

Decision for dispute CAC-UDRP-104786

Case number	CAC-UDRP-104786
Time of filing	2022-08-10 09:01:51
Domain names	boehringerengelheim.pics, boehringerengelheim.quest, boehringerengelheim.shop

Case administrator

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

Organization	Boehringer Ingelheim Pharma GmbH & Co.KG
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Complainant representative

Organization	NAMESHIELD S.A.S.
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Respondent

Name	fei na
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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 names <BOEHRINGERINGELHEIM.PICS>, <BOEHRINGERINGELHEIM.QUEST>, and <BOEHRINGERINGELHEIM.SHOP>.

IDENTIFICATION OF RIGHTS

Boehringer Ingelheim Pharma GmbH & Co.KG (the 'Complainant') is the owner of a number of Trade Mark registrations internationally including for BEOHRINGER INGELHEIM and BEOHRINGER-INGELHEIM in various classes.

FACTUAL BACKGROUND

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

The Complainant is a German family-owned pharmaceutical group of companies founded by Albert Boehringer in Ingelheim am Rhein, Germany. Since being founded in 1885, BOEHRINGER INGELHEIM has become global research driven pharmaceutical enterprise with around 52,000 employees and its three main business areas are human pharmaceuticals, animal health and biopharmaceuticals. In 2021, BEOHRINGER INGELHEIM had net sales of 20.6 billion euros.

The Complainant is the owner of a number of trade marks, including registrations for the "Boehringer Ingelheim" and "Boehringer-Ingelheim" word marks.

In addition, the Complainant is also the owner of numerous domain names which feature the "Boehringer Ingelheim" and "Boehringer-Ingelheim" word marks such as <boehringer-ingelheim.com> which was registered by the Complainant in 1995 and

is being used by the Complainant as their corporate website address.

The disputed domain names, <boehringerengelheim.pics>, <boehringerengelheim.quest> and <boehringerengelheim.shop> (the 'Domain Names') were all registered on 7 August 2022. The websites attached to these domain names are all parking pages featuring commercial links.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant contends that the three disputed domain names are identical to its registered trade marks.

Further, the Complainant argues that the addition of the new gTLD suffixes '.PICS', '.QUEST' and '.SHOP' are not sufficient to absolve the finding that the disputed domain names are identical to the Complainant's 'Boehringer-Ingelheim' trade mark and such suffixes do not change the overall impression of the designations as being connected to its trade mark.

The Complainant also argues that the Respondent does not have any rights or legitimate interests in the three disputed domain names. In this respect, the Complainant contends that the Respondent is not known under any of the disputed domain names. In addition, the Complainant contends that the Respondent is not related in any way to the Complainant and the Complainant does not carry out any activity for, nor has any business with, the Respondent. The Complainant states it has not granted the Respondent any licence; nor has it authorised the Respondent to make any use of the Complainant's "Boehringer-Ingelheim" trade mark; nor has the Complainant authorised the registration of any of the 3 disputed domain names.

Finally, the Complainant contends the Respondent does not have any rights or legitimate interest in the 3 disputed domain names because each of the disputed domain names resolves to a parking page featuring commercial links, which the Complainant contends is not a bona fide offering of goods or services or legitimate non-commercial or fair use.

In addition to the above, the Complainant also contends that the disputed domain names have been registered and are being used in bad faith.

The Complainant alleges that the disputed domain names are identical to or confusingly similar to its well-known and distinctive "Boehringer-Ingelheim" trade mark. As a result of this distinctiveness, the Complainant contends that it is reasonable to infer that the Respondent has registered and used the disputed domain names with the full knowledge of the Complainant's trade mark.

In addition, as the disputed domain names resolve to parking pages featuring commercial links. The Complainant contends the Respondent has used the Complainant's trade mark in an attempt to attract internet users for commercial gain to such websites which the Complainant states constitutes evidence of bad faith.

RIGHTS

The Panel is satisfied the Complainant has shown the disputed domain names are identical or confusingly similar to the trade mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Panel is satisfied the Complainant has shown the Respondent to have no rights or legitimate interests in respect of the disputed domain names (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Panel is satisfied the Complainant has shown the disputed domain names have been registered and are 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.

The Complainant, being represented by Name Shield S.A.S., first filed its complaint in relation to the disputed domain names with the Czech Arbitration Court (the 'CAC') on 8 August 2022. However, the Complainant had not been able to sufficiently identify the Respondent. Following a registrar verification, which identified the Respondent as 'Fei Na' said to be located in

Dallas in American Samoa, the Complainant filed an amended complaint on 10 August 2022. The CAC then formally commenced proceedings on 10 August 2022 and the Respondent was notified of the complaint accordingly. The Respondent failed to submit a response within the time frame required in the complaint or at all, and a 'Notification of the Respondent's Default' was issued by the CAC on 31 August 2022. Having received a Statement of Acceptance and Declaration of Impartiality, the CAC appointed Steve Palmer of Palmer Biggs IP Solicitors in the UK as the Panel in these UDRP proceedings.

