Decision for dispute CAC-UDRP-106843

Case number	CAC-UDRP-106843
Time of filing	2024-09-11 12:27:18
Domain names	boehringer-ingelhelms.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	Stephen Connelly

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 is the owner of a portfolio of trademark and service mark registrations including the following:

International Trademark BOEHRINGER-INGELHEIM (figurative) registration n°221544, registered on July 2, 1959 for goods in classes 1, 2, 3, 4, 5, 6, 16, 17, 19, 29, 30, 32;

International Trademark BOEHRINGER INGELHEIM registration n°568844 registered on March 22, 1991 for goods in classes 1, 2, 3, 4, 5, 9, 10,16, 30, 31.

FACTUAL BACKGROUND

The Complainant is a manufacturer and merchant of pharmaceutical products with net sales of €25.6 billion in the year 2023, and has an established internet presence and owns a portfolio of domain names that incorporate the BOEHRINGER INGELHEIM and BOEHRINGER-INGELHEIM mark including <boehringer-ingelheim.com> which is the address of the Complainant's principal website.

The disputed domain name <boehringer-ingelhelms.com> was registered on September 3, 2024, and while it remains inactive resolving to a parking page, the Respondent has created an MX record for the disputed domain name which facilitates the creation of an e-mail account.

There is no information available about the Respondent except for that provided in the Complaint, as amended, the Registrar's WhoIs for the disputed domain name and the response from the Registrar to the request by the Center for details of the registration of the disputed domain name for the purposes of this proceeding.

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.

The Complainant has an established internet presence and owns a portfolio of domain names that incorporate the BOEHRINGER INGELHEIM and BOEHRINGER-INGELHEIM mark including <boehringer-ingelheim.com> which is the address of the Complainant's principal website.

The disputed domain name <boehringer-ingelhelms.com> was registered on September 3, 2024, and while it remains inactive, resolving to a parking page, the Respondent has created an MX record for the disputed domain name which facilitates the creation of an e-mail account.

There is no information available about the Respondent except for that provided in the Complaint, as amended, the Registrar's WhoIs for the disputed domain name and the response from the Registrar to the request by the Center for details of the registration of the disputed domain name for the purposes of this proceeding.

The Complainant claims rights in the BOEHRINGER INGELHELMS and BOEHRINGER-INGELHELMS mark established by its ownership of the portfolio of registered trademarks described above and extensive use of the mark by its group of companies in the manufacture and marketing of pharmaceuticals. It submits that it is a global research-driven pharmaceutical enterprise with 53,500 employees. It is divided into two business areas: Human Pharma and Animal Health. In 2023, the group achieved net sales of €25.6 billion.

The Complainant alleges that the disputed domain name is confusingly similar to, and is an obvious misspelling of, its BOEHRINGER-INGELHEIM trademark.

It is submitted that the substitution of the letter "i" by the letter "l" and the addition of the letter "s" in the disputed domain name <boehringer-ingelhelms.com> are characteristic of a typosquatting practice intended to create confusing similarity between the Complainant's trademark and the disputed domain name; and previous panels have found that a slight spelling variation does not prevent a finding that a domain name at issue is confusing similar to a trademark relied upon by a complainant.

Furthermore, the Complainant contends that the addition of the generic Top-Level Domain ("gTLD") extension <.com> does not change the overall impression of the designation as being connected to the Complainant's trademark, and does not prevent the likelihood of confusion between the disputed domain name and its trademark.

It is next alleged that the Respondent has no rights or legitimate interests in the disputed domain name and referring to the screen capture exhibited in an annex to the Complaint, Complainant argues that:

the Respondent is not identified in the Whois database as the disputed domain name;

the Respondent is not related to the Complainant in any way;

the Complainant does not carry out any activity for, and has no business with, the Respondent;

the Complainant has not granted any license or authorization to the Respondent to make any use of the Complainant's BOEHRINGER-INGELHEIM trademark, or to apply for registration of the disputed domain name;

the disputed domain name is a typosquatted version of the BOEHRINGER-INGELHEIM mark, explaining that typosquatting is the practice of registering a domain name in an attempt to take advantage of Internet users' typographical errors;

the Respondent has not demonstrated any activity in respect of the disputed domain name;

the exhibited screen capture demonstrates that the disputed domain name resolves to a parking page and as the Respondent has not made any use of the disputed domain name since its registration, it is clear that the Respondent has no demonstrable plan to use it.

The Complainant next alleges that the disputed domain name was registered and is being used in bad faith, arguing that the disputed domain name is confusingly similar to the Complainant's trademark, and given the distinctiveness of the Complainant's trademark and its reputation, it is reasonable to infer that the Respondent registered and used the disputed domain name with full knowledge of the Complainant's trademark. See Boehringer Ingelheim Pharma GmbH & Co. KG v. Marius Graur WIPO Case No. D2019-0208, ("Because of the very distinctive nature of the Complainant's trademark [BOEHRINGERINGELHEIM] and its widespread and longstanding use and reputation in the relevant field, it is inconceivable that the Respondent registered the disputed domain name without being aware of the Complainant's legal rights.").

