

Decision for dispute CAC-UDRP-103735

Case number	CAC-UDRP-103735
Time of filing	2021-04-14 09:55:44
Domain names	boehringeringelheimpetregates.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	Sugarcane Internet Nigeria Limited
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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 the owner of:
international trademark BOEHRINGER-INGELHEIM registration number 221544, registered on July 2 1959 for goods and services in classes 1, 2, 3, 4, 5, 6, 16, 17, 19, 20, 30 and 32; and
international trademark BOEHRINGER INGELHEIM registration number 568844 registered on 22 March 1991 for goods in 1, 2, 3, 4, 5, 9,10, 16, 30 and 31.

FACTUAL BACKGROUND

The Complainant is a manufacturer of pharmaceuticals and owns the BOEHRINGER INGELHEIM for which it owns a large portfolio of trademarks including the terms "BOEHRINGER INGELHEIM" in several countries including the abovementioned international registrations.

The Complainant has an established Internet presence and one of its domain names is <<boehringeringelheimpetrebates.com>, registered on 14 August 2019 used by the Complainant as the address of its website that offers rebates on pet health products.

The disputed domain name <boehringeringelheimpetregates.com> was registered on 10 April 2021 and resolves to a

parking page with commercial links.

There is no information available about the Respondent, except for that provided in the Complaint, the Registrar's Whois and the information provided by the Registrar in response to the Centre's request for verification of the registration details of the disputed domain name. The Registrar confirmed that the Complainant, who had availed of a privacy protection service to conceal his identity on the published Whois, is the registrant.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant claims rights in the disputed domain name, established by its ownership of its portfolio of registered trademarks. Additionally, the Complainant submits that it has a substantial reputation and goodwill in the mark which it has used since 1885 in its pharmaceutical business and has grown to a global research-driven pharmaceutical enterprise with approximately 52,000 employees and net sales of €19.6 billion in 2020.

The Complainant alleges that the disputed domain name is confusingly similar to its trademark BOEHRINGER-INGELHEIM because the trademark is included in its entirety in the domain name.

In addition of the terms "pet" and "regates" do not change the overall impression of the designation as being connected to the Complainant's trademark BOEHRINGER-INGELHEIM and so do prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and domain names associated. Boehringer Ingelheim Pharma GmbH & Co.KG v. Fundacion Comercio Electronico CAC Case No. 103124, <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' 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.").

On the contrary, the Complainant submits that these additions worsen the likelihood of confusion, as there is a direct reference to the Complainant's website at <www.boehringeringelheimpetrebates.com>.

The Complainant adds that the addition of the generic Top-Level Domain suffix ".com" does not change the overall impression of the designation as being connected to the trademark BOEHRINGER-INGELHEIM. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and associated domain name. Citing Hoffmann-La Roche AG v. Macalve e-dominios S.A. WIPO Case No. D2006-0451 ("It is also well established that the specific top level of a domain name such as ".com", ".org" or ".net" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar.").

The Complainant submits that the disputed domain name is confusingly similar to the Complainant's trademark arguing that the Respondent is not identified in the Whois database as the disputed domain name. 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. Citing, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group Forum Case No. FA 1781783 <bobsfromsketchers.com> ("Here, the WHOIS information of record identifies Respondent as "Chad Moston / Elite Media Group." The Panel therefore finds under Policy paragraph 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy paragraph 4(c)(ii).").

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name asserting that the Complainant the Respondent is not affiliated with nor authorized by the Complainant in any way; that the Complainant does not carry out any activity for, nor has any business with the Respondent and that neither license nor authorization has been granted to the Respondent to make any use of the Complainant's BOEHRINGER-INGELHEIM mark, or to apply for registration of the disputed domain name by the Complainant.

Furthermore, as the disputed domain name resolves to a parking page with commercial links, past panels have found that such use is not a bona fide offering of goods or services or legitimate non-commercial or fair use. Citing Vance Int'l, Inc. v. Abend Forum Case No. FA 970871, (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 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).

The Complainant further alleges that the disputed domain name was registered and is being used in bad faith arguing that

the registrant must have had knowledge of the Complainant as it is one of the world's 20 leading pharmaceutical companies, with roughly 52,000 employees worldwide and having €19.6 billion in net sales when the disputed domain name was registered.

The Complainant contends that the disputed domain name which contains Complainant's distinctive and well-known BOEHRINGER-INGELHEIM trademark was chosen and registered in order to create a confusion with the domain name <boehringeringelheimpetrebates.com>, used by the Complainant as the address of its website that offers rebates on pet health products.

