

Decision for dispute CAC-UDRP-104042

Case number	CAC-UDRP-104042
Time of filing	2021-09-30 08:51:42
Domain names	boehringer-ingelheim.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	Obrain Group
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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 large portfolio of 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. Furthermore, the Complainant owns multiple domain names consisting in the wording "BOEHRINGER INGELHEIM", such as <boehringer-ingelheim.com> registered since September 1, 1995.

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 roughly 52,000 employees. The three main business areas of BOEHRINGER INGELHEIM are: human pharmaceuticals, animal health and biopharmaceuticals. In 2020, BOEHRINGER INGELHEIM achieved net sales of 19.6 billion euros. The disputed domain name <boehringer-ingelheim.com>

was registered on September 24, 2021.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

Given Complainant's prominence in the pharmaceutical market it is well-known, and in its niche it is famous. Since BOEHRINGER INGELHEIM is a corporate name that is both distinctive as a mark and distinctive in the marketplace, it is inconceivable that Respondent was unaware of it and registered the domain name for its brand value. The domain name has no independent value except for its association with Complainant.

The Complainant states that the disputed domain name <boehringer-ingelheim.com> is a typosquatted version of the trademark BOEHRINGER-INGELHEIM® and thus confusingly similar to its trademark BOEHRINGER-INGELHEIM® and its associated domain names. The obvious misspelling of the Complainant's trademark, i.e. the substitution of the letters "G" by the letter "Q", is characteristic of a typosquatting practice intended to create confusing similarity between the Complainant's trademark and the disputed domain name. On a side-by-side comparison, the spelling variation is confusingly similar to the Complainant's trademark. The gTLD is not relevant in the assessment of confusing similarity.

The Complainant contends that it has not granted authority or permission to register or use the disputed domain name nor is Respondent commonly known by that name but as "Obbrain Group". Nothing about the domain name or its redirection constitutes making use, or demonstrable preparations for use, of the disputed domain name in connection with a bona fide offering of goods or services, or of making a legitimate non-commercial or fair use of the disputed domain name. Thus, Respondent lacks rights or legitimate interest in the disputed domain name which is typosquatting Complainant's trademark.

The Complainant contends further that it is inconceivable that Respondent registered the disputed domain name without actual knowledge of Complainant's legal rights. Finally, Complainant also points out that Respondent has engineered code changes to the MX code. These preparatory steps (configuring 'MX' or mail exchange records) have been considered in relation to 'use' for the purposes of the Policy by other Panels.

Given the distinctiveness of the Complainant's trademark and its reputation, it is reasonable to infer that the Respondent has registered and used the domain name with full knowledge of the Complainant's trademark. The sole inference from the evidence presented is that Respondent registered and is using the disputed domain name in bad faith.

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

Pursuant to the Policy, paragraph 4(a), a complainant must prove each of the following to justify the transfer of a domain name:

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

In this case, the Czech Arbitration Court has employed the required measures to achieve actual notice of the Complaint to the Respondent, and the Respondent was given a fair opportunity to present its case and defend its registration of <boehringer-ingelheim.com> the subject domain name.

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: "[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name ..."

Notwithstanding Respondent's default Complainant is not relieved from the burden of establishing its claim. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, 3.0, § 4.3: "Noting the burden of proof on the complainant, a respondent's default (i.e., failure to submit a formal response) would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true." However, if a complainant's adduced evidence supports any element of the Policy, a respondent has an opportunity to contest the contention that its registration of the challenged domain name was unlawful.

A. Identical or confusingly similar, §4(a)(i).

This first limb of the Policy requires Complainant to prove that it has a trademark right and that the disputed domain name is identical or confusingly similar to that mark. The Panel finds that Complainant has demonstrated that it has a registered trademark right to the term BOEHRINGER INGELHEIM. Having established that element of the Policy the next question is whether the disputed domain name is identical or confusingly similar to Complainant's mark.

