Decision for dispute CAC-UDRP-106832

Case number	CAC-UDRP-106832
Time of filing	2024-09-02 10:09:28
Domain names	jointheranksboehringer-ingelheim.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Boehringer Ingelheim Pharma GmbH & Co.KG

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Name	akosaa laisiaao

OTHER LEGAL PROCEEDINGS

The Panel is unaware of any pending or decided legal proceedings relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant owns a portfolio of trademarks, including the terms “BOEHRINGER INGELHEIM” in several countries, such as:

- International trademark “BOEHRINGER-INGELHEIM” n°221544, registered since July 2, 1959; and,

- International trademark “BOEHRINGER INGELHEIM” n°568844 registered since March 22, 1991;

- International trademark BOEHRINGER INGELHEIM n°1160936 registered since March 25, 2013.

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, the Complainant has become a global research-driven pharmaceutical enterprise and has around 53,500 employees. It is divided into two business areas: Human Pharma and Animal Health. In 2023, the Complainant achieved net sales of 25.6 billion euros.

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

The disputed domain name was registered on August 28, 2024 and resolves to a parking page with commercial links. Besides, MX servers are configured.

PARTIES CONTENTIONS

COMPLAINANT

1. The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights

The Complainant states that the disputed domain name is confusingly similar to its trademark “BOEHRINGER-INGELHEIM” and its domain names associated as the trademark is entirely contained.

The Complainant asserts that the addition of the generic term “JOIN THE RANKS” is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark. It does not change the overall impression of the designation as being connected to the Complainant’s trademark. Thus, there is a likelihood of confusion between the disputed domain name and the Complainant’s trademark.

It is well-established that “a domain name that wholly incorporates a Complainant’s registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP”.

Furthermore, the Complainant contends that the addition of the gTLD “.COM” does not change the overall impression of the designation as being connected to the Complainant’s trademark. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and its domain names associated.

Thus, the Complainant contends that the disputed domain name is confusingly similar to the Complainant’s trademark.

2. The Respondent has no rights or legitimate interests in respect of the disputed domain name

The Respondent contends that the Respondent is not identified in the Whois database as the disputed domain name. Past panels have held that a Respondent was not commonly known by a disputed domain name if the WHOIS information was not similar to the disputed domain name.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the domain name and he is not related in any way with the Complainant. The Complainant does not carry out any activity for, nor has any business with the Respondent.

Furthermore, the disputed domain name resolves to a parking page with commercial links. Past panels have found it is not a bona fide offering of goods or services or legitimate non-commercial or fair use.

Thus, the Complainant contends that the Respondent has no rights or legitimate interest on the disputed domain name.

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

The Complainant states that the disputed domain name is confusingly similar to its trademark.

Besides, all the results of a search of the term “JOIN THE RANKS BOEHRINGER INGELHEIM” refers to the Complainant.

Given the distinctiveness of the Complainant's trademark and its reputation, it is reasonable to infer that the Respondent has registered and used the domain name with full knowledge of the Complainant's trademark.

Furthermore, the disputed domain name resolves to a parking page with commercial links. The Complainant contends the Respondent has attempted to attract Internet users for commercial gain to his own websites thanks to the Complainant’s trademarks for its own commercial gain, which is an evidence of bad faith.

Finally, the disputed domain name has been set up with MX records which suggests that it may be actively used for email purposes. This is also indicative of bad faith registration and use because any email emanating from the disputed domain name could not be used for any good faith purpose.

On these bases, the Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith.

RESPONDENT

No administratively compliant Response has been filed.

RIGHTS

To the satisfaction of the Panel, the Complainant has shown that the disputed domain name is identical or confusingly similar to the trademark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

To the satisfaction of the Panel, the Complainant has 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

To the satisfaction of the Panel, the Complainant has 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 the Policy 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**

First, the Panel is satisfied that the Complainant has shown it owns rights in the "BOEHRINGER INGELHEIM" trademarks, with registration and evidence provided dating the trademark registration back to 1959.

Turning to analyze if there is a confusing similarity between the disputed domain name and the trademark. The disputed domain name consists of two main elements. The Panel will tackle the first element of the disputed domain name before moving on to the second one.

