

Decision for dispute CAC-UDRP-103726

Case number	CAC-UDRP-103726
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Time of filing	2021-04-09 09:27:14
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Domain names	boehringeringelheimpetrebates.com, boehringeringelheimpeterbates.com
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Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (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 names.

IDENTIFICATION OF RIGHTS

The Complainant is, inter alia, a registered owner of the following trademark containing word elements "BOEHRINGER" and „INGELHEIM”:

- (i) BOEHRINGER-INGELHEIM (word), International (WIPO) Trademark, registration date 2 July 1959, trademark no. 221544, registered for goods in classes 1, 2, 3, 4, 5, 6, 16, 17, 29, 29, 30 and 32; and
- (ii) BOEHRINGER-INGELHEIM (stylised letters), International (WIPO) Trademark, registration date 22 March 1991, trademark no. 568844, registered for goods in classes 1, 2, 3, 4, 5, 6, 16, 17, 29, 29, 30 and 32;

besides other trademarks consisting of the " BOEHRINGER " or „INGELHEIM" denominations (collectively referred to as "Complainant's trademarks").

The Complainant has also registered a number of domain names under generic Top-Level Domains ("gTLD") and country-code Top-Level Domains ("ccTLD") containing the terms "BOEHRINGER" and „INGELHEIM", for example domain name

<boehringeringelheimpetrebates.com> used by the Complainant to offer rebates on pet health products.

FACTUAL BACKGROUND

The Complainant (Boehringer Ingelheim Pharma GmbH & Co.KG). is German 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 disputed domain names <boehringerigngelheimpetrebates.com> and <boehringeringelheimpeterbates.com> were both registered on 1 April 2021 and are held by the Respondent.

The domain name websites (i.e. websites available under internet address containing the disputed domain names) are not genuinely used and merely redirect to a third party parking page with various commercial links.

The Complainant seeks transfer of the disputed domain names to Complainant.

PARTIES CONTENTIONS

The Parties' contentions are the following:

COMPLAINANT:

CONFUSING SIMILARITY

The Complainant states that:

- The Complainant's trademarks are distinctive and well-known trademarks. Past panels have confirmed the notoriety of the trademark consisting of the term "BOEHRINGER-INGELHEIM" in various UDRP case;
- The disputed domain names contain "BOEHRINGER" and "INGELHEIM" word elements, and it is thus almost identical (i.e. confusingly similar) to Complainant's trademarks;
- As for the first disputed domain names, an addition of letter "G" to into the word INGELHEIM (i.e. forming IGNGELHEIM) is not sufficient to escape confusingly similarity between the disputed domain names and Complainant's trademarks;
- As for the second disputed domain name, the only difference between the Complainant's trademarks and the said disputed domain name is a term "PETERBATES", which is a misspelled version of the descriptive term "pet rebates"; and
- Both disputed domain names represent a clear case of so called "typosquatting" which means that the disputed domain names are based on combination of the Complainant's trademark "BOEHRINGER-INGELHEIM" and the misspelled term pet rebates "(i.e. PETERREBATES)".

Thus, according to the Complainant the confusing similarity between Complainant's trademarks and the disputed domain names is clearly established.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant states that:

- The Respondent has not been commonly known by the disputed domain names;
- The Complainant has not authorized, permitted or licensed the Respondent to use Complainant's trademarks in any manner.

The Respondent has no connection or affiliation with the Complainant whatsoever. On this record, Respondent has not been commonly known by the disputed domain names;

- Furthermore, the disputed domain names link to a parking page. Therefore, the Complainant contends that Respondent has not made any genuine use of disputed domain names since its registration, and it confirms that Respondent has no demonstrable plan to use the disputed domain names;
- Besides, the Complainant contends that the Respondent choose to register the disputed domain names to create a confusion with Complainant's domain name <boehringerengelheimpetrebates.com> used by the Complainant to offer rebates on pet health products; and
- The Complainant refers to previous domain name decisions in this regard.

BAD FAITH REGISTRATION AND USE

The Complainant states that:

- Seniority of the Complainant's trademarks predates the disputed domain names registration and such trademarks are well known in relevant business circles. The Respondent can be considered to be aware of the Complainant's trademark when registering the disputed domain names due to well-known character thereof, which should have been checked by the Respondent by performing a simple internet search;
- The disputed domain names (at the time of filing of the complaint) resolve to a mere parking site with no genuine content. In the light of the foregoing, the Complainant asserts that the disputed domain names were registered and used with the sole purpose of selling the disputed domain names to the Complainant or a third party;
- It is well-founded that registration of the disputed domain names that are confusingly similar to the Complainant's trademarks which enjoys strong reputation, plus other facts, such as above described non-use of the disputed domain names and Respondent's engagement in typosquatting, are sufficient to establish bad faith under the 4(a)(iii) of the Policy;
- The Complainant refers to previous domain name decisions contending that registering a domain name (i) incorporating trademarks that enjoy high level of notoriety and well-known character and at the same time (ii) abusing typosquatting, constitute prima facie registration in bad faith, despite a fact that such domain names are not genuinely used;
- The Complainant refers to previous domain name decisions in this regard.

