

Decision for dispute CAC-UDRP-103751

Case number	CAC-UDRP-103751
Time of filing	2021-04-22 09:29:49
Domain names	boehringeringelheipetrbates.com, boehringerringelheempetrebates.com

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	Whois Privacy Corp.
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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 owns a large portfolio of trademarks including the wording "BOEHRINGER INGELHEIM" in several countries, such as the international trademark BOEHRINGER-INGELHEIM n°221544, registered since July 2, 1959 and duly renewed, designating several countries and claiming protection for goods in classes 1, 2, 3, 4, 5, 6, 16, 17, 19, 29, 30 and 32, as well as the international trademark BOEHRINGER INGELHEIM, No. 568844, registered since March 22, 1991 for goods in classes 1, 2, 3, 4, 5, 9, 10, 16, 30 and 31, and duly renewed.

In addition, the Complainant owns multiple domain names including the wording "BOEHRINGER INGELHEIM", among which <boehringeringelheipetrebates.com>, registered on August 14, 2019. This domain name is used to offer the Complainant's pet food at reduced prices.

FACTUAL BACKGROUND

The Complainant is a German family-owned pharmaceutical group of companies with origins dating back to 1885, when it was founded by Albert Boehringer in Ingelheim am Rhein.

Ever since, the Complainant has become a global research-driven pharmaceutical enterprise and has today about 140 affiliated companies worldwide, with approximately 52,000 employees. Its three business areas are "human pharmaceuticals", "animal health" and "biopharmaceuticals". In 2020, net sales of the Boehringer group of companies amounted to around 19,6 billion Euros.

The disputed domain names <boehringeringelheipetrates.com> and <boehringerringelheempetrebates.com> were registered on April 16, 2021 and resolve to a parking page with commercial links.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Complainant contends that the disputed domain names are confusingly similar to its trademark BOEHRINGER-INGELHEIM.

The misspellings in the trademark BOEHRINGER-INGELHEIM, i.e., the deletion of the letter "M" in the disputed domain name <boehringeringelheipetrates.com>, or the addition of the letter "R", in the domain name <boehringerringelheempetrebates.com>, and the substitution of letter "l" by the letter "I", are not sufficient to escape the finding that the domain names are confusingly similar to its trademarks. It does not change the overall impression of the designations as being connected to the Complainant's trademarks.

Besides, the addition of the terms "PET RBATES" or "PET REBATES" is not sufficient to escape the finding that the disputed domain names are confusingly similar to the trademark BOEHRINGER-INGELHEIM. The overall impression of the designations as being connected to the Complainant's trademark remains the same. Rather, this addition worsens the likelihood of confusion, as it directly refers to the Complainant's website at <https://www.boehringeringelheimpetrebates.com/>.

The Complainant further asserts that the Respondent lacks rights or legitimate interests in the disputed domain names.

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. The Complainant did not license nor authorized the Respondent to make any use of the Complainant's trademark or to apply for the registration of the disputed domain names.

Furthermore, the disputed domain names resolve to a parking page with commercial links. This practice does not amount to a bona fide offering of goods or services or to a legitimate non-commercial or fair use of the disputed domain names.

Lastly, the Complainant maintains that the disputed domain names were registered and have been used in bad faith.

The Complainant's trademark is distinctive and well-known. It is therefore inconceivable that the Respondent registered the disputed domain names without being aware of the Complainant's trademark. The Complainant is of the opinion that the Respondent registered the disputed domain names to create confusion with the domain name <boehringeringelheimpetrebates.com>, used by the Complainant to offer rebates on its pet health products.

The disputed domain names resolve to a parking page 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.

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

1.

The Panel agrees that the disputed domain names are confusingly similar to the Complainant's trademark. As a matter of fact, the disputed domain names consist of a misspelling of the Complainant's trademark followed by the wording "petrbates" or "petrebates", as the case may be. Despite the misspellings, the Complainant's trademark is fully recognizable within the disputed domain names. The replacement of one letter with another, or the deletion of one letter are certainly not sufficient to exclude similarity, also due to the fact that the Complainant's trademark consists in a long wording. Thus, changing one or two letters does not affect the overall appearance of the Complainant's trademark. Furthermore, the Complainant's trademark is highly distinctive and is immediately recognizable even with a misspelling.

