

Decision for dispute CAC-UDRP-103696

Case number	CAC-UDRP-103696
Time of filing	2021-03-29 09:21:20
Domain names	boehringeringelimpetrebates.com, boehringerringelheimpetrebates.com, wwwboehringerringelheimpetrebates.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 Privacy Services LTD
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OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other proceedings, pending or decided, which relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following registered trademarks:

- the international trademark "BOEHRINGER-INGELHEIM" no. 221544, registered since 1959-07-02;
- the international trademark "BOEHRINGER INGELHEIM" no. 568844 registered since 1991-03-22.

The Complainant is also the owner of the domain name <boehringeringelheimpetrebates.com> which bears the terms "BOEHRINGER INGELHEIM" registered and used since 2019-08-14.

FACTUAL BACKGROUND

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.

The Complainant has become a global research-driven pharmaceutical enterprise and has today about 51,000 employees.

The three business areas of BOEHRINGER INGELHEIM are human pharmaceuticals, animal health, and biopharmaceuticals.

In 2019, the net sales of the BOEHRINGER INGELHEIM group amounted to about 19 billion EUR.

The Respondent registered the following disputed domain names on 2021-03-22:

- <boehringeringelimpetrebates.com>;
- <boehringerringelheimpertrebates.com>; and
- <wwwboehringerringelheimpetrebates.com>.

All of the disputed domain names are offered for sale for a minimum offer of 500 USD.

The Complainant challenges the Respondent's registration of the disputed domain names under paragraph 4(a)(i) of the Uniform Dispute Resolution Policy ("Policy") and seeks relief that the disputed domain names be transferred to the Complainant.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

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

The Complainant contends that the disputed domain names are confusingly similar to its trademark "BOEHRINGER-INGELHEIM", to which trademark the Respondent has included in the disputed domain names in its entirety.

When part of a domain name is identical to a well-known trademark, it increases the likelihood of confusion or association between the domain name holder and the trademark owner. It is, therefore, sufficient to establish identity or confusing similarity for the purposes of the Policy. See *Oki Data Americas, Inc. v. ASD, Inc*, WIPO Case No. D2001-0902; *Dr. Ing. h.c. F. Porsche AG v Vasilij Terkin*, WIPO Case No D2003-003-0888.

The addition of the generic Top-Level Domain suffix ".com" does not change the overall impression of the designation of a disputed domain name as being connected to a trademark. It does not prevent the likelihood of confusion between a disputed domain name and the true owner of the trademark, and the domain name associated with the true owner of the trademark.

Applying the above well-established principles to the present case before the Panel, taking each of the disputed domain names in turn, the Panel finds as follows:

(a) The disputed domain name <boehringeringelimpetrebates> (spacing added for emphasis) omits the letters "he" between the words "ingel" and "im". It would otherwise be identical to the Complainant's trademark "BOEHRINGER INGELHEIM", and the Complainant's domain name <boehringeringelheim petrebates> (spacing added for emphasis).

The Panel considers that the subtle omission of the letters "he" makes the disputed domain name confusingly similar to the Complainant's trademark, and more particularly its domain name with the addition of the words "petrebates".

(b) The disputed domain name <boehringerringelheimpertrebates> (spacing added for emphasis) adds the letter "r" in between the terms "BOEHRINGER" and "INGELHEIM", and misspelled the generic term "pet rebates" as "pert rebates".

The Complainant refers to this panel's decision in CAC Case No. 103124, Boehringer Ingelheim Pharma GmbH & Co.KG v. Fundacion Comercio Electronico <boehringeringelheimpetreebates.com> to support its contention about the misspelled version of a generic term "pet rebates" which was "PET R RE E BATES" (additions of the letters "R" and "E").

The situation is also similar in this case where the addition of the letter "r" interposed between the two words comprising the Complainant's trademark is insufficient to distinguish the disputed domain name from the Complainant's trademark so as to avoid the likelihood of confusion. The same analysis applies to the misspelled word "pet" in the disputed domain name.

The Panel considers that the mere addition or omission of letters to subtly change a domain name so as to avoid it being identical to the trademark is nevertheless in this case confusing or likely to confuse legitimate consumers intending to seek out the Complainant's business.

(c) The disputed domain name <www boehringer r ingelheim petrebates> (spacing added for emphasis) has the letters "www" and "r" added to the Complainant's trademark and is almost identical to the Complainant's domain name.

