Decision for dispute CAC-UDRP-101286

Case number	CAC-UDRP-101286
Time of filing	2016-09-07 10:56:48
Domain names	boehringer.lol

Case administrator

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

Complainant

Organization	BOEHRINGER INGELHEIM PHARMA GMBH & CO.KG
Organization	ACTELION Pharmaceuticals Ltd

Complainant representative

Organization	Nameshield (Maxime Benoist)

Respondent

Name	Cameron Jackson

OTHER LEGAL PROCEEDINGS

No other proceedings have been notified to the Panel.

IDENTIFICATION OF RIGHTS

According to evidence it has adduced, the first Complainant is the registered holder, among others, of the trademarks "BOEHRINGER" (WIPO No.799761), “BOEHRINGER INGELHEIM” (WIPO No. 221544) in respect of its own corporate brand and of the mark "VETMEDIN" (No. 463307) in respect of its pharmaceutical product brand, all registered with WIPO under its Madrid international trademark system so as to be applicable in numerous countries. The common class of these marks under the Nice Classification System is 05, "Pharmaceutical Products".

According to evidence it has adduced, the second Complainant is the registered holder, among others, of the trademark “ACTELION” (WIPO No. 1034998) in respect of its own corporate brand and of the marks “OPSUMIT” (WIPO No. 1084328), “TRACLEER” (WIPO No. 751536), “UPTRAVI” (WIPO No.1084036), “VALCHLOR” (WIPO No.1202611), “VELETRI” (WIPO No. 760333) and “ZAVESCA” (WIPO No. 948682) in respect of its pharmaceutical product brands, all registered with WIPO under its Madrid international trademark system so as to be applicable in numerous countries. The common class of these marks under the Nice Classification System is 05, "Pharmaceutical Products".

Both Complainants have furthermore adduced evidence from their websites of the notoriety of their respective

pharmaceutical product brands and of their taking out domain names in respect of each of the names subject to their trademarks, alone or in combination with supplementary terms in certain domain name strings.

FACTUAL BACKGROUND

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

UDRP panels widely agree that incorporating a trademark into a domain name can be sufficient to establish that the domain name is identical to a registered trademark, notably:

- WIPO Case No. DCO2014-0023, Boursorama S.A. v. Daven Mejon;
- WIPO Case No. D2007-1629, F. Hoffmann-La Roche AG v. Relish Entreprises;
- WIPO Case No. D2002-0358, Thaigem Global Marketing Limited v. Sanchai Aree;
- WIPO Case No. D2000-0503,Uniroyal Engineered Products, Inc. v. Nauga Network Services.

Panels have, further, held that the addition of words can worsen the confusing similarity between a trademark and a domain name, notably:

- WIPO Case No. D2010-2124, Costco Wholesale Corporation and Costco Wholesale Membership, Inc. v. Kenneth Terrill: "The addition of certain words, as here, can "exacerbate […] the confusing similarity between the [Complainant's] trademark and the Domain Name and increase […] the risk of confusion between the Domain Name and the […] trademarks."

- WIPO Case No. D2003-0748 Yellow Corporation v. MIC: "when a domain name is registered which is a well-known trademark in combination with another word, the nature of the other word will largely determine the confusing similarity".

The Complainant also referred to WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd., in respect of the principle accepted by Panels in practice that a Complainant is required only to make out a prima facie case that the Respondent lacks rights or legitimate interests.

In respect of the Respondent's previous conduct, the Complainant referred to:
- CAC case no. 101150, ALSTOM S.A. v. Cameron Jackson;
- WIPO case no. D2015-2214, BHP Billiton Innovation Pty Ltd v. Cameron Jackson;
- WIPO case no. D2015-2226, Statoil ASA ("statoil") v. Cameron Jackson;
- WIPO case no. D2015-1782, BHP Billiton Innovation Pty Ltd v. Cameron Jackson;
- WIPO case no. D2015-0090, Tommy Bahama Group, Inc.,v. Cameron Jackson;
- CAC case no. 101219, BOEHRINGER INGELHEIM PHARMA GMBH & CO.KG v. Cameron David Jackson;
- CAC case no. 101199, BOEHRINGER INGELHEIM PHARMA GMBH & CO.KG v. Cameron David Jackson;
- WIPO case no. D2016-0559, Solvay SA v. Cameron David Jackson;
- WIPO case no. D2016-0628, Comerica Bank v. Cameron David Jackson;
- WIPO case no. D2016-0692, Zions First National Bank v. Cameron David Jackson;
- WIPO case no. D2016-0414, Thule Sweden AB v. Cameron David Jackson;
- WIPO case no. D2016-0261, William Grant & Sons Limited / The Glenfiddich Distillery v. Cameron David Jackson.

