

Decision for dispute CAC-UDRP-104139

Case number	CAC-UDRP-104139
Time of filing	2021-11-08 09:16:39
Domain names	boehringerequinerebates.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 unaware of any other pending or decided legal proceedings relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant owns various trademarks, including the word "BOEHRINGER" in several countries, such as the international trademark BOEHRINGER n° 799761 registered since December 2, 2002.

FACTUAL BACKGROUND

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

The Complainant is a family-owned pharmaceutical group of companies with roots going back to 1885, 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 business areas of BOEHRINGER INGELHEIM are human pharmaceuticals, animal health, and biopharmaceuticals. In 2020, net sales of the BOEHRINGER INGELHEIM group amounted to about EUR 19.6 billion.

Furthermore, the Complainant owns multiple domain names in the wording "BOEHRINGER", such as <boehringeringelheimequinerebates.com> registered and used since August 14, 2019.

The disputed domain name <boehringerequinerebates.com> was registered on November 2, 2021, and is inactive at the date of the dispute filing.

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.

Indeed, adding the terms "EQUINE REBATES" is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark BOEHRINGER. It does not change the overall impression of the designation as being connected to the Complainant's trademark BOEHRINGER. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant and its trademark.

On the contrary, this addition worsens the likelihood of confusion, as it directly refers to the Complainant's website <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. Therefore, it does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademarks, and its domain names associated.

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

The Complainant asserts that the Respondent is not identified as the disputed domain name in the Whois database. 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.

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 regarding 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 use the Complainant's trademarks BOEHRINGER or apply for registration of the disputed domain name by the Complainant.

Besides, the disputed domain name is inactive. Therefore, the Complainant contends that Respondent did not use the disputed domain name since its registration, and it confirms that Respondent has no demonstrable plan to use the disputed domain name. Therefore, it demonstrates a lack of legitimate interests regarding the disputed domain name.

Thus, following the preceding, the Complainant contends that the Respondent has no right or legitimate interest regarding 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.

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.

Besides, the Complainant's trademark BOEHRINGER is distinctive and well-known.

Besides, the Complainant contends that the Respondent chose to register the disputed domain name to create 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 disputed domain name is inactive. The Complainant contends that the Respondent has not demonstrated any activity regarding the disputed domain name. Therefore, it is not possible to conceive of any plausible actual or contemplated active use of the disputed 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 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, incorporating a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use.

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

To the satisfaction of the Panel, the Complainant has shown that the disputed domain name is identical or confusingly similar to the trademark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

To the satisfaction of the Panel, the Complainant has 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

To the satisfaction of the Panel, the Complainant has 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 the Policy were met, and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

I. Identical or Confusingly Similar

The Panel is satisfied that the Complainant has shown it owns rights in the "BOEHRINGER" trademark since at least December 2002.

The Panel must now analyze if there is a confusing similarity between the disputed domain name and the trademark. As per evidence in the record, the disputed domain name reproduces the trademark verbatim, namely, "BOEHRINGER".

In addition, the disputed domain name, <boehringerequinerebates.com>, strings together two generic words, namely "equine" and "rebates". These terms' addition is not substantive enough to dispel the confusing similarity between the disputed domain name and the Complainant's trademarks. This addition may enhance the confusing similarity with the Complainant's trademarks, as it aims to replicate a domain name commonly used by the Complainant through its course of business, namely <boehringeringelheimequinerebates.com>. However, further analysis will be discussed under the following elements below.

Based on this, the Panel finds the disputed domain name confusingly similar to the Complainant's trademarks. As a result, the Panel determines that the Complaint has satisfied the first element set under paragraph 4(a)(i) of the Policy.

II. Rights or Legitimate Interests

Based on the evidence on record and acknowledging that the Respondent failed to produce any allegations or evidence necessary to demonstrate its rights or legitimate interests in the disputed domain name, the Panel must turn to the uncontested facts. These indicate that a) the Respondent is not commonly known by the disputed domain name; b) the Respondent is not affiliated with the Complainant; c) the Respondent has no license or authorization to use the trademarks; d) the Respondent is not authorized to carry out any activity for the Complainant and has no business dealings with the Complainant.

In failing to respond to the Complainant's contentions, the Respondent has not rebutted the prima facie case, as described in paragraph 2.1 of WIPO 3.0 Overview.

In addition to this, the Respondent's use of the trademark plus the use of two generic terms, namely "equine" and "rebates", seems to indicate that the Respondent not only was aware of the Complainant but deliberately targeted the Complainant to benefit from the association to the Complainant and confuse Internet users as to the source of sponsorship. A practice like this can never be considered a bona fide offering under the Policy.

The actions of the Respondent reinforce this. After the notification of the proceedings, the Respondent chose not to provide an explanation or defense. Instead, the Respondent redirected the website to random links.

Based on the above and the probability balance, it is difficult to conceive the Respondent having rights or legitimate interest in the disputed domain name. This reasoning is closely linked to the potential of having fair or non-commercial uses of the disputed domain name; however, this analysis is better suited under the third element.

The Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name. Therefore the Complainant has fulfilled the second requirement set under paragraph 4(a) of the Policy.

III. Registered and Used in Bad Faith

As per the record and evidence at hand, the Panel finds that the Respondent was likely aware of the Complainant and targeted the Complainant's trademark when registering the disputed domain name. This conclusion is reinforced by the fact that the Respondent seems to evoke a connection to the Complainant's trademark by including the trademark in its entirety, with the only addition of two generic words, namely "equine" and "rebates". These two words evoke one of the Complainant's domain names used in its ordinary course of business, namely, <boehringeringelheimequinerebates.com>.

In addition to this, it is worth noting that the website resolving from the disputed domain name was modified after the initiation of the proceedings instead of responding. Without having any other explanation from the Respondent, in

conjunction with the other facts and evidence, in this case, it strengthens the allegations and the points raised by the Complainant on the bad faith registration and use of the disputed domain name.

All the preceding analysis leaves the Panel no other option than to conclude that that the most likely intention of the Respondent was to intentionally attempt to attract, for commercial gain, Internet users to its website/ disputed domain name, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website and/or disputed domain name, as per illustrated under paragraph 3.1 of WIPO 3.0 Overview.

In light of the case's circumstances, based on the available records, the Panel finds that the Complainant has proven that the disputed domain name was registered and is used in bad faith according to paragraph 4(a)(iii) of the Policy.

IV. Decision

For the preceding reasons and concurrence with the provisions specified under Paragraph 4(i) of the Policy and Paragraph 15 of the Rules, the Panel orders the transfer of the disputed domain name to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOEHRINGEREQUINEREBATES.COM**: Transferred

PANELLISTS

Name	Rodolfo Carlos Rivas Rea
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DATE OF PANEL DECISION 2021-12-07

Publish the Decision
