

Decision for dispute CAC-UDRP-103731

Case number	CAC-UDRP-103731
Time of filing	2021-04-13 10:12:31
Domain names	boehringeringelmpetrebates.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 which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the proprietor of various marks, including a trade mark 'BOEHRINGER INGELHEIM' registered under the Madrid international system in respect of various territories (221544, first registered 2 July 1959; 568844, first registered 22 March 1991) in classes such as 1 (chemicals), 5 (pharmaceutical products for humans and animals) and 31 (animal food). These marks have been duly renewed and are valid, and are applicable in a wide range of jurisdictions.

FACTUAL BACKGROUND

The Complainant, a company with its seat in Ingelheim, Germany, was founded in the 19th century and now carries out activities, in multiple territories and at a significant scale (e.g. employing c. 52,000 people), in the pharmaceutical and animal health industries. It is the Registrant of various domain names of its own, used for websites, such as <BOEHRINGER-INGELHEIM.COM> first registered in 1995, and of particular relevance to the present dispute, <BOEHRINGERINGELHEIMPETREBATES.COM> first registered on 13 August 2019 and <BOEHRINGERINGELHEIMEQUINEREBATES.COM> first registered on 14 August 2019.

The Respondent, a body with legal personality (foundation), with its seat in Panama City, Panama, registered the disputed

domain name on 6 April 2021. The Panel notes that the registration of the disputed domain name also includes the name of an individual, Carolina Rodrigues.

PARTIES CONTENTIONS

No administratively compliant Response has been filed. Neither the written notice of the Complaint nor the advice of delivery thereof was returned to the Czech Arbitration Court; two e-mails sent to the Respondent was successfully relayed. The Respondent never accessed the online platform.

The Complainant contends that the disputed domain name was registered and is being used in bad faith, relying in particular upon the well-known nature of its mark and its activities, as well as the confusing similarities between the disputed domain name and its mark, and the lack of any justification provided by the Respondent. The Complainant emphasises the distinctiveness of its mark, a pattern of conduct on the part of the Respondent, and its own specific activities at its own websites; the Complainant also refers to a number of earlier decisions under the Policy in respect of variations on 'pet rebates' or 'equine rebates'. It requests that the disputed domain name be transferred to it.

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).

The disputed domain names differ from the mark in which the Complainant has rights in a number of respects (disregarding, in accordance with UDRP practice, the generic TLD .com).

First, there are differences between the Complainant's relevant mark and the disputed domain names. In respect of the disputed domain name <boehringeringelmpetrebates.com>, the difference is between 'INGELHEIM' (in the mark) and 'INGELM' in the domain name. This represents the omission of 'HEI'. The result is that the disputed domain name is confusingly similar to the mark, especially as the overall impression on the user may be of close similarity at first glance, and the term appears to have no other discernible meaning.

Second, the Panel notes that the string 'PETREBATES' is included in the disputed domain name, but not in any of the Complainant's marks. The Panel is therefore required to consider whether the disputed domain name is confusingly similar to a mark in which the Complainant has rights. The most likely interpretation of this string - which has no dictionary meaning of its own - is as the English-language term 'pet rebates'. As the Complainant is active in manufacturing and distributing animal health products, and indeed has for some time now (and prior to the registration of each of the disputed domain names) operated a website at the domain names <BOEHRINGERINGELHEIMPETREBATES.COM> and <BOEHRINGERINGELHEIMEQUINEREBATES.COM>, through which it offers rebates (retrospective discounts) to customers who have bought animal (pet or equine) health products, it is not difficult to find that the additional text is descriptive of activities associated with the Complainant including those carried out under its trade marks.

The Panel is strengthened in this conclusion (and indeed the other aspects of the Policy discussed below) by its review of the very large number of recent decisions (two of which involved this Panelist) of variously constituted Panels (some pertaining to multiple domain names) at this Provider, which have concerned the Complainant and a successful argument concerning the use of 'rebates' or 'pet rebates'. Most of these decisions also involved the present Respondent. (See also the summary and list of earlier cases found in the recent decision, CAC Case 103715 Boehringer Ingelheim Pharma GmbH v Fundacion Comercio Electronico, <BOEHRINGERINGELHEIMPETREBATES.COM>). There have been around 40 of these cases over the last year and a half, and the number of disputed domain names transferred from the Respondent to the Complainant is approaching a hundred. The Complainant has rightly highlighted a number of these decisions in its Complaint. The Panel notes that there have been eight such decisions (in respect of 13 disputed domain names), all with the same Respondent as the present case, over the last month alone, with every single panel finding for the Complainant with no reservations.

