Decision for dispute CAC-UDRP-106717

Case number	CAC-UDRP-106717
Time of filing	2024-07-17 14:52:11
Domain names	boehringer-ltd.com

Case administrator

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

Complainant

Organization	Boehringer Ingelheim Pharma GmbH & Co.KG

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Organization	Yating

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 holds a large portfolio of trademarks, including the word “BOEHRINGER,” in various countries, among others, the international trademark BOEHRINGER (Reg. No. 799761), registered on December 2, 2002.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant is a German family-owned pharmaceutical group with origins dating back to 1885 when it was founded by Albert Boehringer (1861-1939) in Ingelheim am Rhein. Since then, the Complainant has grown into a global research-driven pharmaceutical company, currently employing approximately 53,500 people. The Complainant's two main business areas are human pharmaceuticals and animal health. In 2023, the Complainant recorded net sales of around 25.6 billion euros.

The disputed domain name **<boehringer-ltd.com>** was registered on May 30, 2024.

PARTIES CONTENTIONS

The Complainant:

i) The Complainant holds rights to the trademark BOEHRINGER (International Reg. No. 799761, registered on December 2, 2002). The disputed domain name is confusingly similar to the Complainant's trademark BOEHRINGER because it only adds the generic term "LTD" and the ".com" gTLD.

ii) The Respondent has no rights or legitimate interests in the disputed domain name: the Respondent is not commonly known by the disputed domain name; the Respondent has no affiliation with the Complainant; the Complainant has no business relationship with the Respondent and does not conduct any activities on their behalf; and the Respondent has not been granted any license or authorization to use the Complainant's trademark. The disputed domain name redirects to content that impersonates an affiliate website of the Complainant by reproducing its "BOEHRINGER INGELHEIM" mark. Using the disputed domain name to offer competing goods or services does not qualify as a bona fide offering of goods or services, nor as legitimate non-commercial or fair use under Policy paragraph 4(c)(i) & (iii).

iii) The Respondent has registered and is using the disputed domain name in bad faith: the Respondent registered and used the domain name with full awareness of the Complainant's trademark. The Respondent has used the disputed domain name to attract Internet users and potentially offer fraudulent content while impersonating a company affiliated with the Complainant.

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 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."

Paragraph 4(a) of the Policy requires that complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:
(1) the domain name registered by respondent is identical or confusingly similar to a trademark or service mark in which complainant has rights; and
(2) respondent has no rights or legitimate interests in respect of the domain name; and
(3) 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 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. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint 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, D2000-0009 (WIPO Feb. 29, 2000) (“In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.”).

Rights

The Complainant asserts that it holds rights to the trademark BOEHRINGER (International Reg. No. 799761, registered on December 2, 2002). An international trademark registration is sufficient to establish the necessary rights in the mark for the purposes of the Policy. Therefore, the Panel concludes that the Complainant has established its rights in the BOEHRINGER mark.

The Complainant also argues that the disputed domain name <boehringer-ltd.com> is confusingly similar to the Complainant’s trademark BOEHRINGER, as it incorporates the Complainant’s mark in its entirety and merely adds the generic term “LTD” along with the “.com” gTLD. Adding a generic and/or descriptive term and a gTLD to the Complainant's mark does not adequately differentiate the disputed domain name from the mark under Policy 4(a)(i). See Empowered Medical Solutions, Inc. d/b/a QRS-Direct and QRS Magnovit AG v. NULL NULL / QUANTRON RESONANCE SYSTEMS / JIM ANDERSON / HTR / unknown HTR / HTR, FA 1784937 (Forum June 8, 2018) ("Adding or removing descriptive terms or a gTLD is insufficient to differentiate a disputed domain name from a complainant's mark under Policy ¶ 4(a)(i)."); see also MTD Products Inc v J Randall Shank, FA 1783050 (Forum June 27, 2018) ("The disputed domain name is confusingly similar to Complainant's mark as it wholly incorporates the CUB CADET mark before appending the generic terms 'genuine' and 'parts' as well as the '.com' gTLD."). Therefore, the Panel agrees and finds that the disputed domain name is confusingly similar to the Complainant’s BOEHRINGER mark under Policy paragraph 4(a)(i).

No rights or legitimate interests

The Complainant must first make a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain name under paragraph 4(a)(ii) of the Policy, then the burden shifts to the Respondent to show it does have rights or legitimate interests. See Section 2.1, WIPO Jurisprudential Overview 3.0 (“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 Complainant argues that the Respondent has no rights or legitimate interests in the disputed domain name: the Respondent is not listed in the WHOIS database under the disputed domain name and is therefore not commonly known by it; the Respondent has no connection with the Complainant; the Complainant does not engage in any activities with, nor has any business relationship with the Respondent; and no license or authorization has been granted to the Respondent to use the Complainant’s trademark. The Panel notes that the WHOIS information for the disputed domain name lists the registrant as "Yating," and there is no evidence suggesting that the Complainant has authorized the Respondent to use the BOEHRINGER mark in any capacity. Consequently, the Panel finds that the Respondent is not commonly known by the disputed domain name under paragraph 4(c)(ii) of the Policy.

