

Decision for dispute CAC-UDRP-104757

Case number	CAC-UDRP-104757
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Time of filing	2022-07-29 09:17:28
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Domain names	respimat.xyz
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Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	BOEHRINGER INGELHEIM INTERNATIONAL GMBH
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Complainant representative

Organization	NAMESHIELD S.A.S.
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Respondent

Name	Justin
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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 name.

IDENTIFICATION OF RIGHTS

The Complainant is a pharmaceutical group of companies, among its products is a propellant-free platform inhaler for sufferers of COPD and asthma which is marketed under the RESPIMAT mark for which the Complainant owns a portfolio of trademark registrations including the following:

International trademark RESPIMAT, registration number 582813, registered on January 24, 1992 for goods in class 6;
International trademark RESPIMAT, registration number 697143, registered on July 6, 1998 for goods in class 7; and
International trademark RESPIMAT, registration number 1018281, registered on September 2008, for goods in class 9.

FACTUAL BACKGROUND

The Complainant is a pharmaceutical group of companies, among its products is a propellant-free platform inhaler for sufferers of COPD and asthma which is marketed under the RESPIMAT mark for which the Complainant owns a portfolio of trademark registrations including those described above.

The Complainant has an established Internet presence, owning a number of Internet domain name registrations incorporating the word “respimat”, including <respimat.com> which was registered on February 2, 1999.

The disputed domain name <respimat.xyz> was registered on July 25, 2022 and resolves to a third-party web page on which the disputed domain name is being offered for sale.

In the absence of a timely Response, there is no information available about the Respondent, except for that provided in the Complaint, the Registrar's Whois and the information provided by the Registrar to the Complainant in response to a request by the Center for details of the registration of the disputed domain name for the purposes of this proceeding. The Registrar has confirmed that the Respondent is the registrant of the disputed domain name.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant submits that it is a pharmaceutical group of companies, specialising in human pharma, animal health and biopharmaceutical contract manufacturing with approximately 52,000 employees and revenue in 2021 amounting to approximately €20.6 billion.

Among its products is propellant-free platform inhaler for sufferers of COPD and asthma which is marketed under the RESPIMAT mark for which it owns the portfolio of trademark registrations described above.

Among its products is a propellant-free platform inhaler for sufferers of COPD and asthma which is marketed under the RESPIMAT mark.

The Complainant alleges that the disputed domain name <respimat.xyz> is identical to its RESPIMAT mark because it includes the mark its entirety, without any adjunction of letter or word.

The Complainant further contends that the addition of the New generic Top-Level Domain ("gTLD") extension ".xyz" is not sufficient to escape a finding that the disputed domain name is identical to the Complainant's trademark and does not change the overall impression of the designation as being connected to its trademark. See the WIPO Overview 3.0 which states at §1.11.1, that the applicable Top Level Domain ("TDL") in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusion similarity test.

The Complainant next alleges that the Respondent has no rights or legitimate interests in the disputed domain name, arguing that the Respondent is not identified in the Whois database as the disputed domain name and past panels have held that a respondent is not commonly known by a disputed domain name if the WHOIS information is not similar to the disputed domain name. For instance, *Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group* Forum Case No. FA 1781783 <bobsfromsketchers.com> ("Here, the WHOIS information of record identifies Respondent as "Chad Moston / Elite Media Group." The Panel therefore finds under Policy ¶ 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy ¶ 4(c)(ii).").

The Complainant adds that the Respondent is not related to the Complainant in any way and asserts that the Complainant does not carry out any activity for the Respondent, the Complainant has no business with the Respondent and neither license nor authorization has been granted by the Complainant to the Respondent to make any use of the Complainant's RESPIMAT trademark, or apply for registration of the disputed domain name.

Finally, referring to a screen capture of a website which has been exhibited in an annex to the Complaint, the Complainant submits that the disputed domain name resolves to a third-party's web page on which the disputed domain name is offered for sale.

The Complainant contends that such a general offer to sell the disputed domain name is evidence that the Respondent lack of rights or legitimate interest. See *Enterprise Holdings, Inc. v. Webmaster & Support* Forum Case No. 1562569 ("A general solicitation to sell a disputed domain name provides further evidence of a respondent's lack of rights and legitimate interests in a disputed domain name. [...] Therefore, the Panel finds that Respondent's willingness to sell the <wwenterprise.us> domain

name is credible evidence that Respondent lacked rights and legitimate interests in the disputed domain name pursuant to Policy ¶ 4(a)(ii).”)

The Complainant submits that it has therefore made out a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name and therefore the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name and if the Respondent fails so to do, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. See *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. D2003-0455.

The Complainant next alleges that the disputed domain name was registered and is being used in bad faith, arguing that the disputed domain name is confusingly similar to the Complainant’s RESPIMAT trademark which was registered many years before the registration of the disputed domain name.

Moreover, the Complainant’s RESPIMAT mark is also registered in the Trade Mark Clearing House (TMCH) since June 4, 2019.

The Complainant adds that the term “RESPIMAT” is highly related to the Complainant, and all the results of a simple Google search for the term, relate to or refers to the Complainant and its RESPIMAT-branded products as shown in a copy of a Google search exhibited by the Complainant in an annex to the Complaint.

The Complainant submits that therefore the registrant of the disputed domain name had actual and constructive knowledge of the Complainant’s RESPIMAT mark at the time of the registration of the disputed domain name.

