Decision for dispute CAC-UDRP-102875

Case number	CAC-UDRP-102875
Time of filing	2020-01-23 10:01:49
Domain names	boehringeringelheimppetrebates.com

Case administrator

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

Complainant

Organization	Boehringer Ingelheim Pharma GmbH & Co.KG

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Organization	Fundacion Comercio Electronico

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any pending or decided legal proceedings that relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant submitted evidence that it is the registered owner of the international trademark registration No. 221544 for "Boehringer-Ingelheim" (word), registered since 2 July 1959 for the classes 01, 02, 03, 04, 05, 06, 16, 17, 19, 29, 30 and 32, designated for numerous countries.

FACTUAL BACKGROUND

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

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 has become a global research-driven pharmaceutical enterprise and has today about roughly 50,000 employees. The three business areas of Boehringer are human pharmaceuticals, animal health, and biopharmaceuticals. In 2018, net sales of the Boehringer group amounted to about EUR 17.5 billion.

The Complainant is the registered holder of the domain name <boehringer-ingelheim.com> since 1 September 1995 and it has been using the domain name <boehringeringelheimpetrebates.com> used by the Complainant to offer rebates on pet

health products.

The disputed domain name <boehringeringelheimppetrebates.com> was registered on 17 January 2020 and redirects to a parking page with commercial links.

The Registrar confirmed that the Respondent is the current registrant of the disputed domain name and that the language of the registration agreement is English.

The Respondent has not filed a Response.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Complainant made the following contentions:

The Complainant states that the disputed domain name is confusingly similar to its trademark "BOEHRINGER-INGELHEIM" which is reproduced in its entirety, except for the dash. The addition of the terms “PPET REBATES” is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark "BOEHRINGER-INGELHEIM". It does not change the overall impression of the designation as being connected to the Complainant’s trademark "BOEHRINGER-INGELHEIM". It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and domain names associated.

The Complainant argues that it is well-established that "a domain name that wholly incorporates a Complainant’s registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP" (the Complainant refers to WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin). On the contrary, the addition of the terms “PPET REBATES” worsens the likelihood of confusion, as it directly refers to the Complainant’s website www.boehringeringelheimpetrebates.com.

Moreover, the Complainant contends that the addition of the generic Top-Level Domain suffix “.COM” does not change the overall impression of the designation as being connected to the trademark "BOEHRINGER-INGELHEIM". It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and its domain names associated.

Thus, the Complainant believes that the disputed domain name is confusingly similar to the Complainant’s trademark.

Regarding Respondent's rights or legitimate interests, the Complainant points to the decision in the WIPO case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd., according to which the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. The Complainant asserts that the Respondent is not identified in the Whois database as the disputed domain name. 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.

The Complainant contends that the Respondent is not affiliated with nor authorized by the Complainant in any way. The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. 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 "BOEHRINGER-INGELHEIM", or apply for registration of the disputed domain name by the Complainant.

Furthermore, the disputed domain name redirects to a parking page with commercial links. According to the Complainant, past UDRP panels have found that it is not a bona fide offering of goods or services or legitimate non-commercial or fair use

(e.g. Forum No. FA 970871 and WIPO No. D2007-1695).

Thus, in accordance with the foregoing, the Complainant contends that the Respondent has no right or legitimate interest in respect of the disputed domain name.

Turning to the bad faith argument, the Complainant asserts that the disputed domain name is confusingly similar to its trademark "BOEHRINGER-INGELHEIM" and that it is one of the world's 20 leading pharmaceutical companies, with roughly 50,000 employees worldwide and 17,5 million euros in net sales. The Complainant's trademark "BOEHRINGER-INGELHEIM" is a distinctive and well-known trademark. The Complainant states that past UDRP panels have confirmed the notoriety of the trademark "BOEHRINGER-INGELHEIM" in cases WIPO Case No. D2019-0208, CAC Case No. 102274 and WIPO Case No. D2016-0021.

The Complainant also contends that the Respondent chose to register the disputed domain name to create confusion with the domain name <boehringeringelheimpetrebates.com> used by the Complainant to offer rebates on pet health products.

Moreover, the Respondent has already registered domain names comprising the trademark "BOEHRINGER-INGELHEIM" (CAC Case No. 102765, Boehringer Ingelheim Pharma GmbH & Co.KG v. Fundacion Comercio Electronico <boheringer-ingelheim.com>). Consequently, given the distinctiveness of the Complainant's trademark and its reputation, the Complainant considers it reasonable to infer that the Respondent has registered and used the disputed domain name with full knowledge of the Complainant's trademark.

Furthermore, the Complainant remarks that the disputed domain name redirects to a parking page with commercial links. The Complainant contends the Respondent has attempted to attract Internet users for commercial gain to his own website thanks to the Complainant's trademark for its own commercial gain, which is an evidence of bad faith pursuant to previous UDRP case law (e.g. WIPO Case No. D2018-0497).

Finally, the Complainant points out that the Respondent has been involved in numerous UDRP cases involving third parties' trademarks, which also evidences bad faith (e.g. Forum Case No. 1873874, Enterprise Holdings, Inc. v. Carolina Rodrigues / Fundacion Comercio Electronico; CAC Case No. 102696, AMUNDI ASSET MANAGEMENT v. Fundacion Comercio Electronico; CAC Case No. 102688, Novartis AG v. Fundacion Comercio Electronico).