The Complainant relied on the finding in WIPO case No. D2000-1164, Boeing Co. v. Bressi, where a "Respondent has advanced no basis on which he could conclude that it has a right or legitimate interest in the domain names".

In relation to alleged bad faith, the remark in NAF case No. FA109697, LFP, Inc. v. B & J Props., that a "respondent cannot simply do nothing and effectively "sit on his rights" for an extended period of time when the respondent might be capable of doing otherwise", while "passive holding", under the appropriate circumstances, can fall within the concept of the domain name being used in bad faith, particularly where the domain name in question contains a well-known trademark. The Complainant cited here:

- WIPO Case No. D2000-0003 Telstra Corporation Limited v. Nuclear Marshmallows;

- WIPO Case No. D2008-0028 Action S.A. v. Robert Gozdowski;
- WIPO Case No. D2000-0400CBS Broadcasting, Inc. v. Dennis Toeppen.

The Complainant then, in alleging bad faith registration, cited the remark that "a sophisticated domainer who regularly registers domain names cannot be 'wilfully blind' to whether a particular domain name may violate trademark rights": WIPO Case No. D2009-0209 Mahindra & Mahindra Limited v. Portfolio Brains LLC.

Finally, the Complainant brought to the Panel's notice WIPO Case No. D2014-0306 Boehringer Ingelheim Pharma GmbH & Co. KG v. Klinik Sari Padma, BAKTI HUSADA: “the Panel finds it is highly unlikely that [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.”

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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).

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).

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).

PROCEDURAL FACTORS

This proceeding involves multiple disputed domain names and a Complaint introduced on behalf of two Complainants, raising two distinct procedural aspects.

(1) Multiple domain names

Under the UDRP Rules, Paragraph 3(a), the Complaint can be “initiated” by “[a]ny person or entity”. This applies in respect of any disputed domain name. However, under Paragraph 10(e), as part of the “General Powers of the Panel”, the Panel is charged with deciding upon any request by a party to consolidate multiple domain name disputes. Longstanding practice in the administration of various UDRP ADR providers, supported by various previous Panels, has regularly admitted such consolidation in one Complaint against the same Respondent, provided that it would not be inequitable to the Respondent so to proceed. Alleged infringement of similar rights of the Complainant by the same Respondent will generally meet this test and thus provide a fair and procedurally efficient method of proceeding. This state of affairs corresponds to the claims made in the Complaint in the present proceeding by reference to each domain name relative to the Complainant concerned.

The Panel thus, in exercise of its powers under the UDRP Rules cited above, admits the Complaint in respect of multiple domain names, since nothing is disclosed from the Case File that would indicate the Respondent might be prejudiced by so proceeding (and in the absence of a Response).

(2) Multiple Complainants

Under Art. 3(a) of the UDRP Supplemental Rules of the Czech Arbitration Court, a Complaint can be introduced by more than one Complainant (a so-called “Class Complaint”), provided that:

-“[t]he Class Complaint is based on legal arguments applicable equally, or substantially in the same manner, to all the disputed domain names;
- the person representing several different Complainants joined in the Class Complaint must provide evidence that it is authorized to act on behalf of each of the Complainants; and
- for the avoidance of doubt, the Panel can order transfer of any of the disputed domain name(s) only to the individual Complainant on [whose] behalf such transfer was requested in the Class Complaint, in accordance with the Policy.“

Upon examination of the Complaint, it is clear to the Panel that:

- the same legal arguments apply, mutatis mutandis, on behalf of the two Complainants, namely in respect of alleged registration and/or use by the Respondent of the disputed domain names in violation of the Complainants’ product and brand names in the same industrial sector;
- sufficient evidence has been provided, in the form of signed and stamped power of attorney documents sent to the Case Administrator by the Complainant, to attest that the authorized representative (Nameshield) is duly acting for both Complainants in this joint claim; and
- the Complaint’s claims for transfer from the Respondent of the disputed domain names are structured correctly in accordance with each Complainant’s respective rights and entities.

In addition, the Panel considered, under its general duty of impartiality, whether there was any reason to consider that the Respondent might nevertheless suffer any prejudice procedurally by joining the claims of the two Complainants. Had there been any, the Panel would in its view be obliged to give precedence to procedural fairness over procedural efficiency. However, examination of the Case File disclosed no such reason (and the Respondent had entered no Response).

