

Decision for dispute CAC-UDRP-103832

Case number	CAC-UDRP-103832
Time of filing	2021-06-01 08:34:31
Domain names	boehringer-ingelheims.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

Name	Jack Mcclurg
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OTHER LEGAL PROCEEDINGS

The Panel is unaware of any other pending or decided legal proceedings in respect of the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant relies upon the following registered trade marks, amongst others:

- International trade mark registration no. 221544, dated 2 July 1959, for the word mark BOEHRINGER INGELHEIM, in classes 1, 2, 3, 4, 5, 6, 16, 17, 19, 29, 30 and 32 of the Nice Classification; and
- International trade mark registration no. 568844, dated 22 March 1991, for the word mark BOEHRINGER INGELHEIM, in classes 1, 2, 3, 4, 5, 9, 10, 16, 30 and 31 of the Nice Classification.

FACTUAL BACKGROUND

The Complainant's contentions can be summarised as follows:

I. The disputed domain name is confusingly similar to trade marks in which the Complainant has rights

The Complainant states that it is a German family-owned pharmaceutical group of companies with roots going back to 1885, which was founded by Albert Boehringer in Ingelheim am Rhein.

The Complainant further states that it has become a global research-driven pharmaceutical enterprise, being among the world's 20 leading pharmaceutical companies, with about roughly 52,000 employees. The Complainant's three main businesses comprise human pharmaceuticals, animal health and biopharmaceuticals, and in 2020 the Complainant achieved net sales of EUR 19.6 million.

In addition to the trade marks mentioned above and the many more trade marks in its portfolio, the Complainant informs that it is also the owner of numerous domain names which contain the words "BOEHRINGER INGELHEIM", including <boehringer-ingelheim.com>, which was registered as far back as 1995.

The disputed domain name <boehringer-ingelheims.com> was registered on 24 May 2021. The website to which the disputed domain name resolves is currently inactive, although the MX servers are configured.

The Complainant avers that the disputed domain name is confusingly similar to the Complainant's trade mark BOEHRINGER INGELHEIM and to its associated domain names. The Complainant contends that the disputed domain name is a typosquatting version of the Complainant's trade mark BOEHRINGER INGELHEIM.

In order to substantiate its contention, the Complainant relies on previous UDRP cases, namely CAC Case No. 102708, Boehringer Ingelheim Pharma GmbH & Co.KG v stave co ltd (in respect of the domain name <boehringer-ingelheim.com>); and WIPO Case No. D2006-1043, Edmunds.com, Inc. v Digi Real Estate Foundation (in respect of the domain name <edmundss.com> and the complainant's trade mark "EDMUNDS"). In both matters, the panels determined that domain names which contain a common or obvious misspelling of a trade mark normally will be found to be confusingly similar to such trade mark, where the misspelled trade mark remains the dominant or principal component of the domain names.

The Complainant further alludes to the fact that UDRP panels have found that the Top Level Domain (TLD) suffixes (<.com> in the present matter) are typically not relevant in the appreciation of confusing similarity. In this respect, the Complainant cites WIPO Case No. D2006-0451, F. Hoffmann-La Roche AG v Macalve e-dominios S.A.

II. The Respondent has no rights or legitimate interests in respect of the disputed domain name

The Complainant relies on WIPO Case No. D2003-0455, Croatia Airlines d.d. v Modern Empire Internet Ltd. to elucidate the evidentiary test under the UDRP, which requires the Complainant to make out a prima facie case. If successfully made, the burden of production is shifted to the Respondent to elicit any evidence to the contrary.

The Complainant asserts that the Respondent has no rights in the disputed domain name, and that the Respondent is not affiliated with, nor authorised by, the Complainant in any way. The Complainant does not carry out any activity for, nor has any business with, the Respondent. The Respondent has not been authorised or licensed by the Complainant to make any use of the Complainant's trade mark BOEHRINGER INGELHEIM nor to apply for registration of the disputed domain name by the Complainant.

