

Decision for dispute CAC-UDRP-105663

Case number	CAC-UDRP-105663
Time of filing	2023-07-26 09:44:55
Domain names	boehringer-ingelheimpharma.com

Case administrator

Name	Olga Dvořáková (Case admin)
------	-----------------------------

Complainant

Organization	BOEHRINGER INGELHEIM PHARMA GMBH & CO.KG
--------------	------------------------------------------

Complainant representative

Organization	NAMESHIELD S.A.S.
--------------	-------------------

Respondent

Organization	Suvarnallc
--------------	------------

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

Boehringer Ingelheim Pharma GmbH & Co.KG is the owner, among others, of the following trademark registrations related to BOEHRINGER INGELHEIM which enjoy protection in numerous countries:

- Word mark "BOEHRINGER-INGELHEIM", International Registration (WIPO), Registration No. 221544, registered on July 2, 1959 and duly renewed;
- Word mark "BOEHRINGER INGELHEIM", International Registration (WIPO), Registration No. 568844, registered on March 22, 1991 and duly renewed.

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 roughly 53,000 employees. The three main business areas of BOEHRINGER INGELHEIM are: human pharmaceuticals, animal health and biopharmaceuticals. In 2022, BOEHRINGER INGELHEIM achieved net sales of around 24.1 billion euros. The Complainant owns a large portfolio of trademarks including the wording BOEHRINGER

INGELHEIM in several countries, as well as many domain names consisting in or including the wording BOEHRINGER INGELHEIM. The disputed domain name <boehringer-ingelheimpharma.com> was registered on July 19, 2023 and it is direct to a parking page; besides, MX servers are configured.

The Complainant states that the disputed domain name <boehringer-ingelheimpharma.com> is confusingly similar to its trademark "BOEHRINGER INGELHEIM". In particular, the Complainant contends that the mere addition of the word "pharma" is not sufficient to escape the finding that the domain name is confusingly similar to the Complainant's trademarks since said word directly refers to the Complainant's business activity.

The Complainant also contends that the Respondent is not known as the disputed domain name and that the same Respondent has no rights or legitimate interests in respect of the domain name <boehringer-ingelheimpharma.com>. In addition, the Complainant informs that (i) the Respondent is not related in any way with BOEHRINGER INGELHEIM and (ii) 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.

In the Complainant's view, it appears obvious that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark "BOEHRINGER INGELHEIM". According to the Complainant, this practical was intentionally designed to be confusingly similar with the Complainant's trademark.

Finally, the Complainant notes that the disputed domain name resolves to a parking page with commercial links and that, in consideration of the above, it is clear that Respondent has attempt to attract Internet users for commercial gain to his own website thanks to the Complainant's trademark "BOEHRINGER INGELHEIM" for its own commercial gain. The fact that MX servers are configured it is also relevant in the Complainant's view since the disputed domain name, despite not actively used, is set up to send and receive e-mail.

PARTIES CONTENTIONS

Complainant's contentions are summarised above.

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 4(a) of the Policy provides that to obtain the transfer of the disputed domain name, the Complainant must prove that each of the following elements is present:

- (i) the disputed 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 disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

1) The Panel finds that the disputed domain name <boehringer-ingelheimpharma.com> is confusingly similar to the Complainant's trademark "BOEHRINGER INGELHEIM". The disputed domain name clearly incorporates the "BOEHRINGER INGELHEIM" trademark being the adding of the hyphen totally irrelevant for the purpose of the present comparison. Furthermore, the addition of the descriptive word "pharma" in the disputed domain name even increases the likelihood of confusion with the Complainant's business activity since it clearly refers to the Complainant's business activity.

In previous cases almost identical to the one at hand the Panel has declared the confusing similarity between the "BOEHRINGER INGELHEIM" trademark and the domain name (see, among others, Boehringer Ingelheim Pharma GmbH & Co.KG v. Whois Privacy Corp., CAC Case No. 103620 <boehringer-ingelheimpetrebates.com>; Boehringer Ingelheim Pharma GmbH & Co.KG v. Jo Ann Henderson, CAC Case No. 101599 <boehringer-ingelheim.de.com>; Boehringer Ingelheim Pharma GmbH & Co.KG v. boehringer ingelheim, CAC Case No. 101446 <boehringer-ingelheim.ind.com>). The Top-Level Domain ("gTLD") ".com" in the disputed domain name may also be disregarded since the use of a gTLD is technically required to operate the disputed domain name and it does not serve to identify the source of the goods or services provided by the registrant of the disputed domain name (see for instance Statoil ASA v. Martins Ogemdi, WIPO Case No. D2015-0001). The Complainant therefore succeeds on the first element of the Policy.

