINGER INGELHEIM”, such as <boehringeringelheimpetrebates.com> which has been registered and in use since August 14, 2019.

The disputed domain name <boehringeringelheimpetrewards.com> was registered on October 23, 2020 and resolves to a parking page with commercial links.

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

According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that the disputed domain name should be transferred or cancelled:

(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 rights 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 has examined the evidence available to it and has come to the following conclusion concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

CONFUSING SIMILARITY WITH EARLIER RIGHTS

The Complainant has stated that the disputed domain name <boehringeringelheimpetrewards.com> is confusingly similar to its trademark BOEHRINGER-INGELHEIM.

The addition of the generic term “PET REWARDS” does not alter the finding that the domain name is confusingly similar to the trademark BOEHRINGER-INGELHEIM. It does not change the overall impression of the designation as being connected to the Complainant’s trademark BOEHRINGER-INGELHEIM. The domain name is dominated by the name BOEHRINGER-INGELHEIM, which is protected for the Complainant and which is highly distinctive and well-known. The term “PET REWARDS” on the other hand must be considered to be generic and descriptive and therefore of less importance to the overall impression created by the domain name as a whole.

It is well-established that a domain name that wholly incorporates a Complainant’s registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP, as held in e.g. WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin.

Moreover, the Complainant has asserted that the addition of the generic Top-Level Domain suffix “.COM” does not change the overall impression of the designation as being connected to the trademark BOEHRINGER-INGELHEIM.

As held e.g. in 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.

This finding is based on the settled practice in evaluating the existence of a likelihood of confusion of

a) disregarding the top-level suffix in the domain name (i.e. “.com”), and

b) not finding that the addition of generic terms such as “PET REWARDS” to a protected trademark would be sufficient to distinguish a domain name from a trademark which is entirely contained in a domain name.

Therefore, the Panel comes to the conclusion that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the UDRP.

NO RIGHTS OR LEGITIMATE INTERESTS

The onus to make out a prima facie case that the Respondent lacks rights or legitimate interests is placed on the Complainant. However, once such a prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP (see e.g. WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

In this case, the Complainant has stated that the Respondent is not affiliated with it nor authorized by it in any way. Neither license nor authorization have been granted to the Respondent to make any use of the Complainant's trademark or apply for registration of the disputed domain name by the Complainant. The Complainant does not carry out any activity for or have any business with the Respondent.

The Respondent failed to provide any information and evidence whatsoever that could have shown that it has relevant rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a) (ii) of the Policy).

Furthermore, the disputed domain name resolves to a parking page with commercial links. Past panels have found it is not a bona fide offering of goods or services or legitimate non-commercial or fair use in such decisions as 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) or WIPO Case No. D2007-1695, Mayflower Transit LLC v. Domains by Proxy Inc./Yariv Moshe which held that the 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.

Therefore, the Panel concludes that the Respondent did not establish any right or legitimate interest to the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy)and comes to the conclusion that the Complainant has satisfied the requirement under paragraph 4(a)(ii) of the UDRP Policy.

BAD FAITH

The Complainant contends that it is one of the world's 20 leading pharmaceutical companies, with roughly 51,000 employees worldwide and 19 million euros in net sales.

The Complainant's trademark BOEHRINGER-INGELHEIM is distinctive and well-known. Past Panels have confirmed the notoriety of the Complainant's trademarks in decisions such as WIPO Case No. D2019-0208, Boehringer Ingelheim Pharma GmbH & Co. KG v. Marius Graur, where, based on the very distinctive nature of the Complainant's trademark [BOEHRINGER-INGELHEIM] and its widespread and longstanding use and reputation in the relevant field, it was held to be inconceivable that the Respondent registered the disputed domain name without being aware of the Complainant's legal rights." In CAC Case No. 102274, BOEHRINGER INGELHEIM PHARMA GMBH & CO.KG v. Karen Liles it was held that in the absence of a response from Karen Liles and given the reputation of the Complainant and its trademark, the Panel inferred that the Respondent had the Complainant's trademarks BOEHRINGER-INGELHEIM in mind when registering the disputed domain name.

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 domain name with full knowledge of the Complainant's trademark.

Since the disputed domain name resolves to a parking page with commercial links, the Complainant has put forward that the Respondent has attempted to attract internet users to its own website for commercial gain relying on the Complainant's trademarks for its own commercial gain, which is an act of bad faith. Such findings are mirrored in decisions such as WIPO Case No. D2018-0497, StudioCanal v. Registration Private, Domains By Proxy, LLC / Sudjam Admin, Sudjam LLC where it was held that 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 remained that the Respondent controlled and could not (absent some special circumstance) disclaim responsibility for, the content appearing on the website to which the disputed domain name resolved. The Panel therefore presumed that the Respondent had 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 resolved. Accordingly, the Panel found that the disputed domain name was registered and was being used in bad faith.

Finally, the actions of the Respondent reflect a pattern of conduct as shown in the following cases:
- Forum Case No FA1912678 CrossFirst Bankshares, Inc. v. Carolina Rodrigues / Fundacion Comercio Electronico;
- WIPO Case No D2020-2256 Carvana, LLC v. Registration Private of Domains By Proxy, LLC. / Carolina Rodrigues, Fundacion Comercio Electronico;
- CAC No 103270 Boehringer Ingelheim Pharma GmbH & Co.KG v. Fundacion Comercio Electronico.

For all the above reasons, the Panel concludes that the Respondent has registered and is using the disputed domain name in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy). The Complainant has therefore also satisfied the requirement under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOEHRINGERINGELHEIMPETREWARDS.COM**: Transferred

PANELLISTS

Name	**Udo Pfleghar**

DATE OF PANEL DECISION 2020-12-04

Publish the Decision