Decision for dispute CAC-UDRP-101436

Case number	CAC-UDRP-101436
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Domain names	boehringer-ingl1heim.com

Case administrator

Name	Aneta Jelenová (Case admin)

Complainant

Organization	BOEHRINGER INGELHEIM PHARMA GMBH & CO.KG

Complainant representative

Organization	Nameshield (Maxime Benoist)

Respondent

Name	Jackie Uding

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 these proceedings, the Complainant relies on the following trademarks:

- BOEHRINGER INGELHEIM (word), US registration No. 74667607, filed on April 26, 1995 and granted on June 24, 1997, covering goods in class 5;

- BOEHRINGER 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;

- BOEHRINGER INGELHEIM (device), international registration No. 722462 of July 2, 1999, covering goods in classes 5, 10 and 30;

- BOEHRINGER INGELHEIM (device), EUTM registration No. 000084657, filed on June 2, 1998 and duly renewed, covering goods in class 5;

- BOEHRINGER (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

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

The Complainant is a German family-owned pharmaceutical group of companies, founded in 1885 by Albert Boehringer in Ingelheim am Rhein.

Ever since, the Complainant has become a very large pharmaceutical enterprise with activities all around the world and thousands of employees.

The Complainant owns a large portfolio of trademarks including the wording "BOEHRINGER INGELHEIM" (with or without a dash between the two words), among which an international registration dating back to 1959. It also owns a multitude of related domain names, like <boehringer-ingelheim.com> since 1995 and <boehringeringelheim.com> since 2004.

The Disputed domain name <BOEHRINGER-INGL1HEIM.COM > was registered on January 29, 2017 by a predecessor of the Respondent, the latter being the current owner.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Complainant contends that the Disputed domain name is confusingly similar to its BOEHRINGER INGELHEIM trademarks, as it fully incorporates this trademark in a misspelled way. This last element is insufficient to escape the finding that the Disputed domain name is confusingly similar to the Complainant's trademark. Indeed, the slightly differentiated spelling of the Complainant’s mark, as to its second component word “ingelheim” (i.e. the deletion of the letter “E" and the addition of the number “1” after the letter “L”), as well as the use of the gTLD “.com” does not change the overall impression of a most likely connection with the trademark BOEHRINGER INGELHEIM of the Complainant. It would be a clear case of typosquatting.

The Complainant maintains that the Respondent lacks rights or legitimate interests in the Disputed domain name because the Complainant is not affiliated with nor has it ever authorised the Respondent to register its trademark as a domain name, the Complainant has never licensed its trademark to the Respondent, and because the Disputed domain name does not resolve to an active website since its registration, but to a parking webpage. 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 distinctiveness and reputation of the BOEHRINGER INGELHEIM trademark, the Respondent registered the Disputed domain name with full knowledge of the Complainant's trademark in an intentionally designed misspelled way 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 Respondent used the Disputed domain name as a parking webpage with sponsored links, with the purpose of attracting internet traffic for commercial gain, which is a clear indication of bad faith. 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.

For all these 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 Disputed 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, written in a misspelled way, which is a classic case of typosquatting.

As far as the gTLD ".com" is concerned, it is generally recognized that top level domains do not have any bearing in the assessment of identity or confusing similarity, according to paragraph 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 Disputed 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 had never authorised the Respondent to register the BOEHRINGER INGELHEIM trademark in a domain name, and that it had 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 non-commercial 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 Disputed 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 has chosen 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 Disputed 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 Disputed 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 BOEHRINGER 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.

For all circumstances mentioned above, the Panel 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, written in a misspelled way, a classic typosquatting case. 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 non-commercial 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 the Disputed domain name that could amount to a legitimate use.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOEHRINGER-INGL1HEIM.COM**: Transferred

PANELLISTS

Name	**Sozos-Christos Theodoulou**

DATE OF PANEL DECISION 2017-03-20

Publish the Decision