Decision for dispute CAC-UDRP-106607

Case number	CAC-UDRP-106607
Time of filing	2024-06-13 13:29:29
Domain names	nexgardbravecto.com

Case administrator

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

Complainant

Organization	BOEHRINGER INGELHEIM ANIMAL HEALTH FRANCE

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Organization	Ronnachai Nakapun

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 owns the following rights:
International trademark NEXGARD® n° 1166496 registered since May 29, 2013;
European trademark NEXGARD® n° 011855061 registered since October 9, 2013;
International trademark NEXGARD® n° 1676177 registered since May 19, 2022.

FACTUAL BACKGROUND

Complainant is the number one global player in the pet and equine markets. It helps provide longer and healthier lives for companion animals. NEXGARD® is a drug delivered in a beef-flavoured chew that kills adult fleas and is indicated for the treatment and prevention of flea infestations and the treatment and control of tick infestations in dogs and puppies from eight weeks of age. The disputed domain name <nexgardbravecto.com> combines Complainant's brand with a competing brand, BRAVECTO.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant states that the disputed domain name <nexgardbravecto.com > is confusingly similar to its trademark NEXGARD®. The word “bravecto” is a competitor's trademark. Claimant states that combining its trademark with the trademark of a competitor is proof that Respondent is attempting capitalize on Complainant’s mark. This is underscored by the fact that <nexgardbravecto.com> resolves to a website offering for sale Complainant’s pet products together with competing products.

The Complainant alleges that it is well-established that “a domain name that wholly incorporates a Complainant’s registered trademark may be sufficient to establish the three elements of the UDRP.” The Panel concurs with this observation. The disputed domain name <nexgardbravecto.com> was registered on June 7, 2024 and resolves to a website selling pet food and accessories, especially the NEXGARD-branded products.

RESPONDENT:
The Respondent has not appeared formally or informally to controvert the evidence submitted by the Complainant.

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 15(a) of the Rules for the UDRP ('the Policy') instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

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

(i) the domain name registered by respondent is identical or confusingly similar to a trademark or service mark in which complainant has rights; and
(ii) respondent has no rights or legitimate interests in respect of the domain name; and
(iii) the domain name has been registered and is being used in bad faith.

In view of the Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations and adduced proof pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. In the absence of evidence to the contrary, the Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint and annexes as true unless the evidence is clearly contradictory. See Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc., FA 95095 (FORUM July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); see also Talk City, Inc. v. Robertson, WIPO Case No. D2000-0009 (WIPO February 29, 2000) ("In the absence of a response, it is appropriate to accept as true all [reasonable] allegations of the Complaint.").

A. Identical or Confusingly Similar to a Mark in which Complainant has a Right:

To succeed under the first element, a complainant must pass a two-part test by first establishing that it has rights, and thereafter that the disputed domain name is either identical or confusingly similar to the mark. The first element of a UDRP complaint “serves essentially as a standing requirement.” Here, the Complainant has established that it has rights in the word mark NEXGARD® by providing the Panel with the evidence that it has registrations in several jurisdictions for its mark. The fact that these registrations do not include Thailand the Respondent's residence is of no relevance. The consensus view which the Panel adopts is that a national or an international trademark registration is sufficient to establish rights in that mark. As such, the Panel finds that the Complainant has established that it has a right in the word mark NEXGARD®.

The second part of the test calls for comparing the Complainant’s mark with the disputed domain name entails “a straightforward visual or aural comparison of the trademark with the alphanumeric string in the domain name. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark." See WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin; WIPO Overview 3.0 at section 1.7.

The Panel observes that the single difference in this case is the addition of the word “bravecto” which is a trademark owned by a competing producer of similar goods. Where the relevant trademark is recognizable within the disputed domain name it is sufficient to establish confusing similarity. The addition of the gTLD "..com" does not have any impact on the overall impression of the dominant portion of the disputed domain name and is therefore irrelevant in determining the confusing similarity between NEXGARD® and <nexgardbravecto.com>. See WIPO Case No. D2006-0451, F. Hoffmann-La Roche AG v. Macalve e-dominios S.A. (“It is also well established that the specific top level of a domain name such as ‘.com’, ‘.org’ or ‘.net’ does not affect the domain name for the purpose of determining whether it is identical or confusingly similar.”).

Accordingly, Complainant has satisfied Paragraph 4(a)(i) of the Policy.

B. Determining Whether Respondent Lacks rights or legitimate interests in the disputed domain name:

To establish the second of the three elements, the Complainant must first demonstrate that Respondent lacks rights and legitimate interests in the disputed domain name. Recognizing that the proof for establishing this element is under the Respondent's control, the Complainant may satisfy this burden by offering a prima facie case based on such evidence as there is, thus shifting the burden to the Respondent to produce evidence to overcome the presumption that it lacks rights or legitimate interests in the disputed domain name. See Advanced International Marketing Corporation v. AA-1 Corp, Forum Claim No. FA 780200 (finding that a complainant must offer some evidence to make its prima facie case and satisfy Policy paragraph 4(a)(ii).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. It states that it did not authorize the Respondent to register the disputed domain name, the Respondent is not using the disputed domain name for any bona fide use, nor can it claim to be known by the name " NEXGARD" as the Registrar disclosed Respondent’s name is Ronnachai Nakapun located in Thailand.

