Decision for dispute CAC-UDRP-106822

Case number	CAC-UDRP-106822
Time of filing	2024-08-29 09:28:09
Domain names	boehringer-ingelheimfrance.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Boehringer Ingelheim Pharma GmbH & Co.KG

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Organization	Search light

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, conducting business under the company / trade name Boehringer Ingelheim Pharma GmbH & Co.KG, owns numerous trademarks including the wording “BOEHRINGER INGELHEIM” registered in several countries, such as:

- the international trademark (figurative) BOEHRINGER-INGELHEIM no. 221544 in Nice classes 01, 02, 03, 04, 05, 06, 16, 17, 19, 29, 30, 32, registered since 2 July 1959;
- the international trademark (figurative) BOEHRINGER INGELHEIM no. 568844 in Nice classes 01, 02, 03, 04, 05, 09, 10, 16, 30, 31, registered since 22 March 1991;
- the international trademark (figurative) BOEHRINGER INGELHEIM no. 1160936 in Nice classes 05, 10, registered since 25 March 2013.

Furthermore, the Complainant owns multiple domain names consisting in the wording “BOEHRINGER INGELHEIM”, such as <boehringer-ingelheim.com> registered since 1 September 1995 and used in relation to its main website.

The above-mentioned rights of the Complainant are hereinafter referred to as the BOEHRINGER INGELHEIM Trademark.

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. Ever since, it has become a global research-driven pharmaceutical enterprise and it has today roughly 53,500 employees. The Complainant's two business areas are: human pharmaceuticals and animal health. In 2023, the Complainant achieved net sales of 25.6 billion Euros.

The disputed domain name <boehringer-ingelheimfrance.com> was registered on 27 August 2024 and, at the moment of the issuance of this decision, resolves to an e-commerce website in French selling pharmaceuticals and containing the Complainant's logo in its header.

The facts asserted by the Complainant are not contested by the Respondent.

PARTIES CONTENTIONS

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

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

Upon commencement of the administrative proceedings, the Respondent replied to the e-mail notification of the CAC with the message: “What is this?”. The CAC has provided the Respondent with detailed information about the procedure. The Respondent has neither contacted the CAC again, nor has submitted a Response.

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

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to succeed in the administrative proceeding:

(i) the disputed domain name is identical or confusingly similar to a trade mark 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 by the Respondent in bad faith.

I. THE COMPLAINANT’S RIGHTS AND THE CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAME TO THE COMPLAINANT'S MARK

The Complainant has established that it has rights in the BOEHRINGER INGELHEIM Trademark registered worldwide since 1959.

The disputed domain name consists of the following elements: the wording "BOEHRINGER INGELHEIM" divided by a hyphen, plus the geographical term "FRANCE", and the top-level domain (TLD) ".COM".

In UDRP disputes, the test for identity or confusing similarity involves a straightforward, reasoned comparison between the complainant's trademark and the disputed domain name. This typically entails a side-by-side evaluation of the domain name and the textual elements of the relevant trademark to determine if the mark is recognizable within the domain name. When a domain name fully incorporates a trademark, or at least a dominant feature of it is evident in the domain name, the domain is generally deemed confusingly similar to the mark for the purposes of UDRP standing. Adding other terms—whether descriptive, geographical, derogatory, or otherwise—does not prevent a finding of confusing similarity under this first element. The TLD is usually disregarded in determining identity or similarity, as it is simply a technical aspect of registration.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark, because it contains the entirety or at least the distinctive part of such mark, namely "BOEHRINGER INGELHEIM", combined with the geographical term "FRANCE". This additional term neither affects the attractive power of the Complainant's mark, nor is sufficient to distinguish the disputed domain name from the BOEHRINGER INGELHEIM Trademark.

Accordingly, the Panel finds that the Complainant has proven the first element of the paragraph 4(a) of the Policy and the disputed domain name is confusingly similar to the Complainant's mark.

II. THE RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

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. If the 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.

The Complainant contends to have no relationship whatsoever with the Respondent. The Respondent has never received any approval of the Complainant, expressed or implied, to use the Complainant's trademark or to register and use the disputed domain name.

