

Decision for dispute CAC-UDRP-103987

Case number	CAC-UDRP-103987
Time of filing	2021-08-19 09:46:47
Domain names	career-boehringerengelheim.com

Case administrator

Organization	Denisa Bilík (CAC) (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	Jamie Eden
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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 invokes two registered trademarks in this case:

- BOEHRINGER-INGELHEIM., international trademark No. 221544 registered since July 2, 1959 in classes 1, 2, 3, 4, 5, 6, 16, 17, 19, 29, 30 and 32, and covering various countries; and
- BOEHRINGER INGELHEIM, international trademark No. 568844 registered since March 22, 1991 in classes 1, 2, 3, 4, 5, 9, 10, 16, 30 and 31, and covering various countries.

FACTUAL BACKGROUND

The Complainant is part of a family-owned pharmaceutical group of companies with roots going back to 1885. The Complainant's group has become a global research-driven pharmaceutical enterprise with about 52,000 employees. The main business areas of the Complainant are human pharmaceuticals, animal health and biopharmaceuticals. In 2020, net sales of the Complainant's group of companies amounted to approximately EUR 19,6 billion.

The Complainant is the owner of registered marks comprising the terms "BOEHRINGER INGELHEIM" in several classes in

numerous countries all over the world. The Complainant also owns domain names comprising the same terms, such as <boehringer-ingelheim.com> registered since 1995. The Complainant uses <careers.boehringer-ingelheim.com> as a subdomain to inform Internet users about employment at the Complainant.

The disputed domain name <career-boehringeringelheim.com> was registered on August 10, 2021 and is inactive.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant considers the disputed domain name to be confusingly similar to trademarks in which it has rights. The Complainant claims that the Respondent has no rights or legitimate interests in respect of the disputed domain name. According to the Complainant, the Respondent does not use the disputed domain name in connection with any legitimate use. Also, according to the Complainant, the Respondent is not related in any way to the Complainant and has not been authorized to register or use the disputed domain name. Finally, the Complainant considers that the disputed domain name was registered and is being used in bad faith. The Complainant contends that the Respondent knew of the existence of the Complainant's trademark. The Complainant further contends that the Respondent has registered the disputed domain name to create a likelihood of confusion with the Complainant's website linked to the subdomain <careers.boehringer-ingelheim.com>. According to the Complainant, 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.

RESPONDENT:

The Respondent did not reply to the Complainant's contentions.

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

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

The onus is on the Complainant to make out its case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainant must show that all three elements set out in Paragraph 4 (a) of the Policy have been established before any order can be made to transfer a domain name. As the proceedings are administrative, the standard of proof is the balance of probabilities.

Thus, for the Complainant to succeed, it must prove, within the meaning of Paragraph 4(a) of the Policy and on the balance of probabilities, that:

1. The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
2. The 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.

The Panel has therefore dealt with each of these requirements in turn.

1. Identity or confusing similarity

The Complainant must first establish that there is a trademark or service mark in which it has rights. The Complainant has clearly established that there are BOEHRINGER INGELHEIM trademarks in which it has rights. The Complainant's BOEHRINGER INGELHEIM trademark has been registered and used in connection to the Complainant's pharmaceuticals business.

The disputed domain name <career-boehringeringelheim.com> incorporates the Complainant's BOEHRINGER INGELHEIM trademark in its entirety, merely preceding it with the generic term "career" and a hyphen. In these circumstances, the Panel finds that the confusing similarity is obvious.

It is well established that the Top-Level Domains ("TLDs") such as ".com" may be disregarded when considering whether the disputed domain name is confusingly similar to the trademark in which the Complainant has rights (see section 1.11 WIPO Overview 3.0).

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks. Accordingly, the Complainant has made out the first of the three elements that it must establish.

2. No rights or 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.

It is established case law that it is sufficient for the Complainant to make a prima facie showing that the Respondent has no right or legitimate interest in the disputed domain name in order to shift the burden of proof to the Respondent (see section 2.1 WIPO Overview 3.0 and *Champion Innovations, Ltd. V. Udo Dussling (45FHH)*, WIPO case No. D2005-1094; *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO case No. D2003-0455; *Belupo d.d. v. WACHEM d.o.o.*, WIPO case No. 2004-0110).

