Decision for dispute CAC-UDRP-101202

Case number	CAC-UDRP-101202
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Domain names	us-boehringer-ingelheim.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	BOEHRINGER INGELHEIM PHARMA GMBH & CO.KG

Complainant representative

Organization	Nameshield (Maxime Benoist)

Respondent

Name	Patrick Ryan

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 owner of several trademarks, including the still valid IR-trademark <Boehringer Ingelheim> with the registration number 568844, which was registered on March 22nd, 1991, in the classes 01, 02 ,03, 04, 05, 09, 10, 16,30 and 31. The still valid EU-trademark <Boehringer Ingelheim> with the registration number 002493195, which was registered on May 20th, 2003, in the classes 1, 3, 5, 9, 10, 16, 30, 31, 41 and 42.

The Complainant is also the holder of a huge number of domain names including the trademark <BOEHRINGER INGELHEIM>, i.e. the actively used domain name “Boehringer-Ingelheim.com”, created on September 1st, 1995, the domain name “BoehringerIngelheim.com”, created on July 4th, 2004, the domain name “BoehringerIngelheim.us”, created on May 16th, 2002, and the domain name “Boehringer-Ingelheim.us”, created on May 1st, 2002.

FACTUAL BACKGROUND

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

The Complainant, Boehringer Ingelheim Pharma GmbH & Co. KG is a global pharmaceutical enterprise set up in 1885 by

Albert Boehringer in Ingelheim (Germany). The two main business areas of the Complainant are Human Pharmaceuticals and Animal Health. The Complainant uses the trademark <BOEHRINGER INGELHEIM> inter alia in relation to its human pharmaceuticals and animal health business, for which the Complainant and its trademark <BOEHRINGER INGELHEIM> are well-known.

The disputed domain name <us-boehringer-ingelheim.com> was registered on January 13th, 2016, by Patrick Ryan. The disputed domain name <us-boehringer-ingelheim.com> is currently inactive. It displays an inactive page ("404 error page") since its registration.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Complainant contends that the Respondent does not have the right to use the Complainants' trademark <BOEHRINGER INGELHEIM> as part of its domain name. The Respondent, Patrick Ryan, is in no way connected with the Complainant nor authorized by the Complainant to make any use of the Complainants' trademark <BOEHRINGER INGELHEIM>. The Respondent has not applied for registration of the disputed domain name <us-boehringer-ingelheim.com> by the Complainant.

As far as the Complainants' contentions are concerned, the Complainant claims the disputed domain name <us-boehringer-ingelheim.com> to be confusingly similar to its trademarks and its domain names associated. Furthermore, the Complainant contends that the Respondent has no rights or legitimate interest in the disputed domain name <us-boehringer-ingelheim.com>. Finally, the Complainant states that the disputed domain name <us-boehringer-ingelheim.com> has been registered in bad faith.

According to the Complainant, prior UDRP panels have established a confusing similarity where the domain name contains the entire mark as well as the geographically descriptive term "US." In that regard, the Complainant quotes several UDRP decisions:
- NAF case no. FA 96676 Dollar Fin. Grp., Inc. v. Jewald & Assocs. Ltd., FA96676: the addition of 'US' or 'USA' does not alter the underlying mark held by the complainant.
- NAF case no. FA1509001639501 Novartis AG v. EVANS KELVIN.
- WIPO Case no. D2014-0306 Boehringer Ingelheim Pharma GmbH & Co. KG v. Klinik Sari Padma, BAKTI HUSADA : "Panel finds it is highly unlikely that Respondent had no knowledge of Complainant's company name and legal rights to the trademark BOEHRINGER INGELHEIM […], considering its notorious status and success in the pharmaceutical field."
- WIPO Case no. D2014-0306 Boehringer Ingelheim Pharma GmbH & Co. KG v. Klinik Sari Padma, BAKTI HUSADA : "Panel finds it is highly unlikely that Respondent had no knowledge of Complainant's company name and legal rights to the trademark BOEHRINGER INGELHEIM […], considering its notorious status and success in the pharmaceutical field."

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.
Again, in that regard the Complainant provides a list of cases:
- WIPO - D2000-0003 - Telstra Corporation Limited v. Nuclear Marshmallows
- WIPO - D2000-0400 - CBS Broadcasting, Inc. v. Dennis Toeppen

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the 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).

The disputed domain name <us-boehringer-ingelheim.com> is confusingly similar to the trademark <BOEHRINGER INGELHEIM> which the disputed domain name <us-boehringer-ingelheim.com> contains in its entirety and from which the

disputed domain name <us-boehringer-ingelheim.com> only differ in the addition of the letters “us” at the beginning of the disputed domain name separate by a hyphen. This addition of letters is not sufficient to distinguish the disputed domain name <us-boehringer-ingelheim.com> from the Complainants’ trademark <BOEHRINGER INGELHEIM>

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 Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy).

The disputed domain name <us-boehringer-ingelheim.com> is not being used since its registration. Indeed the disputed domain name <us-boehringer-ingelheim.com> does not display any content; rather the disputed domain name is inactive.

The Respondent has not made any legitimate or fair use of the disputed domain name <us-boehringer-ingelheim.com>. The Respondent, Patrick Ryan, is not commonly known by the disputed domain name <us-boehringer-ingelheim.com>. There is no other basis on which the Respondent could claim a right or legitimate interest in the disputed domain name <us-boehringer-ingelheim.com>.

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Domain Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

Given the notoriety of the Complainant, the Complainants’ company name and trademark <BOEHRINGER INGELHEIM> and its reputation it is highly unlikely that the Respondent would have been unaware of this facts at the time of registration; rather it must be assumed that the Respondent has registered the disputed domain name <us-boehringer-ingelheim.com> in full knowledge of the Complainants’ trademarks.

The disputed domain name <us-boehringer-ingelheim.com> resolves to an inactive page (“404 error page”). The concept of a domain name “being used in bad faith” includes inaction. The particular circumstances of this case lead to conclusion that by non-use of the disputed domain name <us-boehringer-ingelheim.com> (“passive holding”) the disputed domain name is also being used in bad faith by the Respondent. The Complainants’ trademark <BOEHRINGER INGELHEIM> has a strong reputation and is widely known. The Respondent has provided no response to the compliant. The Respondent has also taken active steps to conceal its true identity and actively provided false contact details.

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 Panel finds that the disputed domain name <us-boehringer-ingelheim.com> is confusingly similar to the <BOEHRINGER INGELHEIM> trademarks in which the Complainant has rights.

Furthermore the Respondent has no rights or legitimate interests in the disputed domain name <us-boehringer-ingelheim.com>. The Panel finds that the Complainant successfully submitted prima facie evidence that the Respondent has made no use of, or demonstrable preparations to use the disputed domain name. This prima facie evidence was not challenged by the Respondent.

In the absence of a response, the Panel, considering the fame and reputation of the Complainants’ trademarks, infers that the Respondent had the Complainants’ <BOEHRINGER INGELHEIM> trademarks in mind when registering the disputed domain name <us-boehringer-ingelheim.com>. The Panel is of the opinion that the Complainants’ plausible allegation of bad faith of the Respondent regarding the registration and the use of the disputed domain name <us-boehringer-ingelheim.com> is correct. Therefore the disputed domain name was registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **US-BOEHRINGER-INGELHEIM.COM**: Transferred

PANELLISTS

Name	**Prof. Dr. Lambert Grosskopf, LL.M.Eur.**

DATE OF PANEL DECISION 2016-05-04

Publish the Decision