

Decision for dispute CAC-UDRP-106625

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| Case number | CAC-UDRP-106625 |
| Time of filing | 2024-06-19 10:09:25 |
| Domain names | boehringer-ingeilheim.com |

Case administrator

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

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| Organization | Boehringer Ingelheim Pharma GmbH & Co.KG |
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Complainant representative

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| Organization | NAMESHIELD S.A.S. |
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Respondent

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| Organization | Kyaw Lay (Boehringer Ingelheim Singapore Pte. Ltd.) |
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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

The Complainant has established by evidence that it owns a large portfolio of trademarks including the International trademark No. 221544 for BOEHRINGER-INGELHEIM, registered on July 2, 1959, and the International trademark No. 568844 for BOEHRINGER INGELHEIM, registered on March 22, 1991 (collectively “the BOEHRINGER INGELHEIM trademark”).

FACTUAL BACKGROUND

The Complainant is a prominent German pharmaceutical company that has been in business since 1885. It owns a large portfolio of trademarks including the aforesaid trademarks and several domain names that it uses in its business including <boehringer-ingeilheim.com>, registered on September 1, 1995. The Respondent registered the domain name <boehringer-ingeilheim.com> (“the disputed domain name”) on June 13, 2024 and has caused it to resolve to the official website of the Complainant without permission. The Complainant is concerned that the spelling of the domain name is virtually the same as its trademark, that it gives the false impression that it is an official domain name of the Complainant and that it has the potential to be used for improper purposes and to the detriment of the Complainant. Accordingly, the Complainant has instituted this proceeding to have the disputed domain name transferred to itself.

PARTIES CONTENTIONS

COMPLAINANT

The disputed domain name is confusingly similar to the BOEHRINGER INGELHEIM trademark, as it merely adds the letter “i” before the letter “l” of the trademark. Thus, in registering the domain name, the Respondent has engaged in typosquatting which, as has been demonstrated in many prior UDRP decisions, shows confusing similarity with the BOEHRINGER INGELHEIM trademark.

The Respondent has also added the gTLD “.com” which cannot negate a finding of confusing similarity between the domain name and the trademark.

The Respondent has no rights or legitimate interests in the disputed domain name. In that regard, the Complainant must first establish a prima facie case and, if it is successful, the onus of proof reverts to the Respondent to disprove the prima facie case.

The prima facie case in this proceeding is established by the evidence that the Respondent has registered the disputed domain name in the name of the Complainant’s subsidiary Boehringer Ingelheim Singapore Pte. Ltd. But as the Respondent’s e-mail address (tommy2918@fastmail.com) is not affiliated with that company, the Respondent is shown to be using the identity of the Complainant’s subsidiary to increase the likelihood of confusion with the Complainant.

The Respondent is not related to the Complainant and the Complainant does not carry out any activity for, nor have any business with, the Respondent.

No license nor authorization has been granted to the Respondent to make any use of the Complainant’s BOEHRINGER INGELHEIM trademark or to register the disputed domain name. The disputed domain name is a typosquatted version of the Complainant’s BOEHRINGER INGELHEIM trademark.

The disputed domain name redirects to the Complainant’s official website.

The Respondent is not using the disputed domain name for a *bona fide* offering of goods or services or a legitimate non-commercial or fair use.

The disputed domain name was registered and is being used in bad faith.

That is so because:

- the disputed domain name is confusingly similar to the BOEHRINGER INGELHEIM trademark;
- it must be inferred that the Respondent registered and used the disputed domain name with full knowledge of the BOEHRINGER INGELHEIM trademark;
- the Respondent used the Complainant’s Singapore subsidiary’s identity in registering the disputed domain name;
- the misspelling of the trademark in the disputed domain name shows that the disputed domain name was intended by the Respondent to be misleading;
- the disputed domain name redirects to the Complainant’s official website, showing that the Respondent had knowledge of the Complainant’s rights prior to the registration of the disputed domain name;
- the intention of the Respondent must have been to take advantage of the Complainant’s good reputation; and
- MX servers are configured, suggesting that the domain name may be actively used for e-mail purposes which would itself be a use in bad faith.

Finally, it is submitted that as the Complainant has made out all of the elements that it must prove, it is entitled to the relief it seeks, namely the transfer of the domain name from the Respondent to the Complainant.

RESPONDENT

The Respondent did not file a Response in this proceeding.

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

DISCUSSION AND FINDINGS

This is a mandatory administrative proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy ("the Policy" or "UDRP") of the Internet Corporation for Assigned Names and Numbers ("ICANN"), the Rules for Uniform Domain Name Dispute Resolution Policy ("the Rules"), and the CAC Supplemental Rules.

