

Decision for dispute CAC-UDRP-103973

Case number	CAC-UDRP-103973
Time of filing	2021-08-12 09:18:35
Domain names	boehringeringelheimequinerebate.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	Fundacion Comercio Electronico
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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 a very large portfolio of registered trade marks including for the word mark "BOEHRINGER INGELHEIM" as well as many figurative marks which include that as the word element.

This includes the international trade mark, BOEHRINGER INGELHEIM, no.221544, registered in 1959 and a further international trade mark, BOEHRINGER INGELHEIM, no. 568844 registered in 1991.

It also has an EUTM no. 2493195 being a word mark registered in 2003 in classes 1, 3, 5, 9, 10, 16, 30, 31, 41, 42.

The Complainant owns multiple domain names which include the name and word mark, "BOEHRINGER INGELHEIM", such as <boehringer-ingelheim.com> which it registered in 1995 and <boehringeringelheim.com> registered in 2004.

In particular it has the domain name <boehringeringelheimequinerebates.com>. This is used by the Complainant to offer rebates on equine health products.

In jurisdictions that protect rights arising from use, the Complainant also has unregistered rights arising from its very substantial use in trade.

FACTUAL BACKGROUND

The Complainant is a German family-owned pharmaceutical group with roots going back to 1885, when it was founded by Albert Boehringer (1861-1939) in Ingelheim am Rhein.

From those early beginnings, the Complainant has become a global research-driven pharmaceuticals heavy-weight with approximately 50,000 employees.

The three main business areas of the Complainant are: human pharmaceuticals, animal health and biopharmaceuticals.

In 2020, the Complainant achieved net sales of around 19.6 billion euros.

The disputed domain name <boehringeringelheimequinerebate.com> was registered on 4 August 2021 and is parked.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

I. The disputed domain name is confusingly similar to the protected mark

The Complainant states that the disputed domain name is confusingly similar to its trademark BOEHRINGER-INGELHEIM®, included in the domain name in its entirety. The addition of the terms "EQUINE REBATE" is not sufficient to escape the finding that the domain name is confusingly similar to its trademarks. It does not change the overall impression of the designation as being connected to the Complainant's trademarks. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademarks and domain names associated. On the contrary, this addition worsens the likelihood of confusion, as it directly refers to the Complainant's website <https://www.boehringeringelheimequinerebates.com/>.

Moreover, the Complainant asserts that the addition of the generic Top-Level Domain suffix ".COM" does not change the overall impression of the designation as being connected to the trademark BOEHRINGER-INGELHEIM®. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademarks and its domain names associated. E.g. WIPO Case No. D2006-0451, F. Hoffmann-La Roche AG v. Macalve e-dominios S.A. ("It is also well established that the specific top level of a domain name such as ".com", ".org" or ".net" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar.").

Similar case: CAC Case No. 103124, Boehringer Ingelheim Pharma GmbH & Co.KG v. Fundacion Comercio Electronico <boehringeringelheimpetreebates.com> ("The disputed domain name and the Complainant's trademarks are very similar since they differ in a mere addition of misspelled version of a generic term "pet rebates" (i.e. addition of "PETREEBATES") to the Complainant's trademark. This, however, cannot prevent the association in the eyes of internet consumers between the disputed domain name and the Complainant's trademarks and thus the likelihood of confusion still exists. To conclude, addition of a non-distinctive term cannot sufficiently distinguish the disputed domain name from the Complainant's trademarks."). Consequently, the disputed domain name is confusingly similar to the Complainant's trademark.

II. The Respondent does not have any rights or legitimate interest in the disputed domain name

According to the WIPO Case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd., 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 Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Complainant asserts that the Respondent is not identified in the Whois database as the disputed domain name. Past panels have held that a Respondent was not commonly known by a disputed domain name if the WHOIS information was not similar to the disputed domain name.

For instance Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com> (“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).”).

The Complainant contends that the Respondent is not affiliated with nor authorized by the Complainant in any way. The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. 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 trademarks BOEHRINGER-INGELHEIM®, or apply for registration of the disputed domain name by the Complainant.

Furthermore, the disputed domain name resolves to a registrar parking page. Therefore, the Complainant contends that Respondent did not make any use of disputed domain name since its registration, and it confirms that Respondent has no demonstrable plan to use the disputed domain name. It demonstrates a lack of legitimate interests in respect of the disputed domain name. Thus, in accordance with the foregoing, the Complainant contends that the Respondent has no right or legitimate interest in respect of the disputed domain name.

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

The Complainant states that the disputed domain name is confusingly similar to its trademark BOEHRINGER-INGELHEIM®. The Complainant is one of the world’s 20 leading pharmaceutical companies, with roughly 52,000 employees worldwide and 19.6 billion euros in net sales. 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.”).

Besides, the Complainant contends that the Respondent choose to register the disputed domain name to create a confusion with the domain name <boehringeringelheimequinerebates.com>, used by the Complainant to offer rebates on equine health products. 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. Furthermore, the domain name resolves to a registrar parking 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, an infringement of the Complainant's rights under trademark law, or an attempt to attract, for commercial gain, Internet users to his own website, by creating a likelihood of confusion with Complainant's trademark as to the source, sponsorship, affiliation or endorsement of Respondent's website.

As prior WIPO UDRP panels have held, the incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use.

For instance:

- WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows;
- WIPO Case No. D2000-0400, CBS Broadcasting, Inc. v. Dennis Toeppen.

On these bases, the Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith.

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 Complainant, and its name and mark, are world famous. It is a well-known mark. It uses those online in various ways including at the domain the domain name <boehringeringelheimequinerebates.com>, used by the Complainant to offer rebates on equine health products.

The disputed domain name is <boehringeringelheimequinerebate.com>.

There is only one-character that is different between these two domains. The disputed domain name has a plural, that is, an s, at the end. The Complainant's full name and EUTM word mark, boehringeringelheim, is used in full with the additional material equinerebate, which is an offer/service of the Complainant and in its field of endeavour.

This additional material cannot prevent the inevitable association in the eyes of internet consumers between the disputed domain name and the Complainant's trademarks and thus the likelihood of confusion is real and serious. The addition of a non-distinctive term cannot sufficiently distinguish the disputed domain name from the Complainant's name and trademarks.

This is a blatant and obvious case of typosquatting and also an attempt at impersonation.

Further, while failure to use a domain name is not inherently bad faith; where a domain name includes a famous trade mark, there is no use of the domain name (and so no overt legitimate right or interest) and a respondent has not come forward with any explanation for his selection of the name --or indeed, any answer, then a finding of bad faith is fair, as are the appropriate inferences against the respondent. See Nominet Case DRS0658 (chivasbrothers.co.uk) and see WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows and – WIPO Case No. D2000-0400, CBS Broadcasting, Inc. v. Dennis Toeppen.

The Complainant has discharged its burden under the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOEHRINGERINGELHEIMEQUINEREBATE.COM**: Transferred

PANELLISTS

Name	Victoria McEvedy
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DATE OF PANEL DECISION 2021-09-20

Publish the Decision