The Complainant further asserts that the Respondent is not using the disputed domain name to make a bona fide offering of goods or services under Policy paragraph 4(c)(i), nor is it using it for legitimate noncommercial or fair use under Policy paragraph 4(c)(iii). The Complainant specifically points out that the disputed domain name redirects to a site impersonating an affiliate of the Complainant by reproducing its "BOEHRINGER INGELHEIM" name and mark. The Panel notes that using a disputed domain name’s resolving webpage to offer competing goods or services may not qualify as a bona fide offering of goods or services, nor as legitimate noncommercial or fair use under Policy paragraphs 4(c)(i) & (iii). Previous panels have held that when a respondent attempts to pass itself off as a complainant, it does not constitute a bona fide offering of goods or services, nor does it qualify as legitimate noncommercial or fair use under Policy paragraphs 4(c)(i) & (iii). See Crow v. LOVEARTH.net, FA 203208 (Forum Nov. 28, 2003) (“It is neither a bona fide offering of goods or services, nor an example of legitimate noncommercial or fair use under Policy paragraph 4(c)(i) & (iii) when the holder of a domain name, confusingly similar to a registered mark, attempts to profit by passing itself off as Complainant…”).

Panels have also held that a respondent’s use of a confusingly similar domain name to compete with the complainant does not grant the respondent any rights or legitimate interests. See Coryn Group, Inc. v. Media Insight, FA 198959 (Forum Dec. 5, 2003) (finding that the respondent was not using the domain names for a bona fide offering of goods or services, nor for legitimate noncommercial or fair use, because the respondent used the names to divert Internet users to a website offering services that competed with those offered by the complainant under its marks).

The Complainant has provided a screenshot of the website associated with the disputed domain name. The Panel notes that the website displays the Complainant company’s name and mark, BOEHRINGER INGELHEIM, along with its logo. The Panel finds that the Respondent’s use of the disputed domain name is likely to cause confusion among Internet users, leading them to believe that the website’s content is provided by, or authorized by, a company affiliated with the Complainant. The Panel concludes that the Respondent was not using the domain name for a bona fide offering of goods or services, nor for legitimate noncommercial or fair use, because the Respondent used the disputed domain name to divert Internet users to a website displaying content that competed with the Complainant offerings under its marks, which does not fall within the scope of Policy paragraphs 4(c)(i) & (iii).

The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

Bad faith

Paragraph 4(b) of 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 Complainant argues that the Respondent registered and is using the disputed domain name in bad faith. Given the distinctiveness and reputation of the Complainant's trademark, it is reasonable to infer that the Respondent registered and used the disputed domain name with full knowledge of the Complainant's trademark. While constructive knowledge alone is insufficient to support a finding of bad faith, actual knowledge can demonstrate a respondent's bad faith registration and use. See Orbitz Worldwide, LLC v. Domain Librarian, FA 1535826 (Forum February 6, 2014: "The Panel notes that although the UDRP does not recognize 'constructive notice' as sufficient grounds for finding bad faith per paragraph 4(a)(iii) of the Policy, the Panel here finds actual knowledge through the name used for the domain and the use made of it."). Based on the notoriety of the Complainant's mark and the manner in which the disputed domain name is used, the Panel infers that the Respondent registered the domain with actual knowledge of the Complainant's rights in the BOEHRINGER mark and finds that it registered the disputed domain name in bad faith under Policy paragraph 4(a)(iii).

The Complainant further argues that the Respondent registered and is using the disputed domain name in bad faith by disrupting the Complainant's business and attracting users for commercial gain while offering competing contents. Under Policy paragraphs 4(b)(iii) and (iv), offering counterfeit or competing items to disrupt a complainant's business while attracting users for commercial gain is evidence of bad faith registration and use. See Guess? IP Holding L.P. and Guess?, Inc. v. Linan / linanbangongshi and hu sugor / sugorguoguo, FA 1587466 (Forum Dec. 13, 2014) ("The Panel finds that Respondent's use of the disputed domain names to compete with Complainant by offering counterfeit products and thereby misdirecting Internet users constitutes disruption to Complainant's business, demonstrating bad faith registration and use under Policy ¶ 4(b)(iii)."); see also Affliction, Inc. v. Chinasupply, FA 1223521 (Forum Oct. 23, 2008) (finding that the respondent's attempt to commercially gain by creating confusion about the complainant's connection with the website, by selling counterfeit products, demonstrates bad faith under Policy 4(b)(iv)).

The Panel notes that the Complainant has provided a screenshot of the website associated with the disputed domain name. The Panel specifically observes that the website displays the Complainant's name and mark, BOEHRINGER INGELHEIM, along with its logo. As previously discussed, the Panel finds that the Respondent's use of the disputed domain name is likely to cause confusion among Internet users, leading them to believe that the website's content is provided by, or authorized by, a company affiliated with the Complainant. Therefore, the Panel concludes that the Respondent's actions disrupt the Complainant's business and constitute bad faith registration and use. As a result, the Panel finds that the Respondent registered and used the disputed domain name in bad faith under Policy paragraphs 4(b)(iii) and (iv).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	**Mr. Ho-Hyun Nahm Esq.**

DATE OF PANEL DECISION 2024-08-10

Publish the Decision