

Decision for dispute CAC-UDRP-104829

Case number CAC-UDRP-104829

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Domain names buymicardis.xyz

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 Stacey McGrath

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 trade marks consisting of the name MICARDIS, including the international trade mark MICARDIS, registration number 523578, first registered on 18 May 1988 in international class 5; and the international trade mark MICARDIS, registration number 691750, first registered on 13 March 1998 in international class 5. These trade mark registrations predate the registration of the disputed domain name.

Furthermore, the Complainant owns multiple domain names consisting of the word MICARDIS, including the domain name <micardis.com>, registered on 1 April 1999, which is connected to the official Boehringer Ingelheim Micardis product website for international healthcare professionals.

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 in Ingelheim am Rhein. Today, the Complainant is one of the world's leading research-driven pharmaceutical companies with about 140 affiliate companies world-wide and about 52,000 employees. The three business areas of Boehringer Ingelheim are human pharmaceuticals, animal health and bio pharmaceuticals. In 2021, net sales of the Boehringer Ingelheim group amounted to about EUR 20.6 billion. MICARDIS is a medicine produced by the Complainant and prescribed for the treatment of hypertension.

The Respondent registered the disputed domain name <buymicardis.xyz> on 15 August 2022. As at the date of the amended complaint, the disputed domain name resolved to a parking page with commercial links. As at the date of this decision, the disputed domain name resolves to an error page without active content.

PARTIES CONTENTIONS

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 trade mark or service mark in which the Complainant has rights (within the meaning of 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 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

With regard to the first UDRP element, the Panel finds that the disputed domain name <buymicardis.xyz> is confusingly similar to the Complainant's trade mark MICARDIS. Indeed, the disputed domain name incorporates the Complainant's trade mark in its entirety but adds the generic term "buy" as a prefix to the Complainant's trade mark. The Panel follows in this respect the view established by numerous other decisions that a domain name which wholly incorporates a Complainant's registered trade mark may be sufficient to establish confusing similarity for the purposes of the UDRP, (for example, WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG -v- Vasily Terkin <porsche-autoparts.com>). The Panel further considers it to be well established that the addition of a generic term, such as the term "buy", does not allow a domain name to avoid confusing similarity with a trade mark, (for example, WIPO Case No. D2019-2294, Qantas Airways Limited -v- Quality Ads <qantaslink.com>). The addition of the generic term "buy" is not sufficient to alter the overall impression of the designation as being connected with the Complainant's trade mark and does not prevent a likelihood of confusion between the disputed domain name and the Complainant, its trade mark and its associated domain name. To the contrary, the disputed domain name rather adds to the likelihood of confusion because the term "buy" in conjunction with the Complainant's trade mark MICARDIS suggests that the disputed domain name links to an official website for the sale of the Complainant's MICARDIS product and implies that it is linked to the Complainant and its business.

With regard to the second UDRP element, there is no evidence before the Panel to suggest that the Respondent is currently making any use of, or demonstrable preparations to use, the disputed domain name in connection with any bona fide offering of goods or services. Neither is there any indication that the Respondent is making legitimate non-commercial or fair use of the disputed domain name. Furthermore, the disputed domain name was even initially not being used for any active website but resolved to a parking page with commercial links, which has in itself been regarded by other panels as supporting a finding that a respondent did not have a bona fide offering of goods or services, or make legitimate non-commercial or fair use of the disputed domain name, for example, Forum Case No. FA970871, Vance Int'l, Inc -v- Abend (concluding that the operation of a pay-per-click website at a confusingly similar domain name does not represent a bona fide offering of goods or services, or a legitimate non-commercial or fair use, regardless of whether or not the links resolve to competing or unrelated websites, or if the respondent is itself commercially profiting from the click-through fees); and WIPO Case No. D2007-1695, Mayflower Transit LLC -v- Domains by Proxy Inc./Yariv Moshe ("Respondent's use of a domain name confusingly similar to Complainant's trademark for the purpose of offering sponsored links does not of itself qualify as a bona fide use.")). The Panel further finds that the Respondent is not affiliated with or related to

the Complainant in any way and is neither licensed nor otherwise authorised to make any use of the Complainant's trade mark, or to apply for or use the disputed domain name. Finally, the Whois information does not suggest that the Respondent is commonly known by the disputed domain name <buymicardis.xyz>. Absent any response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

With regard to the third UDRP element, the Panel accepts that the Complainant's trade mark MICARDIS is distinctive. The Panel considers that, if the Respondent had carried out a Google search for the name MICARDIS, the search results would have yielded immediate and obvious references to the Complainant and its product. The Panel concludes that it is difficult in those circumstances to believe that the Respondent was unaware of the Complainant's trade mark. It is therefore reasonable to infer that the Respondent either knew, or should have known, that the disputed domain name would be identical with or confusingly similar to the Complainant's trade mark and that she registered the disputed domain name in full knowledge of the Complainant's trade mark. Indeed, it is unlikely that she would have registered the disputed domain name if it was not because of the Complainant's trade mark.

Furthermore, the website related to the disputed domain name initially resolved to a parking page with commercial links. Based on the decisions of other panels in similar cases, the Panel accepts the Complainant's submissions that the Respondent's attempt to attract Internet users for commercial gain to her own website based on the Complainant's trade mark is evidence of bad faith, (for example, WIPO Case No. D2018-0497, StudioCanal -v- Registration Private, Domains by Proxy, LLC/Sudjam Admin, Sudjam LLC ("In that circumstance, whether the commercial gain from misled Internet users is gained by the Respondent or by the Registrar (or by another third party), it remains that the Respondent controls and cannot (absent some special circumstance) disclaim responsibility for, the content appearing on the website to which the disputed domain name resolves [...] so the Panel presumes that the Respondent has allowed the disputed domain name to be used with the intent to attract Internet users for commercial gain, affiliation, or endorsement of the Respondent's website to which the disputed domain name resolves. Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith.")).

The Panel notes that the disputed domain name is presently not linked to an active website and that it is difficult to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate on the grounds that it would constitute passing-off, or an infringement of the Complainant's rights under trade mark law, in circumstances where that disputed domain name corresponds to the Complainant's trade mark used by the latter to promote its goods and services. Finally, numerous other UDRP decisions have taken the view, which the Panel shares, that the passive holding of a domain name with knowledge that the domain name infringes another party's trade mark rights may in itself be regarded as evidence of bad faith registration and use, (for example, WIPO Case No. D2000-0003, Telstra Corporation Limited -v- Nuclear Marshmallows; and WIPO Case No. D2004-0615, Comerica Inc -v- Horoshiy, Inc.).

Absent any response from the Respondent, or any other information indicating the contrary, the Panel therefore also accepts that the Respondent has registered and is using the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **buymicardis.xyz**: Transferred

PANELLISTS

Name	Gregor Kleinknecht LLM MCI Arb
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DATE OF PANEL DECISION 2022-10-14

Publish the Decision