The Complainant has adduced evidence based on the use of the disputed domain name that Respondent is not using it for any non-commercial or fair use. See Croatia Airlines d. d. v. Modern Empire Internet Ltd., WIPO Case No. D2003-0455 (the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the Policy).

The Panel finds that the Complainant's contentions and proof satisfy the presumptive burden that Respondent lacks rights or legitimate interests in the disputed domain name. Therefore, the burden shifts to respondent to rebut the presumption that it lacks rights or legitimate interests. It has the opportunity to controvert the prima facie case by adducing evidence demonstrating that it has rights or legitimate interests. The Policy sets forth the following nonexclusive list of factors:

(i) "[B]efore any notice to you 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."

(ii) "[Y]ou (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights."

(iii) "[Y]ou are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

Evidence of any one of these defences will satisfy the rebuttal burden, but the absence of any evidence supports a complainant's contention that the respondent lacks rights or legitimate interests in the disputed domain name. The failure of a party to submit evidence on facts in its possession and under its control may permit the Panel to draw an adverse inference regarding those facts. See WIPO Case No. D2000-0004, Mary-Lynn Mondich and American Vintage Wine Biscuits, Inc. v. Shane Brown, doing business as Big Daddy's Antiques.

In this case, the Respondent has misappropriated Complainant’s NEXGARD® trademark and combined it with another trademark in <nexgardbravecto.com> to point it to a website offering Complainant's goods in addition to competing goods. The Complainant asserts that it did not authorize nor does the Respondent have permission to use NEXGARD®. See Emerson Electric Co. v. golden humble /golden globals, FA 1787128 (Forum June 11, 2018) ("lack of evidence in the record to indicate a respondent is authorized to use [the] complainant's mark may support a finding that [the] respondent does not have rights or legitimate interests in the disputed domain name per Policy ¶ 4(c)(ii)"). See Comme Des Garcons, Ltd. and Comme Des Garcons Co., Ltd. v. Lina543

Valen354345cia, Forum Claim No. FA 2001717 (holding: “The disputed domain name incorporates Complainant's registered mark without authorization, and it is being used for a misleading website that passes off as Complainant to promote counterfeit versions of its products and possibly for other fraudulent conduct. Such use does not give rise to rights or legitimate interests under the Policy.”). See also Invesco Ltd. v. Premanshu Rana, Forum Claim No. FA1705001733167 (holding that “[u]se of a domain name to divert Internet users to a competing website is not a bona fide offering of goods or services or a legitimate noncommercial or fair use.”

As the Respondent has not controverted the evidence that it lacks right or legitimate interests in the disputed domain name, and for the reasons herein stated, the Panel finds that the Complainant has satisfied Paragraph 4(a)(ii) of the Policy.

C. Registration and Use in Bad faith:

It is the Complainant's burden under Paragraph 4(a)(iii) of the Policy to prove that the Respondent both registered and is using the disputed domain name in bad faith. It is not sufficient for a complainant to rest its case on the finding under Paragraph 4(a)(ii) of the Policy, although the fact that the Respondent lacks rights or legitimate interests in the disputed domain name maybe a factor in assessing its motivation for registering a domain name that incorporates Complainant's mark with a mark of a competing producer of similar goods.

The Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:

(i) circumstances indicating that the respondent has registered or 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 the complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent 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 respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 respondent's website or location or of a product or service on the respondent's website or location.

The preamble to Paragraph 4(b) states: "For the purposes of Paragraph 4(a)(iii) [the finding of any of the circumstances] shall be evidence of the registration [...] of a domain name in bad faith." In the absence of a respondent to explain and justify its registration and use of a domain name corresponding to a famous or well-known mark, a Panel is compelled to examine the limited record for any exonerative evidence of good faith.

The Complainant's proof in this case focuses the Panel's attention on the fourth factor. As there is no proof that would support the other factors, the Panel will not address them. Here, the Complainant contends and submits proof that the disputed domain name lures consumers to an operating website that sells both Complainant’s and a competitor’s products, thus capitalizing on the Complainant’s mark to conduct its business.

Using a complainant's mark to offer competing goods or services is often held to disrupt the business of the owner of the relevant mark and is evidence of bad faith. See Instron Corporation v. Andrew Kaner c/o Electromatic a/k/a Electromatic Equip't, FA 768859 (Forum September 21, 2006) (holding: "Complainant asserts that Respondent registered and is using the disputed domain names to disrupt Complainant’s business, because Respondent is using the disputed domain names to operate a competing website. The Panel finds that Respondent has registered and used the disputed domain names in bad faith according to Policy ¶ 4(b)(iii)."); also, Southern Exposure v. Southern Exposure, Inc., Forum Claim No. FA 94864 ("The Respondent is using the domain name to attract Internet users to its website by creating confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the Complainant’s website").

It is of no account that two brands have been joined in a single domain name. Decathlon SAS v. Nadia Michalski, WIPO Claim No. D2014-1996 (<decathlon-nke.com>) (holding that “the consensus view among UDRP panelists that neither the Policy nor the Rules expressly require the consent of a third party and previous panels have accepted complaints request that a domain name may be transferred to the complainant.”).

As the Complainant has demonstrated that the Respondent registered and is using the disputed domain name in bad faith, it has satisfied 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. **nexgardbravecto.com**: Transferred

PANELLISTS

Name	**Gerald Levine Ph.D, Esq.**

DATE OF PANEL DECISION 2024-07-15

Publish the Decision