

## Decision for dispute CAC-UDRP-103674

Case number	CAC-UDRP-103674
Time of filing	2021-03-22 10:15:42
Domain names	boehringerengelheimpetbates.com

### Case administrator

Organization	Denisa Bilík (CAC) (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 related to the disputed domain name.

#### IDENTIFICATION OF RIGHTS

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 2nd, 1959

#### FACTUAL BACKGROUND

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

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. Vasilii Terkin).

The Complainant refers to decisions of past panels which have confirmed the notoriety of the trademark BOEHRINGER-INGELHEIM:

- 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.").

CAC Case No. 103124, Boehringer Ingelheim Pharma GmbH & Co.KG v. Fundacion Comercio Electronico <boehringeringelheimpetreebates.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 "PETREEBATES") 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.").

- 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), 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.").

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#### PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLAINT RESPONSE HAS BEEN FILED.

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#### 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).

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#### 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).

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#### 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).

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#### 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.

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#### PRINCIPAL REASONS FOR THE DECISION

The domain name is confusingly similar to the protected trademark as a result of:

- the fact that the Complainant's trademark BOEHRINGER INGELHEIM(r) is included in its entirety in the domain name;
- the added term 'PET BATES' does not prevent the likelihood of confusion, but worsens it because of its directly misleading reference to the Complainant's website <http://boehringeringelheimpetrebates.com>, which is i.a. used to inform visitors of the

website about offers for Pet medicines.

The Respondent has:

- no legitimate interest nor right in respect of the disputed domain name;
- registered and used the domain name in bad faith (by linking it to a parking page with commercial links).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOEHRINGERINGELHEIMPETBATES.COM**: Transferred

## PANELLISTS

Name	<b>Mr. E.J.V.T. van den Broek</b>
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DATE OF PANEL DECISION	2021-04-13
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Publish the Decision