

Decision for dispute CAC-UDRP-103797

Case number	CAC-UDRP-103797
Time of filing	2021-05-12 09:32:41
Domain names	boehringerengelheimpetrebattes.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 (Laurent Becker)
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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

Complainant owns various trademarks including the terms “BOEHRINGER” and “INGELHEIM” in several countries, including the international trademark no. 568844 “BOEHRINGER INGELHEIM” (word), registered since March 22nd, 1991, which is protected in numerous countries and covers various goods in international classes 01, 02, 03, 04, 05, 09, 10, 16, 30, and 31.

The disputed domain name was registered on May 3rd, 2021, i.e. the Complainant’s international trademark registration mentioned above predates the registration of the disputed domain name.

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. Ever since, BOEHRINGER INGELHEIM has become a global research-driven pharmaceutical enterprise and has today about roughly 52,000 employees. The three business areas of BOEHRINGER INGELHEIM are human pharmaceuticals, animal health and biopharmaceuticals. In 2020, net sales of the BOEHRINGER

INGELHEIM group amounted to about EUR 19.6 billion.

An affiliate of the Complainant, Boehringer Ingelheim Animal Health USA Inc., uses the (undisputed) domain name <boehringeringelheimpetrebates.com> for a website dealing with rebates on the Complainant's pet health products.

The Complainant contends that the Respondent is not affiliated with nor authorized by the Complainant in any way. The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant does not carry out any activity for, nor has any business with the Respondent.

The Complainant has neither granted a license nor any other authorization to the Respondent to make any use of the Complainant's "BOEHRINGER(-)INGELHEIM" trademarks, or to apply for registration of the disputed domain name.

The disputed domain name is not used for an active website.

PARTIES CONTENTIONS

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

The only differences between the Complainant's trademark cited above and the disputed domain name are

- the space between "BOEHRINGER" and "INGELHEIM" (which for technical reasons cannot be represented in an internet domain name),
- the misspelling "PETREBATTES" of the descriptive term "pet rebates", and
- the suffix ".com" (which is also owed to the technical requirements of the domain name system).

This renders the Complainant's trademark and the disputed domain name confusingly similar. The Panel agrees with the findings in the very similar CAC case no. 102871 between the same Parties (Boehringer Ingelheim Pharma GmbH & Co.KG v. Fundacion Comercio Electronico) regarding the similar domain name <boehringeringelheimpetrebates.com>: "As the Complainant is active in manufacturing and distributing animal health products, and indeed operates a website at the domain name <BOEHRINGERINGELHEIMPETREBATES.COM>, prior to the registration of the disputed domain name, through which it offers rebates (retrospective discounts) to customers who have bought animal (pet) 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 further finds that the Complainant successfully submitted prima facie evidence that the Respondent has neither made any use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, nor is making a legitimate non-commercial or fair use of the disputed domain name, nor is commonly known under the disputed domain names. This prima facie evidence was not challenged by the Respondent.

The Panel also finds that the Complainant successfully submitted prima facie evidence that the Respondent was aware of Complainant's rights in the well-known and highly distinctive designation “BOEHRINGER INGELHEIM” when he registered the disputed domain name. Again, this prima facie evidence was not challenged by the Respondent, which supports the conclusion that the domain name was REGISTERED in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

Given the fact that the disputed domain name does not resolve to an active website the primary question of this proceeding is whether or not Respondent has also USED the disputed domain name in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy). Complainant's case regarding such bad faith use is that Respondent is effectively engaged in “passive holding” of the disputed domain name within the terms originally established by Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003. The panel in Telstra noted that the question as to which circumstances of “passive holding” may constitute use in bad faith cannot be answered in the abstract. This question may only be determined on the basis of the particular facts of each case. A panel should give close attention to all the circumstances of the Respondent's behaviour, and a remedy can be obtained under the Policy only if those circumstances show that the Respondent's passive holding amounts to acting in bad faith (cf. Sanofi-aventis v. Gerard Scarretta, WIPO Case No. D2009-0229; Mount Gay Distilleries Limited v. shan gai gong zuo shi, CAC Case No. 100707; RueDuCommerce v. TOPNET, CAC Case No. 100617; INFRONT MOTOR SPORTS LICENCE S.r.l. v. VICTOR LEE, CAC Case No. 100385).

With this approach in mind, the Panel has identified the following circumstances as material to the issue in the present case:

(i) The Respondent has a history of registering domain names which incorporate the Complainant's trademark, for instance, the very similar CAC cases no. 102871 and no. 102945 between the same Parties;

(ii) the Complainant's trademark is highly distinctive. Given the Complainant's size and market position its trademark is widely known and has a strong reputation;

(iii) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use of the disputed domain name, nor can the Panel conceive of any such good faith use;

(iv) the registration of a domain name that is almost identical to the domain name which a trademark owner uses for its own website (in this case < boehringeringelheimpetrebates.com>), where the only difference between the trademark owner's legitimate domain name and the disputed domain name is a single additional letter, is a typical pattern used for abusive “typosquatting” registrations; and

(v) taking into account the nature of the disputed domain name the Panel cannot conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law.

Given all of these circumstances the Panel finds that the manner in which the disputed domain name is being used constitutes use in bad faith. The requirements of paragraph 4(a)(iii) of the Policy are therefore met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. BOEHRINGERINGELHEIMPETREBATTES.COM: Transferred

PANELLISTS

Name	Dr. Thomas Schafft
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DATE OF PANEL DECISION	2021-06-18
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Publish the Decision