Decision for dispute CAC-UDRP-101239

Case number	CAC-UDRP-101239
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Domain names	OFEV.SITE

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	BOEHRINGER INGELHEIM PHARMA GMBH & CO.KG

Complainant representative

Organization	Nameshield (Maxime Benoist)

Respondent

Name	hery cama

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other proceedings.

IDENTIFICATION OF RIGHTS

The Complainant has an international registration for the word mark “OFEV” in class 5 for pharmaceuticals, registered IR No. 1120388, registered on 10 April 2012. This translates to national marks in the EU and some 58 other countries. It also has an earlier German national mark. The Complainant is also the owner of a portfolio of domain names including the word “OFEV” and has the .com, .us, .de, .es, .fr, .at, and .asia domains.

FACTUAL BACKGROUND

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

The Complainant was a family-owned pharmaceutical group founded by Albert Boehringer in 1885 in Ingelheim am Rhein and is now a global research-driven pharmaceutical enterprise with 140 affiliated companies world-wide and some 46,000 employees. The two main business areas of the Boehringer Group are Human Pharmaceuticals and Animal Health. In 2013 net sales of the group amounted to some EUR 14.1 billion.

“OFEV” is approved as a prescription drug for treatment of Idiopathic Pulmonary Fibrosis.

The disputed domain name was registered on 3 June 2016 by the Respondent “herycama” domiciled in "Peru". The Complainant contends that the disputed domain name is identical to its trademark OFEV.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

1. The Complainant states that the disputed domain name is identical to its trademark and domain names and the disputed domain name includes the trade mark in its entirety. The Complainant con-tends that addition of the TLD suffix is not sufficient to escape the fact that the disputed domain name is identical to the Complainant's trademark and does not change the overall impression it gives of being connected to its trademark.

The Complainant has previously defended its trademark in several previous UDRP cases, including: WIPO Case No. D2016-0486, Boehringer Ingelheim International GmbH v. Pan Da Da, <ofev.top>; WIPO Case No. D2016-0483, BoehringerIngelheim International GmbH v. li yongtao/Mo Ban Lin Shi, <ofev.xyz>;WIPO Case No. DCC2016-0005, BoehringerIngelheim International GmbH v. xujunxujun, <ofev.cc>; and WIPO Case No. D2016-0094, BoehringerIngelheim International GmbH v. Hector Mil-la, <ofevip.com>.

The Complainant contends that the disputed domain name <ofev.site> is identical to its prior trade-mark OFEV.

2. The Respondent does not have any rights or legitimate interests in the disputed domain name.
According to the WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd., a Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests and once the prima facie case is made, the Respondent has the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP. The Complainant contends that the disput-ed domain name is identical to its prior international trademark registered on 10 April 2012. Fur-thermore, the Respondent is not known by the name. The Complainant contends that the Respond-ent has no rights or legitimate interests in respect of the disputed domain name and is not related or connected in any way to the Complainant. The Complainant does not carry out any activity for, nor has any business with, the Respondent. Neither licence nor authorization has been granted to the Respondent to make any use of the Complainant’s trademark, OFEV, or apply for registration of the disputed domain name.

The disputed domain name points to a webpage displaying sponsored links or pay per click (“PPC”) in relation to the Complainant and it says that previous UDRP panels have found that a domain name corresponding to the trademark of another for the purpose of offering sponsored links is generally not evidence of any rights or legitimate interests, citing WIPO Case No. D2010-1046, Woolworths Limited v. DomainAdminkPrivacyProtect.org/Smvs Consultancy Privacy Limited, (this use of a do-main name, offering or linking to competing goods and services, is not bona fide and cannot confer any rights or legitimate interests) and see WIPO Case No. D2009-0776, Aspen Holdings Inc. v. Rick Natsch, Potrero Media Corporation, (a Respondent cannot establish rights or legitimate interests through the use of a disputed domain name with a pay-per-click landing page containing links to ads that relate to the Complainant's area of commercial activity, this manifests an intent to exploit and profit from the Complainant's mark). The Respondent has registered the disputed domain name with the trademark of the Complainant on the extension “.SITE” solely to divert internet users for a com-mercial gain by proposing sponsored links

3. The disputed domain name has been registered and is being used in bad faith. The Complainant relies on four grounds going to bad faith: (a) use of privacy or proxy registration services; (b) other commercial gain; (c) domain parking and (d) attracting internet users for commercial gain by creating a likelihood of confusion with the Complainant.

The disputed domain name is identical to the prior trademark OFEV and points to a website display-ing sponsored links. The Complainant contends that the disputed domain name displays sponsored links of Complainant’s activity for the purpose of attracting internet traffic. Past panels have held this is bad faith use and registration: see, WIPO Case No. D2008-0422, F.

