

Decision for dispute CAC-UDRP-105768

Case number	CAC-UDRP-105768
Time of filing	2023-09-06 10:49:50
Domain names	boehringer-ingelheim.com

Case administrator

Name	Olga Dvořáková (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	Randy Jones
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OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that are pending or decided and that relate to the Disputed Domain Name.

IDENTIFICATION OF RIGHTS

Complainant states, and provides relevant evidence, that it “owns a large portfolio of trademarks including the wording ‘BOEHRINGER INGELHEIM’ in several countries,” including Int’l Reg. No. 221,544 for BOEHRINGER-INGELHEIM (registered July 2, 1959) and Int’l Reg. No. 568,844 for BOEHRINGER-INGELHEIM (registered March 22, 1991) (the “BOEHRINGER-INGELHEIM Trademark”).

FACTUAL BACKGROUND

Complainant states that it is “a German family-owned pharmaceutical group of companies with roots going back to 1885” and that it “has become a global research-driven pharmaceutical enterprise and has today over 53,000 employees.”

The Disputed Domain Name was created on August 31, 2023, and is not being used in connection with an active website, but “MX servers are configured.”

PARTIES CONTENTIONS

Complainant contends, in relevant part, as follows:

Paragraph 4(a)(i): Complainant states that the Disputed Domain Name is confusingly similar to the BOEHRINGER-INGELHEIM Trademark because “the reversal of the letters ‘l’ and ‘n’, is characteristic of a typosquatting practice intended to create confusing similarity between the Complainant’s trademark and the disputed domain name.”

Paragraph 4(a)(ii): Complainant states that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because, inter alia, “the Respondent is not identified in the Whois database as the disputed domain name”; Respondent “is not related in any way with the Complainant”; “[n]either 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”; “the disputed domain name is a typosquatted version of the trademark BOEHRINGER-INGELHEIM®”; and “the disputed domain name resolves to an inactive page”, which means that “Respondent did not make any use of disputed domain name since its registration, and it confirms that Respondent has no demonstrable plan to use the disputed domain name.”

Paragraph 4(a)(iii): Complainant states that the Disputed Domain Name was registered and is being used in bad faith because, inter alia, “the misspelling of the trademark BOEHRINGER-INGELHEIM®... was intentionally designed to be confusingly similar with the Complainant’s trademark”; “the incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use”; and configuration of MX records “suggests that it may be actively used for email purposes.”

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 UDRP).

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 UDRP).

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 UDRP).

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

Identical or Confusingly Similar: Paragraph 4(a)(i):

Based upon the trademark registrations cited by Complainant, it is apparent that Complainant has rights in and to the BOEHRINGER-INGELHEIM Trademark.

As to whether the Disputed Domain Name is identical or confusingly similar to the BOEHRINGER-INGELHEIM Trademark, the relevant comparison to be made is with the second-level portion of the Disputed Domain Name only (i.e., “boehniger-ingelheim”) because “[t]he applicable Top Level Domain (‘TLD’) in a domain name (e.g., ‘.com’, ‘.club’, ‘.nyc’) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.” WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”), section 1.11.1.

Here, the Disputed Domain Name contains the BOEHRINGER-INGELHEIM Trademark (and only the BOEHRINGER-INGELHEIM Trademark) in its entirety, simply transposing the letters “i” and “n”. As set forth in section of WIPO Overview 3.0: “A domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element.... Examples of such typos include... the inversion of letters and numbers.”

Accordingly, the Panel finds that Complainant has proven the first element of the UDRP.

Rights or Legitimate Interests: Paragraph 4(a)(ii)

Complainant states that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because, inter alia, “the Respondent is not identified in the Whois database as the disputed domain name”; Respondent “is not related in any way with the Complainant”; “[n]either 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”; “the disputed domain name is a typosquatted version of the trademark BOEHRINGER-INGELHEIM®”; and “the disputed domain name resolves to an inactive page”, which means that “Respondent did not make any use of disputed domain name since its registration, and it confirms that Respondent has no demonstrable plan to use the disputed domain name.”

WIPO Overview 3.0, section 2.1, states: “While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of ‘proving a negative’, requiring information that is often primarily within the knowledge or control of the respondent. As such, 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 Panel finds that Complainant has established its prima facie case and without any evidence from Respondent to the contrary, the Panel is satisfied that Complainant has satisfied the second element of the UDRP.

Registered and Used in Bad Faith: Paragraph 4(a)(iii)

Whether a domain name is registered and used in bad faith for purposes of the UDRP may be determined by evaluating four (non-exhaustive) factors set forth in paragraph 4(b) of the UDRP: (i) circumstances indicating that the registrant has registered or the registrant has 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 complainant, for valuable consideration in excess of the registrant’s documented out-of-pocket costs directly related to the domain name; or (ii) the registrant 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 registrant has engaged in a pattern of such conduct; or (iii) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant’s 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 registrant’s website or location or of a product or service on the registrant’s website or location.

WIPO Overview 3.0, section 3.3, states:

“From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or ‘coming soon’ page) would not prevent a finding of bad faith under the doctrine of passive holding.

“While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.”

Here, the BOEHRINGER-INGELHEIM Trademark appears to be distinctive and appears to have a high degree of reputation given that it is protected by a large portfolio of registrations, the oldest of which was registered at least more than 64 years ago and that it is used by a company with more than 53,000 employees. Further, Respondent did not submit a response or provide any evidence of actual or contemplated good-faith use.

Accordingly, the Panel finds that Complainant has proven the third element of the UDRP.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. boehrniger-ingelheim.com: Transferred

PANELLISTS

Name	Douglas Isenberg
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DATE OF PANEL DECISION 2023-10-14

Publish the Decision