The Complainant argues that consequently, given the distinctiveness of the Complainant's trademarks and its reputation, it is reasonable to infer that the Respondent has registered and used the disputed domain name with full knowledge of the Complainant's trademark.

Furthermore, the disputed domain name resolves to a parking page with commercial links as is shown in a screen capture that has been exhibited in an annex to the Complaint. The Complainant contends the Respondent has attempted to attract Internet users for commercial gain to his own website thanks to the Complainant's trademarks for its own commercial gain, which is an evidence of bad faith. Citing *StudioCanal v. Registration Private, Domains By Proxy, LLC / Sudjam Admin, Sudjam LLC WIPO Case No. D2018-0497*, ("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.").

RESPONDENT:

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

Complainant has adduced clear, convincing and uncontested evidence that it holds rights in the BOEHRINGER INGELHEIM trademark and service mark established through its ownership of its international trademark registrations described above and its extensive use of the mark in its global pharmaceutical business.

The disputed domain name <boehringeringelheimpetregates.com> consists of Complainant's BOEHRINGER INGELHEIM trademark in combination with the nonsense term "petregates" and the generic Top Level Domain extension <.com>.

The Complainant's BOEHRINGER INGELHEIM trademark is the dominant and only distinctive element in the disputed domain name. Neither the nonsense term "petregates" nor the generic Top-Level Domain extension <.com> contribute any distinguishing characteristics to the disputed domain name.

On the balance of probabilities Internet users would find the disputed domain name confusingly similar to the Complainant's BOEHRINGER INGELHEIM trademark.

This Panel finds therefore that the disputed domain name is confusingly similar to the BOEHRINGER INGELHEIM mark in which Complainant has rights. The Complainant has therefore satisfied first element in the test in Policy paragraph 4(a)(i).

The Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name arguing that

- the Respondent is not affiliated with, nor authorized by, the Complainant in any way;
- the Complainant does not carry out any activity for, nor has any business with the Respondent;
- neither license nor authorization has been granted by the Complainant to the Respondent to make any use of the Complainant's trademarks BOEHRINGER-INGELHEIM, or apply for registration of the disputed domain name; and
- furthermore, the disputed domain name is inactive in that it only resolves to a parking page with commercial links and such use is neither a bona fide offering of goods or services nor legitimate non-commercial or fair use.

It is well established that, as in this case, once a complainant makes out a prima facie case that the respondent has no rights or legitimate interests in the domain name at issue, the burden of production shifts the respondent to prove such rights or interests. The Respondent has failed to discharge that burden and therefore this Panel must find that on the balance of probabilities, the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant has therefore satisfied the second element in the test in Policy paragraph 4(a)(ii) also.

Finally, noting the similarity of the disputed domain name to the Complainant's company name and mark, the distinctive character of the BOEHRINGER-INGELHEIM trademark, the unique character of Complainant's unique <<boehringeringelheimpetrebates.com> domain name, and that the disputed domain almost identical to the Complainant's unique <boehringeringelheimpetrebates.com> domain name, it is most improbable that the disputed domain name was chosen and registered for any reason other than to make reference to the Complainant's name and mark.

This Panel finds therefore that the disputed domain name was, on the balance of probabilities, chosen and registered with the Complainant and its business in mind, in order to take predatory advantage of the Complainant's goodwill and reputation.

The Complainant has adduced convincing evidence that the disputed domain name is being used to resolve to a parking page with commercial links to third party websites.

On the balance of probabilities therefore the Respondent is taking advantage of the Complainant's goodwill and reputation, by using the disputed domain name in bad faith, to intercept Internet traffic intended for the Complainant's website at <www.boehringeringelheimpetrebates.com> which is used by the Complainant to offer rebates on pet health products to its customers; and to divert the traffic, to the Respondent's website in order to profit from links to third parties.

The disputed domain name is a combination of the Complainant's trademark and the nonsense term "petregates". This has only one letter difference from the element "pet rebates" in the Complainant's <boehringeringelheimpetrebates.com> domain name. It follows that on the balance of probabilities the disputed domain name is being used in bad faith in an act of typosquatting by the Respondent.

As this Panel is found that the disputed domain name was registered and used in bad faith, Complainant has succeeded in the third and final element in the test in Policy paragraph 4(a)(iii), and is entitled to succeed in this application.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOEHRINGERINGELHEIMPETREGATES.COM**: Transferred

PANELLISTS

Name	Mr James Jude Bridgeman
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DATE OF PANEL DECISION 2021-05-07