It is further argued that the registration of the disputed domain name <boehringer-ingelhelms.com> being a misspelling of the BOEHRINGER-INGELHEIM mark constitutes registration and use in bad faith.

Moreover, the Complainant argues that it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law. As prior panels established under the Policy have held, the incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use. Please see for instance: Telstra Corporation Limited v. Nuclear Marshmallows WIPO Case No. D2000-0003 and CBS Broadcasting, Inc. v. Dennis Toeppen WIPO Case No. D2000-0400.

Finally, the Complainant refers to a copy document which is exhibited in an annex to the Complaint, which shows that the Respondent has created an MX record for the Complaint.

The Complainant submits that because an MX record allows the Respondent to use the disputed domain name to establish an e-mail account it is indicative of bad faith because any e-mail emanating from the disputed domain name could not be used for any good faith purpose. See for instance JCDECAUX SA v. Handi Hariyono CAC Case No. 102827, ("There is no present use of the disputed domain name but there are several active MX records connected to the disputed domain name. It is concluded that it is inconceivable that the Respondent will be able to make any good faith use of the disputed domain name as part of an e-mail address.").

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

Confusing similarity

The Complainant has provided uncontested convincing evidence of its rights in the BOEHRINGER INGELHELMS and BOEHRINGER-INGELHELMS mark established by its ownership of the portfolio of registered trademarks described above and extensive use of the mark by its group of companies in the manufacture and marketing of pharmaceuticals with annual net sales of €25.6 billion in 2023.

The disputed domain name is composed of Complainant's BOEHRINGER-INGELHEIM trademark albeit with the substitution of the letter "i" by the letter "l" and the addition of the letter "s" and the generic Top Level Domain ("gTLD") extension <.com>.

The Complainant's registered trademarks are clearly recognisable within the disputed domain name <boehringer-ingelhelms.com> and are the only distinctive element in the disputed domain name.

The substitution of the letter "i" by the letter "l" and the addition of the letter "s" likely to go unnoticed by the casual Internet user or

reader of an e-mail address that incorporates the disputed domain name, and therefore do not prevent a finding of confusing similarity.

In the circumstances of this case the gTLD extension <.com> within the disputed domain name may be ignored for the purposes of comparing Complainant's mark and the disputed domain name, because it would be considered by Internet users to be a necessary technical element for a domain name registration.

This Panel finds therefore that the disputed domain name is identical to the BOEHRINGER-INGELHEIM mark in which the Complainant has rights and the Complainant has therefore succeeded in the first element of the test in Policy paragraph 4(a)(i).

Legitimate Interests

Complainant has made out a prima facie case that the Respondent has no rights legitimate interests in the disputed domain names as set out in Complainant's detailed submissions above.

It is well established that once a complainant makes out a prima facie case that a respondent has no rights or legitimate interests in the domain name at issue, the burden of production shifts to the respondent to prove its rights or legitimate interests.

Respondent has failed to discharge that burden and therefore this Panel must find that Respondent has no rights or legitimate interests in the disputed domain name.

Complainant has therefore succeeded in the second element of the test in Policy paragraph 4(a)(ii).

Bad faith

The Complainant's well known and eponymous BOEHRINGER INGELHEIM and BOEHRINGER-INGELHEIM registered trademarks are clearly recognizable within and is confusingly similar to the disputed domain name.

The earliest registration of the BOEHRINGER-INGELHEIM mark is dated July 2, 1959, whereas the disputed domain name <boehringer-ingelhelms.com> was registered on September 3, 2024, sixty-five years later.

The composition of the disputed domain name <boehringer-ingelhelms.com> has no meaning other than as a misspelling of the Complainant's mark. There appears to be no plausible reason for registering the disputed domain name other than to engage in typosquatting by registering the disputed domain name to create confusion among Internet users.

On the balance of probabilities, therefore, this Panel finds that the disputed domain name was in fact chosen and registered with Complainant's mark in mind with the intention of taking predatory advantage of Complainant's rights and goodwill in the BOEHRINGER-INGELHEIM mark.

The exhibited screen capture shows that the disputed domain name resolves to an inactive parking page. There is no indication that the Respondent has put the disputed domain name to any active use or intends to use the disputed domain name for any legitimate or bona fide purpose. In the absence of a Response or other communication or explanation from the Respondent, this Panel finds that the passive holding of the disputed domain name by the Respondent constitutes use in bad faith for the purposes of the Policy.

Of great concern is the fact that the Respondent has created an MX record for the disputed domain name which facilitates the creation of an e-mail account.

This Panel finds therefore that the disputed domain name was registered and is being used in bad faith and Complainant has succeeded in the third element of the test in Policy paragraph 4(a)(iii).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	**James Bridgeman**

DATE OF PANEL DECISION 2024-10-10

Publish the Decision