

Decision for dispute CAC-UDRP-103868

Case number	CAC-UDRP-103868
Time of filing	2021-06-17 09:41:07
Domain names	boehringers-Ingelheim.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	Sophie Fraser
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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 a family-owned pharmaceutical group of companies founded by Albert Boehringer (1861-1939) in Ingelheim am Rhein. BOEHRINGER INGELHEIM has become a global research-driven pharmaceutical enterprise and has today about roughly 50,000 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 million.

The Complainant further states and provides evidence to support, that it is the owner, among others, of multiple trademark registrations including the terms "BOEHRINGER INGELHEIM" in several countries:

- the international trademark BOEHRINGER-INGELHEIM n°221544, registered since July 2, 1959; and
- the international trademark BOEHRINGER INGELHEIM n°568844 registered since March 22, 1991.

Furthermore, the Complainant owns multiple domain names consisting in the wording "BOEHRINGER INGELHEIM", such as

<boehringer-ingelheim.com> registered since September 1, 1995.

The disputed domain name <boehringers-Ingelheim.com> was registered on June 10, 2021, and resolves to an inactive page.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant draws Panel attention to previous UDRP decisions:

- CAC Case No. 102708, Boehringer Ingelheim Pharma GmbH & Co.KG v. stave co ltd <boehringer-ingelheim.com> (It is the common view among UDRP panelists that a domain name which contains a common or obvious misspelling of a trademark normally will be found to be confusingly similar to such trademark, where the misspelled trademark remains the dominant or principal component of the domain name, see Edmunds.com, Inc. v. Digi Real Estate Foundation, WIPO Case No.D2006-1043, <edmundss.com>. The disputed domain name is such a typosquatting domain and is accordingly confusingly similar to the trademark of the Complainant.”);
- Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group (“Here, the WHOIS information of record identifies Respondent as “Chad Moston / Elite Media Group.” The Panel therefore finds under Policy 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy 4(c)(ii).”);
- Forum Case No. 1765498, Spotify AB v. The LINE The Line / The Line (“The Panel finds that Respondent’s registration of the domain name is typosquatting and indicates it lacks rights and legitimate interests in the domain name per Policy 4(a)(ii).”);
- Forum Case No. 1597465, The Hackett Group, Inc. v. Brian HERN / The Hackett Group (“The Panel agrees that typosquatting is occurring, and finds this is additional evidence that Respondent has no rights or legitimate interests under Policy 4(a)(ii).”);
- WIPO Case No. D2019-0208, Boehringer Ingelheim Pharma GmbH & Co. KG v. Marius Graur (“Because of the very distinctive nature of the Complainant’s trademark [BOEHRINGER-INGELHEIM] and its widespread and longstanding use and reputation in the relevant field, it is inconceivable that the Respondent registered the disputed domain name without being aware of the Complainant’s legal rights.”);
- CAC Case No. 102274, BOEHRINGER INGELHEIM PHARMA GMBH & CO.KG v. Karen Liles (“In the absence of a response from Karen Liles and given the reputation of the Complainant and its trademark (see, among others, WIPO Case No. D2016-0021, Boehringer Ingelheim Pharma GmbH & Co.KG v. Kate Middleton), the Panel infers that the Respondent had the Complainant’s trademarks BOEHRINGER-INGELHEIM in mind when registering the disputed domain name.”);
- WIPO Case No. D2016-1546, Boehringer Ingelheim Pharma GmbH & Co. KG v. Martin Hughes <boehringer-ingalheim.com> (“the registration of the Domain Name which contains obvious misspelling of the Complainant’s BOEHRINGER-INGELHEIM trademark and which is virtually identical to the Complainant’s <boehringer-ingelheim.com> domain name constitutes registration and use bad faith.”);
- WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows;
- WIPO Case No. D2000-0400, CBS Broadcasting, Inc. v. Dennis Toeppen;
- CAC Case No. 102827, JCDECAUX SA v. Handi Hariyono (“There is no present use of the disputed domain name but there are several active MX records connected to the disputed domain name. It is concluded that it is inconceivable that the Respondent will be able to make any good faith use of the disputed domain name as part of an e-mail address.”).

PARTIES' CONTENTIONS:

COMPLAINANT:

- The disputed domain name is confusingly similar to the protected mark

The Complainant states that the Respondent has registered a disputed domain name that is confusingly similar to its trademark BOEHRINGER-INGELHEIM and its domain names associated.

