

Decision for dispute CAC-UDRP-103970

Case number	CAC-UDRP-103970
Time of filing	2021-08-12 09:15:32
Domain names	boehringerengelheimonline.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 S.A.S.
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Respondent

Name	ADRIAN Richie
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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 relies upon the following registered trademarks, amongst others:

- International trademark 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 trademark 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.

The Complainant owns multiple domain names comprising the trademark BOEHRINGER INGELHEIM.

The disputed domain name <boehringerIngelheimonline.com> was registered on 3 August 2021, and is redirecting to the Complainant's official Canadian web site <https://www.boehringer-ingelheim.ca>.

FACTUAL BACKGROUND

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 comprises the main trademark of the Complainant just with the descriptive term "on Line" added to it.

Accordingly, the Complainant believes this is a clear case of squatting of a famous trademark/domain name.

- The 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 trade mark BOEHRINGER-INGELHEIM has to be authorized by the Complainant but it was not. The Complainant contends that the Respondent is not affiliated with nor authorized by the Complainant in any way. The Respondent's domain name is redirected to the Complainant's official Canadian web site and for this reason has a fully knowledge of the Complainant's prior rights and industrial activities.

For the above reason the Complainant states that the disputed domain name has been registered by the Respondent in an effort to take advantage of its good reputation with the sole aim to create confusion with the Complainant's trademarks and domain names.

- 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 disputed domain name with full knowledge of the Complainant's trademark.

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 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 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 descriptive term "on line".

The Panel finds that the Respondent registered a disputed domain name which is almost identical to the famous Complainant's trademarks. 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.

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 even if redirects to the Canadian official website of the Complainant <https://www.boehringer-ingelheim.ca/>. This however is a self evident proof that the Respondent did know the reputation and activities of the Complainant.

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 <boehringerlingelheimonline.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 adding a descriptive term "on line" 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 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 an evident squatting activity 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.

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.

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.

At the same time 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. BOEHRINGERINGELHEIMONLINE.COM: Transferred

PANELLISTS

Name Massimo Cimoli

DATE OF PANEL DECISION 2021-09-16

Publish the Decision
