

Decision for dispute CAC-UDRP-104198

Case number CAC-UDRP-104198

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Domain names nexgard.shop

Case administrator

Organization Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization BOEHRINGER INGELHEIM ANIMAL HEALTH FRANCE

Complainant representative

Organization NAMESHIELD S.A.S.

Respondent

Name Walter Huertas Serrato

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 a global leader in the animal health industry and part of family-owned Boehringer Ingelheim, founded in 1885. The Complainant is based in France, and claims to be the number one global player in the pet and equine pharmaceutical markets.

The Complainant owns a large portfolio of trademarks, including NEXGARD, being:

- International Trademark (WIPO), NEXGARD Reg. No. 1166496 registered on May 29, 2013; and
- European Trademark (EUIPO), NEXGARD Reg. No. 011855061 registered on October 9, 2013.

The disputed domain name <nexgard.shop> was registered on November 24, 2021 and currently resolves to a parked page with commercial links, consisting, some of them, of changing, auto-generated pay-per-click (PPC) links to websites operated by third parties.

FACTUAL BACKGROUND

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The Complainant is part of the family-owned company Boehringer Ingelheim, founded in 1885. The Boehringer Ingelheim company has more than 50,000 employees, with three business areas Human Pharma, Animal Health and Biopharmaceutical Contract Manufacturing and in 2020 achieved net sales of 19.6 billion euros.

The Complainant is focused on the veterinary pharmaceutical industry with a worldwide presence. The Complainant is a relevant global player in the pet and equine pharmaceutical markets, providing longer, happier, and healthier lives for companion animals, and ultimately to their owners.

The Complainant is a global leader in prevention through vaccines and parasiticides, providing value through innovation solutions, to that unique bond between human health and animal health.

NEXGARD is an innovative 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.

According to the evidence, the disputed domain name <nexgard.shop> was registered on November 24, 2021 and currently resolves to a parked page with commercial links, consisting, some of them, of changing, auto-generated pay-per-click (PPC) links to websites operated by third parties.

PARTIES CONTENTIONS

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

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical 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

In accordance with Paragraph 4(a) of the Policy, the onus is on the Complainant to prove:

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

Accordingly, this Panel proceeds to analyze each UDRP Element:

1. Identical or Confusingly Similar:

The disputed domain name <nexgard.shop> is identical to Complainant's NEXGARD trademark, due to it is included on its entirety (see *Boehringer Ingelheim Animal Health France v. Hwang Gyu Sun*, WIPO Case No. 2021-0635; *Boehringer Ingelheim Animal Health France v. Mr Nyob*, CAC Case No. 103532; *Boehringer Ingelheim Animal Health France v. (Ma Hai Jian)*, WIPO Case No. DCN2021-0034).

Regarding the New Generic Top Level Domain Name (ngTLD), it is well established by the Domain Name Jurisprudence that such element may typically be disregarded for the purpose of the First UDRP Element assessment (see point 1.11.1 and 1.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0").

Therefore, this Panel agrees that in this present Case, the ngTLD '.shop' does not prevent to reach into the conclusion that the disputed domain name is identical to Complainant's Trademark NEXGARD.

2. Rights or Legitimate Interests:

Through the submitted evidence, and based on Respondent's Default, this Panel is convinced that the Complainant has established its prima facie case in relation to the Second Element of the Policy, due to:

- (1) the Respondent is not commonly known by the disputed domain name or by the term "NEXGARD";
- (2) the Respondent is not affiliated with or authorized by the Complainant in any way;
- (3) the Complainant has not granted any rights to the Respondent to use the NEXGARD trademark, whether a license to offer any product or service, or any rights to apply for registration of the disputed domain name by the Complainant;
- (4) the Respondent has selected such a fantasy term as NEXGARD, which it can be easily found at the top of a simple Google Search, and despite of it, registered as a domain name on November 24, 2021, very well after Complainant's trademark rights over NEXGARD on May 29, 2013; and
- (5) the Respondent is not making a bona fide offering of goods or services by means of the disputed domain name, or a legitimate non-commercial or fair use of it.

In consequence, this Panel finds that the Respondent has no rights or any legitimate interest over the disputed domain name.

3. Registered and Used in Bad Faith:

Paragraph 4(b) of the Policy describes several non-exclusive and merely illustrative circumstances to demonstrate a respondent's bad faith use and registration.

In the present Case scenario, the Respondent falls into Paragraph 4(b)(iv):

"by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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

respondent's website or location.”

In addition, this Panel considers that it is very unlikely that the Respondent was not aware about the value and reputation of such a widely known Trademark as NEXGARD registered at least since May 29, 2013, constituting evidence of bad faith registration. In relation to it, point 3.2.2 of the WIPO Jurisprudential Overview 3.0. states that:

“Noting the near instantaneous and global reach of the Internet and search engines, and particularly in circumstances where the complainant's mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers), panels have been prepared to infer that the respondent knew, or have found that the respondent should have known, that its registration would be identical or confusingly similar to a complainant's mark. (...)” (emphasis added).

In relation to the use of the disputed domain name, it has been established by the Domain Name Jurisprudence, that only under special circumstances a Respondent doesn't have control over the content of the website to which the disputed domain resolves, condition that in the present Case seems to be very unlikely, due to, in addition, the absent of any Response (see StudioCanal v. Registration Private, Domains By Proxy, LLC / Sudjam Admin, Sudjam LLC, WIPO Case No. D2018-0497). Also, it is well established that Parking Pages with pay-per-click links (PPC), have a high and a strong potential of affecting the value of a trademark, due to it capitalizes on the reputation and goodwill of a complainant's trademark rights, misleading Internet users, whether such links are or not related to a Complainant's competitor (see Vance Int'l, Inc. v. Jason Abend, Forum Case No. FA 970871).

Point 3.5 of the WIPO Jurisprudence Overview 3.0 discusses the responsibility of a respondent over the PPC content of a website, under the following terms:

“Particularly with respect to “automatically” generated pay-per-click links, panels have held that a respondent cannot disclaim responsibility for content appearing on the website associated with its domain name (nor would such links ipso facto vest the respondent with rights or legitimate interests).

Neither the fact that such links are generated by a third party such as a registrar or auction platform (or their affiliate), nor the fact that the respondent itself may not have directly profited, would by itself prevent a finding of bad faith.

While a respondent cannot disclaim responsibility for links appearing on the website associated with its domain name, panels have found positive efforts by the respondent to avoid links which target the complainant's mark (e.g., through “negative keywords”) to be a mitigating factor in assessing bad faith.” (emphasis added).

In the present Case, the disputed domain name is used as a Parking Page with PPC links, that even when are not intrinsically redirected to a Complainant's competitor website, constitutes a non-authorized commercial activity, that negatively affects the Complainant's Trademark value, investment and reputation over NEXGARD (see SAP SE v. Domains by Proxy, LLC / Kamal Karmakar, WIPO Case No. D2016-2497).

Therefore, considering the facts, the evidence and the Domain Name Jurisprudence, this Panel is ready to conclude that the use and registration of the disputed of the domain name are in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. NEXGARD.SHOP: Transferred

PANELLISTS

Name Ms. MARÍA ALEJANDRA LÓPEZ GARCÍA

DATE OF PANEL DECISION 2021-12-29

Publish the Decision