A. Administrative compliance

By notification dated June 19, 2024 and in accordance with paragraph 4(b) of the Rules, the CAC notified the Complainant that the Complaint was administratively deficient in that the Complaint did not sufficiently identify the Respondent. The notification invited the Complainant to have regard to the Registrar's verification available in the online case file in the form of a non-standard communication regarding the appropriate identification of the domain name holder. Also on June 19, 2024, the Complainant filed an Amended Complaint with the deficiency having been rectified and the CAC determined that the Complaint should be admitted to proceed further in the Administrative Proceeding.

The Panel has reviewed all of the above matters and makes a finding that within the meaning of paragraph 4(b) of the Rules, the administrative deficiency has been corrected and that this matter has proceeded properly to the Panel in accordance with the Policy and the Rules.

B. Substantive matters

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable. In that regard, the Panel also notes that the onus is on the complainant to make out its case and past UDRP panels have consistently said that a complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

The Panel therefore turns to discuss the various issues that arise for decision on the facts as they are known.

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

- (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 will therefore deal with each of these requirements in turn.

Identical or Confusingly Similar

The Complainant has adduced evidence that the Panel accepts, that the Complainant is the registered owner of a large portfolio of trademarks including the International trademark for BOEHRINGER-INGELHEIM No.221544, registered on July 2, 1959, and the International trademark for BOEHRINGER INGELHEIM No. 568844, registered on March 22, 1991 (collectively "the BOEHRINGER

INGELHEIM trademark”).

It will be seen therefore that the BOEHRINGER INGELHEIM trademark was registered well before the disputed domain name was registered, which was on June 13, 2024. The Complainant has verified that the Respondent is the registrant of the disputed domain name.

The Panel therefore finds that the Complainant “has” a trademark which the Policy requires it to prove and which it has done.

The Panel next finds that the disputed domain name is confusingly similar to the BOEHRINGER INGELHEIM trademark for the following reasons.

First, the domain name includes the entirety of the BOEHRINGER INGELHEIM trademark, with a minor spelling alteration. Accordingly, it is clear that the domain name has been inspired by and is an attempt to copy the BOEHRINGER INGELHEIM trademark. It is also clear and has been held many times in prior UDRP decisions that when internet users see an entire trademark used in a domain name in this way, even with a minor spelling alteration, they naturally conclude that the domain name is an official domain name of the trademark owner or at least that it is being used with the permission of the trademark owner.

Secondly, the domain name is not a complete duplication of the trademark as it adds the letter “i” before the letter “l” of the trademark. Thus, in registering the disputed domain name, the Respondent has engaged in typosquatting which, as has been demonstrated in many prior UDRP decisions, shows confusing similarity between the domain name and the trademark.

Thirdly, the fact that the domain name has been created by making such minor changes to the trademark, which are nevertheless, apparent for everyone to see, suggests instantly that the Respondent is about some activity designed to do damage to the Complainant by some means involving use of the domain name. In fact, it can be assumed that the Respondent was hoping that internet users who came across the domain name would not notice that the spelling of the trademark had been changed and would assume that the domain name was an official domain name of the Complainant and that it was being used for a legitimate purpose, neither of which, of course, is true.

Finally, the “.com” suffix which the Respondent has also added, is disregarded for the purposes of assessing confusing similarity, as it could not negate the clear impression being given that the domain name is confusingly similar to the trademark, which it clearly is.

Taken as a whole, the internet user would look at the domain name and conclude that it is similar to the trademark, because the entirety of the substance of the trademark goes to make up the domain name, and also that it was confusingly similar to the trademark, because it gives rise to a question mark as to whether it really is an official domain name of the Complainant or not.

The Panel therefore finds that the disputed domain name is confusingly similar to the BOEHRINGER INGELHEIM trademark and that this conclusion is supported by the prior UDRP decisions cited by the Complainant.

The Complainant has thus made out the first of the three elements that it must establish.

Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name. But by virtue of paragraph 4(c) of the Policy, it is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [respondent] 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; or
- (ii) you [respondent] (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; or
- (iii) you [respondent] are making a legitimate noncommercial 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.

Thus, if a respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the domain name, the complainant will have failed to discharge its onus and the complaint will fail.

It is also well-established that a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests and that when such a *prima facie* case is made out, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent cannot do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

The Panel, after considering all of the evidence in the Complaint, finds that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name.

That *prima facie* case is made out from the following considerations.

- the Complainant has clearly established its rights in the BOEHRINGER INGELHEIM trademark;
- it is clear from the spelling alteration to the trademark that the Respondent must have devised the domain name with the intention of creating a domain name that would be confusingly similar to the Complainant’s famous trademark and in the hope that it would mislead and deceive at least some internet users. Such an intention could not conceivably give rise to a right or legitimate interest in

the domain name;

