

Decision for dispute CAC-UDRP-105933

Case number	CAC-UDRP-105933
Time of filing	2023-11-06 08:47:52
Domain names	boehringer-ingolheim.com

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	Zarnab Saleem
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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 name.

IDENTIFICATION OF RIGHTS

Complainant alleges to have a large portfolio of trademarks including the wording "BOEHRINGER INGELHEIM" in several countries. Complainant submits evidence of one trademark registrations being the international trademark registration n°568844 BOEHRINGER-INGELHEIM registered since March 22, 1991. This trademark is registered in many countries.

FACTUAL BACKGROUND

Complainant is one of the top 20 companies in the pharmaceutical industry. It is a family-owned business since 1885, when it was founded by Albert Boehringer (1861-1939) in Ingelheim am Rhein. Ever since, BOEHRINGER INGELHEIM has become a global research-driven pharmaceutical enterprise and has today over 53,000 employees. BOEHRINGER INGELHEIM operates in three business being Human Pharma, Animal Health and Biopharmaceutical Contract Manufacturing. In 2022, BOEHRINGER INGELHEIM achieved net sales of 24.1 billion euros.

Complainant owns multiple domain names consisting of the wording "BOEHRINGER INGELHEIM", such as <boehringer-ingelheim.com> registered since September 1, 1995, for which evidence is submitted.

The disputed domain name <boehringer-ingolheim.com> was registered on October 27, 2023 and resolves to an inactive page headed with the code 500 followed by the text 'Unable to connect'.

The owner of the disputed domain name was revealed only after the Verification Request of CAC and is Zarnab Saleem.

Complainant seeks transfer of the disputed domain name.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

RIGHTS

Complainant has submitted a trademark registration for BOEHRINGER-INGELHEIM.

The disputed domain name is of a later registration date.

The obvious misspelling of the Complainant's trademark BOEHRINGER-INGELHEIM, i.e. the substitution of the letter "E" by the letter "O", is characteristic of a typosquatting practice intended to create confusing similarity between the Complainant's trademark and the disputed domain name.

The slight spelling variation constitutes that the disputed domain name is confusingly similar to the Complainant's trademark.

It is needless to say, as stated in many UDRP cases, that the gTLD ".COM" is not relevant in the appreciation of confusing similarity.

Thus, the Complainant has, to the satisfaction of the Panel, shown the disputed domain name is confusingly similar to the trademark BOEHRINGER-INGELHEIM in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

Moreover, the disputed domain name was registered later than the trademark rights were established.

NO RIGHTS OR LEGITIMATE INTERESTS

The Panel notes that Complainant bears the 'general burden of proof' under paragraph 4(a)(ii) of the Policy, which burden shifts to the Respondent once Complainant makes a prima facie showing that the Respondent lacks rights or legitimate interests. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the Policy. As such, this is determined in many UDRP cases.

In this particular case the Panel finds that Complainant has indeed made a prima facie showing that Respondent does not have rights or legitimate interests in the domain name within the meaning of Paragraph 4(a) of the Policy.

This finding is based on the following, non-disputed, circumstances brought forward by Complainant.

Complainant demonstrates that Respondent is not identified in the Whois database. The Whois Record refers to an e-mail address of the Registrar, being abuse@namecheap.com. Only after the Verification check by CAC the identity of the Respondent was revealed, namely the person Zarnab Saleem.

The Panel finds that it is clear that the Respondent is not commonly known by the disputed domain name and consequently the potential situation that demonstrates rights or legitimate interest as determined in article 4 (c)(ii), which article provides an example for establishing a rights or legitimate interest, is not met.

Further Complainant states that Respondent is not related in any way to the Complainant: 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 BOEHRINGER-INGELHEIM, or apply for registration of the disputed domain name by the Complainant.

As Respondent did not react the Panel concludes that these statements of Complainant are true.

