

Decision for dispute CAC-UDRP-103516

Case number	CAC-UDRP-103516
Time of filing	2021-01-21 09:27:50
Domain names	boehringeringeelheimpetrebates.com, boehringeringerelheimpetrebates.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)
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Complainant

Organization	Boehringer Ingelheim Pharma GmbH & Co.KG
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Complainant representative

Organization	Nameshield (Enora Millocheau)
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Respondent

Organization	Fundacion Comercio Electronico
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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 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, BOEHRINGER INGELHEIM has become a global pharmaceutical enterprise and has roughly 51,000 employees. In 2019, net sales of the BOEHRINGER INGELHEIM group amounted to about EUR 19 million.

The Complainant is the owner of the following trademark registrations in several countries, including but not limited to:

- 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 <boehringeringeelheimpetrebates.com> registered and used since August 14, 2019.

FACTUAL BACKGROUND

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

The Complainant points out several prior panel decisions, for instance:

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”: WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasilij Terkin.

Similar case: CAC Case No. 103455, Boehringer Ingelheim Pharma GmbH & Co.KG v. Fundacion Comercio Electronico <boehringeringelhimpetebates.com> (“The Panel is of the opinion that in a situation where the Complainant’s trademark is entirely (or nearly entirely with the exception of a misspelling) included in the litigious Domain name, the adjunction of generic terms does not generally change the assessment as far as the first condition is concerned.”).

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).”).

- 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.”).

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

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

First, the Complainant claims rights in the BOEHRINGER INGELHEIM mark through its trademark registrations. By virtue of its trademark registrations, Complainant has proved that it has rights in the mark under paragraph 4(a) of the Policy. See Avast Software s. r. o. v Milen Radumilo, 102384, (CAC 2019-03-12).

Second, the Complainant claims that the prominent part of the disputed domain names are confusingly similar to its trademark registrations and domain name. In particular, the Complainant points out that the disputed domain names reproduce its trademark BOEHRINGER-INGELHEIM with the deletion of the hyphen ("-") and addition of the letters "E" and "ER". The comparison between Complainant's official domain name and the disputed domain names are as below:

- Complainant's official domain name: <boehringeringelheimpetrebates.com>; and
- disputed domain names: <boehringeringEelheimpetrebates.com>, <boehringeringERelheimpetrebates.com>.

Despite there is an additional term "PET REBATES" in the disputed domain names, it is not sufficient to differentiate themselves from the Complainant's Trademarks and domain name. See Boehringer Ingelheim Pharma GmbH & Co.KG v. Fundacion

Comercio Electronico, 103455 (CAC 2021-01-07) ("The Panel is of the opinion that in a situation where the Complainant's trademark is entirely (or nearly entirely with the exception of a misspelling) included in the litigious Domain name, the adjunction of generic terms does not generally change the assessment as far as the first condition is concerned.").

The Panel accepts that the changes of the characters do not alter the overall impression of the designation as being connected to the Complainant and its trademarks, and the ".com" generic top-level domain ("gTLD") is irrelevant when establishing whether or not a mark is identical or confusingly similar for the purposes of paragraph 4(a)(i) of the Policy. The length of the disputed domain names further confuses Internet users to spot the difference between Complainant's official domain name and the disputed domain names. See *Belron International Limited v Andrea Paul*, 103381, (CAC 2020-12-09) and *LESAFFRE ET COMPAGNIE v Tims Dozman*, 102430, (CAC 2019-04-02).

For the foregoing reasons, the Panel finds the Complainant has satisfied 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). More specifically, the Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain names, and the burden of proof then shifts to the Respondent to show it does have rights or legitimate interests. See *PepsiCo, Inc. v Smith power production*, 102378, (CAC 2019-03-08) ("The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.").

First, the Complainant contends that the Respondent is not affiliated with nor authorized by the Complainant in any way and 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 BOEHRINGER-INGELHEIM, or apply for registration of the disputed domain names by the Complainant.

The Complainant further contends that the Respondent is passively holding the disputed domain names and the disputed domain names do not resolve to any active website. The Respondent did not make any use of disputed domain names since the registration, and it confirms that Respondent has no demonstrable plan to use the disputed domain names. It demonstrates a lack of legitimate interests in respect of the disputed domain names.

It is commonly agreed that passive holding does not constitute a bona fide offering of goods and services or a legitimate non-commercial or fair use of the disputed domain names, see *ARCELOMITTAL (SA) v. Milen Radumilo*, 102379 (CAC 2019-04-18).

The Panel finds that the Complainant has established a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain names and the Respondent has not rebutted the assertion.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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).

First, the Complainant reiterates that the Complainant is one of the leading pharmaceutical companies in the world and its trademark BOEHRINGER INGELHEIM is distinctive and well-known. It is reasonable to infer that the Respondent had actual knowledge of the Complainant's rights in its asserted trademark BOEHRINGER INGELHEIM. The disputed domain names are confusingly similar to Complainant's domain name <boehringerengelheimpetrebates.com> which is being used by the Complainant to offer rebates on pet health products. Registering a domain name similar to a well-known brand with actual

knowledge clearly constitutes to registration in bad faith, see ARCELORMITTAL (SA) v acero, 102399, (CAC 2019-04-22). On this basis, the Panel accepts that the disputed domain name was registered in bad faith.

Second, the Complainant asserts that the Respondent has not demonstrated any activity in respect of the disputed domain names, and it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain names by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law. In addition, the Complainant also points out that the Respondent has already been involved in numerous UDRP proceedings, several regarding the Complainant's trademark including Boehringer Ingelheim Pharma GmbH & Co.KG v. Fundacion Comercio Electronico, 103455 (CAC 2021-01-08) <boehringeringelhimpetebates.com> and Boehringer Ingelheim Pharma GmbH & Co.KG v. Fundacion Comercio Electronico, 103404 (CAC 2020-12-15) <boehringeringelheimptrebates.com>. Without any reasonable justification presented by the Respondent, the Panel is satisfied with the Complainant's assertions and the Respondent's previous UDRP record further evinces both the registration and use of the disputed domain names are in bad faith.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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

Having established all three elements required under the UDRP Policy, the Panel concludes that relief shall be granted.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **BOEHRINGERINGEELHEIMPETREBATES.COM**: Transferred
- 2. **BOEHRINGERINGERELHEIMPETREBATES.COM**: Transferred

PANELLISTS

Name **Mr Paddy TAM**

DATE OF PANEL DECISION 2021-02-18

Publish the Decision