On the first element, the Panel notes, based on the record at hand, that the disputed domain name reproduces the trademark in its entirety, namely "BOEHRINGER INGELHEIM", with the addition of a hyphen between the two parts of it.

The second element of the disputed domain name is the words “join the ranks” without spaces separating them.

Adding this word heightens the appearance of confusing similarity with the trademark "BOEHRINGER INGELHEIM" since the Complainant seems to frequently use this term.

A more complete analysis of this will be conducted in the elements below, but suffice to say that in what relates to the first element, the slight difference, that is, the addition of the terms “join the ranks”, is immaterial and, therefore, insufficient to dispel the confusing similarity between the trademark and the disputed domain name. Similarly, as mentioned earlier, the second element of the disputed domain name, namely the term “join the ranks”, may even enhance the confusing similarity, as will be discussed below.

Consequently, the Panel determines that the Complaint has satisfied the Policy's first element set under paragraph 4(a)(i).

2. **Rights or Legitimate Interests**

Based on the evidence on record and acknowledging that the Respondent failed to produce any allegations or evidence necessary to demonstrate its rights or legitimate interests in the disputed domain name, the Panel must turn to the uncontested facts.

The uncontested facts indicate that a) the Respondent is not commonly known by the disputed domain name; b) the Respondent is not related to the Complainant; c) the Respondent is not authorized to carry out any business activity for the Complainant; d) the Respondent has no license or authorization to use the trademarks; e) the disputed domain name resolves to a parking page with commercial links and f) the disputed domain has activated MX records.

Based on the above, the record at hand, and on the balance of probability, and considering that the Respondent has failed to respond to the Complainant's contentions, the Respondent has consequently not rebutted the prima facie case, as described in paragraph 2.1 of WIPO 3.0 Overview.

The above fact pattern, on the balance of probabilities, and in conjunction with the use of the terms "join the ranks" in the disputed domain name, indicates, if nothing else, a likely intention to confuse Internet users with a likely implied association with the Complainant by appearing to be a formal channel of the Complainant.

The evidence on record leads the Panel to conclude that the Respondent did not have rights or legitimate interests in the disputed domain name.

Consequently, the Panel determines that the Respondent has no rights or legitimate interests in the disputed domain name. Subsequently, the Complainant has fulfilled the second requirement set under paragraph 4(a)(ii) of the Policy.

3. **Registered and Used in Bad Faith**

As per the record and evidence, the Panel finds that the Respondent was likely aware of the Complainant and had the Complainant's trademark in mind when registering the disputed domain name. This is further reinforced by the fact that the "BOEHRINGER INGELHEIM" trademark predates the registration of the disputed domain name. The global reputation of the "BOEHRINGER INGELHEIM" mark indicates that the Respondent knew or should have known about the Complainant's rights when registering the disputed domain name.

Furthermore, this conclusion is supported by the fact that the Respondent seems to evoke a connection to the Complainant's trademark by including the terms "join the ranks", which are frequently used by the Complainant in the disputed domain name. This appears to be an active effort by the Respondent to appear as a formal channel of the Complainant, without any visible explanation in the disputed domain name regarding its association with the Complainant. Without further explanation from the Respondent, this appears to misrepresent a link between the disputed domain name and the Complainant. In this case, as the record supports, the Respondent appears to have targeted the Complainant on the balance of probabilities.

All the preceding analysis leaves the Panel no other option than to conclude that the most likely intention of the Respondent was to intentionally attempt to attract, for commercial gain, Internet users to its website/disputed domain name by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website and/or disputed domain name, as per illustrated under paragraph 3.1 of WIPO 3.0 Overview.

In light of the case's circumstances, based on the available records, the Panel finds that the Complainant has proven that the disputed domain name was registered and is used in bad faith according to paragraph 4(a)(iii) of the Policy.

4. **Decision**

For the preceding reasons and in concurrence with the provisions specified under Paragraph 4(i) of the Policy and Paragraph 15 of the Rules, the Panel orders the transfer of the disputed domain name to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **jointheranksboehringer-ingelheim.com**: Transferred

PANELLISTS

Name	**Rodolfo Rivas Rea**

DATE OF PANEL DECISION 2024-09-26

Publish the Decision