On these bases, the Complainant concludes that the Respondent has registered and is using 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).

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

This is a mandatory administrative proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") and the CAC Supplemental Rules.

Paragraph 15 of the Rules provides that the Panel shall decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

According to Paragraph 4(a) of the Policy, the Complainant must prove each of the following: (i) the domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; (ii) the Respondent has no rights or legitimate interests in respect of the domain name; (iii) the domain name has been registered and is being used in bad faith.

A. Identical or confusingly similar

The Complainant demonstrated that it owns the asserted international trademark registration for the word mark "Boehringer-Ingelheim" that was registered more than 60 years earlier than the disputed domain name. It is well established that a nationally or regionally registered trademark confers on its owner sufficient rights to satisfy the requirement of having trademark rights for the purposes of standing to file a UDRP case. Therefore, the Panel finds that the Complainant has established such rights.

It is also well established that the generic top-level suffix .com may be disregarded when considering whether a domain name is identical or confusingly similar to a trademark in which the complainant has rights, as it is a necessary technical requirement of a domain name.

The disputed domain name incorporates the Complainant's trademark "Boehringer-Ingelheim" in its entirety, except for the hyphen. The adding of the terms “PPET REBATES” must be considered as insufficient to prevent or diminish confusing similarity. The Panel agrees with the Complainant that such addition does not change the overall impression of the designation as being connected to the Complainant’s trademark "Boehringer-Ingelheim", particularly given the descriptiveness of the added terms "PET REBATES" and link to the animal product offers by the Complainant. Therefore, such addition cannot prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and its associated domain names.

The Panel, therefore, finds that the disputed domain name is confusingly similar to the trademark in which the Complainant has rights.

B. Lack of rights or legitimate interests

The Respondent has not filed a Response and has neither provided any other information that would oppose the Complainant's allegations. Therefore, the Panel holds that the Complainant successfully presented its prima facie case that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

In particular, the Respondent is not in any way connected with the Complainant nor is it authorized to use the Complainant’s trademark for its commercial activities. In addition, the Respondent is not commonly known by the disputed domain name pursuant to Paragraph 4(c)(ii) of the Policy. Furthermore, it was demonstrated by evidence submitted by the Complainant that the disputed domain name has not been used for a bona fide offering of goods or services or a legitimate non-commercial or fair use, particularly because it redirects to a parking page with commercial links (at least the time of making the Complaint).

The Panel, therefore, finds that the Respondent has no rights or legitimate interest in the disputed domain name.

C. Registration and use of the disputed domain name in bad faith

With respect to the bad faith argument, the Complainant states, in summary, that the disputed domain name is confusingly similar to its well-known trademark; that the Respondent had actual knowledge of the Complainant's rights in the trademark because it (a) chose the disputed domain name to create a confusion with the domain name <boehringeringelheimpetrebates.com> which the Complainant uses to offer rebates on pet health products, and (b) had already before registered the domain name <boheringer-ingelheim.com> that clearly includes misspelled trademark of the Complainant; that the disputed domain name is redirected to a parking page with commercial links; and that the Respondent has a track record containing numerous UDRP case where the Respondent's bad faith was established.

The Panel has already found that the disputed domain name is confusingly similar to the Complainant's trademark "Boehringer-Ingelheim". The Panel believes that the Complainant submitted evidence that sufficiently demonstrates the Respondent must have been aware of the existence of the Complainant, its trademark and its <boehringer-ingelheim.com> and <boehringeringelheimpetrebates.com> domain names. The evidence submitted by the Complainant also shows that, at least upon filing the complaint, the disputed domain name was directed to a parking page with commercial links.

It is well established that mere registration of a domain name that is confusingly similar to a trademark by an unaffiliated entity can lead to the presumption of bad faith. Furthermore, typical circumstances demonstrating respondent's bad faith include a situation where the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location (see Paragraph 4(b)(iv) of the Policy). In view of the Panel, it is beyond any doubt that the disputed domain is intentionally composed to include an extra letter "P" so that visitors to the Complainant website at <boehringeringelheimpetrebates.com> who misspell the address are redirected to the commercial links at the disputed domain, ultimately to the commercial gain of the Respondent.

Furthermore, the Panel has taken notice of the other UDRP cases involving the Respondent which are mentioned in the Complaint. Of its own motion, the Panel has also become aware of further recent decisions concerning the Respondent (as well as the same Complainant) - CAC Case No. 102854, CAC Case No. 102871 and CAC Case No. 102872. The Panel can safely conclude that the Respondent is a "repeat offender" and has clearly been engaged in a pattern of conduct of registering domain names containing the marks of the Complainant (and) others.

Taking into account the above-described facts and evidence submitted by the Complainant, the Panel is satisfied that not one but several signs of bad faith in registering and use of the disputed domain name by the Respondent can be found in this case. Therefore, the Panel finds that the disputed domain name has been registered and has been used by the Respondent in bad faith.

In conclusion, the Panel finds that all three elements required by Paragraph 4(a) of the Policy were met and makes the following decision.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOEHRINGERINGELHEIMPPETREBATES.COM**: Transferred

PANELLISTS

Name	**Mgr. Vojtěch Chloupek**

DATE OF PANEL DECISION 2020-03-14