- the evidence of the Complainant is that the Respondent is not related in any way to the Complainant's business, is not affiliated with the Complainant or authorized by it in any way to use the BOEHRINGER INGELHEIM mark trademark or any altered spelling thereof and does not carry out any activity for, nor has any business with, the Complainant;
- the evidence is that no licence nor authorisation has been granted by the Complainant to the Respondent to make any use of the trademark or to register the disputed domain name; that evidence also shows that the disputed domain name is a typosquatted version of the Complainant's trademark;
- the evidence is that the Respondent registered the disputed domain name in the name of Kyaw Lay as Registrant and the Complainant's subsidiary in Singapore, Boehringer Ingelheim Pte. Ltd. as the Registrant/Admin/Tech/Billing Organization. This is apparent from the Registrar's Verification Response that the Panel has inspected. The Verification Response also reveals that the Registrant/Admin/Tech/Billing e-mail address was given as "tommyy2918@fastmail.com" which address is not affiliated with the aforesaid subsidiary; the provision of such false information was clearly an act of deception, making it inconceivable that the Respondent has a right or legitimate interest in the domain name; moreover, it shows a deliberate attempt by the Respondent to register a domain name that was confusingly similar to the Complainant's trademark;
- the evidence in annex to the complaint shows that the disputed domain name was redirected to the Complainant's official website, showing again an attempt to give the false impression that the domain name was an official domain name of the Complainant, which it was not;
- none of this conduct shows that the Respondent used the domain name for a bona fide offering of goods or services within the meaning of Policy 4(c)(i); there was nothing bona fide in such conduct;
- nor did such conduct show that the Respondent made a legitimate non-commercial or fair use of the domain name within the meaning of Policy 4(c)(iii); and
- nor did such conduct come within any of the criteria for a right or legitimate interest in a domain name that are set out in paragraph 4(c)(i) – (iii) of the Policy and nor could it show that the Respondent had a right or legitimate interest in the domain name on any other basis.

These facts give rise to the prima facie case made out by the Complainant.

The Respondent has not filed a Response or made any other answer to the claims of the Complainant and is in default. Accordingly, the *prima facie* case has not been rebutted and the Complainant has made out the second of the three elements that it must establish.

Registered and Used in Bad Faith

The Complainant must prove on the balance of probabilities both that the disputed domain name was registered in bad faith and that it is being used in bad faith.

Paragraph 4(b) of the Policy sets out four circumstances, any one of which is evidence of the registration and use of a domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive. The four specified circumstances are:

- (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 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 the respondent'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 respondent's website or location or of a product or service on the site or location.

The Panel finds for the following reasons that the disputed domain name was registered and has been used by the Respondent in bad faith:

- the structure of the domain name as devised by the Respondent makes it clear that the domain name is confusingly similar to the BOEHRINGER INGELHEIM trademark and that this was the intention of the Respondent;
- it must be inferred that the Respondent registered and used the domain name with full knowledge of the trademark; clearly the Respondent had that knowledge because it contrived to make the domain name confusingly similar to the BOEHRINGER INGELHEIM trademark and made only a minor spelling alteration to the trademark; the misspelling shows that the domain name was intended to be misleading; moreover the Complainant's trademark is famous and it is simply unbelievable that the Respondent could have plucked the domain name out of the air. Thus, it must be concluded that the Respondent set about misappropriating the Complainant's mark, knowing what it was doing and with the intention of doing harm to the Complainant and probably making money for itself by selling the domain name if it could or otherwise using it for its own benefit;
- the evidence shown from the Registrar's Verification Response demonstrates that the Respondent has used the Complainant's Singapore subsidiary's identity in the registration of the domain name;
- the disputed domain name redirects to the Complainant's official website, demonstrating that the Respondent had knowledge of the

Complainant's rights prior to the registration of the domain name and that it set about giving the false impression that the domain name was an official domain name of the Complainant;

- the only inference that can be drawn from the evidence is that the intention of the Respondent must have been to take advantage of the Complainant's good reputation with a view to trading on it by one means or another;
- MX servers are configured, suggesting that the domain name may be actively used for e-mails for an improper purpose to the benefit of the Respondent and to the detriment of the Complainant; and
- the conduct of the Respondent leads to the conclusion that in registering the domain name deceptively and without any authority to do so, it must have intended to create a likelihood of confusion, with the intention of attracting internet users who might think that the domain name was an official domain name of the Complainant and that it would lead to an official website of the Complainant. Thus, the matter comes within the provisions of paragraph 4(b)(iv) of the Policy.

All of the facts therefore show that the Respondent registered and used the domain name in bad faith. There is no conceivable ground for concluding that the Respondent was acting in good faith, as the Respondent was clearly targeting the Complainant.

Finally, in addition and having regard to the totality of the evidence, the Panel finds that, in view of Respondent's registration of the disputed domain name, retaining it, and using it as aforesaid, the Respondent registered and used it in bad faith within the generally accepted meaning of that expression.

Accordingly, the Complainant has shown the third of the three elements that it must establish.

On all of the above issues, the Complainant has cited numerous prior UDRP decisions that support its contentions.

The Complainant has therefore made out its case and is entitled to the relief it seeks.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

| | |
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| Name | Neil Brown |
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DATE OF PANEL DECISION 2024-07-19

Publish the Decision
