

Decision for dispute CAC-UDRP-104652

Case number	CAC-UDRP-104652
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Time of filing	2022-06-17 09:10:10
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Domain names	boehringeremployees.com, boehringeringelheimemployees.com
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Case administrator

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

Organization	Boehringer Ingelheim Pharma GmbH & Co.KG
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Complainant representative

Organization	NAMESHIELD S.A.S.
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Respondent

Organization	Clearer Technology
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Respondent representative

Name	Anthony Joseph Biller
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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 names.

IDENTIFICATION OF RIGHTS

The Complainant is a 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. Ever since, BOEHRINGER INGELHEIM has become a global research-driven pharmaceutical enterprise.

The Complainant is the owner of the following trademark registrations in several countries, including but not limited to:

- the international trademark BOEHRINGER® no.799761 registered since December 22, 2002;
- the international trademark BOEHRINGER-INGELHEIM® no.221544, registered since July 2, 1959; and
- the international trademark BOEHRINGER INGELHEIM® no.568844 registered since March 22, 1991.

Furthermore, the Complainant owns multiple domain names consisting in the wording “BOEHRINGER”, such as <boehringer.com>, registered since January 12, 2000 and <boehringer-ingelheim.com> registered and used since September 1, 1995.

FACTUAL BACKGROUND

The Complainant is a 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. Ever since, BOEHRINGER INGELHEIM has become a global research-driven pharmaceutical enterprise and has today about roughly 52,000 employees. The three business areas of BOEHRINGER INGELHEIM are Human Pharma, Animal Health and Biopharmaceutical Contract Manufacturing. In 2021, net sales of the BOEHRINGER INGELHEIM group amounted to about 20.6 billion euros.

The Respondent is based in the United States and registered the disputed domain names in the United States.

The disputed domain names <boehringeremployees.com> and <boehringeringelheimemployees.com> were registered on June 10, 2022.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant states that the disputed domain names are confusingly similar to its trademarks and the addition of the term “EMPLOYEES” is not sufficient to escape the finding that the domain names are confusingly similar to the trademarks BOEHRINGER® and BOEHRINGER-INGELHEIM®.

The Complainant asserts that the Respondent is not identified in the Whois database as the disputed domain names and is not affiliated with nor authorized by the Complainant in any way.

The Complainant contends the Respondent has attempt to attract Internet users for commercial gain to his own websites thanks to the Complainant's trademarks for its own commercial gain, which is evidence of bad faith.

RESPONDENT:

The disputed domain names were registered on June 10, 2022 by the Respondent. The Respondent has been developing the pages of the disputed domain names since and each site continues to be under development at the time of this Response. The disputed domain names comprise Complainant's trademark coupled with the distinguishing term “employees.” The addition of this term alerts the Internet user that the domain is from, for, or about Complainant's employees, and not necessarily a page originating directly from the Complainant. Arriving at the corresponding website confirms what the domain names indicate, that the pages are for Complainant's employees, providing information to the employees about Complainant's activities and about what rights the employees may have while employed by Complainant.

Respondent intends to use the disputed domain names for purposes of educating Complainant's employees and the general public of their civil rights, unionization rights, and the Complainant's policies and practices. Additionally, Respondent intends to

use the domains for purposes of collecting information regarding whether and to what extent Complainant has abused and discriminated against Complainant's employees. The evidence Complainant presents is the parking pages in which the disputed domain names resolved to is one with commercial links and attached the respective parking pages. This is stale evidence, as the domains were under development at that time and remain under development. The websites have materially changed since the filing of this Dispute and will continue to change as they are developed for the purposes explained herein.

Respondent did not register and is not using the disputed domain names in bad faith. As set forth above, Respondent did not purchase these domain names for re-sale. Respondent is not profiting off the project associated with the disputed domain names. Respondent's intended use is to provide information and to empower Complainant's employees regarding their rights.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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).

First, the Complainant claims rights in the BOEHRINGER and BOEHRINGER INGELHEIM marks through its trademark registrations. By virtue of its trademark registrations, Complainant has proved that it has rights in the mark under paragraph 4(a) of the Policy. See *Avast Software s. r. o. v Milen Radumilo*, 102384, (CAC 2019-03-12).

Second, the Complainant claims that the prominent part of the disputed domain names are confusingly similar to its trademark registrations. The addition of the term "EMPLOYEES" does not reduce the similarity between Complainant's trademarks and the disputed domain names and does not change the overall impression of the designations as being connected to Complainant's trademarks.

Despite the Respondent argues that the term "employees" distinguishes between the disputed domain names and Complainant's trademarks, the Panel is of the view that it is well established that the additional term would not prevent the finding of confusingly similar, see paragraph 1.6 of the WIPO Overview 3.0: "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements." See also *Boehringer Ingelheim Pharma GmbH & Co.KG v. Fundacion Comercio Electronico*, 103455 (CAC 2021-01-07) ("The Panel is of the opinion that in a situation where the Complainant's trademark is entirely (or nearly entirely with the exception of a misspelling) included in the litigious Domain name, the adjunction of generic terms does not generally change the assessment as far as the first condition is concerned.").

