

Decision for dispute CAC-UDRP-103607

Case number	CAC-UDRP-103607
Time of filing	2021-03-01 09:24:40
Domain names	boehringereringelherimpetrebates.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 name.

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 research-driven pharmaceutical enterprise and has today about 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 billion.

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

- 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

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

FACTUAL BACKGROUND

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

The Complainant refers to previous panel decisions, for instance:

- CAC Case No. 103124, Boehringer Ingelheim Pharma GmbH & Co.KG v. Fundacion Comercio Electronico <boehringerengelheimpetrreebates.com> ("The disputed domain name and the Complainant's trademarks are very similar since they differ in a mere addition of misspelled version of a generic term "pet rebates" (i.e. addition of "PETRREEBATES") to the Complainant's trademark. This, however, cannot prevent the association in the eyes of internet consumers between the disputed domain name and the Complainant's trademarks and thus the likelihood of confusion still exists. To conclude, addition of a non-distinctive term cannot sufficiently distinguish the disputed domain name from the Complainant's trademarks.").
- 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.").

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

1. Identical or confusingly similar

The Complainant contended that the disputed domain name <boehringereringelherimpetrebates.com> is identical to its registered trademark "BOEHRINGER INGELHEIM". The Complainant is a family-owned pharmaceutical group of companies with roots going back to 1885, and a global research-driven pharmaceutical enterprise.

The disputed domain name <boehringereringelherimpetrebates.com> incorporates the Complainant's trademark, by adding "r" and "er" and the deletion of hyphen. The addition and deletion of certain letter does not significantly affect the appearance or pronunciation of the domain name, creating virtually identical and/or confusingly similar marks to the Complainant's trademark. In accordance with WIPO Jurisprudential Overview 3.0 para 1.9, a domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element. Therefore, a misspelled trademark does not preclude the finding of confusing similarity within the meaning of paragraph 4(a)(i) of the Policy and the Panel needs to reach to other evidence in finding the Respondent's intention to confuse users, before a final determination can be made.

The added term "pet rebates" has different possible meanings, but the Complainant actually owned the <boehringeringelheimpetrebates.com> domain name which revolves to a rebate website created by the Complainant for its customers. The added term "pet rebates" adds to the overall impression of the designation as being connected to the Complainant's trademark BOEHRINGER-INGELHEIM®.

As the Complainant stated, it is well established that the addition of a top level domain would not change the determination that the disputed domain name is identical to the Complainant's trademark. According to WIPO Overview 3.0 §1.11.1, "the applicable Top Level Domain ("TLD") in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusion similarity test". According to WIPO Overview 3.0 §1.11.2, "the ordinary meaning ascribed to a particular TLD would not necessarily impact assessment of the first element." Here, the addition of the new gTLD ".com" should not impact the assessment of the identity or confusing similarity within the meaning of paragraph 4(a)(i) of the Policy.

The Panel therefore concludes that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

2. No rights or legitimate interests

Although the Respondent did not file an administratively compliant (or any) response, the Complainant is still 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 has offered three arguments to support its contention that the Respondent has no rights or legitimate interests in respect of the disputed domain name. Firstly, the Respondent is not commonly known as the disputed domain name; secondly, neither license or authorization has been granted to the Respondent; thirdly, the disputed domain name resolves to a parking page with commercial links.

According to the information of the Respondent as provided by the Registrar, the name of the Respondent's organization is protected by privacy shield WHOISGUARD Inc and is revealed to be "Fundacion Comercio Electronico". Based on the Respondent's name and contact details shown, there seems to be no evidence that Respondent is either commonly known by the names "BOEHRINGER-INGELHEIM" or in any way affiliated with Complainant. There is no evidence suggests that the Respondent is in anyway associated with the name "boehringereringelherimpetrebates". The Complainant also contended that it does not carry out any activity for, nor has any business with the Respondent. It has never licensed nor authorized the Respondent to make any use of the Complainant's trademark.

On the basis of preponderance of evidence, and in the absence of any evidence to the contrary or any administratively compliant response being put forward by the Respondent, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain name within the meaning of paragraph 4(a)(ii) of the Policy.

3. Bad faith

By trying to establish the bad faith element of paragraph 4(a) of the Policy, the Complainant has primarily attempted to rely on paragraph 4(b)(i) and 4(b)(iv) of the Policy.

There are a couple of instances cited by the Complainant that can be used to prove that the disputed domain name is registered and used in bad faith.

As far as registration goes, UDRP panels have consistently held that the mere registration of a domain name that is confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. The Complainant is one of the world's 20 leading pharmaceutical companies. The Complainant's trademark "BOEHRINGER-INGELHEIM" is distinctive and well known. The fact that the Respondent has registered a domain name is registered long after the Complainant's trademark became known, and modified the distinctive trademark by adding "R" and "ER" that the Respondent had knowledge of the Complainant's trademark at the time of registration of the disputed domain name. The Complainant's trademark "BOEHRINGER-INGELHEIM" is not a common word and a simple Google search reveals all results and references related to the Complainant's brand. Therefore, it is reasonable to conclude that the Respondent registered the disputed domain name with the knowledge of the Complainant's trademark and/or brand influence. In addition, the Respondent choose to register the disputed domain name to create a confusion with <boehringerengelheimpetrebates.com> used by the Complainant to offer rebates on pet health products.

The disputed domain name is not used for any bona fide offerings. As far as usage of the disputed domain name, the disputed domain name has been resolved to a pay-per-click ("PPC") website. Panels have recognized that the use of a domain name to host a page comprising PPC links would be permissible – and therefore consistent with respondent rights or legitimate interests under the Policy – where the domain name consists of an actual dictionary word(s) or phrase and is used to host PPC links (WIPO Overview 3.0 §2.9), which does not seem to match scenarios presented by this case. In this case, the disputed domain name to host a parked page comprising multiple PPC links, and the Respondent shows no efforts to suppress PPC advertising related to the Complainant's trademark.

In view of the above, in the absence of any evidence to the contrary (or any administratively compliant response) being put forward by the Respondent, the Panel determines that 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 THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **BOEHRINGERERINGELHERIMPETREBATES.COM**: Transferred

PANELLISTS

Name	Carrie Shang
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DATE OF PANEL DECISION 2021-04-03

Publish the Decision