

Decision for dispute CAC-UDRP-104596

Case number CAC-UDRP-104596

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Domain names pradaxainjury.com

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization Boehringer Ingelheim Pharma GmbH & Co. KG

Complainant representative

Organization NAMESHIELD S.A.S.

Respondent

Name Suiwang Ma

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 owns a portfolio of brands including the trademark "PRADAXA" in several countries, such as the international trademark "PRADAXA" No. 807503 registered on July 09, 2003 for pharmaceutical preparations.

The Complainant is also the owner of the domain name <pradaxa.com> created on March 06, 2003.

FACTUAL BACKGROUND

The Complainant is a German family-owned pharmaceutical group of companies with roots going back to 1885, when it was founded by Albert Boehringer (1861-1939) in Ingelheim am Rhein.

BOEHRINGER has become a global research-driven pharmaceutical enterprise with more than 52,000 employees. The three business areas of BOEHRINGER are human pharmaceuticals, animal health and biopharmaceuticals. In 2021, net sales of the BOEHRINGER group of companies amounted to about 20.6 Billion Euros.

PRADAXA (generic name: Dabigatran) is an oral anticoagulant from the class of the direct thrombin inhibitors. It is being

studied for various clinical indications and in some cases, it offers an alternative to warfarin as the preferred orally administered anticoagulant since it cannot be monitored by blood tests for international normalized ratio monitoring while offering similar results in terms of efficacy.

The Respondent registered the disputed domain name <pradaxainjury.com> on April 24, 2022.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain name is 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 Complainant contends that the disputed domain name is confusingly similar to its trademark "PRADAXA", to which trademark the Respondent has included in the disputed domain name in its entirety with the addition of the generic term "INJURY".

When part of a domain name is identical to a well-known trademark, it increases the likelihood of confusion or association between the domain name holder and the trademark owner. It is, therefore, sufficient to establish identity or confusing similarity for the purposes of the Policy. See *Oki Data Americas, Inc. v. ASD, Inc*, WIPO Case No. D2001-0902; *Dr. Ing. h.c. F. Porsche AG v Vasily Terkin*, WIPO Case No D2003-003-0888.

The Complainant contends that the addition of the generic term "INJURY" is not sufficient to avoid the likelihood of confusion.

The disputed domain name incorporates the Complainant's trademark "PRADAXA" in its entirety to form the term "PRADAXAINJURY". The Panel considers that this does not change the overall impression of the designation as being connected with the Complainant's trademark "PRADAXA". The Panel considers, in this case, that it increases the likelihood of confusion between the disputed domain name and the Complainant as the true owner of the trademark, and the domain name associated with the Complainant and its business in pharmaceuticals.

The Complainant further contends that the gTLD is viewed as a standard registration requirement and as such is disregarded and referred to *Forum Case No. FA 153545, Gardline Surveys Ltd v. Domain Finance Ltd* in support of this contention.

It is now a well-established principle in the domain name space that generic top-level domains such as ".com", ".org" or ".net" do not affect the domain name for the purpose of determining whether it is identical or confusingly similar. See, for example, *WIPO Case No. D2006-0451, F. Hoffmann-La Roche AG v. Macalve e-dominios S.A.*

The Panel considers that the addition of the generic top-Level domain suffix ".com" does not change the overall impression of the designation of the disputed domain name as being connected to the Complainant's trademark "PRADAXA". Indeed, the Panel considers the addition of the suffix ".com" is irrelevant when assessing whether a domain name is identical or confusingly similar to a trademark. This is because gTLDs are only required for the functionality of a website.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark and that paragraph 4(a)(i) of the Policy is satisfied.

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.

A complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such a prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP. See WIPO Case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.

In support of this ground, the Complainant makes three contentions:

First, the Respondent is not identified in the WHOIS database as the disputed domain name.

Where information in the WHOIS database is not similar to the disputed domain name, a respondent is not commonly known by the disputed domain name. See, for example, Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com>; Forum Case No. FA 699652, The Braun Corporation v. Wayne Loney.

The Panel accepts this contention, which is supported by the evidence from the WHOIS database adduced by the Complainant.

Secondly, the Complainant contends that the Respondent is not related in any way with the Complainant. Specifically, the Complainant contends as follows:

- (a) the Complainant does not carry out any activity for nor has any business with the Respondent.
- (b) the Complainant has not licensed nor authorized the Respondent to make use of its trademark "PRADAXA" or apply for registration of the disputed domain name.

The Panel accepts this uncontradicted contention.

Thirdly, the Complainant contends that the Complainant has not made any use of the disputed domain name since its registration.

The Complainant's evidence shows that the disputed domain name resolves to an inactive webpage.

The Respondent has not filed any administrative compliant response to the Amended Complaint. As such, the Complainant's evidence is uncontradicted.

The Panel is prepared to accept the inference that the Respondent has not used nor intends to use the disputed domain name.

Accordingly, the Panel finds the Respondent has no right or legitimate interests in the disputed domain name.

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.

There are two elements that must be satisfied – registration and use in bad faith.

Registration in bad faith

The evidence shows that the Complainant's trademark "PRADAXA" is a well-known trademark. The Complainant's address and business are located in Germany. The Respondent appears to be located in the People's Republic of China.

The Complainant contends that the Respondent must have been aware of the Complainant's trademark "PRADAXA" at the time the Respondent registered the disputed domain name.