Essentially, the Respondent has appropriated the trademark BOEHRINGER INGELHEIM with the addition of the letter "S", the substitution of the letter "I" by the letter "L" and the use of the gTLD ".COM", concluding that the domain name <boehringers-Ingelheim.com> is confusingly similar to the Complainant's trademark and it does not change the overall impression of the designation as being connected to the trademark BOEHRINGER-INGELHEIM.

Accordingly, the Complainant believes this is a clear case of "typosquatting", i.e. the disputed domain name contains an obvious misspelling of the Complainant's trademark: BOEHRINGERS-LNGELHEIM instead of BOEHRINGER-INGELHEIM.

- Respondent does not have any rights or legitimate interest in the disputed domain name

The Complainant argues that the Respondent has no rights to the disputed domain name, and any use of the trademark BOEHRINGER-INGELHEIM has to be authorized by the Complainant. The Complainant contends that 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. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademark BOEHRINGER-INGELHEIM, or apply for registration of the disputed domain name by the Complainant.

Furthermore, the Complainant also claims that the disputed domain name is a typosquatted version of the trademark BOEHRINGER-INGELHEIM. Typosquatting is the practice of registering a domain name in an attempt to take advantage of Internet users' typographical errors and can be evidence that a respondent lacks rights and legitimate interests in the domain name.

Finally, the Complainant provides that the disputed domain name is not used or did not make any use of since its registration, and confirms that Respondent has no demonstrable plan to use the disputed domain name since its registration.

- The disputed domain name has been registered and is being used in bad faith

The Complainant states that the Complainant's trademark BOEHRINGER-INGELHEIM is distinctive and well-known. Past panels have confirmed the notoriety of the Complainant's trademark. Given the distinctiveness of the Complainant's trademark and its reputation, the Complainant argues it is reasonable to infer that the Respondent has registered and used the domain name with full knowledge of the Complainant's trademark.

The Complainant further contends that the Respondent registered the disputed domain name with the misspelling of the trademark BOEHRINGER-INGELHEIM to intentionally create confusion with the Complainant's trademark, which is evidence of bad faith.

Consequently, given the distinctiveness of the Complainant's trademarks and its reputation, it is reasonable to infer that the Respondent has registered and used the disputed domain name with full knowledge of the Complainant's trademark.

Finally, the Complainant provided that the disputed domain name resolves to an inactive page. The Complainant contends that the Respondent has not demonstrated any activity in respect of the disputed domain name, and it is not possible to 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.

PARTIES CONTENTIONS

RESPONDENT:

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 UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (UDRP) of the Internet Corporation for Assigned Names and Numbers (ICANN) (the "Policy") provides that complainant must prove each of the following to obtain transfer or cancellation of the domain name:

1. that respondent's domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights; and
2. that respondent has no rights or legitimate interests in respect of the domain name; and
3. the domain name has been registered and is being used in bad faith.

1) The disputed domain name is confusingly similar to a trademark in which the Complainant has rights (Para.4(a)(i) of the Policy).

The Complainant has provided evidence and proved to be the owner of several BOEHRINGER-INGELHEIM trademarks in various jurisdictions. Essentially, the Respondent has appropriated the trademark BOEHRINGER-INGELHEIM with the addition of the letter "S", the substitution of the letter "I" by the letter "L" to presumably lead consumers to believe that it is affiliated with the Complainant. The disputed domain name thus incorporates almost the entirety of the well-known BOEHRINGER-INGELHEIM trademark as its distinctive element.

The Panel finds that the Respondent's registered a disputed domain name which is confusingly similar to the Complainant's

trademark BOEHRINGER-INGELHEIM since the typosquatting elements used by the Respondent do not eliminate any confusing similarity. This is especially true where, as here, the trademark is “the dominant portion of the domain name,” *LEGO Juris A/S v. Domain Tech Enterprises*, WIPO Case No. D2011-2286, or where the trademark in the domain name represents “the most prominent part of the disputed domain name[] which will attract consumers’ attention.” *Kabushiki Kaisha Toshiba dba Toshiba Corporation v. WUFACAI*, WIPO Case No. D2006-0768.

