Decision for dispute CAC-UDRP-102889

Case number	**CAC-UDRP-102889**
Time of filing	**2020-01-31 12:09:55**
Domain names	**boehirnger-ingelheim.com**

Case administrator

Name	**Šárka Glasslová (Case admin)**

Complainant

Organization	**Boehringer Ingelheim Pharma GmbH & Co.KG**

Complainant representative

Organization	**Nameshield (Enora Millocheau)**

Respondent

Name	**Mark August**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant owns a large portfolio of trademarks including the wording “BOEHRINGER INGELHEIM” in several countries, such as the international trademark BOEHRINGER-INGELHEIM Reg. No. 221544, registered on July 2, 1959 and duly renewed.

FACTUAL BACKGROUND

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

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. Ever since, the Complainant has become a global research-driven pharmaceutical enterprise and has today about roughly 50,000 employees. The three main business areas of the Complainant are: human pharmaceuticals, animal health and biopharmaceuticals. In 2018, the Complainant achieved net sales of around 17.5 billion Euros.

The Complainant owns a large portfolio of trademarks including the wording “BOEHRINGER INGELHEIM” in several

countries, such as the international trademark BOEHRINGER-INGELHEIM Reg. No. 221544, registered on July 2, 1959 and duly renewed.

The Complainant owns multiple domain names consisting in the wording “BOEHRINGER INGELHEIM,” such as <boehringer-ingelheim.com> registered on September 1, 1995.

The disputed domain name <boehirnger-ingelheim.com> was registered on January 28, 2019.

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 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

Paragraph 15(a) of the Rules for the UDRP ('the Policy') instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

(1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
(2) Respondent has no rights or legitimate interests in respect of the domain name; and
(3) the domain name has been registered and is being used in bad faith.

In view of the Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. See Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc., FA 95095 (Forum July 31, 2000 - holding that the respondent’s failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); see also Talk City, Inc. v. Robertson, D2000-0009 (WIPO Feb. 29, 2000) (“In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.”).

Rights

The Complainant contends that it has rights in the BOEHRINGER-INGELHEIM (e.g. International Reg. No. 221544 registered on July 2, 1959 and duly renewed) through its registration of the mark with the WIPO. Registration of a mark with the WIPO sufficiently establishes the required rights in the mark for purposes of the Policy. As such, the Panel finds that the Complainant has established its rights in the mark 'BOEHRINGER-INGELHEIM.'

The Complainant further contends that the disputed domain name is confusingly similar to the Complainant's trademark BOEHRINGER-INGELHEIM on the grounds that i) the inversion of the letters "I" and "R" is not sufficient to escape the finding that the domain name <boehirnger-ingelheim.com> is confusingly similar to the Complainant's trademark and it does not change the overall impression of the designation as being connected to the trademark BOEHRINGER-INGELHEIM; ii) the disputed domain name constitutes a misspelled word of the Complainant's registered trademark BOEHRINGER-INGELHEIM; and iii) this is thus a clear case of "typosquatting", i.e. the disputed domain name contains an obvious misspelling of the Complainant's trademark.

The Panel agrees with the Complainant, and thus it finds that the disputed domain name is confusingly similar to the Complainant's trademark BOEHRINGER-INGELHEIM.

No rights or legitimate interests

Complainant must first make a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy paragraph 4(a)(ii), then the burden shifts to Respondent to show it does have rights or legitimate interests. See Croatia Airlines d. d. v. Modern Empire Internet Ltd., WIPO Case No. D2003-0455 (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 UDRP). See also Advanced International Marketing Corporation v. AA-1 Corp, FA 780200 (Forum November 2, 2011 - finding that a complainant must offer some evidence to make its prima facie case and satisfy Policy paragraph 4(a)(ii)).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name: the Respondent is not identified in the WHOIS database as the disputed domain name, and thus it is not commonly known by 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; the Respondent did not make any use of disputed domain name since its registration; the Respondent has no demonstrable plan to use the disputed domain name; and the disputed domain name is a typosquatted version of the Complainant's trademark BOEHRINGER-INGELHEIM; and typosquatting is the practice of registering a domain name in an attempt to take advantage of Internet users' typographical errors and can be evidence that a respondent lacks rights and legitimate interests in the disputed domain name.