A side-by-side comparison of the domain name and the BOEHRINGER INGELHEIM trademark indicates that <boehringer-ingelheim.com> is confusingly similar to the mark in that it incorporates Complainant's trademark. The substitution of one letter for another does not create a name distinctive from the Complainant. see *Edmunds.com, Inc. v. Digi Real Estate Foundation*, D2006-1043 (WIPO October 6, 2006), <edmundss.com>. The disputed domain name is such a typosquatting domain and is accordingly confusingly similar to the trademark of the Complainant."). At the threshold it is necessary only to consider "whether a domain name is similar enough in light of the purpose of the Policy to justify moving on to the other elements of a claim for cancellation or transfer of a domain name." The Panel in *Nicole Kidman v. John Zuccarini, d/b/a Cupcake Party*, D2000-1415 (WIPO January 23, 2001) notes that "numerous prior panels have held [the purposes of the Policy are satisfied] when a domain name wholly incorporates a complainant's registered mark." Similarly, *Magnum Piering, Inc. v The Mudjackers and Garwood S. Wilson, Sr.*, D2000-1525 (WIPO January 21, 2001). Panelists generally disregard the top-level suffixes as functional necessities, thus the top-level extension is irrelevant in determining the issue under the first requirement of the Policy.

Having demonstrated that <boehringer-ingelheim.com> is confusingly similar to Complainant's BOEHRINGER-INGELHEIM trademark in which it has rights the Panel finds Complainant has satisfied Para. 4(a)(i) of the Policy.

B. Rights and legitimate interests, Para. 4(a)(ii)

Under paragraph 4(a)(ii) of the Policy, a complainant has the burden of establishing that a respondent lacks rights or legitimate interests in respect of the disputed domain name, but this burden is light. It is sufficient in the first instance for Complainant to allege a prima facie case, and if the evidence presented is conclusive or yields a positive inference that Respondent lacks rights or legitimate interests, the burden shifts to Respondent to rebut the allegations. This concept of shifting burdens is clearly explained in *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, D2003-0455 (WIPO August 21, 2003) in which the Panel held that "[s]ince it is difficult to prove a negative ... especially where the Respondent, rather than complainant, would be best placed to have specific knowledge of such rights or interests—and since Paragraph 4(c) describes how a Respondent can demonstrate rights and legitimate interests, a Complainant's burden of proof on this element is light."

Once the complainant makes such a prima facie showing, "the burden of production shifts to the respondent, though the burden of proof always remains on the complainant. If the respondent fails to come forward with evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP," *Malayan Banking Berhad v. Beauty, Success & Truth International*, D2008-1393 (December 8, 2008). Finally, "in the absence of direct evidence, complainant and the panel must resort to reasonable inferences from whatever evidence is in the record," *Euromarket Designs, Inc. v. Domain For Sale VMI*, D2000-1195 (WIPO October 26, 2000).

In this case, Complainant contends that Respondent has no rights or legitimate interests in the disputed domain name, because the Respondent has no permission to use the BOEHRINGER-INGELHEIM trademark. The evidence in the record is conclusive that Respondent Obrain Group is not commonly known under the disputed domain name. See *Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group*, FA1804001781783 (Forum May 11, 2018) ("Here, the WHOIS information of record identifies Respondent as "Chad Moston / Media Group." The Panel therefore finds under Policy 4(c)(ii) that Respondent is not commonly known by the disputed domain name. *Amazon Technologies, Inc. v. Suzen Khan / Nancy Jain / Andrew Stanzy*, FA 1741129 (FORUM August 16, 2017) (finding that respondent had no rights or legitimate interests in the disputed domain names when the identifying information provided by WHOIS was unrelated to the domain names or respondent's use of the same). Accordingly, Complainant has demonstrated prima facie that Respondent lacks rights or legitimate interests in the disputed domain name.

Once the burden shifts, Respondent has the opportunity of demonstrating its right or legitimate interest by showing the existence of any of the following nonexclusive circumstances:

- (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 non-commercial 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.

If a respondent proves any of these circumstances or indeed anything else that shows it has a right or legitimate interest in the domain name, the complainant will have failed to discharge its onus and the respondent must succeed. However, where respondent fails to respond, the Panel must assess the record before it. Respondent has failed to respond.

Here, the choice of the domain name corresponds to the trademark. Substituting one letter for another, a "Q" for a "G" does not create a distinctive term separate from the mark, but in fact reinforces the identity of domain name and mark. *Spotify AB v. The LINE The Line / The Line*, 1765498 (Forum February 6, 2018) ("The Panel finds that Respondent's registration of the domain name is typosquatting and indicates it lacks rights and legitimate interests in the domain name per Policy paragraph 4(a)(ii).") Therefore, Respondent's default and its failure to rebut Complainant's evidence is particularly telling. Since there is no proof otherwise, the record supports the conclusion that Respondent lacks any right or legitimate interest as measured by the three

circumstances of Paragraph 4(c) subparagraphs. See *Deutsche Telekom AG v. Britt Cordon*, D2004-0487 (WIPO September 13, 2004) (holding that "once a complainant establishes a prima facie case that none of the three circumstances establishing legitimate interests or rights applies, the burden of production on this factor shifts to the Respondent. Given the evidence presented by Complainant, Respondent's default in appearance supports the conclusion that it lacks rights or legitimate interests in the disputed domain name." Similarly in *Malayan Banking Berhad*, supra. (holding that "[i]f the respondent fails to come forward with evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.").