Also, it is well established that typosquatting can constitute a finding that the domain name is confusingly similar (*Deutsche Bank Aktiengesellschaft v. New York TV Tickets Inc.*, WIPO Case No. D2001-1314, *DaimlerChrysler Corporation v. Worshipping, Chrysler, and Chr*, aka *Dream Media* and aka *Peter Conover*, WIPO Case No. D2000-1272 and *Playboy Enterprises v. Movie Name Company*, WIPO Case No. D2001-1201). The Panel considers this to be a clear case of typosquatting.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark BOEHRINGER-INGELHEIM.

2) The Respondent lacks rights or legitimate interests in the disputed domain name (Para. 4(a)(ii) of the Policy).

Under the Policy, a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy (see WIPO Overview 2.0, paragraph 2.1).

According to the Complainant, the Respondent has no rights to the disputed domain name, and any use of the trademark BOEHRINGER-INGELHEIM has to be authorized by the Complainant. The Respondent has not been authorized or licensed by the Complainant to use the disputed domain name.

The Respondent has no right or legitimate interests in the disputed domain name resolving to an inactive page at the time of the decision in the present case (see, e.g., *Philip Morris USA Inc. v. Daniele Tornatore*, WIPO Case No. D2016-1302). Past panels 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. See *Forum Case No. FA 1773444, Ashley Furniture Industries, Inc. v. Joannet Macket / JM Consultants* (“The Panel finds that Respondent’s lack of content at the disputed domain shows the lack of a bona fide offering of goods or services or a legitimate noncommercial or fair use per Policy 4(c)(i) and (iii).”).

In a present case, the Respondent failed to file a Response in which it could have provided evidence in support of its rights or legitimate interests. Therefore, all these circumstances are sufficient to establish a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name.

The Panel thus takes the view that the Respondent lacks rights or legitimate interests in the disputed domain name.

3) The disputed domain name has been registered and is being used in bad faith (Paragraph 4(a)(iii) of the Policy).

The Panel agrees with the Complainant that its trademark BOEHRINGER-INGELHEIM is distinctive and well known and finds that the disputed domain name <boehringers-Ingelheim.com> is confusingly similar to the Complainant's well-known trademark. It is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark. The Complainant's use and registration of the trademark BOEHRINGER-INGELHEIM largely precede the registration date of the disputed domain name. The fact that the Respondent registered the disputed domain name with the misspelling of the trademark BOEHRINGER-INGELHEIM clearly indicates that the Respondent had knowledge of the Complainant's trademark at the time of registration of the disputed domain name. It is reasonable to conclude that this is evidence of registration of the domain name in bad faith.

The disputed domain name redirects to an inactive page. According to the Panel, a passive holding of the disputed domain name may amount to bad faith when it is difficult to imagine any plausible future active use of the disputed domain name by the Respondent that would be legitimate and not infringing the Complainant's well-known mark or unfair competition and consumer protection legislation (See Inter-IKEA v Polanski, WIPO Case No. D2000 1614; Inter-IKEA Systems B.V. v. Hoon Huh, WIPO Case No. D2000 0438; Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003). Countless UDRP decisions also confirmed that the passive holding of a domain name with the knowledge that the domain name infringes another party's trademark rights is evidence of bad faith registration and use (see, in this regard, Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003).

The fact that a complainant's trademark has a strong reputation and is widely used and the absence of evidence whatsoever of any actual or contemplated good faith use are further circumstances that may evidence bad faith registration and use in the event of passive use of domain names (see section 3.3, WIPO Overview 3.0).

In addition, the Policy defines that one of the actions which constitute bad faith pursuant to paragraph 4(b)(iv) of the Policy is the use of the domain name to intentionally attempt to attract, for commercial gain, Internet users to respondent's 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 respondent's web site or location or of a product or service on respondent's web site or location.

The Panel believes it is likely that this was at least one of the reasons behind the Respondent's registration and use of the disputed domain name. Accordingly, the Panel finds that the Respondent has engaged in typosquatting to cause confusion with the Complainant's trademark for their own commercial gain, and therefore the disputed domain name was registered and is being used in bad faith within the meaning of Paragraph 4(a)(iii) of the Policy.

For all reasons stated above, the Panel is satisfied that the Complainant has proven the third element of the Policy that is that the Respondent's registration and use of 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. BOEHRINGERS-LNGELHEIM.COM: Transferred

PANELLISTS

Name	Mgr. Barbora Donathová, LL.M.
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DATE OF PANEL DECISION 2021-07-15

Publish the Decision