Moreover, Complainant claims that the disputed domain name is a typosquatted version of the trademark BOEHRINGER-INGELHEIM. Typosquatting is the practice of registering a domain name in an attempt to take advantage of Internet users' typographical errors and can be evidence that a respondent lacks rights and legitimate interests in the domain name.

The Panel sees these circumstances as not meeting one of the examples article 4 (C) of the Policy, namely article 4 (C) (iii) in which it is stated that a domain name holder is making a legitimate noncommercial or fair use of the domain name when there is no intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. Typosquatting is per definition a way to misleadingly divert the consumer.

Lastly, Complainant alleges that the disputed domain name resolves to an inactive page and provides evidence thereof.

The Panel finds that this indeed is an indication of non-legitimate interest and contrary to the circumstance that provides legitimate interest and as defined in article 4 (C)(i): before any notice of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services.

Given these circumstances and the fact that Respondent failed to give a reaction 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

Complainant alleges that its trademark BOEHRINGER INGELHEIM has a reputation and that it therefore it is reasonable to infer that the Respondent has registered and used the domain name with full knowledge of the Complainant's trademark.

Complainant did not submit any specific evidence of the reputation. Nevertheless, the Panel is convinced that BOEHRINGER INGELHEIM has a reputation as this has been demonstrated by the following facts:

In the Company Profile Complainant's tradename, which is identical to the submitted trademark registration, has been in use since 1885,

In the same Company Profile it is stated that the company has over 52,000 employees, 24.1 billion euros net sales in 2022 and belongs to the top 20 companies in the pharmaceutical industry.

All those data allow the Panel to conclude that the knowledge about Complainant is wide spread,

Further, in earlier UDRP case dating back to the year 2016 the Panel decided that the BOEHRINGER INGELHEIM mark is distinctive and well known (WIPO Case No. D2016- 0021, Boehringer Ingelheim Pharma GmbH & Co.KG v. Kate Middleton)

Moreover, the Panel can confirm herself that BOEHRINGER INGELHEIM is commonly well-known.

It follows from this reputation that the Panel concludes that indeed Respondent has registered the disputed domain name that is different in only one letter (the 'O' instead of the 'E') from Complainant's trademark with full knowledge of the Complainant's trademark and by doing so aimed to create confusion.

Moreover, this type of registration can be defined as typosquatting which is another reason to conclude that the disputed domain name is registered in bad faith according to article 4 (a) (iii) of the Policy.

However, in order to satisfy the requirements of article 4 (a) (iii) of the Policy it should be established that the domain name is also being used in bad faith.

Use in bad faith is acknowledged by passive holding of a domain name. That is determined in past UDRP cases. However, this passive holding should be explained by providing specific circumstances that prove it in order to constitute use in bad faith. In WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows it is very well illustrated what circumstances would constitute use in bad faith. Moreover, in the same case it is determined that being used in bad faith is not limited to positive action, for inactivity by the Respondent can amount to the domain name being used in bad faith.

Circumstances of establishing use in bad faith could be:

- (i) the Complainant's trademark has a strong reputation and is widely known;
- (ii) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the domain name;
- (iii) the Respondent has taken active steps to conceal its true identity, by operating under a name that is not a registered business name;
- (iv) the Respondent has actively provided, and failed to correct, false contact details, in breach of its registration agreement; and
- (v) taking into account all of the above, it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law.

All the above circumstances are at stake in the present case as already illustrated: Complainant has a trademark with reputation; Respondent has not reacted in this case; Respondent had a hidden identity and the disputed domain name did not resolve in any active webpage.

In light of these particular circumstances, the Panel concludes that the Respondent's passive holding of the domain name in this particular case satisfies the requirement of paragraph 4(a)(iii) that the domain name "is also being used in bad faith" by Respondent.

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

As the requirements of the Policy are met as explained above the Complaint is accepted.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **boehringer-ingolheim.com**: Transferred
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PANELLISTS

Name	Marieke Westgeest
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DATE OF PANEL DECISION **2023-12-15**

Publish the Decision