Accordingly, the Panel finds that Complainant has succeeded on this element, thus it satisfies paragraph 4(a)(ii) of the UDRP.

C. Registered and Used in Bad Faith, §4(a)(iii)

Having determined that Respondent lacks rights or legitimate interests, the Complainant must then 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.

Paragraph 4(b) of the Policy sets out four nonexclusive 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.

Of the four circumstances, the fourth most readily applies as the domain name is clearly intended to attract Internet users seeking to reach Complainant's website or purchase its products and services. The domain name in this case redirects to an index page. It cannot conceivably be used for a legitimate purpose. *Telstra*, supra.; also *National Football League v. Thomas Trainer*, D2006-1440 (WIPO December 29, 2006) <nflnetwork.com> (holding that "when a registrant, such as respondent here, obtains a domain name that is [identical and] to a famous mark, with no apparent rights or legitimate interests in the name, and then fails to respond to infringement claims and a UDRP Complaint, an inference of bad faith is warranted." Added to this the reconfiguration of email service indicated above supports a conclusion that the purpose for registering <boehringer-ingelheim.com> is to take advantage of Complainant's goodwill with the likelihood that it is intended to also take advantage of and deceive consumers whose emails it is likely to harvest or use in some harmful fashion.

While it is not clear whether Respondent has specifically used the disputed domain name to receive email messages it is nonetheless likely that an email account was set up to achieve that purpose. See *Pepsico, Inc. v. Allen Othman*, CAC Case No. 102380 (ADR.eu April 25, 2019) ("In light of the evidence presented by the Complainant, the Panel finds that the disputed domain name was registered and is being used in bad faith, including through its use in association with the configuration of email accounts (MX records). The requirements for the acceptance of a Complaint under paragraph 4 of the Policy have therefore been met."). Where the facts demonstrate an intent to capitalize on an owner's mark in the manner in which Complainant describes and which is supported by proof in the record, the registration is prima facie abusive. *Royal Bank of*

(WIPO February 23, 2020) (<investease.com>. It is clear that where the facts of the case establish that the respondent's intent in registering or acquiring a domain name was to unfairly capitalize on the complainant's nascent ... trademark, panels have been prepared to find the respondent acted in bad faith.). See WIPO Overview 3.0, section 3.8.2. The Panel concurs that setting up an email account for the disputed domain name supports an inference directly concerning infringing use of the domain name. Respondent can have no legitimate interest in sending or receiving email from the disputed domain name because it will likely lead recipients of the email to mistakenly believe that the mail originates with permission or approval of the trademark owner.

The Panel finds that the present case is one in which the presumption of bad faith is satisfied. The presumption is further strengthened by the strong inference of Respondent's actual knowledge of Complainant's and its BOEHRINGER INGELHEIM trademark and of its intention to take advantage of its attractive value on the Internet solely for the reason of its goodwill flowing from its widely known or famous brand. The consensus expressed in WIPO Overview 3.0, section 3.1.4. is that "the mere registration of a domain name that is identical or confusingly similar ... to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith." Particularly probative in this case is that Complainant holds the domain name <boehringer-ingelheim.com> and the only difference with the disputed domain name is the substitution of one letter for another. Absent a cogent explanation from Respondent justifying its choice of domain name, this supports the conclusion that it registered <boehringer-inqelheim.com> with the purpose of taking advantage of Complainant's goodwill and reputation.

The Panel finds that the Complainant has shown that the Respondent registered and is using 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) as well as within the larger notion of abusive conduct. The Panel finds that Complainant has adduced more than sufficient evidence to prove Respondent's bad faith based on the foregoing considerations.

Accordingly, the Respondent has registered and used the disputed domain name in bad faith and that its conduct firmly supports the conclusion that the registration of <boehringer-inqelheim.com> was abusive. Having thus demonstrated that Respondent registered and is using the disputed domain name in bad faith, Complainant has also satisfied paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	Gerald M. Levine, Ph.D, Esq.
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DATE OF PANEL DECISION 2021-10-25

Publish the Decision