The Complainant further asserts that the Respondent is not known by the disputed domain name, in so far as the Whois information is not similar to the disputed domain name. On this point, the Complainant cites Forum Claim No. FA1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v Chad Moston / Elite Media Group.

Finally, the Complainant informs that the website to which the disputed domain name resolves is inactive. The Complainant contends on this point that past UDRP decisions have held that the lack of use of a domain name is considered an important indicator of the absence of legitimate interests by the Respondent.

In view of the above factors, the Complainant argues that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

III. The Respondent registered and is using the disputed domain name in bad faith

The Complainant contends that, given the Complainant's trade mark's distinctiveness and reputation, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trade mark BOEHRINGER INGELHEIM.

In respect of the above, the Complainant relies on previous UDRP decisions, of particular note CAC Case No. 102274, BOEHRINGER INGELHEIM PHARMA GMBH & CO.KG v Karen Liles; WIPO Case No. D2016-0021, Boehringer Ingelheim Pharma GmbH & Co.KG v Kate Middleton; and WIPO Case No. D2016-1546, Boehringer Ingelheim Pharma GmbH & Co. KG v Martin Hughes.

In addition, the Complainant states that the disputed domain name resolves to an inactive website. In this regard, the Complainant argues that the Respondent has not demonstrated any activity in respect of the disputed domain name, that it is not possible to conceive any plausible actual or contemplated use of the disputed 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 trade mark law. The Complainant relies on further previous UDRP decisions to base its claim that the incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use (WIPO Case No. D2000-0003, Telstra Corporation Limited v Nuclear Marshmallows; and WIPO Case No. D2000-0400, CBS Broadcasting, Inc. v Dennis Toeppen).

Lastly, the Complainant avers that the disputed domain name has been set up with MX records, which suggests that it may be actively used for e-mail purposes. In the Complainant's view, this is also indicative of bad faith registration and use because any e-mails from the disputed domain name could not be used for any good faith purpose. The Complainant relies on CAC Case No. 102827, JCDECAUX SA v. Handi Hariyono to support its claim on this point.

On these bases, the Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain name is identical or confusingly similar to trade marks 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

Pursuant to Rule 15 of the UDRP Rules, the Panel shall decide a complaint on the basis of the statements and documents

submitted and in accordance with the UDRP Policy, the UDRP Rules, and any rules and principles of law that the Panel deems applicable.

Paragraph 4(a) of the UDRP Policy provides the following threshold for the Complainant to meet in order to divest the Respondent of the disputed domain name:

- i. The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- ii. The Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- iii. The disputed domain name has been registered and is being used in bad faith.

It is therefore incumbent on the Complainant the onus of meeting the above threshold. The evidentiary standard under the UDRP proceedings is the balance of probabilities and, on that basis, the Panel will now proceed to determine each of the three Policy elements in turn.

I. Identical or Confusingly Similar

The UDRP test under the first element provides for a juxtaposing approach, according to which the textual components of the disputed domain name and the Complainant's trade marks are to be compared side by side.

In order to succeed under the first element of the Policy, the Complainant must provide evidence that it has rights in a trade mark or service mark, following which the Panel shall assess whether or not the disputed domain name is identical or confusingly similar to the Complainant's trade mark(s).

Upon review of the case file, the Panel is satisfied that the Complainant has trade mark rights in the terms "BOEHRINGER INGELHEIM", dating back to 1959.

The disputed domain name <boehringer-ingelheims.com> was registered on 24 May 2021. The Complainant's trade mark BOEHRINGER INGELHEIM is wholly incorporated in the disputed domain name.