PRINCIPAL REASONS FOR THE DECISION

The 3 disputed domain names are <boehringerengelheim.pics>, <boehringerengelheim.quest> and <boehringerengelheim.shop>. From a side by side comparison between these domain names and the textual components of the Complainant's trade mark registrations for "Boehringer Ingelheim" and "Boehringer-Ingelheim" the Complainant's trade mark appears to have been reproduced in its entirety in each of the disputed domain names save for a space or a hyphen, which may be disregarded. The '.pics', '.quest' and '.shop' suffixes may also be disregarded when it comes to considering whether a domain name is identical or confusingly similar to a trade mark in which a complainant has rights. Given the high level of distinctiveness and strong reputation of the Complainant's 'Boehringer Ingelheim' trade mark, the Panel concludes that the disputed domain names are identical and/or confusingly similar to the trade mark(s) for which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy. The Complainant succeeds on the first element of the policy.

RIGHTS OR LEGITIMATE INTERESTS

The Respondent failed to file an administratively compliant (or any) response to the Complainant's complaint. In the circumstances, the Panel finds from the facts put forward that there is no evidence of any circumstances of the type specified in paragraph 4(c) of the Policy, or of any other circumstances giving rise to a right to or legitimate interest in any of the disputed domain names. The Respondent does not appear to have any trade marks associated with the 'Boehringer Ingelheim' or 'Boehringer-Ingelheim' trade marks or any variation thereof. Further, there is no evidence that the Respondent is commonly known by the name 'Boehringer Ingelheim' or any variation thereof, and the Respondent does not have authorisation from the Complainant to use the 'Boehringer-Ingelheim' or 'Boehringer Ingelheim' trade marks. There is no evidence to show the Respondent has used the disputed domain names for any bona fide offering of goods or services of its own. At the time of the Complaint being filed, the websites attached to the disputed domain names resolved to a parking page with commercial links. This is not a bona fide offering of goods and services under 4(c)(i) of the Policy and it is not a legitimate non-commercial or fair use under 4(c)(iii) of the Policy particularly where such links compete with or capitalise on the reputation and goodwill of the Complainant's trade marks or may otherwise mislead Internet users. On the balance of probabilities, and in the absence of any evidence to the contrary (or any administratively compliant response at all) being put forward by the Respondent, the Panel finds that the Respondent does not have any rights or legitimate interests in the disputed domain names within the meaning of paragraph 4(a)(ii) of the Policy.

REGISTERED AND USED IN BAD FAITH

The third element of paragraph 4(a) of the Policy requires the Complainant to establish that the disputed domain names have been registered, and are being used in bad faith by the Respondent. In this respect, Paragraph 4(b) provides a non-exhaustive criteria which shall be evidence of the registration and use of a domain name in bad faith. This includes the use of a domain name to intentionally attract, for commercial gain, internet users to a website, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation or endorsement of its website or location or of product or service on your website or location (paragraph 4(B)(iv) of the Policy). The Panel believes it is likely that this was at least one of the reasons behind the Respondent's registration and use of the disputed domain names. The most likely source of traffic that the disputed domain names would generate will be from Internet users who mistakenly type the disputed domain names into their Internet browsers instead of the Complainant's domain name. It is also likely that the use of the websites attached to the disputed domain names, to provide sponsored links to third party websites including competitors of the Complainant, will be for commercial gain (click through income). The Panel considers that the likelihood of confusion with the Complainant's mark(s) is further enhanced by the nature of the commercial links considering they appear to focus on the pharmaceutical / medical industry, within which the Complainant is well known.

On the balance of probabilities, and in the absence of any evidence to the contrary (or any administratively compliant response at all) being presented by the Respondent, the Panel believes from the facts of this case that the Respondent had knowledge of the Complainant’s trade marks ‘Boehringer Ingelheim’ and/or ‘Boehringer-Ingelheim’ and they had this knowledge prior to their registration and subsequent use of the disputed domain names.

In light of the above, the Panel is satisfied that the requirements of the third element of paragraph 4(a) of the policy has been met and the disputed domain names were registered and are being used in bad faith by the Respondent.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **BOEHRINGERINGELHEIM.PICS**: Transferred
- 2. **BOEHRINGERINGELHEIM.QUEST**: Transferred
- 3. **BOEHRINGERINGELHEIM.SHOP**: Transferred

PANELLISTS

Name	Steve Palmer
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DATE OF PANEL DECISION	2022-09-15
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Publish the Decision