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).

The Complainant contends that the Respondent is not affiliated with nor authorised by the Complainant in any way, and that the Complainant does not carry out any activity for, nor has any business with the Respondent. Moreover, the Complainant declares that it has neither licensed nor authorised the Respondent to make use of its mark.

The Respondent is known as the organisation 'Fundacion Comercio Electronico' but has not participated in these proceedings, and so also provides no evidence of affiliation, rights, or legitimate interests. The Complainant's company name and trade marks are manifestly derived from the name of the Complainant's founder (Boehringer) and its geographic location (the German city of Ingelheim). As such, the Panel cannot find any reason why the non-participating Respondent would choose to carry out its activities under this name, nor indeed under the various names that have been, as listed above, the subject of successful Complaints across multiple Panels over the last fifteen months.

The disputed domain name, at the time of this decision, ultimately leads Web users to a 'parking' page with what appear to be commercial links to various providers of goods or services. This too does not sustain any argument that the Respondent is engaged in (e.g.) the bona fide offering of goods or services in a way that would constitute rights or legitimate interests for the purposes 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).

The Respondent has registered the disputed domain name through a proxy service, though it is clear to the Panel that this Respondent has registered many domain names with a similar pattern of similarity to the Complainant's marks and activities. As Panels have repeatedly held in these cases, the Complainant's mark is clearly well known and would have been known by any Respondent - and this Respondent in particular - at the point of registration.

The Panel also notes the Complainant's reference to the decision in WIPO Case No. D2000-0003, *Telstra Corporation v Nuclear Marshmallows*, where the doctrine of 'passive holding' is outlined, and the fact that the disputed domain name is not presently being used other for a default or parking page (though at the time of this decision, it appears as if a 'redirect' to a page with automatically generated links is now in place). The present case fits the criteria for passive holding well. If one applies the summary found in the WIPO Jurisprudential Overview, version 3.0, para 3.3, all aspects are found: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity, and (iv) the implausibility of any good faith use to which the domain name may be put.

The Panel can also conclude that, at least in recent days through the application of redirection, the Respondent 'intentionally attempted to attract, for commercial gain, Internet users to its website', by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's web site (paragraph 4(b)(iv) of the Policy).

Moreover, the Respondent has manifestly engaged in a pattern of conduct of registering domain names containing the marks of others including the Complainant's mark. As such, this Panel also finds that the activities of the Respondent meet the requirements set out in paragraph 4(b)(ii) of the Policy (registering a domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the Respondent has] engaged in a pattern of such conduct).

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.

It is noted that the present Panel has made two prior decisions, in favour of the Complainant, in respect of proceedings between the same parties: CAC Case 102871 Boehringer Ingelheim Pharma GmbH v Fundacion Comercio Electronico, <BOEHRINGERINGLHEIMPETREBATES.COM> and CAC Case 102950 Boehringer Ingelheim Pharma GmbH v Fundacion Comercio Electronico, <BOEHRINGERELHEIMPETREBATES.COM> and <BOEHRINGERINGINGELHEIMPETREBATES.COM>.

As some of the factual issues (e.g. the Complainant's marks), and the arguments advanced by the Complainant, are the same in the earlier decision and this one, there will be, necessarily, some close similarities between the decisions. However, all due consideration has been given to the specific facts and legal arguments in respect of these present proceedings.

PRINCIPAL REASONS FOR THE DECISION

In the absence of any Response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name <BOEHRINGERELINGELMPETREBATES.COM>. On the other hand, it is clear that the Complainant has rights in respect of the trademark BOEHRINGER INGELHEIM (with which the disputed domain name is confusingly similar), and has carried out various online activities including websites dedicated to the provision of 'pet rebates' and 'equine rebates'. In light of the evidence presented, the Panel can find that the disputed domain name was registered being operated in bad faith, for a number of reasons including passive holding. The Panel noted the concentration of cases concerning this Complainant and Respondent since early 2020, all further having in common the use of the term 'pet rebates' or a close variant thereof. The requirements for the acceptance of a Complaint under paragraph 4 of the Policy have therefore been met, and the Panel ordered that the disputed domain name be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. BOEHRINGERINGELMPETREBATES.COM: Transferred

PANELLISTS

Name	Prof Daithi Mac Sithigh
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DATE OF PANEL DECISION 2021-05-09

Publish the Decision