The addition of the letter "s" after the term "ingelheim" in the disputed domain name is rather immaterial to produce any distinctiveness and, therefore, insufficient to dispel the visual and phonetic confusion between the disputed domain name and the Complainant's trade mark BOEHRINGER INGELHEIM (see e.g. CAC Case No. 102708, Boehringer Ingelheim Pharma GmbH & Co.KG v stave co ltd, in respect of the domain name <boehringer-ingelheim.com>; and CAC Case No. 103570, Boehringer Ingelheim Pharma GmbH & Co.KG v Joe Bob Concept View Ltd, in respect of the domain name <boehringer-ingelheim.com>).

The Panel further notes that TLD suffixes are typically disregarded in the assessment of the first element of the Policy. The reason for that is because a TLD is part of the anatomy of a domain name, being the last component positioned right after the final dot (e.g. ".com", ".org", ".net") (see WIPO Jurisprudential Overview 3.0, paragraph 1.11).

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trade mark BOEHRINGER INGELHEIM, the result of which being that the Complainant has succeeded under the requirement of paragraph 4(a)(i) of the Policy.

II. Rights or Legitimate Interests

The second element of the Policy provides that the Respondent shall demonstrate that it has rights or legitimate interests in the disputed domain name. It therefore falls on the Complainant the burden to refute any such allegations.

Paragraph 4(c) of the Policy sets out a non-exhaustive list of examples by which the Respondent can demonstrate its rights or legitimate interests in the disputed domain name, as follows:

- (i) before any notice of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The evidentiary standard under the UDRP proceedings is such that, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production shifts to the respondent to provide evidence to the contrary.

The Respondent did not submit a Response in these UDRP proceedings. Therefore, the Panel will make a determination on the basis of the available evidence.

Having reviewed the case file, the Panel notes that the Respondent does not carry out any activity for, or has any business or relationship of any nature with, the Complainant. There is no contractual arrangement between the parties to that effect, nor has the Complainant otherwise authorised the Respondent to make any use of the Complainant's trade mark, or to apply for registration of the disputed domain name on the Complainant's behalf. The Complainant has also not authorised the Respondent to make any use of the Complainant's trade mark BOEHRINGER INGELHEIM, and there is no evidence on the record to suggest that the Respondent (as an individual, business, or other organisation) has been commonly known by the disputed domain name.

The Panel notes that there is also no evidence on the record to suggest that the Respondent is affiliated with, or endorsed by, the Complainant (and, in any event, any affiliation or endorsement has been denied by the Complainant).

In addition, in the Panel's view, the choice of a domain name which incorporates a complainant's trade mark wholly (as in this case) or nearly wholly, and is unaccompanied or unsupported by any credible explanation as to the reason for this coincidence, could further evidence a lack of rights or legitimate interests.

Lastly, the Panel notes that under the second element of the Policy, the Complainant also contends (a) that the lack of use of the disputed domain name should be factored into the assessment of the absence of legitimate interests; and (b) that the Respondent is not known by the disputed domain name because the Whois information is not similar to the disputed domain name.

With respect to item (a) above, the Panel addressed the matter of lack of use of a domain name in CAC Case No. 103774, *BOURSORAMA SA v Benjamin Kors*, in which the Panel advocated for a more cautionary approach regarding this assessment. The Panel takes the view that the lack of use may equate to an absence of rights or legitimate interests in a domain name. However, in the case at hand, the disputed domain name was registered only two (2) days before these UDRP proceedings commenced. In line with the Panel's determination in CAC Case No. 103774, it would be precipitous for this Panel to find that the absence of use of the disputed domain name per se equated to lack of rights or legitimate rights. The Panel therefore makes no ruling on this particular point. Instead, the Panel notes that the evidence on the available record does not demonstrate, before any notice of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services. In addition, the

available record does not demonstrate that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers.

With respect to item (b) above, as regards the Whois information, the Panel does not find the argument articulated by the Complainant to be compelling. Whilst the Whois information may be a factor to be considered in the overall assessment of whether or not a respondent is “known by the domain name”, that in isolation lacks the probative value to sustain the allegation that the Respondent lacks rights or legitimate interests, in the Panel’s view.