The addition of the wordings "petrbates" and "petrebates" cannot prevent a finding of high confusing similarity of the disputed domain names with the Complainant's trademarks, due to the fact that these wordings are clearly descriptive (even in the case of "petrbates", which contains a clear typo), and refer to one of the businesses of the Complainant, that is "animal health".

Therefore, the addition of the wording "petrebates", rather than diminishing the confusing similarity with the Complainant's trademark enhances it.

For all the above-mentioned reasons, the Panel is satisfied that the first condition under the Policy is met.

2.

In assessing the Respondent's lack of rights or legitimate interests in the disputed domain names, the Panel must take into account that proving a negative fact for the Complainant is a difficult, if not almost impossible task. For this reason, it is generally accepted in UDRP proceedings that it is sufficient for the complainant to establish a prima facie case that the respondent lacks rights or legitimate interests in the disputed domain name to shift the burden of proof to the respondent.

In the case at issue, the Complainant has stated that it has never licensed its trademark to the Respondent, nor authorised in any other way the Respondent to use its trademark, including to register it (or a confusingly similar term) as part of a domain name. Moreover, the Respondent does not appear to have been commonly known by the disputed domain names.

The Complainant has shown that at the time of the filing of the Complaint, the disputed domain names led to parking pages containing pay-per-click links. The Respondent is probably deriving some income from these links and the use of the disputed domain names in such a way does not amount to a bona fide offering of goods or services, or to a legitimate, non-commercial or fair use of the disputed domain names (for similar decisions, see among others, CAC's decision No. 102373, dated April 20, 2019, referring to the domain name <avastsupport.com>; CAC's decision No. 102393, dated April 12, 2019, referring to the domain name <amundi-hk.com>, etc.).

In view of the foregoing, the Panel is satisfied that the second condition under the Policy is met.

3.

In relation to the last condition set forth by the Policy, the Panel notes that the Complainant's trademark is certainly one that enjoys strong reputation, especially in the pharmaceutical field. The reputation of the BOEHRINGER-INGELHEIM trademark has been confirmed in several other prior UDRP decisions such as CAC's decision No. 02274 of January 24, 2019, referring to the domain name <boehringer-Ingelhelm.com> and CAC's decision No. 102130 of October 2, 2018, referring to the domain name <boehringeringelheim.com>.

The disputed domain names contain misspellings of the Complainant's trademarks. It is therefore hardly conceivable that the disputed domain names were registered without having in mind the Complainant's trademark. This is further confirmed by the fact that one of the companies belonging to the Complainant's group is the owner of the domain name <boehringeringelheimpetrebates.com> used to offer rebates on pet health products. It is therefore evident that the Respondent has been inspired by this domain name when registering the disputed ones.

As far as use in bad faith is concerned, the disputed domain names lead to parking pages containing sponsored links, from which the Respondent most probably derives some kind of economic advantage. The Respondent is therefore exploiting domain names confusingly similar to the Complainant's trademark (and almost identical to the domain name <boehringeringelheimpetrebates.com> belonging to the Complainant), to divert traffic intended for the Complainant's website to its own, for commercial gain. Such kind of use amounts to use in bad faith even if the pay-per-click links appearing on the websites are "automatically" generated. Indeed, it is well established that a respondent cannot disclaim responsibility for any content appearing on the website associated with its domain name (see in this respect, para. 3.5 of the WIPO Jurisprudential Overview 3.0).

Furthermore, the Panel has noted in both cases, the disputed domain names are also used as e-mail addresses for their Registrant, Administrative and Technical contacts. Therefore, the disputed domain names have likely been used to send e-mails under the Complainant's name, taking advantage of its good name and reputation. The unauthorised impersonation of a third party through the abusive use of its well-known trademark as part of an e-mail address amounts to bad faith.

For all the aforementioned reasons, the Panel is satisfied that also the third and last condition under paragraph 4(a)(iii) of the Policy is met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. BOEHRINGERINGELHEIPETRBATES.COM: Transferred
2. BOEHRINGERRINGELHEEMPETREBATES.COM: Transferred

PANELLISTS

Name	Angelica Lodigiani
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DATE OF PANEL DECISION 2021-05-28

Publish the Decision