2) The Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain name as it is not commonly known under the disputed domain name and was never authorized to use the "BOEHRINGER INGELHEIM" trademark by the Complainant. The Respondent, in the absence of any Response, has not shown any facts or element to justify prior rights or legitimate interests in the disputed domain name. The Complainant therefore succeeds on the second element of the Policy.

3) Paragraph 4(b) of the UDRP Policy sets out the following examples of circumstances that will be considered by an Administrative Panel to be evidence of the bad faith registration and use of a domain name:

- (i) circumstances indicating that the domain name was registered or acquired 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 complainant, for valuable consideration in excess of the domain name registrant's out-of-pocket costs directly related to the domain name; or
- (ii) the domain name was registered in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the domain name registrant has engaged in a pattern of such conduct; or
- (iii) the domain name was registered primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the domain name registrant intentionally attempted to attract for financial gain, Internet users to the registrant's website 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 the registrant's website or location or of a product or service on the registrant's website or location.

The above examples are not exclusive and other circumstances may exist that demonstrate the registration and use of a domain name in bad faith.

As to the registration of the disputed domain name in bad faith, the reputation of the Complainant's trademark is such that, in the Panel's view, the Respondent could not ignore the trademark "BOEHRINGER INGELHEIM" at the time of the registration of <boehringer-ingelheimpharma.com>. This consideration is reinforced by the fact that the Respondent has chosen to register a domain name which reproduces also the word "pharma" which clearly refers to the Complainant's business activity and is also part of the Complainant's company name. It is therefore obvious that the Respondent selected the disputed domain name to create confusion with the Complainant affairs. Therefore, it is the Panel's view that the Complainant was in bad faith when it decided to register the domain name in dispute since said registration was done having perfectly in mind the Complainant's trademark and the Complainant's business activity.

Furthermore, there is no evidence that the disputed domain name has been actively used by the Respondent for a website containing a concrete offer of goods and/or services. Instead, it only directs to a parking page containing various commercial links. This circumstance reveals the Respondent's primary motive in relation to the registration and use of the disputed domain name which is, in the Panel's view, to profit from the goodwill associated with the Complainant's "BOEHRINGER INGELHEIM". According to previous decisions, by diverting Internet users to the website associated with the disputed domain name, the Respondent is benefiting from pay-per-click revenue and profits, which is evidence of use of the disputed domain name in bad faith (see, Accor SA v. Domain Administrator, PrivacyGuardian.org / Zhichao Yang, WIPO Case No. D2017-1322 and Accor SA v. Jan Everno, The Management Group II, WIPO Case No. D2017-2212). Finally, the Panel has verified that the Respondent has set up "MX-records" for the disputed domain name. This entails that the Respondent can send e-mails through the e-mail address "@boehringer-ingelheimpharma.com". The Respondent can therefore use the disputed domain name to send fraudulent e-mails such as messages containing spam and/or phishing attempts that Internet users could well assume were sent by the Complainant. (See Confédération Nationale du Crédit Mutuel, Crédit Industriel et Commercial v. Khodor Dimassi, WIPO Case No. D2016-1980; Paris Saint-Germain Football v. MHP Private, WIPO Case No. D2019-0036). Albeit that there are no concrete examples of such use, it seems inconceivable that the Respondent will be able to make any good faith use of the disputed domain name as part of an e-mail address. The Panel finds that the mere conduct of making preparation for sending e-mails which are very likely to confuse the recipient of such e-mails as to their origin, is without justification and is inconsistent with the Complainant's exclusive rights in the "BOEHRINGER INGELHEIM" trademark (see Accenture Global Services Limited v. Registration Private, Domains by Proxy, LLC / Richa Sharma, Name Redacted, WIPO Case No. D2019-2453). In consideration of the above, the Panel deems that the domain name in dispute was registered and used in bad faith and accordingly that the Complainant has satisfied also the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **boehringer-ingelheimpharma.com**: Transferred
-

PANELLISTS

Name	Guido Maffei
------	---------------------

DATE OF PANEL DECISION **2023-08-17**

Publish the Decision
