

Decision for dispute CAC-UDRP-104133

Case number CAC-UDRP-104133

Time of filing 2021-11-05 09:29:38

Domain names metacam.live

Case administrator

Name Iveta Špiclová (Case admin)

Complainant

Organization BOEHRINGER INGELHEIM VETMEDICA GmbH

Complainant representative

Organization NAMESHIELD S.A.S.

Respondent

Organization Acce Group LLC

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 the owner of several trademarks consisting of the term "METACAM" in particular the international trademark METACAM® n° 547717 registered since January 8, 1990 in class 5. Further, the Complainant owns domain names consisting of the term "METACAM", such as <metacam.com>, created on June 24, 2003.

FACTUAL BACKGROUND

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

The Complainant is part of a family-owned pharmaceutical group of companies with roots going back to 1885, when it was founded by Albert Boehringer. The Complainant group has become a global research-driven pharmaceutical enterprise of around 52,000 employees. The three business areas of Complainant's group are human pharmaceuticals, animal health and biopharmaceuticals. In 2020, net sales of the Complainant's group amounted to about EUR 19.6 billion.

The Complainant contends that its trademark "METACAM" is a medicine used for cats and dogs to reduce post-operative pain and inflammation following surgery, which can also be used for lactating cows and calves.

The Complainant owns several trademarks and domain names, characterised by the presence of the distinctive term "METACAM".

According to Complainant's non-contested allegations, the trademark "METACAM" was registered in the Trade Mark Clearing House (TMCH), for which the last renewal was made on April 16, 2014.

According to Complainant's further non-contested allegations, the term METACAM is only known in relation with the Complainant and its METACAM product and has no dictionary meaning in any language.

On October 28, 2021, the Respondent Acce Group LLC, an organization located in the United States, registered the disputed domain name <METACAM.LIVE>.

The disputed domain name resolves to a registrar parking page.

According to the information on the case file, 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 facts asserted by the Complainant are not contested by the Respondent.

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

THREE ELEMENTS COMPLAINANT MUST ESTABLISH UNDER THE POLICY

According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that the disputed domain name should be transferred or cancelled:

- (i) the disputed domain name is identical or confusingly similar to a trademark 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 in bad faith.

The Panel has examined the evidence available to it and has come to the following conclusion concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

(A) THE COMPLAINANT'S RIGHTS AND CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAME TO THE COMPLAINANT'S RIGHTS

Sufficient evidence has been submitted by the Complainant of its trademark rights in the term METACAM (or its transliteration) for non-steroidal anti-inflammatory veterinary products. Further, the Complainant is the owner of domain names that incorporate its trademark including <METACAM.COM>. All of the above were created and registered prior to October 28, 2021, the creation date of 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. As such, the Panel finds that the Complainant possesses rights in its METACAM trademark.

UDRP panels agree that the TLD may usually be ignored for the purpose of determination of identity or confusing similarity between a domain name and the Complainant's trademark as it is technical requirement of registration (see paragraph 1.11.1 WIPO Overview 3.0).

Therefore, the Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy and the disputed domain name is identical or confusingly similar to Complainant's mark.

(B) RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAME

The second element of the Policy requires that the Complainant establish that the Respondent has no rights or legitimate interests in the disputed domain name. The generally adopted approach by UDRP panels, when considering the second element, is that if a complainant makes out a prima facie case, the burden of proof shifts to the respondent to rebut it; see, for example, CAC Case No. 102333, Amedei S.r.l. v sun xin. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (see e.g. WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

However, the burden of proof still remains with the Complainant to make out its prima facie case on a balance of probabilities; see, for example, CAC Case No. 102263, Intesa Sanpaolo S.p.A. v Ida Ekkert. Moreover, the wording of paragraph 4(a)(ii) of the Policy requires a complainant to establish that the respondent has no rights or legitimate interests in the domain name in issue. Simply establishing that the complainant also has rights in the domain name in issue is insufficient.

In the present case, the Complainant asserts that the Respondent is not commonly known by the disputed domain name, is not in any way related to the Complainant, nor has the Respondent been granted an authorization or license to use the disputed domain name by the Complainant. This has not been contested by the Respondent. Instead, the Respondent has not responded in any form and thus has failed to provide any information and evidence whatsoever that could have shown that it has relevant rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a) (ii) of the Policy).

Therefore, the Panel concludes that neither the Respondent nor the evidence establishes that the Respondent has any right or legitimate interest to the disputed domain name. The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

(C) BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME

The third element requires Complainant to show that the disputed domain name has been registered and used in bad faith under paragraph 4(a)(iii) of the Policy. *Hallmark Licensing, LLC v. EWebMall, Inc.*, Case No. D2015-2202 (WIPO, February 12, 2016) (“The standard of proof under the Policy is often expressed as the “balance of the probabilities” or “preponderance of the evidence” standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true.”).

For this purpose, the Complainant has successfully put forward prima facie evidence that the Respondent has not made use, or demonstrable preparations to use, of either the disputed domain name in connection with a bona fide offering of goods or services, or of making a legitimate non-commercial or fair use of the disputed domain name. Complainant submits the Respondent is not commonly known under the disputed domain name and that Respondent has never been authorized or licensed by Complainant to use the Complainant’s trademark(s) or register the disputed domain name. This prima facie evidence has not been challenged by the Respondent.

At the time the disputed domain name was registered, it is unlikely that the Respondent did not have knowledge of the Complainant’s rights on the trademarks, since the trademark “METACAM” was registered in the Trade Mark Clearing House (TMCH), for which the last renewal was made before the disputed domain name was created. Additionally, Complainant adduced evidence to show that, if the Respondent had carried out a Google search for the term METACAM, the search results would have yielded immediate and obvious references to the Complainant. In light of these factors, it is therefore reasonable to infer that the Respondent either knew, or should have known, that the disputed domain name would be identical, or confusingly similar to, the Complainant’s trademarks and that they registered the disputed domain name with knowledge of the Complainant’s trademarks.

In the present case, the disputed domain name redirects to a registrar parking page. It is well established that the non-use of a domain name does not prevent a finding of bad faith under the doctrine of passive holding. Whether there is passive holding cannot be answered in abstract, but rather the Panel must consider the totality of the circumstances applicable to a specific case (*Telstra Corporation Limited v. Nuclear Marshmallows* WIPO Case No. D2000-0003). In this present case the factors which lead the Panel to conclude that Respondent’s passive holding amounts to bad faith are: (i) the Complainant’s trademark has a strong reputation and is widely known, as evidenced by its significant presence on the internet (as shown through the Google search results) and substantial use in the United States and in other countries around the world, (ii) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the domain name, (v) taking into account the above, it is unlikely any actual or contemplated active use of the domain name by the Respondent would not be illegitimate, such as by being a passing off, or an infringement of the Complainant’s rights under trademark law.

Therefore, in light of the above analysis, the Panel concludes that the Complainant made out its case that the disputed domain name was registered and is being used in bad faith, and thus has satisfied the requirement under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. METACAM.LIVE: Transferred

PANELLISTS

Name	Claire Kowarsky, LL.M
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DATE OF PANEL DECISION 2021-12-03

