Decision for dispute CAC-UDRP-106967

Case number	CAC-UDRP-106967
Time of filing	2024-10-21 10:18:10
Domain names	boehrimger-lngelheim.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	WebXpo Inc

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 claims to own a large portfolio of trademarks including the wording “BOEHRINGER INGELHEIM” in several countries, including but not limited to the followings:

- international trademark BOEHRINGER-INGELHEIM no. 221544, registered since 2 July 1959; and
- international trademark BOEHRINGER INGELHEIM no. 568844, registered since 22 March 1991.

Furthermore, the Complainant owns multiple domain names consisting in the wording “BOEHRINGER INGELHEIM”, such as <boehringer-ingelheim.com> registered since 1995-09-01.

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, BOEHRINGER INGELHEIM 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, BOEHRINGER INGELHEIM achieved net sales of 25.6 billion euros.

The disputed domain name was registered on 15 October 2024 and resolves to a parking page.

PARTIES CONTENTIONS

The Complainant contends that the 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).

The Complainant claims rights in the BOEHRINGER-INGELHEIM mark through its trademark registrations. By virtue of its trademark registrations, Complainant has proved that it has rights in the mark under paragraph 4(a) of the Policy. See Avast Software s. r. o. v Milen Radumilo, 102384, (CAC 2019-03-12).

The Complainant further claims that the disputed domain name is confusingly similar to its trademark BOEHRINGER-INGELHEIM and its primary domain name <boehringer-ingelheim.com>. The misspelling of the Complainant's trademark BOEHRINGER-INGELHEIM, i.e. the substitution of the letters "N" and "I" by the letters "M" and "L" are characteristic of a typosquatting practice intended to create confusing similarity between the Complainant's trademark and the disputed domain name.

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.

- Complainant's trademark: BOEHRINGER-INGELHEIM
- Complainant's primary domain name: <boehringer-ingelheim.com> (BOEHRINGER-INGELHEIM.COM)
- The disputed domain name: <boehrimger-lngelheim.com> (BOEHRIMGER-LNGELHEIM.COM)

By doing side-by-side comparisons, the Panel accepts that the changes of the characters are extremely difficult to be spotted by Internet users and do not alter the overall impression of the designation as being connected to the Complainant and its trademark The Panel is also of the view that the ".com" generic top-level domain ("gTLD") is irrelevant when establishing whether or not a mark is identical or confusingly similar for the purposes of paragraph 4(a)(i) of the Policy. See Intesa Sanpaolo S.p.A. v. carlos daniel dos santos, 103116 (CAC 2020-07-23) ("The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name. 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. It this comparison, the cc- or g- TLD is usually not taken into account.")

For the foregoing reasons, the Panel finds the Complainant has satisfied 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). More specifically, the Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name, and the burden of prove then shifts to the Respondent to show it does have rights or legitimate interests. See PepsiCo, Inc. v Smith power production, 102378, (CAC 2019-03-08) ("The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.").

The Complainant claims that neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademark BOEHRINGER-INGELHEIM, or apply for registration of the disputed domain name by the Complainant. The Complainant further submits that the Respondent has not used, nor prepared to use, the disputed domain name in connection with a bona fide offering of goods or services, nor a legitimate noncommercial or fair use. Furthermore, the Complainant also claims that the disputed domain name is a typosquatted version of the trademark BOEHRINGER-INGELHEIM. Typosquatting is the practice of registering a domain name in an attempt to take advantage of Internet users' typographical errors and can be evidence that a respondent lacks rights and legitimate interests in the domain name. Besides, the disputed domain name resolves to a parking page. The Complainant contends that Respondent did not make any use of the disputed domain name since its registration, and it confirms that Respondent has no demonstrable plan to use it. It demonstrates a lack of legitimate interests in respect of the disputed domain name.

The Panel finds that the Complainant has established a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name. The burden of proof has been shifted to the Respondent to prove that it has right or legitimate interests to the disputed domain name. However, the Respondent has not submitted a compliant response to rebut the assertions within the required period of time.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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).

The Complainant reiterates that 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. Therefore, by registering the disputed domain name with the misspelling of the trademark BOEHRINGER-INGELHEIM, the Complainant can state that this practical was intentionally designed to be confusingly similar with the Complainant’s trademark.

Moreover, the disputed domain name resolves to a parking page. The Complainant contends that the Respondent has not demonstrated any activity in respect of the disputed domain name, and 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.

Having considered to the totality of the circumstances and without receiving an administrative compliant response, the Panel is of the view that the Respondent is more likely than not to have actual knowledge of Complainant's BOEHRINGER-INGELHEIM trademark during the registration of the disputed domain name taking into the account that the disputed domain name was registered more than 60 years later than the Complainant registered its BOEHRINGER-INGELHEIM in 1959. The Panel also considered that the passively holding of the disputed domain name also constitutes bad faith, see Intesa Sanpaolo S.p.A. v. Amir Mt, 103701 (CAC 2021-05-14) ("Panels have found that the non-use of a domain name could constitute registration and use of bad faith under the doctrine called as 'passive holding'.")

For the foregoing reasons, the Panel finds the Complainant has satisfied 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

Having established all three elements required under the UDRP Policy, the Panel concludes that the disputed domain name should 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. **boehrimger-lngelheim.com**: Transferred

PANELLISTS

Name	**Mr Paddy TAM**

DATE OF PANEL DECISION 2024-11-14

Publish the Decision