The Complainant asserts that all the Google results of a search of the term "PRADAXA" refer to the Complainant's drug and adduced evidence of the Google results which shows the reference to the trademark made in the first webpage results.

The Panel considers that it is reasonable to infer that the Respondent knew of or should have known about the Complainant's rights, and therefore registered the disputed domain name with full knowledge of the Complainant's trademark.

The Panel notes that other past panel decisions referred to the well-known nature of the Complainant's trademark. See CAC Case No. 101250, Boehringer Ingelheim Pharma GmbH & Co. KG v. Huang ChaoQiong <pradaxa.xyz>; CAC Case No. 102971, Boehringer Ingelheim Pharma GmbH & Co. KG v. neeraj manchanda <pradaxadosing.com>; WIPO Case No. D2021-1710, Boehringer Ingelheim Pharma GmbH & Co. KG v. Contact Privacy Inc. Customer 1249661349 / fcu dwt, yoyaofang <hkpradaxa.com>.

The Panel accepts the Complainant's trademark "PRADAXA" is well-known; it has a longstanding use of its trademark in relation to the services it offers; evidence adduced by the Complainant of a search of the term "PRADAXA" refers to the Complainant.

Accordingly, the Panel finds it is inconceivable that the Respondent would have registered the disputed domain name without being aware of the Complainant's legal rights.

Use in bad faith

The Panel has already referred to the uncontradicted facts set out in the Amended Complaint and accepts the evidence and contention that the disputed domain name resolves to an inactive webpage.

The Complainant contends that the Respondent has not demonstrated any activity in respect of the disputed domain name, and it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law.

The Panel accepts and adopts the general approach by prior WIPO UDRP panels that have held that the incorporation of a famous mark into a domain name, coupled with an inactive webpage, may be evidence of bad faith registration and use. See WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows; WIPO Case No. D2000-0400, CBS Broadcasting, Inc. v. Dennis Toeppen.

The Panel finds in this case, from the uncontradicted evidence, that the Respondent's incorporation of the Complainant's well-known trademark into the disputed domain name coupled with an inactive webpage supports the Complainant's contention of registration and use in bad faith.

Further, the Czech Arbitration Court has also provided written notice of the Complaint to the Respondent with no administratively compliant responses made in respect to any good faith use of the disputed domain name.

This conduct, the bona fides of which are clearly left unexplained by the Respondent, is in the Panel's view evidence of bad faith. See WIPO Case No. D2018-0497, StudioCanal v. Registration Private, Domains By Proxy, LLC / Sudjam Admin, Sudjam LLC; Forum Case No. FA 1623939, Citigroup Inc. v. Kevin Goodman.

In the circumstances, the Panel finds it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would be legitimate.

The Panel, therefore, concludes that the Respondent's holding of the disputed domain name in this case satisfies the requirement that the disputed domain name is being used in bad faith by the Respondent.

Accordingly, the Panel finds that the registration of the disputed domain name and its use was in bad faith.

PROCEDURAL FACTORS

Notification of proceedings to the Respondent

When forwarding a Complaint, including any annexes, electronically to the Respondent, paragraph 2 of the Rules states that CAC shall employ reasonably available means calculated to achieved actual notice to the Respondent.

Paragraphs 2(a)(i) to (iii) set out the sort of measures to be employed to discharge CAC's responsibility to achieve actual notice to the Respondent.

Due to the COVID-19 pandemic the written notice of the Complaint was not sent by the Czech Arbitration Court as the destination country of the Respondent does not provide delivery services now. This procedure was preapproved by ICANN.

On June 21, 2022 the CAC by its non-standard communication stated as follows (omitting irrelevant parts):

- As far as the e-mail notice is concerned, the CAC received a confirmation that the e-mail sent to postmaster@pradaxainjury.com was returned back undelivered as the e-mail addresses had permanent fatal error;
- The e-mail notice was also sent to 3039079359@qq.com, but CAC never received any proof of delivery or notification of undelivery.

No further e-mail address could be found on the disputed site. The Respondent never accessed the online platform.

Given the reasonable measures employed by CAC as set out in the above non-standard communication, the Panel is satisfied that CAC has discharged this responsibility.

PRINCIPAL REASONS FOR THE DECISION

The Complainant owns the registered trademark "PRADAXA" and the domain name <pradaxa.com> which is used in connection with its goods or services for a considerable time. It is a well-known trademark.

The Respondent registered the disputed domain name on April 24, 2022. The disputed domain name has the addition of generic term "INJURY" at the end of the Complainant's trademark which is incorporated in its entirety.

The Complainant challenges the Respondent's registration of the disputed domain name under paragraph 4(a)(i) of the Uniform Dispute Resolution Policy and seeks relief that the disputed domain name be transferred to the Complainant.

The Respondent has failed to file any administratively compliant response.

For the reasons articulated in the Panel's reasons above, the Complainant has satisfied the Panel of the following:

- (a) The disputed domain name is confusingly similar to the Complainant's well-known trademark "PRADAXA".
 - (b) The Respondent has no rights or legitimate interests in respect of the disputed domain name.
 - (c) The disputed domain name has been registered and is being used in bad faith.
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FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. PRADAXAINJURY.COM: Transferred
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PANELLISTS

Name Adjunct Prof William Lye, OAM QC

DATE OF PANEL DECISION 2022-06-23

Publish the Decision