The Respondent has been identified as Search light - Joel Sanchez, having its address in Alaska (US). There is no evidence available that the Respondent, as an individual, business, or other organization, has been commonly known by the disputed domain name or has acquired any rights in a trademark or trade name corresponding to the disputed domain name.

The disputed domain name incorporates the Complainant's trademark, combined with a geographical term, and, thus is confusingly similar to the BOEHRINGER INGELHEIM Trademark.

UDRP panels have found that domain names identical or confusingly similar to a complainant's trademark carry a high risk of implied affiliation. A domain name consisting of a trademark plus an additional term (descriptive, geographical, pejorative, meaningless, or otherwise) at the second- or top-level is seen as tending to suggest sponsorship or endorsement by the trademark owner. Thus, UDRP panels have largely held that such composition cannot constitute fair use.

The Complainant has provided evidence that, at the moment of filing the Complaint, the disputed domain name was resolving to a parking page and MX servers were configured. Thus, there is no evidence that, before any notice to Respondent of the dispute, the Respondent used, or demonstrably prepared to use, the domain names or names corresponding to the domain names in connection with a bona fide offering of goods or services.

Upon her appointment and during the issuance of this decision, the Panel visited the website linked to the disputed domain name and found it resolving to an e-commerce website in French with the Complainant's logo in its header and selling pharmaceuticals. Obviously, this deliberate change in the use of the disputed domain name cannot be considered by the Panel a legitimate noncommercial or fair use of the domain name by the Respondent, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark.

While the Complainant has established its prima facie case, the Respondent has not submitted a Response to the Complaint and, thus, has failed to invoke any of the circumstances, which could demonstrate any rights or legitimate interests in the disputed domain name.

Therefore, the Panel is satisfied that the Complainant has met the second requirement of the paragraph 4(a) of the Policy and finds that the Respondent lacks rights or legitimate interests to the disputed domain name.

III. THE REGISTRATION AND THE USE OF THE DISPUTED DOMAIN NAME IN BAD FAITH

As mentioned under the first element, the Complainant has sufficiently demonstrated to own rights in the BOEHRINGER INGELHEIM Trademark since 1959. The Complainant's trademark was registered worldwide well before the date of registration of the disputed domain name (27 August 2024), is widely-known and is valid also in the territory where the Respondent resides (US).

The disputed domain name is to be considered confusingly similar to the Complainant's trademark, since it incorporates the entirety or at least the distinctive part of the BOEHRINGER INGELHEIM Trademark. The addition of the geographical term "FRANCE" and the TLD ".COM" (technical requirement of the registration) are not sufficient elements to escape the finding of confusing similarity between the disputed domain name and the Complainant's trademark.

UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.

Given the distinctiveness and reputation of the Complainant's prior mark acquired during the years and confirmed also by several UDRP decisions, it is inconceivable that the Respondent could have registered the disputed domain name for a mere chance without actual knowledge of the Complainant's rights in such mark and the intention to exploit such reputation by diverting traffic away from the Complainant's website.

The Complainant has submitted the results of a Google search carried out on the terms "BOEHRINGER INGELHEIM FRANCE", all of them related to the Complainant. Should the Respondent have performed a similar search on the Internet before registering the disputed domain name, he would have easily learnt about the Complainant's activities and trademark.

Even assuming that the Respondent had no knowledge of the Complainant's prior mark at the time of registration of the disputed domain name (which is highly unlikely), he omitted to verify that the disputed domain name would have infringed the Complainant's earlier rights or, even worse, he verified it and deliberately proceeded with the infringing registration.

As for the use, for a period of time after the registration the disputed domain name resolved to a parking page (passive holding). During this administrative proceeding, the disputed domain name was put into active use. Currently, the disputed domain name is directing Internet users to an e-commerce website in French selling pharmaceuticals and containing the Complainant's logo in the header of the website. This clearly confirms that the Respondent has targeted the Complainant with the registration and the use of the disputed domain name.

Therefore, the Panel finds that, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of such website or of the product or services on the Respondent's website (paragraph 4(b)(iv) of the Policy).

The Panel is satisfied that the Complainant has met the third requirement of the paragraph 4(a) of the Policy and finds that the disputed domain name has been registered and is being used in bad faith.

Consequently, the disputed domain name is to be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	**Ivett Paulovics**

DATE OF PANEL DECISION 2024-09-23

Publish the Decision