Decision for dispute CAC-UDRP-101420

Case number	CAC-UDRP-101420
Time of filing	2017-01-25 08:38:29
Domain names	BOEHRINGERINGELHEIMINC.COM

Case administrator

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

Complainant

Organization	BOEHRINGER INGELHEIM PHARMA GMBH & CO.KG

Complainant representative

Organization	Nameshield (Maxime Benoist)

Respondent

Name	ANDREAS NEUMANN

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided legal proceedings relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

In this proceeding, the Complainant relies on the following trademarks:

- BOHERINGER INGELHEIM (word), international registration No. 221544 of July 2, 1959, covering goods in classes 1, 2, 3, 4, 5, 6, 16, 17, 19, 29, 30 and 32;
- BOHERINGER INGELHEIM (word), US registration No. 74667607, filed on April 26, 1995 and granted on June 24, 1997, covering goods in class 5;
- BOHERINGER INGELHEIM (device), EUTM registration No. 84657, filed on June 2, 1998 and duly renewed, coverign goods in class 5;
- BOHERINGER INGELHEIM (device), international registration No. 722462 of July 2, 1999, covering goods in classes 5, 10 and 30;
- BOHERINGER (word), international registration No. 799761 of December 2, 2002, covering goods in classes 1 , 2, 5, 10, 16, 30, 31, 35, 41, 42 and 44 .

FACTUAL BACKGROUND

The Complainant is a German family-owned pharmaceutical group of companies with origins dating back to 1885, when it was founded by Albert Boehringer in Ingelheim am Rhein.

Ever since, the Complainant has become a global research-driven pharmaceutical enterprise and has today about 140 affiliated companies worldwide, with approximately 46,000 employees. The two main activity areas are "human pharmaceuticals" and "animal healh". In 2013, net sales of the Boehringer group of companies amounted to around 14,1 billion Euros.

The Complainant owns a large portfolio of trademarks including the wording "BOEHRINGER INGELHEIM" , among which <boehringer-ingelheim.com>, registered on September 1, 1995, and <boehringeringelheim.com> registered on July 4, 2004.

The disputed domain name <boehringeringelheiminc.com> was registered on October 27, 2016. On December 22, 2016 the Complainant sent a cease and desist letter to the Respondent by email at the address jjrqckxfk@whoisprivacyprotect.com. The Respondent did not respond to said letter.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Complainant contends that the disputed domain name is confusingly similar to its BOEHRINGER INGELHEIM trademark, as it fully includes this trademark followed by the suffix "inc", and the gTLD ".com". Both these elements are insufficient to escape the finding that the domain name is confusingly similar to the Complainant's trademark. Indeed, the acronym "inc" refers to a company legal form in the United States, and is therefore a generic term. Moreover, it is generally recognised that the gTLD ".com" does not count in assessing confusing similarity with the complainant's trademark.

The Complainant maintains that the Respondent lacks rights or legitimate interests in the disputed domain name because the Complainant never authorised the Respondent to register its trademark as a domain name, the Complainant never licensed its trademark to the Complainant, and because the disputed domain name does not resolve to an active website since its registration. Given the distinctiveness and reputation of the Complainant's trademark, the Complainant contends that the disputed domain name has been registered in order to prevent it from reflecting its mark in a corresponding domain name. Thus, the Respondent registered and used the disputed domain name to create a likelihood of confusion with the Complainant's trademark.

According to the Complainant, given the reputation of the BOEHRINGER INGELHEIM trademark, the Respondent registered the disputed domain name with full knowledge of the Complainant's trademark and this is evidence of the fact that the disputed domain name was registered in bad faith.

With respect to use in bad faith, the Complainant points out that the incorporation of a famous trademark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use. According to the Complainant, the Respondent has maintained the disputed domain name in order to prevent the Complainant from registering its trademark as a domain name. Furthermore, the Respondent did not reply to the cease and desist letter of the Complainant, failing to invoke any circumstance that could demonstrate its good faith in the registration and use of the disputed domain name. For all this reasons, the Complainant concludes that the Respondent registered and used the disputed domain name in bad faith.

