

Decision for dispute CAC-UDRP-103993

Case number	CAC-UDRP-103993
Time of filing	2021-08-24 09:09:12
Domain names	boehringer-ingelhcim.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)
--------------	---

Complainant

Organization	Boehringer Ingelheim Pharma GmbH & Co.KG
--------------	--

Complainant representative

Organization	NAMESHIELD S.A.S.
--------------	-------------------

Respondent

Organization	tateandlyle inc
--------------	-----------------

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 has established by evidence that the Panel accepts that it is the owner of the BEOHRINGER-INGELHEIM trademark, being the international trademark No. 221544 for BEOHRINGER-INGELHEIM registered on July 2, 1959 and duly renewed and that it was the owner of that trademark when the disputed domain name was registered ("the BEOHRINGER-INGELHEIM trademark").

The Complainant has also established by evidence that the Panel accepts that it is the owner of many other trademarks that include the words BEOHRINGER INGELHEIM.

FACTUAL BACKGROUND

The Complainant is a long-established and prominent German company in the pharmaceutical industry. It has extensive activities internationally. It has an extensive range of trademarks for BEOHRINGER-INGELHEIM and BEOHRINGER INGELHEIM, in particular the BEOHRINGER-INGELHEIM trademark and other trademarks including the words BEOHRINGER INGELHEIM which are very well known and very valuable. It also owns many domain names incorporating those trademarks.

The Respondent registered the <boehringer-ingelhcim.com> domain name on August 17, 2021. The Complainant is concerned that this misspelling of its trademark tarnishes the BEOHRINGER-INGELHEIM trademark and will lead to confusion in the community as to whether it is an official domain name of the Complainant or not.

It has therefore brought this proceeding to have the domain name transferred from the Respondent to itself.

PARTIES CONTENTIONS

CONTENTIONS OF THE PARTIES

COMPLAINANT

The Complainant made the following contentions.

1. The disputed domain name is confusingly similar to the BEOHRINGER-INGELHEIM trademark.

That is because the disputed domain name is an obvious misspelling of the trademark, as it deletes the letter “e” where last appearing and replaces it with the letter “c”. This is characteristic of the practice of typosquatting, which has long been recognized as a ground for a finding of confusing similarity between a domain name and a trademark. In the present case the confusing similarity was also clearly intended.

2. The Respondent does not have any rights or legitimate interests in the disputed domain name.

The 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 out, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name and if the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the Policy.

There is no evidence that Respondent is commonly known by the disputed domain name and the WHOIS information shows that it is not so known.

The Respondent is clearly not related in any way with the Complainant and the Complainant does not carry out any activity for, nor have any business with, the Respondent.

The Complainant has neither licensed nor authorized the Respondent to make any use of the Complainant’s BOEHRINGER-INGELHEIM trademark, or apply for registration of the disputed domain name.

Furthermore, this is clearly a case of typosquatting of the BOEHRINGER-INGELHEIM trademark by the Respondent.

Thus, the Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name.

3. The Respondent registered and has used the disputed domain name in bad faith. That is so for the following reasons.

The disputed domain name <boehringer-ingelhcim.com> is confusingly similar to the BOEHRINGER-INGELHEIM trademark and, given the distinctiveness of the trademark and its reputation, it is reasonable to infer that the Respondent has registered and used the domain name with full knowledge of the trademark.

Therefore, by registering the disputed domain name <boehringer-ingelhcim.com> with the misspelling of the BOEHRINGER-

INGELHEIM trademark, it must have been intended to cause this confusing similarity with the Complainant's trademark.

Consequently, it is clear that the Respondent has registered the disputed domain name in bad faith and has used it to create a likelihood of confusion with the Complainant's trademark as to source, affiliation or endorsement, within the meaning of paragraph 4(b)(iv) of the Policy, and thus in bad faith.

Accordingly, the Respondent has registered and used the disputed domain name in bad faith.

RESPONDENT:

The Respondent did not file a Response in this proceeding and is therefore in default.

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

This is a mandatory administrative proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP") of the Internet Corporation for Assigned Names and Numbers ("ICANN"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the CAC Supplemental Rules.

A. Administrative deficiency

By notification dated August 25, 2021 and in accordance with paragraph 4 (b) of the Rules, the CAC notified the Complainant that the Complaint was administratively deficient in that the Complaint had not sufficiently described the Respondent.

The notification invited the Complainant to see the Registrar's Verification available in the online case file in the form of a Nonstandard Communication regarding the appropriate identification of the domain name holder. The Registrar's Verification stated that the Respondent was Dinah Moore and provided the contact information. On August 25, 2021, the Complainant filed an Amended Complaint correcting the identification of the Respondent and the CAC determined that the Complaint should be admitted to proceed further in the Administrative Proceeding.

The Panel has reviewed all of the above matters and makes a finding that within the meaning of paragraph 4(b) of the Rules, the administrative deficiencies have been corrected and that this matter has proceeded properly to the Panel in accordance with the Policy and the Rules.

B. Substantive matters

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In that regard, the Panel also notes that the onus is on the Complainant to make out its case and past UDRP panels have consistently said that a complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

The Panel therefore turns to discuss the various issues that arise for decision on the facts as they are known.

For the complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

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

The Panel will therefore deal with each of these requirements in turn.

A. Identical or Confusingly Similar

The Complainant has adduced evidence that the Panel accepts that it is the registered owner of the BEOHRINGER-INGELHEIM trademark and as such has rights in that trademark.

The Panel next finds that the disputed domain name <boehringer-ingelhcim.com> registered on August 17, 2021 is confusingly similar to the BEOHRINGER-INGELHEIM trademark for the following reasons.

