

Decision for dispute CAC-UDRP-105039

Case number CAC-UDRP-105039

Time of filing 2022-12-02 11:14:02

Domain names boehringerhealth.com

Case administrator

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

Complainant

Organization Boehringer Ingelheim Pharma GmbH & Co.KG

Complainant representative

Organization NAMESHIELD S.A.S.

Respondent

Name John Mark

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 owner of the following registered trademarks:

- International trademark no. 799761 BOEHRINGER (word), registered since 2 December 2002 in Nice classes 1, 3, 5, 10, 16, 30, 31, 35, 41, 42, 44;
- European Union trademark no. 002932853 BOEHRINGER (word), registered since 13 November 2002 in Nice classes 1, 3, 5, 10, 16, 30, 31, 41, 42, 44.

The Complainant is also owner of the domain name <boehringer.com> registered since 12 January 2000.

The above-mentioned rights of the Complainant are hereinafter referred to as the BOEHRINGER Trademark.

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 (1861-1939) in Ingelheim am Rhein. Ever since, Boehringer has become a global research-driven pharmaceutical enterprise and has today about 140 affiliated companies world-wide with roughly 50,000 employees. The three business areas of Boehringer are: human pharmaceuticals, animal health and biopharmaceuticals. In 2017 alone, net sales of the

Boehringer group of companies amounted to about EUR 18.1 billion.

The disputed domain name <boehringerhealth.com> was registered on 14 November 2022 and redirects to the Complainant's US website (<https://www.boehringer-ingelheim.us/>).

The facts asserted by the Complainant are not contested by the Respondent.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant contends that the disputed domain name is confusingly similar to its trademark, since the BOEHRINGER Trademark is reproduced in its entirety and the addition of the generic term "health" does not prevent the likelihood of confusion between the disputed domain name and the Complainant's trademark.

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

Furthermore, the disputed domain name redirects to the Complainant's website. The Complainant contends that the Respondent has made no demonstrable preparations to use the disputed domain name. Therefore, the Respondent is not using the disputed domain name for a bona fide offering of goods or services.

Finally, the Complainant contends that the registration of disputed domain name confusingly similar to the well-known trademark of the Complainant and, thus, the constructive knowledge on behalf of the Respondent of the Complainant's potential rights, as well as the redirection of the disputed domain name to the Complainant's website, clearly shows the Respondent's bad faith in the registration and use of the disputed domain name.

The Complainant requests the transfer of the disputed domain name.

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).

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

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to succeed in the administrative proceeding:

- (i) the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used by the Respondent in bad faith.

I. THE COMPLAINANT'S RIGHTS AND CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAME TO THE COMPLAINANT'S MARK

The Complainant has established that it has rights in the BOEHRINGER Trademark since 2002.

In assessing identity or confusing similarity the Panel finds that the disputed domain name incorporates the entirety of the Complainant's trademark and differs from such mark by merely adding the generic and descriptive term "health", as well as the TLD ".com". The addition of such generic and descriptive term to the Complainant's mark neither affects the attractive power of such trademark, nor is sufficient to distinguish the disputed domain name from the Complainant's mark. To the contrary, since the additional term is related to the Complainant's business activities, it even enhances the likelihood of confusion on behalf of the Internet users.

In UDRP cases where the relevant trademark is recognizable within the disputed domain name, Panels agree that the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) and letters does not prevent a finding of confusing similarity under the first element (see 1.8 WIPO Overview 3.0). UDRP panels also agree that the top-level domain is usually to be ignored for the purpose of determination of identity or confusing similarity between the disputed domain name and the Complainant's trademark as it is a technical requirement of registration (see 1.11.1 WIPO Overview 3.0).

Hence, this Panel finds that the Complainant has proven the first element of the paragraph 4(a) of the Policy and the disputed domain name is confusingly similar to the Complainant's mark.

II. THE RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS TO THE DISPUTED DOMAIN NAME

It is a consensus view of UDRP panels that the Complainant shall establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name to shift the burden of proof to the Respondent (see 2.1 WIPO Overview 3.0: "[...] where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.")

The disputed domain name was registered with privacy registration service. The Respondent was identified by the registrar with the name John Mark, an individual located in the United States.

The Complainant has no relationship with the Respondent whatsoever. The Respondent has never received any approval of the Complainant, expressed or implied, to use the Complainant's trademark or to register the disputed domain name. There is no evidence that the Respondent has been commonly known by the disputed domain name or has acquired any rights in a trademark or trade name corresponding to the disputed domain name.

The disputed domain name resolves to the Complainant's US website. Such use of the domain name is clearly not a legitimate non-commercial or fair use, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's mark.

While the Complainant has established its prima facie case, the Respondent has not submitted a Response to the Complaint and, thus, has failed to invoke any of the circumstances, which could demonstrate any rights or legitimate interests in the disputed domain name.

Therefore, the Panel is satisfied that the Complainant has met the second requirement of the paragraph 4(a) of the Policy and finds that the Respondent lacks rights or legitimate interests to the disputed domain name.

III. BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME

The Complainant, well-known for its business activities, has sufficiently demonstrated to be owner of the BOEHRINGER Trademark, registered prior to the registration of the disputed domain name.

The Respondent registered the disputed domain name confusingly similar to Complainant's mark, since it wholly incorporates the BOEHRINGER Trademark. The addition of the generic and descriptive term "health" (related to the Complainant's business activities) and the TLD ".com" (technical requirement of the registration) is not sufficient to escape the finding of confusing similarity between the disputed domain name and the Complainant's mark.

Given the good-will and reputation of the Complainant acquired over the years, it is inconceivable that the Respondent could have registered the disputed domain name for a mere chance without actual knowledge of the Complainant and its mark and the intention to exploit such reputation by diverting traffic away from the Complainant's website.

Furthermore, the Respondent used a privacy service when registering the disputed domain name. Although the use of such service is not in and of itself an indication of bad faith, the circumstances and the manner in which such service is used may however impact a panel's assessment of bad faith (see 3.6 WIPO Overview 3.0).

The disputed domain name resolves to the Complainant's US website (where the Respondent is located). Therefore, it is clear the Respondent had knowledge of the Complainant and its prior rights and the willingness to target such mark to attract, for commercial gain, Internet users to his web site or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of his web site or location or of a product or service on his web site or location (paragraph 4(b)(iv) of the Policy).

Taken into account all circumstances of this case, the Panel finds that it is implausible that there is any legitimate purpose in the registration and use of the disputed domain names by the Respondent.

Considered all circumstances of the dispute, the Panel finds that the Complainant has discharged the burden of proof to show that the disputed domain name has been registered and is being used in bad faith (paragraph 4(a)(iii) of the Policy).

Therefore, the disputed domain name is to be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **boehringerhealth.com**: Transferred

PANELLISTS

Name	Ivett Paulovics
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DATE OF PANEL DECISION **2023-01-09**

Publish the Decision
