Decision for dispute CAC-UDRP-106727

Case number	CAC-UDRP-106727
Time of filing	2024-07-18 12:58:11
Domain names	nexgarde-brasil.online

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

Name	Joao Santos

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 provided evidence of ownership of the following trademarks:

- International trademark registration n. 1166496 “NEXGARD”, registered on 29 May 2013 and designating goods in international class 05;
- EU trademark registration n. 011855061 “NEXGARD”, registered on 9 October 2013 and designating goods in international class 05;
- International trademark n° 1676177 “NEXGARD” registered on 19 May 2022.

FACTUAL BACKGROUND

The Complainant, Boehringer Ingelheim Animal Health France, is an international leader in the pet and equine markets. The Complainant has provided evidence of ownership of the registrations for the marks "NEXGARD”.

The disputed domain name <**nexgarde-brasil.online**> was registered on 16 July 2024 directs points to a website selling pet food and accessories.

PARTIES CONTENTIONS

COMPLAINANT:

The disputed domain name is confusingly similar to the Complainant's trademarks NEXGARD and its domain names. The Complainant contends that the marks are entirely reproduced in the disputed domain name, with the addition of the letter "e" and the generic term "Brasil" to the mark.

The Respondent is not commonly known by the disputed domain name. The Complainant contends that the Respondent is not affiliated with nor authorized by the Complainant in any way. The Complainant equally asserts that the use of the domain name in connection to an active website offering pet products for sale, including goods branded to the Complainant's trademark is neither fair, legitimate or non-commercial. On the contrary, the Complainant submits that the disputed domain name is used to disrupt the Complainant's business and creates a false impression of affiliation to the Complainant.

As regards the bad faith of the Respondent, the disputed domain name includes the distinctive and well-known trademark NEXGARD and directs to a website creating a false affiliation with the Complainant, while selling NEXGARD-branded goods. It is reasonable to infer that the Respondent has registered the domain name with full knowledge of the Complainant's trademark.

RESPONDENT:

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

Notwithstanding the fact that no Response has been filed, the Panel shall consider the issues present in the case based on the statements and documents submitted by the Complainant.

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following elements:

i. that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
ii. that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
iii. that the disputed domain name was registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant must establish that it has a trademark or service mark and that the disputed domain name is identical or

confusingly similar to that trademark or service mark for the Complainant to succeed.

The Complainant, Boehringer Ingelheim Animal Health France, is an international leader in the pet and equine markets. The Complainant has provided evidence of ownership of the registrations for the mark "NEXGARD".

As regards the question of identity or confusing similarity for the purpose of the Policy, it requires a comparison of the disputed domain name with the trademarks in which the Complainant holds rights. According to section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), "this test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name".

Also, according to section 1.7 of the WIPO Overview 3.0, "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 for purposes of UDRP standing".

The disputed domain name wholly incorporates the Complainant's trademarks "NEXGARD" in addition to the letter "e", a, hyphen and the generic word "brasil". This addition does not prevent a finding of confusing similarity with the Complainant's trademarks. The fact that a domain name wholly incorporates a complainant's trademark is sufficient to establish identity or confusing similarity for the purpose of the Policy, despite the addition of other words to such marks.

It is well accepted by UDRP panels that a generic Top-Level Domain ("gTLD"), such as ".online", is typically ignored when assessing whether a domain name is identical or confusingly similar to a trademark.

This Panel concludes that the disputed domain name is confusingly similar to the Complainant's trademark and therefore finds that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, any of the following circumstances, if found by the Panel, may demonstrate the respondent's rights or legitimate interests in the disputed domain name:

i. before any notice to it of the dispute, the respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a bona fide offering of goods or services; or
ii. the respondent has been commonly known by the disputed domain name, even if it has acquired no trademark or service mark rights; or
iii. the respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The consensus view of UDRP panels on the burden of proof under paragraph 4(a)(ii) of the Policy is summarized in section 2.1 of the WIPO Overview 3.0, which states: "[…] 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 record shows that the Respondent uses the Complainant's trademark in the disputed domain name and on the content of the website associated with that domain name without authorization from the Complainant. The Respondent does not create a false impression of affiliation with the Respondent, but rather blatantly impersonates the Complainant by reproducing its trademarked name and logo in the header and footer sections of the website associated with the disputed domain name.

Past Panels have developed case law on the grounds of which the respondents may be granted rights of legitimate interests in a disputed domain name where the respondents sell complainants trademarked goods. See Oki Data Americas, Inc. v. ASD, Inc., WIPO Case No. D2001-0903. However, the Panel discards such reasoning as nothing from the record of the case shows that the Respondent was in fact an authorized distributor of the Complainant.

Additionally, the evidence on record does not show that the Respondent was commonly known, as an individual or an organization, by the disputed domain name.

The Panel concludes that the Respondent has no right or legitimate interests in the disputed domain name and therefore finds that the requirement of paragraph 4(a)(ii) of the Policy is satisfied.

C. Registration and Use in Bad faith

For the purpose of Paragraph 4(a) (iii) of the Policy, the following circumstances, in particular but without limitation, if found by the panel to be present, shall be evidence of the registration and use of the domain name in bad faith:

i. circumstances indicating that the holder has registered or 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 holders documented out-of-pocket costs directly related to the domain name; or
ii. the holder 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 holder has engaged in a pattern of such conduct; or
iii. the holder has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
iv. by using the domain name, the holder has intentionally attempted to attract, for commercial gain, Internet users to the holder'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 your website or location or of a product or service on the holder's website or location.

The Panel considers that the Respondent' conduct in this case constitutes bad faith registration and use of the disputed domain name within the meaning of paragraphs 4(a)(i) and 4(a)(iv)of the Policy. The evidence on the record shows that the Respondent was certainly aware of the existence of the Complainant and of the rights of the Complainant, and that the Respondent, by registering and using the disputed domain name has intentionally attracted internet users by creating a likelihood of confusion with the Complainant's trademark, for commercial gain.

The Complainant’s trademark NEXGARD is so widely well-known and has enjoyed such a long-standing reputation that it is inconceivable that a third party would register any domain name reproducing the mark without prior knowledge.

There is also evidence of bad faith use, in that the Respondent is using the disputed domain name to direct Internet traffic to a for-profit online store that sells NEXGARD-branded pet care goods without authorization from the Complainant.

The Panel concludes that the Respondent has registered and is using the disputed domain name in bad faith, and finds that the requirement of paragraph 4(a)(iii) of the Policy is satisfied.

The matter presented to this Panel is a clear-cut case of cybersquatting that falls perfectly in line with the Policy. The Complainant has successfully demonstrated all elements required under the Policy and the Respondent’s absence of Response only emphasizes the Complainant’s claim.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **nexgarde-brasil.online**: Transferred

PANELLISTS

Name	**Arthur Fouré**

DATE OF PANEL DECISION 2024-08-23

Publish the Decision