The Panel refers to and repeats its views expressed in (b) above. For similar reasons, the Panel considers that the disputed domain name is confusingly similar to the Complainant's trademark.

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.

A complainant is 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 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 WIPO Case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.

Here, the Complainant contends that the Respondent is not affiliated with nor licensed or authorized by the Complainant to use any of its trademarks "BOEHRINGER-INGELHEIM", and as such the Respondent has no rights or legitimate interests in the disputed domain names. The Complainant states that it does not carry out any activity for nor has any business with the Respondent.

The Panel accepts this uncontradicted contention.

The Complainant also contends that the Respondent is not identified in the WHOIS database as the disputed domain names.

It is clear that the WHOIS information here is not similar to the disputed domain names, and therefore the Respondent is not commonly known by the disputed domain names.

The evidence also shows that the disputed domain names were registered many years after the registrations of the Complainant's trademarks.

The disputed domain names also resolve to a parking page with commercial links. In addition, the disputed domain names are offered for sale for a minimum offer of 500 USD. The Complainant contends this general offer to sell the disputed domain names evidences the Respondent's lack of rights or legitimate interests.

The Panel is prepared to accept that such conduct is not a bona fide offering of goods or services or legitimate non-commercial or fair use.

See Forum Case No. FA 970871, Vance Int'l, Inc. v. Abend where the panel considered 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.

See also WIPO Case No. D2007-1695, *Mayflower Transit LLC v. Domains by Proxy Inc./Yariv Moshe* where the panel considered that the respondent's use of a domain name confusingly similar to the complainant's trademark for the purpose of offering sponsored links does not of itself qualify as a bona fide use.

Accordingly, the Panel considers that the evidence adduced by the Complainant supports its contention that there is no bona fide offering of goods or services nor a legitimate non-commercial or fair use of the disputed domain names. See *Ustream.TV, Inc. v. Vertical Axis, Inc*, WIPO Case No. D2008-0598.

The Panel is prepared to draw the adverse inference that the Respondent is likely profiting from the confusion likely to arise from consumers believing that the disputed domain names are connected to or associated with the Complainant's trademarks and its business.

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.

There are two elements that must be satisfied – registration and use in bad faith.

As for registration of the disputed domain names, the Panel accepts the Complainant's evidence to support this element. In particular, the Panel is persuaded by the evidence that the Complainant's trademark registrations predate the registration of the disputed domain names, and the Respondent has never been authorised by the Complainant to register the disputed domain names nor was licensed to use the disputed domain names.

Further, the evidence shows that the Complainant's trademarks "BOEHRINGER-INGELHEIM" and "BOEHRINGER INGELHEIM" are distinctive and well-known around the world, and prima facie would indicate that the Respondent knew or ought to have known of the Complainant or the Complainant's trademarks or business at the time the Respondent registered the disputed domain names.

The Panel notes that other past panel decisions referred to the notoriety of the Complainant's trademarks. See WIPO Case No. D2019-0208, *Boehringer Ingelheim Pharma GmbH & Co. KG v. Marius Graur*; CAC Case No. 102274, *BOEHRINGER INGELHEIM PHARMA GMBH & CO.KG v. Karen Liles*; WIPO Case No. D2016-0021, *Boehringer Ingelheim Pharma GmbH & Co.KG v. Kate Middleton*).

The Panel accepts the distinctive nature of the Complainant's trademarks "BOEHRINGER-INGELHEIM" and "BOEHRINGER INGELHEIM"; its widespread and long use and reputation in the pharmaceutical and other related fields; and accordingly it is inconceivable that the Respondent would have registered the disputed domain names without being aware of the Complainant's legal rights.

The Panel considers that by the subtle way in which the Respondent added to or omitted letters or misspelled generic words, using the Complainant's trademarks as the base, makes it compelling that the Respondent had the Complainant's trademarks "BOEHRINGER INGELHEIM" in mind when registering the disputed domain names.

Use in bad faith:

The Panel has already referred to the uncontroverted facts set out in the Complaint and accepts the evidence and contention that the disputed domain names resolve to a parking page with commercial links to attract internet users for commercial gain to his own websites, by offering the disputed domain names for sale to the general public.

This conduct, the bona fides of which are left unexplained by the Respondent, is evidence of bad faith. See WIPO Case No.

D2018-0497, StudioCanal v. Registration Private, Domains By Proxy, LLC / Sudjam Admin, Sudjam LLC; Forum Case No. FA 1623939, Citigroup Inc. v. Kevin Goodman.