The Panel notes that the Respondent has not been commonly known by the disputed domain name and that the Respondent has not acquired trademark or service mark rights. According to the information provided by the Registrar, the Respondent is "Jamie Eden". The Respondent's use and registration of the disputed domain name was not authorized by the Complainant. There are no indications that a connection between the Complainant and the Respondent existed.

Generally speaking, UDRP panels have found that where a domain name consists of a trademark plus an additional term, such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner (see section 2.5.1 WIPO Overview 3.0). In this case, the disputed domain name incorporates the Complainant's BOEHRINGER INGELHEIM trademark in its entirety, merely preceding it with the generic term "career" and a hyphen. Moreover, the Panel observes that the Complainant uses the subdomain <careers.boehringer-ingelheim.com> which is nearly identical to the disputed domain name. Therefore, the Panel finds that the disputed domain name carries a high risk of implied affiliation with the Complainant and cannot constitute fair use.

Moreover, the Panel is of the opinion that the Respondent is not making a legitimate non-commercial or fair use of the disputed domain name. In fact, the Respondent is not making any use of the disputed domain name in connection with an active website.

The Respondent had the opportunity to demonstrate his rights or legitimate interests but did not do so. In the absence of a Response from the Respondent, the prima facie case established by the Complainant has not been rebutted.

Therefore, the Panel finds that the Complainant has established that the Respondent has no rights or legitimate interests in the disputed domain name. In light of the above, the Complainant succeeds on the second element of the Policy.

3. Bad faith

Complainant must prove on the balance of probabilities that the disputed domain name was registered in bad faith and that it is being used in bad faith (see section 4.2 WIPO Overview 3.0 and e.g. *Telstra Corporation Limited v. Nuclear Marshmallow*, WIPO Case No. D2000-0003; *Control Techniques Limited v. Lektronix Ltd*, WIPO Case No. D2006-1052).

According to the Panel, the awareness of a respondent of the complainant and/or the complainant's trademark rights at the time of registration can evidence bad faith (see *Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. D2011-2209; *Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite*, WIPO Case No. D2001-1070).

In the instant case, the Panel finds it inconceivable that the Respondent was not aware of the Complainant's rights at the moment it registered the disputed domain name. The disputed domain name incorporates the Complainant's distinctive mark in its entirety and only adds a generic word. Moreover, the well-known character of the Complainant's BOEHRINGER-INGELHEIM trademark has been confirmed by previous UDRP Panels:

- *Boehringer Ingelheim Pharma GmbH & Co. KG v. Marius Graur*, WIPO Case No. D2019-0208 ("Because of the very distinctive nature of the Complainant's trademark 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.");
- *BOEHRINGER INGELHEIM PHARMA GMBH & CO.KG v. Karen Liles*, CAC Case No. 102274 ("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.").

The Panel observes that the disputed domain name is inactive. The passive holding of a domain name may amount to bad faith when it is difficult to imagine any plausible future active use of a domain name by the respondent that would be legitimate and would not interfere with the complainant's well-known mark (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*, supra). Additional factors to support a finding of bad faith in relation to the passive holding of a domain name include the degree of distinctiveness or reputation of the Complainant's mark, and the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use (see section 3.3 of WIPO Overview 3.0).

In the present case, the Panel is of the opinion that the Complainant's BOEHRINGER INGELHEIM trademark is distinctive and widely used, which makes it difficult to conceive any plausible legitimate future use of the disputed domain name by the Respondent.

By failing to respond to the Complaint, the Respondent did not take any initiative to contest the foregoing. Pursuant to paragraph 14 of the Rules, the Panel may draw the conclusions it considers appropriate.

Therefore, the Panel finds that, on the balance of probabilities, it is sufficiently shown that the disputed domain name was registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. CAREER-BOEHRINGERINGELHEIM.COM: Transferred
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PANELLISTS

Name	Flip Petition
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DATE OF PANEL DECISION 2021-09-20

Publish the Decision