First, the domain name includes the entirety of the BEOHRINGER-INGELHEIM trademark, apart from the fact that the letter "e" where last appearing in the trademark has been omitted and the letter "c" has been substituted for it.

Accordingly, the internet user observing the domain name would assume that the entirety of the trademark was incorporated in the domain name and that therefore it was an official domain name of the Complainant. Put in different words, the internet user would conclude that the domain name was confusingly similar to the trademark.

The Complainant correctly submits that this practice is referred to as typosquatting and that it has long been regarded as a ground for a finding of confusing similarity. The Panel makes that finding in the present case and it also finds that the alteration was probably made intentionally.

The alteration in the spelling of the trademark is so minor and the fact that it has been made is so brazen that it is impossible to come to any other conclusion than that the domain name is confusingly similar to the trademark.

It is also now well established that the addition of a generic top level domain, such as ".com" in the present case, cannot negate confusing similarity that is otherwise present, as it is in the present case.

Accordingly, the domain name is confusingly similar to the Complainant's trademark and the Complainant has thus shown the first of the three elements that it must establish.

B. Rights and Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

But by virtue of paragraph 4(c) of the Policy, it is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

(i) before any notice to you [respondent] of the dispute, your 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) you [respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you [respondent] are 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.

Thus, if a respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the domain name, the complainant will have failed to discharge its onus and the complaint will fail.

It is also well-established that a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests and that when such a prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent cannot do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Panel, after considering all of the evidence in the Complaint, finds that the Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name.

That prima facie case is made out from the following considerations.

The Respondent has taken the Complainant's prominent BEOHRINGER-INGELHEIM trademark and has used it in its domain name, making only a minor change in the spelling of the trademark when it has been incorporated in the domain name. Such an act of typosquatting cannot give rise to a right or legitimate interest in the domain name.

It is clear from the evidence that the Respondent is not commonly known by the domain name under Policy 4(c)(ii).

The evidence of the Complainant is to the effect that the Respondent is not related in any way to the Complainant's business, is not affiliated with the Complainant or authorized by it in any way to use the trademark, does not carry out any activity for, nor has any business with, the Complainant and has not been given any license or permission to use the Complainant's trademark in a domain name or anywhere else.

The disputed domain name does not resolve to an active website showing a legitimate use of the domain name, but merely to a site noting that it has been hosted, but openly displaying the incorrect spelling of the domain name. This shows that the Respondent is so open about its misappropriation of the trademark that the domain name could not possibly give rise to a right or legitimate interest. In fact, it would be impossible to conceive of any circumstance where the Respondent could show that it has a right or legitimate interest in the disputed domain name.

These facts give rise to the prima facie case made out by the Complainant.

The Respondent has not filed a Response or made any other answer to the claims of the Complainant and is in default. Accordingly, the prima facie case has not been rebutted and the Complainant has made out the second of the three elements that it must establish.

C. Registered and Used in Bad Faith

The Complainant must prove on the balance of probabilities both that the disputed domain name was registered in bad faith and that it is being used in bad faith: *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003.

Paragraph 4(b) of the Policy sets out four circumstances, any one of which is evidence of the registration and use of a domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive. The four specified circumstances are:

- (i) circumstances indicating that the respondent has registered or 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 the respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) 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 the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's website 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 the respondent's website or location or of a product or service on the site or location.

The Panel finds that the Complainant has shown that the Respondent registered and used the disputed domain name in bad faith both in general and in particular, because the Respondent's conduct puts the case squarely within paragraph 4(b) (iv) of the Policy and probably within other provisions of paragraph 4 (b).

That is so for the following reasons.

First, the disputed domain name <boehringer-ingelhcim.com> is confusingly similar to the BOEHRINGER-INGELHEIM trademark and, given the distinctiveness of the trademark and its reputation, it is reasonable to infer that the Respondent has registered and used the domain name with full knowledge of the trademark. In any event the trademark is famous and the Respondent must have known this to be so. Thus, by registering the disputed domain name <boehringer-ingelhcim.com> with the misspelling of the BOEHRINGER-INGELHEIM trademark, the Respondent must have intended to cause this confusing similarity with the Complainant's trademark and hence create confusion in the market as to the origin of any goods and services offered under the disputed domain name.

The bad faith necessarily created by doing this is exacerbated by the fact that the Complainant and its name and trademark are famous in the pharmaceutical industry and if the domain name were used to sell those products on the internet, there is a real risk that they would be counterfeit and pose a real threat to public health, as is seen so often.

The Panel therefore accepts and agrees with the Complainant's contention that the Respondent has registered the disputed domain name in bad faith and has used it to create a likelihood of confusion with the Complainant's trademark as to source, affiliation or endorsement, within the meaning of paragraph 4(b)(iv) of the Policy, and thus in bad faith. The likelihood is that

the Respondent would have eventually used the domain name to link it to per-per-click offerings for commercial benefit to itself. Apart from trying to sell the domain name to the Complainant, it is difficult to conceive of any other use the Respondent could have had in mind for the domain name. In any event, any such proposed use would have been in bad faith.

Registering the domain name as it has done with the typosquatting so apparent would also be in bad faith as it would also clearly disrupt the business of the Complainant in breach of paragraph 4(b) (iii) of the Policy.

Apart from the registration and use of the domain name being in bad faith by reason of the specific criteria set out in paragraph 4 (b) of the policy, they are also in bad faith in general and within the normal meaning of the word.

Accordingly, the Respondent has registered and has used the disputed domain name in bad faith.

The Complainant has thus made out the third of the three elements that it must prove.

The Complainant is therefore entitled to the relief that it seeks.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	The Hon. Neil Brown, QC
------	-------------------------

DATE OF PANEL DECISION	2021-09-19
------------------------	------------

Publish the Decision