The Czech Arbitration Court has also provided written notice of the Complaint to the Respondent with no administratively compliant responses made in respect to any good faith use of the disputed domain names.

In the circumstances, it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain names by the Respondent that would be legitimate.

The Panel, therefore, concludes that the Respondent's holding of the disputed domain names in this particular case satisfies the requirement that the disputed domain names are being used in bad faith by the Respondent.

Accordingly, the Panel finds that the registration of the disputed domain names and their use were in bad faith.

PROCEDURAL FACTORS

Notification of proceedings to the Respondent

When forwarding a Complaint, including any annexes, electronically to the Respondent, paragraph 2 of the Rules states that CAC shall employ reasonably available means calculated to achieved actual notice to the Respondent.

Paragraphs 2(a)(i) to (iii) set out the sort of measures to be employed to discharge CAC's responsibility to achieve actual notice to the Respondent.

On 2021-04-20 the CAC by its non-standard communication stated as follows (omitting irrelevant parts):

- that neither the written notice of the Complaint nor the advice of delivery thereof was returned to the Czech Arbitration Court. The CAC is therefore unaware whether the written notice was received by the Respondent or not;
- As far as the e-mail notice is concerned, the CAC received a confirmation that the e-mail sent to fundacionprivacy@protonmail.com was successfully relayed;
- The e-mail notice sent to postmaster@laintesasapaolo.com was returned back undelivered as the e-mail address had permanent fatal errors;
- The e-mail notice sent to postmaster@boehringeringelimpetrebates.com was returned back undelivered as the e-mail address had permanent fatal errors;
- The e-mail notice sent to postmaster@wwwboehringerringelheimpetrebates.com was returned back undelivered as the e-mail address had permanent fatal errors.

No further e-mail address could be found on the disputed site. The Respondent never accessed the online platform.

Given the reasonable measures employed by CAC as set out in the above non-standard communication, the Panel is satisfied that CAC has discharged this responsibility.

PRINCIPAL REASONS FOR THE DECISION

This is yet another unfortunate case where the owner of the trademarks has to spend money to commence a panel hearing before the CAC to obtain relief by way of the transfer of the disputed domain names to the Complainant.

The internet has a vast ocean of domain names that legitimate users are entitled to create to attract consumers to their websites for whatever reason. Consumers are therefore entitled to engage with those websites that promote a brand or trademark with which they identify and associate without being confused or misled in some way because of confusingly looking domain names with those of the trademark owners.

The Boehringer name is one such well-known brand or business used to distinguish its goods and services that dates to the

1800s. It has notoriety and a worldwide reputation.

The Complainant has had to take legal steps again to protect its rights against a Respondent who is alleged to have registered the disputed domain names which are confusingly similar to the Complainant's unquestionably well-known trademarks by either incorporating wholly the Complainant's trademarks into the disputed domain names or devising a subtle omission or addition of a letter or a misspelled word using in substance the Complainant's trademarks. There is no ingenuity in any of this. It is typical of the type of cases before the CAC where no administratively compliant responses are filed by respondents to whom such complaints are made against them.

It is clear in cases such as this that complainants must be vigilant as to the potential misuse of their intellectual property rights in the domain name space. It is inevitable that complainants will have to incur additional costs in protecting their legitimate rights, especially when in this case the disputed domain names resolve to a parking page with commercial links related to the Respondent.

It is also clear from the evidence that the Respondent seeks only to profit if it could sell any of the disputed domain names for a sum of money. One wonders why anyone would even bother buying a domain name that is likely to be disputed in a forum like the CAC.

Like so many of these undefended matters, most complainants come well prepared with their submissions and evidence in support. The Complainant has proven its case. The Respondent has failed to provide any response. It is therefore proper that the Panel infers that from the totality of the evidence the Respondent does not have any rights or legitimate interests in the disputed domain names. The Panel is also persuaded that the disputed domain names were registered and the use of them can only be inferred to have been done in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOEHRINGERINGELIMPETREBATES.COM**: Transferred
2. **BOEHRINGERRINGELHEIMPERTREBATES.COM**: Transferred
3. **WWWBOEHRINGERRINGELHEIMPETREBATES.COM**: Transferred

PANELLISTS

Name	Adjunct Prof William Lye, OAM QC
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DATE OF PANEL DECISION 2021-05-01

Publish the Decision