Hoffmann-La Roche AG v. Tran-sure Enterprise Ltd.: (bad faith made out where disputed domain name was aimed at attracting in-ternet traffic associated with complainant's mark for commercial gain) and WIPO Case No. D2005-1304, Mobile Communication Service Inc v. Webreg, RN (respondent's use of the disputed domain name for a PPC parking page constituted bad faith use because the respondent was attracting inter-net users to its website by confusion as to association with the complainant or its services, disrupting the complainant's business by diverting consumers from the complainant's website).

The Complainant contends the Respondent must be found to have used the disputed domain name intentionally to attract visitors for commercial gain by confusion with the Complainant's trademark, and to have made the registration with that intention, constituting registration and use in bad faith. See WIPO case No. DME2015-0003, Stuart Weitzman IP, LLC v. Zhao Ke - <stuartweitzman.me>.

The Complainant also relies on the fact that it has defended its trademarks against cybersquatting, in several previous UDRP cases (cited above). Previous UDRP panels have found that use a domain name corresponding to the trademark of another for the purpose of offering sponsored links is gen-erally not evidence of any rights or legitimate interests. See WIPO Case No. D2010-1046, Wool-worths Limited v. DomainAdminkPrivacyProtect.org/Smvs Consultancy Privacy Limited and WIPO Case No. D2008-0422, F. Hoffmann-La Roche AG v. Transure Enterprise Ltd.(finding use in bad faith where disputed domain name was aimed at attracting Internet traffic associated with complainant's mark for commercial gain"). See also WIPO case no. DME2015-0003, Stuart Weitzman IP, LLC v. Zhao Ke - <stuartweitzman.me (respondent was found to have used the disputed domain name intention-ally to attract visitors for commercial gain by confusion with the complainant's trademark, and to have made the registration with that intention, constituting registration and use in bad faith).

RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, without doubt, rights in a name and mark identical to the disputed domain name. Suffixes are generally regarded as irrelevant for this purpose, see WIPO Case D2000-0429 (rol-lerblade.net). This means the comparison is ofev and ofev. The rule was introduced before the new gTLDs when both marks were often .coms. In this case there is a .com and a .site. The rule still holds generally, however the suffix may be relevant to the other factors below. The trade mark is highly distinctive and fanciful or arbitrary –that is, it exclusively references the Complainant's goods and has no other meaning and is a made up word, in English, at least. The mark is a relatively new trade mark however and has less than five years of use. We don't have sales or other data relevant to the partic-ular product but can assume the sales are significant.

The Complainant has, to the satisfaction of the Panel, shown the Domain Name is identical or confus-ingly 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

Under paragraph 4(a)(ii) of the Policy, a Complainant must prove that the Respondent has no rights or legitimate interests in respect of the domain name. The non-exhaustive grounds upon which it may rely are set out in paragraph 4(c) of the Policy and so the following may evidence rights or legiti-mate interests: (i) a bona fide offering of goods or services; (ii) being commonly known by the name; and (iii) making legitimate non commercial or fair use of the domain name.

The first category of bona fide offering encompasses third parties such as resellers, sales agents and licencees who have a right in law to use the mark in issue. The third category maps to the various defences in international trade mark norms for free speech and descriptive and nominative use of marks. Both are potentially engaged here merely on the face of the matter.

The Complainant's submitted evidence shows the disputed domain name used to resolve to a page which used to show the following topics listed:

“Drug Treatment, Lung cancer Clinical Trials, Lung Cancer Treatment, Idiopathic Pulmonary Fibrosis, Melanoma Clinical Trials, Cancer Drug, Treatment of Breast Cancer, Lung cancer Side Effects, Breast Cancer Onocology, What is Pulmonary Fibrosis.”

Furthermore, the page to which the disputed domain name previously resolved also displayed a sen-tence: “The Sponsored Listings displayed above are served automatically by a third party. Neither Parkingcrew nor the domain name owner maintain any relationship with the advertisers”.

That is all that’s known to the Panel. In that regard it should be noted that the disputed domain name no longer resolves to any webpage. Given that the Respondent has not filed any response whatsoever (although the Respondent has been duly served in accordance with the Rules) the Panel has no doubt that this failure to resolve is a result of a Takedown Notice from the Complainant to an internet intermediary.

Nevertheless, the Complaint is vague on the question of prima facie legitimate rights or interests of the Respondent in the disputed domain name merely stating: “the disputed domain name displays sponsored links of Complainant’s activity” and “the disputed domain name points to a webpage dis-playing sponsored links or pay per click (“PPC”) in relation to the Complainant” (emphasis added).

As the Panel has no further information about the nature of the links which used to be displayed on a webpage to which used to resolve the disputed domain name, on 1 August 2016 the Panel made a request for further evidence from both parties. The deadline was 5 August 2016 but neither party responded.

Therefore, the Panel must decide whether the Complainant has managed to meet the burden of proof simply on the information and evidence provided in the Complaint. In that regard it should be noted the overall burden of proof rests with the Complainant and that the general standard of proof under the UDRP is on the balance of probabilities. Nevertheless, proving a negative can sometimes be an impossible task as information regarding the Respondent’s business is primarily within his or her knowledge.