In these circumstances, and considering that the UDRP Supplemental Rules of the Czech Arbitration Court were amended following public consultation specifically to allow “class complaints”, the Panel concluded that the joint Complaint in respect of multiple domain names could proceed as submitted.

The Panel is accordingly satisfied that all procedural requirements under the UDRP were met and that there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

1. Background

This case involves as Complainants two companies active in the pharmaceutical sector who have made common cause against a registrant of domain names that infringe their rights on grounds of being identical or confusingly similar to names protected by trademark in particular.

A total of fourteen domain names are in dispute, of which half relate to registered marks for corporate brand names, the other half to similarly protected pharmaceutical product names.

The Respondent, who is the registrant of the fourteen names, is a natural person in New South Wales, Australia, apparently trading on his own account under the business name "Best Real Estate Names".

2. The disputed domain names' similarity to or identity with the Complainants' protected rights

The Panel finds that the disputed domain names (i.e. their stems) are either identical to the marks adduced in evidence by the respective Complainants or incorporate those names prominently.

3. Presence or absence of a legitimate interest on the part of the Respondent

Both Complainants in the Complaint and its Annexes amply substantiate their respective legitimate interest in respect of all of the disputed domain names.

As regards the Respondent, the Panel notes that he was contacted by the first Complainant in the form of a cease and desist letter and responded in writing to that letter prior to the commencement of the present proceedings. The exchanges in this correspondence were submitted in full as evidence to the Panel.

It is clear from the Respondent's answers to the first Complainant that he considered that the purpose of the exchanges was to fix a price for transfer to the first Complainant. At no point did the Respondent indicate that he had any form of legitimate interest or dispute the first Complainant's legitimate interest. Nor is there any indication from the third-party documents contained in the Case File that the Respondent might possess a legitimate interest in any of the disputed domain names. Rather, all the circumstances -- especially the attempt to fix a price and Mr Jackson's record as a Respondent in other UDRP proceedings -- suggest that he had a pecuniary interest but not a legitimate interest by right.

The Panel has no difficulty in finding on this basis that the UDRP test of the lack of a Respondent's legitimate interest has been met on the evidence.

4. Bad faith on the Respondent's part

In the aforementioned correspondence, the Respondent not only asked for a negotiable sum above the simple cost of transfer of a disputed name to the first Complainant, but also attempted to negotiate transfer of a second one -- which the first Complainant's representative had not mentioned in its first cease and desist letter -- as a kind of package deal.

In addition, the Respondent's second reply includes the remark "Good i enjoy wipo too". This might easily be read in the circumstances as meaning that accepting the relatively low price the Respondent was suggesting would spare the first Complainant the effort and cost of initiating UDRP proceedings.

If so, the first Complainant was having none of this; it maintained its demands and launched the UDRP proceedings together with the second Complainant. By joining forces in regard to fourteen instances of registration contrary to their rights as trademark holders, the Complainants were able to show a more consistent pattern of conduct of cybersquatting on the Respondent's part. These parties further reinforced the case for inferring bad faith by invoking earlier Panels' decisions against the Respondent.

While the element of moral turpitude inherent in any finding of bad faith imposes the duty on the Panel not to infer bad faith lightly or mechanically, the absence of any Response by the Respondent in the circumstances just described cannot be overlooked.

The Panel in light of these factors therefore finds that the last UDRP requirement, of the Respondent's bad faith, has been met in the circumstances of this case.

5. Decision

As a consequence of the foregoing, the Panel orders transfer of the disputed domain names to the respective rights holders.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOEHRINGER.LOL**: Transferred
2. **BOEHRINGERINGELHEIMPHARMAGMBH.XYZ**: Transferred
3. **VETMEDIN.XYZ**: Transferred
4. **BOEHRINGERINGELHEIMINTERNATIONAL.XYZ**: Transferred
5. **ZAVESCA.XYZ**: Transferred
6. **VELETRI.XYZ**: Transferred

7. **VALCHLOR.XYZ**: Transferred
8. **UPTRAVI.XYZ**: Transferred
9. **TRACLEER.XYZ**: Transferred
10. **OPSUMIT.XYZ**: Transferred
11. **ACTELIONPHARMACEUTICALSCORPORATIONSWITZERLAND.XYZ**: Transferred
12. **ACTELION.XYZ**: Transferred
13. **ACTELIONLTD.XYZ**: Transferred
14. **ACTELIONBIOTECHNOLOGY.XYZ**: Transferred
15. **ACTELIONBIOTECH.XYZ**: Transferred

PANELLISTS

Name	**Kevin J. Madders**

DATE OF PANEL DECISION 2016-10-30

Publish the Decision