

Decision for dispute CAC-UDRP-104043

Case number CAC-UDRP-104043

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Domain names nexgardchewy.com

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization BOEHRINGER INGELHEIM ANIMAL HEALTH FRANCE

Complainant representative

Organization NAMESHIELD S.A.S.

Respondent

Organization Fundacion Privacy Services LTD

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 is the registered owner of a considerable portfolio of trademarks consisting of the term "NEXGARD", such as:

- International Registration No. 1166496 NEXGARD, registered since May 29, 2013;
 - European Union Trademark No. 011855061 NEXGARD, registered since October 9, 2013.
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FACTUAL BACKGROUND

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

As the number one global player in the pet and equine markets, the BOEHRINGER INGELHEIM ANIMAL HEALTH Business Unit helps provide longer and healthier lives for companion animals.

NEXGARD® is a drug delivered in a beef-flavoured chew that kills adult fleas and is indicated for the treatment and prevention of flea infestations and the treatment and control of tick infestations in dogs and puppies for one month.

The Complainant owns a large portfolio of trademarks including the term "NEXGARD", such as - International Registration No. 1166496 NEXGARD, registered since May 29, 2013 and European Union Trademark No. 011855061 NEXGARD, registered since October 9, 2013.

The disputed domain name <nexgardchewy.com> was registered on June 11, 2021 and resolves to a parking page with commercial links.

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

According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that the disputed domain name should be transferred or cancelled:

- (i) the disputed 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 disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Panel has examined the evidence available to it and has come to the following conclusion concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

CONFUSING SIMILARITY WITH EARLIER RIGHTS

The Complainant has stated that the disputed domain name <nexgardchewy.com > is confusingly similar to its registered trademark NEXGARD. The disputed domain name contains the Complainant's trademark completely in addition to a generic term used by the Complainant to describe the nature of the product. It is a "chewy" preparation to cure dogs of fleas and ticks.

The addition of this term therefore does not change the overall impression of the disputed domain name sufficiently. It will be considered as referring to and being connected to the Complainant's trademark NEXGARD in such a manner that a likelihood of confusion will arise.

It is well-established that “a domain name that wholly incorporates a Complainant’s registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP”. (See WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasily Terkin).

Equally, 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 NEXGARD®, as top-level suffixes (i.e. “.com”) are disregarded in making the comparison. (See WIPO Case No. D2006-0451, F. Hoffmann-La Roche AG v. Macalve e-dominios S.A. which states that “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.”)

As the Complainant’s rights over the term “NEXGARD” have been confirmed by previous panels, there is no reason to come to a different conclusion in this case. (See WIPO Case No. D2021-0635, Boehringer Ingelheim Animal Health France v. Hwang Gyu Sun <nexgard.net>; CAC Case No. 103532, BOEHRINGER INGELHEIM ANIMAL HEALTH FRANCE v. Mr NYOB <nexgardchewables.com>.)

The Panel therefore finds that the disputed domain name is confusingly similar to the Complainant’s trademark and concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the UDRP.

NO RIGHTS OR LEGITIMATE INTERESTS

The onus to make out a prima facie case that the Respondent lacks rights or legitimate interests is placed on the Complainant. However, once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP (see e.g., WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

In this case, the Complainant has stated that the Respondent is not affiliated with him nor authorized by him in any way. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant’s trademark or apply for registration of the disputed domain name by the Complainant. The Complainant does not carry out any activity for, nor has any business with the Respondent.

The Respondent failed to provide any information and evidence whatsoever that could have shown that it has relevant rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a) (ii) of the Policy). Furthermore, the disputed domain names resolve to a parking page with commercial links. Past panels have held that this is not a bona fide offering of goods or services or legitimate non-commercial or fair use. (See e.g., Forum Case No. FA 970871, Vance Int’l, Inc. v. Abend (concluding that the operation of a pay-per-click website at a confusingly similar domain name does not represent a bona fide offering of goods or services or a legitimate non-commercial or fair use, regardless of whether or not the links resolve to competing or unrelated websites or if the respondent is itself commercially profiting from the click-through fees) or WIPO Case No. D2007-1695, Mayflower Transit LLC v. Domains by Proxy Inc./Yariv Moshe (where the “Respondent’s use of a domain name confusingly similar to Complainant’s trademark for the purpose of offering sponsored links does not of itself qualify as a bona fide use.”)

Therefore, the Panel concludes that the Respondent did not establish any right or legitimate interest to the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy) and comes to the conclusion that the Complainant has satisfied the requirement under paragraph 4(a)(ii) of the UDRP Policy.

BAD FAITH

The disputed domain name resolves to a parking page with commercial links. By doing so, the Respondent has attempted to attract Internet users for commercial gain to his own website for his own commercial gain using the Complainant’s trademarks, which is evidence of bad faith. See for instance WIPO Case No. D2018-0497, StudioCanal v. Registration Private,

Domains By Proxy, LLC / Sudjam Admin, Sudjam LLC where the following was held: "In that circumstance, whether the commercial gain from misled Internet users is gained by the Respondent or by the Registrar (or by another third party), it remains that the Respondent controls and cannot (absent some special circumstance) disclaim responsibility for, the content appearing on the website to which the disputed domain name resolve [...] so the Panel presumes that the Respondent has allowed the disputed domain name to be used with the intent to attract Internet users for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, affiliation, or endorsement of the Respondent's website to which the disputed domain name resolves. Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith."

The disputed domain name has therefore been registered and is being used in bad faith as it is a registration of a well-known/famous trade mark. The assumption of bad faith is supported by the use of privacy or proxy registration services.

Therefore, the Panel concludes that the Respondent has registered and is using the disputed domain name in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy). The Complainant has therefore also satisfied the requirement under 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. NEXGARDCHEWY.COM: Transferred

PANELLISTS

Name	Udo Pfleghar, B.A.
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DATE OF PANEL DECISION 2021-11-16

Publish the Decision