The Panel notes that the Respondent has been identified as 'Mark August' and no information suggests that the Complainant has authorized the BOEHRINGER-INGELHEIM mark in any way. Therefore, the Panel finds that the Respondent is not commonly known by the disputed domain name under paragraph 4(c)(ii) of the Policy.

The Complainant contends that the Respondent did not make any use of disputed domain name, and it has not demonstrated any activity in respect of the disputed domain name. Inactive holding of a domain name does not demonstrate rights or legitimate interests in the name per paragraph 4(c)(i) or (iii) of the Policy. See George Weston Bakeries Inc. v. McBroom, FA 933276 (Forum April 25, 2007 - finding that the respondent had no rights or legitimate interests in a domain name under either paragraph 4(c)(i) of the Policy or paragraph 4(c)(iii) of the Policy where it failed to make any active use of the domain name). The Panel therefore finds the Respondent does not have rights or legitimate interests in the domain name per paragraph 4 (c)(i) or (iii) of the Policy.

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.

Bad faith

Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:
(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that the complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or
(ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark 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.

The Complainant contends that the Respondent has registered and is using the disputed domain name in bad faith: given the distinctiveness of the Complainant's trademark and its reputation, it is reasonable to infer that the Respondent has registered and used the domain name with full knowledge of the Complainant's trademark; and the website related to the disputed domain name is currently inactive and MX servers are configured, and 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.

While constructive knowledge is insufficient to support a finding of bad faith, actual knowledge can be used to demonstrate a respondent's bad faith registration and use. See Orbitz Worldwide, LLC v. Domain Librarian, FA 1535826 (Forum February 6, 2014 - "The Panel notes that although the UDRP does not recognize 'constructive notice' as sufficient grounds for finding bad faith per paragraph 4(a)(iii) of the Policy, the Panel here finds actual knowledge through the name used for the domain and the use made of it."). The Panel infers, due to the notoriety of the Complainant's mark that the Respondent registered the disputed domain name with actual knowledge of the Complainant's rights in the BOEHRINGER-INGELHEIM mark and finds that it registered the disputed domain name in bad faith per paragraph 4(a)(iii) of the Policy.

The Panel agrees that the passive holding of a domain name does not necessarily circumvent a finding that the domain name is being used in bad faith within the requirements of paragraph 4(a)(iii) of the Policy. See Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003 (finding that in considering whether the passive holding of a domain name, following a bad faith registration of it, satisfies the requirements of paragraph 4(a)(iii), the panel must give close attention to all the circumstances of the respondent's behavior, and a remedy can be obtained under the Policy only if those circumstances show that the respondent's passive holding amounts to acting in bad faith).

The particular circumstances of this case that the Panel has considered are:

i) the Complainant is a German family-owned pharmaceutical group of companies with roots going back to 1885; the Complainant has become a global research-driven pharmaceutical enterprise and has today about roughly 50,000 employees; and in 2018, the Complainant achieved net sales of around 17.5 billion Euros. As such, the Complainant's mark 'BOEHRINGER-INGELHEIM' is considered as being a well-known and reputable trademark; and

ii) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the disputed domain name.

Taking into account all of the above, the Panel concludes that the Respondent's passive holding of the disputed domain name constitutes bad faith under Policy, paragraph 4(a)(iii) and that the Respondent 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. **BOEHIRNGER-INGELHEIM.COM**: Transferred

PANELLISTS

Name	**Mr. Ho-Hyun Nahm, Esq.**

DATE OF PANEL DECISION 2020-03-04

Publish the Decision