Decision for dispute CAC-UDRP-106757

Case number	CAC-UDRP-106757
Time of filing	2024-07-30 14:41:27
Domain names	boehringer-co.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

Name	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 owns a large portfolio of trademarks for BOEHRINGER in several jurisdictions. As such International Trademark BOEHRINGER n° 799761, registered since December 2, 2002.

FACTUAL BACKGROUND

The Complainant is a German family-owned pharmaceutical group of companies with roots going back to 1885, when it was founded by Albert Boehringer (1861-1939) in Ingelheim am Rhein. Nowadays is a global research-driven pharmaceutical enterprise and has around 53,500 employees with two main business areas: Human Pharma and Animal Health.

BOEHRINGER trademark is to be considered as well-known for UDRP purposes.

Furthermore, the Complainant owns multiple domain names consisting in the wording “BOEHRINGER”, such as <boehringer-ingelheim.com> registered since September 1, 1995.

The disputed domain name <boehringer-co.com> was registered on July 26, 2024 and is inactive.

PARTIES CONTENTIONS

The Complainant

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.

In particular the Complainant alleges that the addition of the term “-co” cannot prevent a finding of confusingly similarity.

The Complainant contends that none of the circumstances depicted in paragraph 4(c) of the Policy applies in this case.

Furthermore, Complainant´s trademark is well-known and the inactive use support a finding of bad faith use and registration.

The 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

1. Identical or Confusingly Similar

The Complainant has shown rights in respect of BOEHRINGER trademark for the purposes of the Policy. It is apparent that the mark BOEHRINGER is reproduced in the disputed domain name <Boehringer-co.com >. The Panel finds that the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. WIPO Overview 3.0, section 1.8. The applicable Top Level Domain (‘TLD’) in a domain name is viewed as a standard registration requirement and as such is disregarded under the first element test.

The Panel finds the first element of the Policy has been established.

2. Rights or Legitimate Interest

Paragraph 4(c) of the Policy sets out non-exclusive examples in which the Respondent may establish rights or legitimate interests in the disputed domain name. However, while the burden of proof in UDRP proceedings rests on the complainant, panels have recognized that proving a respondent lack or rights or legitimate interests in a domain name may result in the often-impossible task

of “proving a negative”. Accordingly, panels have established, since the inception of the UDRP, that it is sufficient to raise a prima facie case against the respondent and then the evidential burden of production shifts to the respondent. See CAC-UDRP-106452.

The Panel finds that the circumstances referred in paragraph 4(c) do not apply for the Respondent. Besides, the silence of the Respondent, once received the Complaint, has avoided the Panel to ponder if any circumstances may oppose to the Complainant´s prima facie showing.

The Panel finds the second element of the Policy has been established.

3. Register and Used in Bad Faith

Noting that bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant’s mark, the Panel now looks at the third requirement of the test.

By registering the disputed domain name that reproduces Complainant’s well-known trademark, the Respondent targeted the Complainant. This is also supported by the fact that the Respondent has already been involved in a dispute with the Complainant in connection with <boehringer-ltd.com>. See CAC-UDRP-106717. Accordingly, the Panel determines that the Respondent knew or should have known about the Complainant and its trademarks when registering the disputed domain name.

Furthermore, Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel notes the distinctiveness and the reputation of the Complainant’s trademark and the composition of the disputed domain name to contend that, in the circumstances of this case, the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

The Panel finds that the Complainant has established the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	**Manuel Moreno-Torres**

DATE OF PANEL DECISION 2024-08-30

Publish the Decision