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 consists of the Complainant's trademark followed by the suffix "inc". The latter is an abbreviation of "incorporation", a suffix indicating a corporation (see https://en.wikipedia.org/wiki/Inc.). It is therefore a

generic term that could simply designate the Complainant's legal form of business. Therefore, this suffix does not add a distinguising element to the Complainant's trademark.
As far as the gTLD ".com", it is generally recognized that top level domains do not have any bearing in the assessment of identity or confusing similarity according to para. 4(a)(i) of the Policy.

Hence, the Panel is satisfied that the first requirement under the Policy is met.

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).

Since proving a negative fact is almost impossible, Panelists in UDRP proceedings have generally agreed that it is sufficient for the Complainant to establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name to shift the burden of proof to the Respondent.

In the case at issue, the Complainant argued that it never authorised the Respondent to register the BOHERINGER INGELHEIM trademark in a domain name, and that it never licensed its trademark to the Respondent.
Furthermore, the disputed domain name does not resolve to an active website and therefore the Respondent cannot demonstrate any use of the disputed domain name in connection with a bona fide offering of goods and services or a legitimate noncommercial or fair use of the disputed domain name.
Finally, there is no other evidence in the case file that could demonstrate that the Respondent has been commonly known by the domain name.

In view of the foregoing the Panel is satisfied that the Complainant has established a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name. In order to rebut the Complainant's arguments, the Respondent had the possibility to make his own defense. However, the Respondent chose not to reply to the cease and desist letter sent by the Complainant and not to file a Response .

Therefore the Panel is satisfied that also the second requirement under the Policy is met.

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).

As far as registration in bad faith is concerned, given the reputation of the Complainant's trademark and the fact that the disputed domain name fully incorporates this trademark, it is clear that, at the time of the registration of the disputed domain name, the Respondent was well aware of the Complainant's trademark. The registration as domain name of a third party's well-known trademark with full knowledge of the fact that the rights over this trademark belong to a third party amounts to registration in bad faith.

With respect to use in bad faith, the disputed domain name does not resolve to an active website. Lack of use of a domain name can amount to use in bad faith in some circumstances, such as when the Complainant’s trademark has such a strong reputation that it is widely known, and when it is impossible to conceive any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate. These are exactly the circumstances that apply in the case at issue. The trademark BOHERINGER INGELHEIM enjoys wide and extensive reputation.Therefore it is impossible to conceive any plausible active use of the disputed domain name that would be legitimate. Considering that the Complainant is one of the top pharmaceutical companies a potential illegitimate use of the disputed domain name entails serious concerns as it may impact human health.

Therefore the Panel finds it clear that the disputed domain name was used in bad faith.

Further evidence of bad faith lies in the fact that the Respondent provided false contact information at the time of the registration of the disputed domain name and concealed his identity behind a privacy protection service. Despite using a privacy protection service in the registration of domain name is not, per se, evidence of bad faith, concealing his own identity and providing false contact details at the time of the registration of a domain name should be considered a behavior in bad faith. Finally, the Respondent did not reply to the Complainant's cease and desist letter, demonstrating a total lack of interest in this procedure and in re-establishing the appropriate ownership of the Complainant's IP rights.

For all circumstances mentioned above, the Panelist is satisfied that also the third requirement under the Policy is satisfied.

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 disputed domain name incorporates the Complainant's trademark followed by a generic term and the gTLD ".com". The disputed domain name is therefore confusingly similar to the Complainant's trademark.

The Respondent was not authorised to include the Complainant's trademark in the disputed domain name, and the Complainant never licensed its trademarks to the Respondent. The Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services, or a legitimate noncommercial or fair use.

The Respondent registered the disputed domain name with full knowledge of the Complainant's well-known trademark. His passive use of the disputed domain name is in bad faith as there is no conceivable use of this domain name that could amount to a legitimate use. Furthermore, the Respondent provided false contact details at the time of the registration of the disputed domain name and conceiled his identiy behind a privacy protection service. Lastly, the Respondent did not reply to the cease and desist letter sent by the Complainant and demonstrated a total lack of interest in this procedure and in replying to the Complainant's legitimate interests.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOEHRINGERINGELHEIMINC.COM**: Transferred

PANELLISTS

Name	**Angelica Lodigiani**

DATE OF PANEL DECISION 2017-03-02

Publish the Decision