The Complainant presents the following evidence, which has been assessed by the Panel:

- Information about the Complainant and its business;
- Excerpts from trademark database regarding Complainant's trademarks;
- Excerpts from WHOIS database regarding Complainant's domain names;
- Excerpt from WHOIS database regarding disputed domain names;
- Screenshots of the disputed domain names websites (evidencing non genuine use of the same);
- Screenshots of the website <boehringerengelheimpetrebates.com> used by the Complainant.

RESPONDENT:

The Respondent has not provided any response to the complaint.

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

RIGHTS

Since the domain name and the Complainant's trademarks are not identical, the key element investigated and considered by the Panel is whether the disputed domain names consisting of a term "BOEHRINGERINGELHEIMPETREBATES.COM" and "BOEHRINGERINGELHEIMPETEREBATES.COM" are confusingly similar to the Complainant's trademarks.

The disputed domain names 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 "PETREREBATES") to Complainant' trademark or adding letter "G" to into the word INGELHEIM (i.e. forming IINGELHEIM) respectively.

This, however, cannot prevent the association in the eyes of internet consumers between the disputed domain names and the Complainant's trademarks and thus the likelihood of confusion still exists. Thus, addition of letter "G" or a misspelled non-distinctive term cannot sufficiently distinguish the disputed domain names from the Complainant's trademarks.

For sake of completeness, the Panel asserts that the top-level suffix in the domain name (i.e. the ".com") must be disregarded under the identity and confusing similarity tests, as it is a necessary technical requirement of registration.

Therefore, the Panel has decided that there is identity in this case, it also concludes that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant's assertions that the Respondent is not commonly known by either disputed domain name and is not affiliated with nor authorised by the Complainant are sufficient to constitute a prima facie showing of absence of rights or legitimate interest in the disputed domain name on the part of the Respondent.

In addition, given the fact that (i) the disputed domain names have not been genuinely used and (ii) in the absence of the Respondent's response, the Panel concludes that there is no indication that the domain names were intended to be used in

connection with a bona fide offering of goods or services as required by UDRP.

Consequently, the evidentiary burden shifts to the Respondent to show by concrete evidence that it does have rights or legitimate interests in that names. However, the Respondent failed to provide any information and evidence that it has relevant rights or legitimate interests in respect of the disputed domain names (within the meaning of paragraph 4(a) (ii) of Policy).

BAD FAITH

The Respondent has not used the disputed domain names in any manner, however, the Panel concludes (as it has been ruled in many similar cases, as for example *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003, <telstra.org>, *Jupiters Limited v. Aaron Hall*, WIPO Case No. D2000-0574, <jupiterscasino.com>, *Ladbroke Group Plc v. Sonoma International LDC*, WIPO Case No. D2002-0131, <ladbrokepoker.com>) that the apparent lack of so-called genuine active use (e.g. to resolve to a website) of the domain name(s) without any active attempt to sell or to contact the trademark holder (passive holding), does not as such prevent a finding of bad faith.

Examples of what may be cumulative circumstances found to be indicative of bad faith include cases in which (i) the Complainant has a well-known trademark and (ii) there is no genuine use (e.g. a mere "parking" or linking to a parking site) of the disputed domain name(s) by the Respondent (irrespective of whether the latter should also result in the generation of incidental revenue from advertising referrals).

In addition, it is clear that by adding a misspelled generic term "PETEREBATES" or "G" into word element INGELHEIM while all other characters of both disputed domain names are identical to the Complainant trademarks, it was Respondent's intention to target Internet users who incorrectly type a website address into their web browser, an illicit activity recognised as „typosquatting“. There are several different reasons for typosquatting, as for example:

- to try to sell the disputed domain names back to the Complainant;
- to monetize the disputed domain names through advertising revenues from direct navigation misspellings of the intended domain;
- to redirect the typo-traffic to Complainant's competitor;
- as a phishing scheme to mimic the Complainant's site, while intercepting passwords or other information which the visitor enters unsuspectingly;
- to install drive-by malware or revenue generating adware onto the visitors' devices;
- to harvest misaddressed e-mail messages mistakenly sent to the typo domain.

All of the activities above are considered as malicious activities.

This is even more likely because the disputed domain names create a confusion with domain name <boehringerengelheimpetrebates.com> used by the Complainant to offer rebates on pet health products.

For the reasons described above, since (i) there is only a remote chance that the Respondent has registered the disputed domain names just by a chance and without having a knowledge about the existence of the Complainant's rights and business (ii) there is no real use of the dispute domain names and (iii) the Respondent is engaged in typosquatting, the Panel contends, on the balance of probabilities, that the disputed domain names have been registered and are being used by the Respondent in bad faith.

Thus, the Panel has taken a view that 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).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOEHRINGERINGELHEIMPETREBATES.COM**: Transferred
 2. **BOEHRINGERINGELHEIMPETERBATES.COM**: Transferred
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PANELLISTS

Name	JUDr. Jiří Čermák
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DATE OF PANEL DECISION	2021-05-15
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Publish the Decision
