

Decision for dispute CAC-UDRP-103989

Case number	CAC-UDRP-103989
Time of filing	2021-08-19 09:35:36
Domain names	newsletterboehringerengelheim.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

Organization	Keep Agencia SAS
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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 owns several trademarks including the wording “BOEHRINGER INGELHEIM” in several countries, such as the international trademark BOEHRINGER-INGELHEIM n° 221544, registered since July 2, 1959 and duly renewed, and the international trademark BOEHRINGER INGELHEIM n° 568844 registered since March 22, 1991. Further the Complainant has a valid national word trademark BOEHRINGER INGELHEIM in Colombia, SIC 131056.

Moreover, the Complainant owns multiple domain names consisting in the wording “BOEHRINGER INGELHEIM”, such as registered since September 1, 1995.

The disputed domain name was registered on August 5, 2021 and redirects to the Registrar parking page.

FACTUAL BACKGROUND

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

The Complainant is a German 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 50,000 employees. The main business areas of BOEHRINGER INGELHEIM are: human pharmaceuticals, animal health and biopharmaceuticals.

The Complainant's trademark BOEHRINGER-INGELHEIM is distinctive and well-known. Past panels have confirmed the notoriety of the Complainant's trademarks.

For instance:

- 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.").

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. The Complainant has in Columbia, where the Respondents resides, a subsidiary Boehringer Ingelheim S.A., Carrera 65B No. 13-13, Apartado Aéreo, No. 4028, Bogotá and a valid national word trademark. Essentially, the Respondent has appropriated the trademark BOEHRINGER-INGELHEIM with the prefix of the descriptive term "newsletter". This addition of letters is not sufficient to distinguish the disputed domain name from the Complainants' trademark BOEHRINGER INGELHEIM. Further the public expects information from the Complainant not only about, though there is a likelihood of confusion.

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," CAC UDRP 103970 - BOEHRINGERINGELHEIMONLINE.COM, Case 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. See also CAC Case 101202 - US-BOEHRINGER-INGELHEIM.COM. The TLD .com does not affect the domain name for the purpose of determining whether it is identical or confusingly similar.

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 providers website. The Combination of Complainants famous company name and the describing word newsletter shows that the Respondent understands the English language and the sense, see WIPO Case no. D2014-0306 Boehringer Ingelheim Pharma GmbH & Co. KG v. Klinik Sari Padma, BAKTI HUSADA: "Panel finds it is highly unlikely that Respondent had no knowledge of Complainant's company name and legal rights to the trademark BOEHRINGER INGELHEIM [...], considering its notorious status and success in the pharmaceutical field."

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 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 "newsletter" 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 a website, by creating a likelihood of confusion with the complainant's trademark as to the source, sponsorship, affiliation, or endorsement of respondent's website or location or of a product or service on respondent's website 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. **NEWSLETTERBOEHRINGERINGELHEIM.COM**: Transferred

PANELLISTS

Name	Dr. jur. Harald von Herget
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DATE OF PANEL DECISION	2021-09-20
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Publish the Decision