The Respondent further rebuts that the use of the disputed domain names should also be considered under the first element of UDRP but the Panel holds an opposite view on this. According to paragraph 1.15 of the WIPO Overview 3.0 which states that "The content of the website associated with the domain name is usually disregarded by panels when assessing confusing similarity under the first element. In some instances, panels have however taken note of the content of the website associated with a domain name to confirm confusing similarity whereby it appears prima facie that the respondent seeks to target a trademark through the disputed domain name. Such content will often also bear on assessment of the second and third elements, namely whether there may be legitimate co-existence or fair use, or an intent to create user confusion." In this case, it is undisputed that the prominent part of the disputed domain names is BOEHRINGER and BOEHRINGER-INGELHEIM, and the both parties are referring to the same marks. The Panel hereby accepts that the disputed domain names are confusingly similar to Complainant's trademark.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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 disputed domain names (within the meaning of paragraph 4(a)(ii) of the Policy). More specifically, the Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain names, and the burden of prove then shifts to the Respondent to show it does have rights or legitimate interests. See *PepsiCo, Inc. v Smith*

power production, 102378, (CAC 2019-03-08) ("The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.").

First, the Complainant contends that the Respondent is not affiliated with nor authorized by the Complainant in any way and does not carry out any activity for, nor has any business with the Respondent. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademarks, or apply for registration of the disputed domain names by the Complainant.

The Complainant further contents that Respondent is not identified in the WHOIS database as the disputed domain names. Past panels have held that a Respondent was not commonly known by a disputed domain name if the WHOIS information was not similar to the disputed domain name. Furthermore, the disputed domain names resolve to a parking page with commercial links.

The Panel finds that the Complainant has established a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain names. The burden of proof has been shifted to the Respondent to prove that it has right or legitimate interests to the disputed domain names.

The Respondent does not dispute the fact that Respondent is not affiliated with nor authorized by the Complainant in any way. The Respondent further states that the disputed domain names were under development. The website resolved by the disputed domain name has changed from the parking pages with commercial links to Complainant's employees' page since the filing of the present dispute and will continue to be further developed.

The Respondent further explains that Respondent intends to use the disputed domain names for purposes of educating Complainant's employees and the general public of their civil rights, unionization rights, and the Complainant's policies and practices. Additionally, Respondent intends to use the domains for purposes of collecting information regarding whether and to what extent Complainant has abused and discriminated against Complainant's employees. The intended use of the disputed domain names is genuine and non-commercial, intended to benefit the employees of Complainant.

The Panel is of the view that successfully registering a domain name does not automatically claim rights or legitimate interests to a domain name. Instead, paragraph 4(c) of the Rules listed some common circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate Respondent's rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel notes that the disputed domain names resolved to pay-per-click websites with commercial links and it only changed to the current employee page after the Complainant filed the present complaint. The Panel does not satisfy with Respondent's explanation and the assessment of the 3 elements under UDRP shall be made based on the status when the complaint was filed. Referring to paragraph 4(a) of the Rules, the disputed domain name shall be locked upon a complaint is filed with one of the UDRP providers. However, the lock can only prevent cyberflight but has no impact to the web content resolved by the disputed domain names. Any material changes related to the disputed domain name shall generally be disregarded, see paragraph 2.11 of the WIPO Overview 3.0 ("Panels tend to assess claimed respondent rights or legitimate interests in the

present, i.e., with a view to the circumstances prevailing at the time of the filing of the complaint.").

The Panel further notes that the Respondent is not affiliated with nor authorized by the Complainant in any way. In addition, the Respondent has not disclosed and provide evidence to show that it is a registered community group or law firm providing legal support to Complainant's employees. There is not sufficient evidence to convince the Panel that Respondent is genuinely providing non-commercial support to Complainant's employees. Having considered the relevant circumstances, the Panel decides that the Respondent failed to prove that it has right or legitimate interests to the disputed domain names.

For the foregoing reasons, the Panel finds the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

First, the Complainant reiterates that the Complainant is one of the leading pharmaceutical companies in the world and its trademarks, BOEHRINGER and BOEHRINGER INGELHEIM, are distinctive and well-known. It is reasonable to infer that the Respondent had actual knowledge of the Complainant's rights in its asserted trademarks BOEHRINGER and BOEHRINGER INGELHEIM. The Respondent has confirmed its knowledge about Complainant and its trademarks.

It is commonly agreed that registering a domain name similar to a well-known brand with actual knowledge clearly constitutes to registration in bad faith, see ARCELORMITTAL (SA) v acero, 102399, (CAC 2019-04-22). On this basis, the Panel accepts that the disputed domain name was registered in bad faith.

Second, the Complainant asserts that the disputed domain names resolve to a parking page with commercial links. The Complainant contends the Respondent has attempt to attract Internet users for commercial gain to his own websites, which is evidence of bad faith. Without any convincing evidence presented by the Respondent, the Panel is satisfied with the Complainant's assertions that the registration and use of the disputed domain names are in bad faith.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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.

PRELIMINARY FINDINGS - GENERAL POWERS OF THE PANEL AND UNSOLICITED SUPPLEMENTAL FILING

Pursuant to Paragraph 10(d) and 12 of the Rules that a Panel shall determine the admissibility, relevance, materiality and weight of the evidence, and request, in its sole discretion, further statements or documents from either of the Parties. Paragraph 4.6 of the WIPO Overview 3.0 also states that unsolicited supplemental filings are generally discouraged, unless specifically requested by the panel and are only accepted under exceptional circumstances. In the present case, the Panel does not find the presence of any exceptional circumstances and both parties have not provided reasons for not submitting the supplemental filings within the Complainant and Response forms.

The Panel hereby decides that the supplemental filings from both parties be disregarded.

PRINCIPAL REASONS FOR THE DECISION

Having established all three elements required under the UDRP Policy, the Panel concludes that relief shall be granted.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOEHRINGEREMPLOYEES.COM**: Transferred
2. **BOEHRINGERINGELHEIMEMPLOYEES.COM**: Transferred

PANELLISTS

Name	Mr Paddy TAM
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DATE OF PANEL DECISION	2022-07-22
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Publish the Decision