Moreover, the Complainant adds that not only does the website to which the disputed domain name resolve contain a page displaying a general offer to sell the disputed domain name but also the Respondent fails to make an active use of the disputed domain name. The Complainant submits that panels established under the Policy in the past have held that failure to actively use a domain name is evidence of bad faith registration and use. See for example *Airbnb, Inc. v. khaled salem Forum Case number FA 1784212*, (“Complainant argues that Respondent diverts traffic to a parked website used to offer the disputed domain name for sale, in bad faith under Policy ¶ 4(a)(iii). The Panel agrees and finds that Respondent’s failure to actively use the disputed domain name demonstrates bad faith per Policy ¶ 4(a)(iii).”).

The Complainant finally contends that the Respondent has registered the disputed domain name only in order to sell it back for out-of-pockets costs, which evinces bad faith registration and use. See *Citigroup Inc. v. Kevin Goodman Forum Case No. FA 1623939* (“Respondent offered the <citi.club> domain name for sale or lease at prices well above even its alleged but unverified acquisition costs. [...] Therefore, the evidence shows that Respondent registered <citi.club> primarily for the purpose of transferring it for a profit and demonstrates Respondent’s bad faith registration and use of the <citi.club> domain name pursuant to Policy ¶ 4(b)(i).”)

RESPONDENT:

No administratively compliant Response has been filed.

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 Complainant has provided uncontested evidence to prove that it has rights in the RESPIMAT mark, established by its ownership of its portfolio of trademark- and service mark- registrations described above and use of the mark, including on the Internet for marketing its inhaler product for sufferers of COPD and asthma.

The disputed domain name <respimat.xyz> consists entirely of the Complainant’s mark in its entirety, in combination with the generic Top Level Domain (“gTLD”) extension <.xyz>.

The gTLD extension <.xyz> would be considered by Internet users as a necessary technical requirement for a domain name and therefore does not prevent a finding of confusing similarity between the disputed domain name and Complainant’s RESPIMAT

mark.

This Panel finds therefore that the disputed domain name <respimat.xyz> is identical to the RESPIMAT mark in which Complainant has rights and Complainant has therefore succeeded in the first element of the test in Policy paragraph 4(a)(i).

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).

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).

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 Complainant has provided uncontested evidence to prove that it has rights in the RESPIMAT mark, established by its ownership of its portfolio of trademark- and service mark- registrations described above and use of the mark, including on the Internet for marketing its inhaler product for sufferers of COPD and asthma.

The disputed domain name <respimat.xyz> consists entirely of the Complainant's mark in its entirety, in combination with the generic Top-Level Domain ("gTLD") extension ".xyz".

The gTLD extension ".xyz" would be considered by Internet users as a necessary technical requirement for a domain name and therefore does not prevent a finding of confusing similarity between the disputed domain name and Complainant's RESPIMAT mark.

This Panel finds therefore that the disputed domain name <respimat.xyz> is identical to the RESPIMAT mark in which Complainant has rights and Complainant has therefore succeeded in the first element of the test in Policy paragraph 4(a)(i).

The Complainant has made out a prima facie case that the Respondent has no rights legitimate interests in the disputed domain name arguing that

- the Respondent is not identified in the Whois database as the disputed domain name and past panels established under the Policy 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;
- the Respondent is not related in any way with the Complainant;
- the Complainant 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 trademark RESPIMAT, or apply for registration of the disputed domain name by the Complainant;
- the disputed domain name is being offered generally for sale to the public on the web page to which the disputed domain name resolves as shown in the screen capture which has been exhibited by the Complainant in an annex to the Complaint and such a general solicitation to sell a disputed domain name provides further evidence of the Respondent's lack of rights and legitimate interests in a disputed domain name.

It is well established that once a complainant makes out a prima facie case that a respondent has no rights or legitimate interests in the domain name at issue, the burden of production shifts to the respondent to prove its rights or legitimate interests.

The Respondent has failed to discharge that burden and therefore this Panel must find that Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has therefore succeeded in the second element of the test in Policy para 4(a)(ii).

The Complainant has adduced uncontested evidence that it has registered and extensively used the RESPIMAT mark on its inhaler products.

The earliest registration for the mark which is relied upon by the Complainant dates back to January 24 1992 which is long before the disputed domain name was registered on July 25, 2022.

The results of the Google search for the term, exhibited by the Complainant has little evidential value to prove that the term exclusively relates to or refers to the Complainant and its RESPIMAT-branded products because the algorithm may generate results of specific interest to the searcher.

Nonetheless, RESPIMAT is a distinctive mark, and given the length extent of the Complainant's prior rights and reputation, including its use on the Internet at website to which the Complainant's eponymous domain name <respimat.com> resolves, it is implausible that the registrant chose and registered the disputed domain name without knowledge of Complainant, its rights and its mark.

Because the disputed domain name is identical to the Complainant's distinctive RESPIMAT mark, and given that it has been offered for sale so soon after it was chosen and registered, this Panel finds that on the balance of probabilities the disputed domain name was registered to target and take predatory advantage of Complainant's mark and goodwill in the RESPIMAT mark.

This Panel finds therefore the disputed domain name was registered in bad faith.

In the absence of any explanation from the Respondent as to why the disputed domain name was chosen and registered, and because it has been offered for sale to the public at large so soon after it was registered on July 25 this year, this Panel finds therefore, on the balance of probabilities that the Respondent registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the Complainant who is the owner of the RESPIMAT trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain name. Such circumstances constitute bad faith use of the disputed domain name for the purposes of the Policy.

As this Panel has found that the disputed domain name was registered and is being used in bad faith, Complainant has succeeded in the third element of the test in Policy paragraph 4(a)(iii).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **RESPIMAT.XYZ**: Transferred

PANELLISTS

Name	Mr James Jude Bridgeman
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DATE OF PANEL DECISION	2022-08-23
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Publish the Decision