The standard of proof under the UDRP requires that an asserting party must establish that it is more likely than not that the claimed fact is true. Conclusory statements or bare assertions which are not supported by evidence are not sufficient.

The Panel notes that the Complaint is drafted in very general terms indeed. There are on the face of it, scenarios which suggest legitimate rights or interests of the Respondent within the meaning of para-graph 4 of the Policy. For example, if the links were to information about the various diseases listed including Idiopathic Pulmonary Fi-brosis, then this could be a legitimate or fair use even through the Complainant's mark is used to drive traffic to the page(s). This would be so even if that clicked through page mentioned, discussed or referenced various other prescription drugs that are used to treat the disease. This is as the drug may be referred to there in a nominative or descriptive sense. That is not trade mark use (use impact-ing the origin function of a trade mark). Use to discuss the pros and cons of a drug in treating a dis-ease or its side effects or other characteristics or otherwise to discuss it, is paradigm fair use. This re-flects the boundary between trade marks and speech- no-one has the right to stop people talking about (even negatively) the drug. The modern view is that moderate click related revenue or spon-sored advertisements do not prevent such use being considered primarily non-commercial in nature.

If the links were to advertisements for the Complainant's drug and the drug offered was the genuine drug, made by the Complainant, even if sold by an unofficial or unauthorized seller, or re-seller; this would also be legitimate use. This flows from the test in OKI Data, WIPO Case D2001 -0903, which has four requirements: (1) actual use of the domain name to offer the goods/services; (2) use to sell only the trade marked goods; (3) a disclaimer to explain accurately the relationship (or not) with the trade mark owner; (4) not corner the market in the domain names that reflect the trade mark. It would be relevant here that the .com is not used by the Respondent, so the disputed domain name does not purport to “impersonate”

the Complainant or corner its commercial names. Under EU law, point (2) and (3) of the rule are too strict and as just as a bricks and mortar store can sell a range of competing products and advertise them by reference to their names and marks, provided it is in ac-cordance with honest practices, so too can online stores, in my view.

If the links were only to advertisements for drugs for Idiopathic Pulmonary Fibrosis made by compet-itors of the Complainant, then under EU law the test might be whether they were offered as alterna-tives (which are not confusing to consumers who understand that the offer is such) or imitations, see Interflora v Marks & Spencer Case C-323/09. However, UDRP panels (made up of trade mark law-yers) tend to take a more conservative view particularly where they find intent or targeting involved in revenue generating parking pages, despite the fact that parking pages are regarded more liberally than in the past due to changing business models online.

In any event, in this case, we do not know and the Complainant has not, even when requested by this Panel, clarified the position. I am not going to infer that if the answer had benefited its case, we might have it.

Nevertheless, as already mentioned above, in this particular case, the Panel has no further infor-mation about the disputed domain name and its use by the Respondent for the Respondent has not submitted any response. According to Paragraph 14 (b) if a party does not comply with request from the Panel, the Panel may draw such inferences as it considers appropriate. Therefore, the Panel is to decide the case based solely on evidence and information provided by the Complainant.

However, in light of the fact that on the Respondent's webpage there was a statement claiming that all the links are advertisements and the Respondent maintains no relationship with the advertisers, the Panel finds on the balance of probabilities that the disputed domain name was used as a pay-per-click website. The Panel concludes that Respondent seeks to take unfair advantage of the value of the trademark. Thus, based on the evidence in the record and considering that the Respondent has not submitted a Response, the Panel finds that the Complainant has made a prima facie case that the Respondent has no rights or legitimate interest in the disputed domain name and this has not been rebutted.

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).

BAD FAITH

For the same reasons as in relation to legitimate use, the Panel finds that the Complainant has met its burden. In other words, the Panel finds the Respondent intentionally attempted to attract Internet users to its website for commercial gain, by causing a likelihood of confusion with the Complainant's trade mark as to the source, sponsorship, affiliation or endorsement of the Respondent's website.

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).

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.

At least one email address relayed in fact, and for the purposes of the policy, service was duly effected upon the Respondent

PRINCIPAL REASONS FOR THE DECISION

The Panel finds that the disputed domain name is identical to the Complainant's trade mark "OFEV" as it includes the trade mark in its entirety, with the mere addition of a hyphen and the Top-Level domain ".site" which is not sufficient to exclude the likelihood of confusion.

Furthermore, based on the evidence on records and considering that the Respondent has not sub-mitted a Response, the

Panel finds that the Complainant has made a prima facie case that the Re-spondent has no rights or legitimate interest in the disputed domain name.

Finally, the Panel finds that the Respondent has registered and used the disputed domain name in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **OFEV.SITE**: Transferred

PANELLISTS

Name	**Victoria McEvedy**

DATE OF PANEL DECISION 2016-08-12

Publish the Decision