Decision for dispute CAC-UDRP-103709

Case number	**CAC-UDRP-103709**
Time of filing	**2021-03-31 08:38:01**
Domain names	**boehringeringelheimperperrebates.com, boehringeringelleimpetrbates.com, boehringeringiheimpetrebates.com, boehringerungeelheimpetrebates.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

Organization	**Fundacion Comercio Electronico**

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

In this proceeding, the Complainant relies on the following trademarks:

- the international trademark BOEHRINGER-INGELHEIM (word) No. 221544, registered since July 2, 1959 and renewed; and

- the international trademark BOEHRINGER INGELHEIM (word) No. 568844, registered since March 22, 1991 and renewed.

FACTUAL BACKGROUND

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

THE DISPUTED DOMAIN NAMES ARE IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

The Complainant is a family-owned pharmaceutical group of companies with roots going back to 1885, founded by Albert

Boehringer (1861-1939) in Ingelheim am Rhein.

Ever since, the Complainant 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 marks indicated above.

The Complainant owns multiple domain names including the words “BOEHRINGER INGELHEIM”, such as <boehringeringelheimpetrebates.com> registered and used since August 14, 2019.

The disputed domain names were registered between March 25, 2021 and March 26, 2021 and resolve to a parking page with commercial links.

The Complainant states that the disputed domain names are confusingly similar to its “BOEHRINGER-INGELHEIM” trademarks.

The Complainant asserts that the substitution, the addition or the deletion of letters in the trademark are not sufficient to escape the finding that the domain names are confusingly similar to the Complainant’s trademark.

Moreover, the addition of different variations of the terms “PET REBATES” is not sufficient to escape the confusion. It does not change the overall impression of the designations as being connected to the Complainant’s trademarks. It does not prevent the likelihood of confusion between the disputed domain names and the Complainant, its trademarks and domain names associated.

On the contrary, these additions worsen the likelihood of confusion, as the directly refer to the Complainant’s own website and business.

The addition of the generic Top-Level Domain suffix “.COM” does not change the overall impression and does not prevent the likelihood of confusion between the disputed domain names and the Complainant’s trademarks.

The Complainant claims the disputed domain names are confusingly similar to the Complainant’s trademark.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAMES

The Complainant asserts that the Respondent is not identified in the Whois database by the disputed domain names. 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.

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 names. 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 names by the Complainant.

The Complainant notes that the disputed domain names resolve to parking pages with commercial links and past UDRP panels have found it is not a bona fide offering of goods or services or legitimate non-commercial or fair use.

Thus, the Complainant contends that the Respondent has no right or legitimate interest in respect of the disputed domain names.

THE DISPUTED DOMAIN NAMES WERE REGISTERED AND ARE BEING USED IN BAD FAITH

The Complainant claims that it is one of the world's 20 leading pharmaceutical companies, with roughly 51,000 employees worldwide and 19 billion euros in net sales and its BOEHRINGER-INGELHEIM trademark is distinctive and well-known.

Past panels have confirmed the notoriety of the Complainant's trademarks.

The Complainant contends that the Respondent choose to register the disputed domain names to create a confusion with the Complainant's domain name <boehringeringelheimpetrebates.com>, used by the Complainant to offer rebates on pet health products.

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

The disputed domain names resolve to parking pages with commercial links. The Complainant contends the Respondent has attempted to attract Internet users for commercial gain to his own websites thanks to the Complainant's trademarks for its own commercial gain, which is an evidence of bad faith.

The Complainant adds that the Respondent was already involved in numerous similar typosquatting cases before the Czech Arbitration Court (CAC) introduced by the Complainant.

Thus, the Complainant asserts that the Respondent has registered and is using the disputed domain names 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 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).

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).

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).

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

A. Identical or confusingly similar with Complainant's trademark

The Complainant owns "BOEHRINGER INGELHEIM" trademark registrations effective in various jurisdictions.

As confirmed by WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), see paragraph 1.2.1: "Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case".

The disputed domain names incorporate the Complainant's trademark with some misspelling and with the addition of the descriptive elements "PET REBATES".

As stated in WIPO Overview 3.0 "where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element" (see par. 1.8).

WIPO Overview 3.0 also states that 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 (see par. 1.9).

In the present case, the Complainant's trademark is clearly recognizable in all the disputed domain names, a misspelling in all the disputed domain names is obvious and the addition of the generic "PET REBATES" element (including its misspelling in some of the disputed domain names) only increases the confusion given the use of these terms by the Complainant and Complainant's own website https://www.boehringeringelheimpetrebates.com/.

The gTLD suffix ".com" is to be disregarded under the confusing similarity test.