For the foregoing reasons, and noting that the Respondent has not provided a Response to refute any of the allegations and evidence produced by the Complainant in these proceedings, the Panel finds that the Complainant has made a prima facie showing of the Respondent’s lack of rights or legitimate interests in the disputed domain name under paragraph 4(a)(ii) of the Policy.

III. Registered and Used in Bad Faith

In order to meet the third requirement under the Policy, the Complainant must provide evidence that the disputed domain name was registered and is being used in bad faith.

The Policy enumerates non-exhaustive circumstances which would evidence bad faith registration and use of a domain name, as follows:

1. circumstances indicating that the respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
2. the respondent has registered the 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 you have engaged in a pattern of such conduct; or
3. the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
4. by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

The Panel has considered the evidence put forward by the Complainant and has undertaken some factual research into matters available on the public record. In the Panel’s view, the case circumstances warrant a concurrent assessment of bad faith registration and use, as follows:

- The disputed domain name wholly incorporates the Complainant’s trade mark BOEHRINGER INGELHEIM, and the addition of the letter “s” in the term “ingelheim” is insufficient to dispel the overall visual and phonetic confusion between the disputed domain name and the Complainant’s trade mark in the Panel’s view;
- There is no credible explanation for the Respondent’s choice of the disputed domain name, which was registered in May 2021, bearing in mind that the Complainant has been in operation for over 60 years, including in the United States, where the Respondent is based. Therefore, the Panel does not look favourably upon the Respondent, and finds it highly unlikely that the Respondent was not aware of the Complainant’s prior rights in the trade mark BOEHRINGER INGELHEIM at the time of registering the disputed domain name, given the Complainant’s reputation, which the Panel accepts;

- The Respondent has not provided a Response within the time prescribed under the UDRP Rules, or at all, and has thus failed to offer any explanation of justification to the matters raised by the Complainant in the context of these proceedings. The Panel is empowered to draw adverse inferences by such failure (UDRP Rule 14 (b));
- There is nothing on the record suggesting that the Respondent is affiliated or otherwise connected with the Complainant and the Complainant denies any association;
- The disputed domain name <boehringer-ingelheims.com> mirrors almost identically the Complainant's domain name <boehringer-ingelheim.com> on which the Complainant operates and commercialises its products across the globe since 1995. In CAC Case No. 103538, Intesa Sanpaolo S.p.A. v lisa brgr, the Panel raised in obiter the rather unfortunate issue of certain business sectors having a heightened risk of being targeted for phishing or fraudulent activities. In the same decision, the Panel also voiced concerns that panels should be mindful of this red flag and act accordingly by placing adequate weight on such evidence as they see fit. Whilst the Complainant's claim in the present matter is not grounded on phishing or fraudulent activities, the Panel nevertheless is of the view that there is a possibility that the disputed domain name might have been registered with the prospective intention of being used in connection with fraudulent activity;
- It appears that the disputed domain name has been set up with MX records, which suggests that the Respondent at the least contemplates, at a certain point in time, the use of emails via the website associated with the disputed domain name. In the Panel's view, this behaviour, unaccompanied or unsupported by a credible explanation from the Respondent, enhances the likelihood of the Respondent's prospective intention of fraudulent activity connected with the disputed domain name;
- The Respondent's failure to provide any evidence of actual or contemplated good faith use of the disputed domain name, which does not resolve to an active website; and
- Taken the above together, and on the balance of probabilities, the overall unlikelihood of any good faith use of the disputed domain name.

The Panel has looked at the overall composite picture of events and finds it, collectively, to be sufficient to justify a finding that the Respondent has registered and is using the disputed domain name in bad faith under the Policy.

In conclusion, the Complainant has made a prima facie showing that the Respondent has registered and is using the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOEHRINGER-INGELHEIMS.COM**: Transferred

PANELLISTS

Name	Dr Gustavo Moser
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DATE OF PANEL DECISION	2021-06-30
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Publish the Decision