Therefore, the Panel finds that the first element of the Policy has been satisfied.

B. Rights or Legitimate Interests

The general rule is the following:

(i) a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests; and

(ii) once such prima facie case is made, the burden shifts to the respondent who has to demonstrate his rights or legitimate interests in respect of the domain name under paragraph 4 (c) of the Policy.

If the respondent fails to do so, the second element of the Policy is satisfied, see Julian Barnes v. Old Barn Studios, WIPO Case No. D2001-0121; Belupo d.d. v. WACHEM d.o.o., WIPO Case No. D2004-0110 and CAC Case No. 101284.

The disputed domain names were registered between March 25, 2021 and March 26, 2021 and resolve to parking pages with commercial links.

The Respondent did not respond.

While failure to respond does not per se demonstrate that the Respondent does not have rights or legitimate interests, it allows all reasonable inferences of fact in the allegations of the complaint to be deemed true (see paragraph 14(b) of the Rules and Vertical Solutions Management, Inc. v. webnet-marketing, inc., FA 95095, National Arbitration Forum).

The Complainant has made a prima facie case in respect of Respondent's lack of rights or legitimate interests, in particular absence of any affiliation, business relations or any authorization from the Complainant to use its trademarks in the disputed domain names, the fact that the Respondent is not known by the disputed domain names, misspelling in all the disputed domain names and the addition of the generic terms indicating connection to the Complainant and its business.

The disputed domain names redirect to parking pages with commercial links and previous panels have found it is not a bona fide offering of goods or services or legitimate non-commercial or fair use (see e.g. CAC Case No. 102862 and WIPO Case No.

D2007-1695, Mayflower Transit LLC v. Domains by Proxy Inc./Yariv Moshe).

Therefore, the Panel finds that the Complainant has satisfied the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists non-exhaustive circumstances indicating registration and use in bad faith.

These circumstances are non-exhaustive and other factors can also be considered in deciding about the bad faith element.

The disputed domain names redirect to parking pages with commercial links.

The Complainant alleges that the Respondent has attempt to attract Internet users for commercial gain thanks to the Complainant's trademarks, which is an evidence of bad faith.

The Panel agrees with the Complainant.

All the circumstances and evidence provided by the Complaint in this dispute demonstrate that the Respondent targeted the Complainant by incorporating Complainant's trademark with a misspelling in the disputed domain names and adding generic terms "Pet Rebates" relating to the Complainant's activity (see CAC Case No. 102862: "the use of terms commonly associated with the activity of the Complainant are evidence that the Respondent was clearly aware of the Complainant and intended to benefit financially from the likelihood of confusion").

As stated by WIPO Overview 3.0 "Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith" (see par. 3.1.4).

The BOEHRINGER-INGELHEIM mark is distinctive and well-known as confirmed by previous UDRP panels (see e.g. WIPO Case No. D2016-0021, Boehringer Ingelheim Pharma GmbH & Co.KG v. Kate Middleton, CAC Case No.102274 and CAC Case No. 102560).

The Panel notes that the Respondent had been a party to many UDRP proceedings and registered domain names similar with third parties trademarks, including the Complainant's marks (see e.g. CAC Cases No.No. 103516, 103498, 103453, 103455, 103404, 103270, 103181, 103124, 103132, 103065, 103009 where the Panel stated: "Taking the above into account, the Panel accepts that the Respondent has registered the disputed domain names with knowledge of the Complainant and targeting the "BOEHRINGER INGELHEIM" trademark in an attempt to extract commercial gain by misleading Internet users that these websites have been authorized by the Complainant and by exposing them to third party commercial pay-per-click links. In addition, the evidence shows that the Respondent has been involved in a pattern of conduct targeting the Complainant and its BOEHRINGER INGELHEIM trademark in bad faith. This satisfies the Panel that the Complainant has established that the Respondent has registered and used the disputed domain names in bad faith" and many others).

It clearly shows Respondent's awareness of the Complainant and its trademarks, targeting the Complainant by the Respondent and serves as an additional proof of Respondent's bad faith in this proceeding.

The Panel holds that the third element of the Policy has been satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOEHRINGERINGELHEIMPERPERREBATES.COM**: Transferred
2. **BOEHRINGERINGELLEIMPETRBATES.COM**: Transferred
3. **BOEHRINGERINGIHEIMPETREBATES.COM**: Transferred
4. **BOEHRINGERUNGEELHEIMPETREBATES.COM**: Transferred

PANELLISTS

Name	**Igor Motsnyi** / **Mocni Konsalting doo**

DATE OF PANEL DECISION 2021-04-25

Publish the Decision