Decision for dispute CAC-UDRP-107128

Case number	**CAC-UDRP-107128**
Time of filing	**2024-12-04 09:49:12**
Domain names	**boehringergo.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

Organization	**Shepherd**

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 the following registered trademark:

Mark	Territory	Registration No.	Registration date	Classes
BOEHRINGER (word)	IR Designations - AG - AU - BQ - CW - DK - EE - FI - GB - GE - IE - IS - JP - KR - LT - NO - SE - SG - SX - TM - TR - UZ – ZM - AL - AM - AZ - BA - BG - BT - BY - CH - CN - CU - DZ - EG - HR - HU - KE - KG - KP - KZ - LI - LR - LS - LV - MA - MC - MD - ME - MK - MN - MZ - PL - RO - RS - RU - SD - SI - SK - SL - SM - SZ - TJ - UA –	799761	02.12.2002	01, 03, 05, 10, 16, 30, 31, 35, 41, 42, 44

	VN			

In addition, the Complainant owns at least one domain name including the term BOEHRINGER, namely <boehringer-ingelheim.com>.

FACTUAL BACKGROUND

The Complainant is a German family-owned pharmaceutical enterprise with a history tracing back to 1885, when Albert Boehringer established the company in Ingelheim am Rhein. Over the years, the Complainant's group has grown into a global, research-driven organization employing approximately 53,500 people. Its operations are divided into two primary sectors: Human Pharma and Animal Health. In 2023, the group reported net sales amounting to 25.6 billion euros.

According to the Complainant's non-contested allegations, the Respondent has no rights or legitimate interest in respect of the disputed domain name and is not related in any way to the Complainant's business.

The Registrar of the disputed domain name confirmed that the Respondent is the current Registrant, and that English is the language of the registration agreement.

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

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

PARTIES CONTENTIONS:

COMPLAINANT:

First element: Confusingly similar to the protected mark

The Complainant argues that the disputed domain name is confusingly similar to its BOEHRINGER trademark and related domain names because the trademark is entirely included within the disputed domain name. The addition of the term "GO" does not sufficiently differentiate the domain name from the trademark, as it does not alter the overall impression of the name being associated with the Complainant's brand. Moreover, the Complainant asserts that the inclusion of the generic top-level domain (gTLD) ".COM" does not affect the overall impression of the designation as being connected to the Complainant's trademark.

Second element: Rights or legitimate interest

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

The Complainant claims that the Respondent is not identified in the Whois database as the registrant of the disputed domain name.

Further, the Complainant asserts that it is not related in any way to the Respondent has not authorized or licensed the Respondent to use the BOEHRINGER-INGELHEIM trademark or to register the disputed domain name.

The Complainant notes that the disputed domain name resolves to an event-related website prominently featuring the Complainant's trademark. This site may be intended to collect personal information from the Complainant's clients, posing a risk of deception. Consequently, according to the Complainant, the Respondent's use of the domain name cannot be considered a bona fide offering of services or fair use, as it is likely to mislead users into believing they are interacting with the Complainant's official website.

Third element: The domain name has been registered and is being used in bad faith

The Complainant asserts that the disputed domain name has been registered and is being used in bad faith.

The Complainant argues that the disputed domain name closely resembles its well-known trademark, BOEHRINGER. This assertion is supported by at least two past UDRP decisions recognizing the trademark's notoriety. Additionally, the domain redirects to a website prominently displaying the Complainant's logo, suggesting that the Respondent was aware of the Complainant's rights at the time of registration.

According to the Complainant, given the distinctiveness and reputation of the BOEHRINGER trademark, it is reasonable to conclude that the Respondent registered and is using the disputed domain name with full knowledge of the Complainant's trademark. The disputed domain name resolves to an event-related website featuring the Complainant's trademark but does not contain any information about the Respondent. The Complainant claims such use creates a likelihood of confusion, intentionally drawing users to the website for commercial gain by implying a connection to the Complainant. Additionally, the website may facilitate the collection of personal information.

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

RESPONDENT:

The Respondent did not submit an administratively compliant response to the Complaint.

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

On December 4, 2024 the Respondent was notified by the dispute resolution provider ("Provider") regarding the commencement of the instant UDRP proceedings. In this notice, the Respondent was properly advised that the deadline for their response in the CAC online platform was within 20 days of commencement, with the option to request an additional 4 calendar-day extension of the deadline.

On December 20, 2024, the Provider sent the Respondent a reminder, informing them that the deadline for filing the response on the online platform would expire on December 24, 2024.

On December 20, 2024, the Respondent contacted the Provider via email as follows:

"Greetings,

I purchased this domain on behalf of our client from GoDaddy. The domain was available when I purchased it back in November, 2024. It is intended to be used at an event in January.

May I receive more information regarding why it is being disputed and what the next actions are?

Regards,

Kelley Stam"

In response to the Respondent's above email, on December 23, 2024, the Provider emailed the Respondent and reaffirmed that the UDRP proceedings had been commenced against them, that a response had to be submitted via the online platform, and that the deadline for filing the response was due to expire on December 24, 2024.

The Provider advises that the Respondent accessed the online platform. However, no response was received via the online platform, nor was there a request to extend the deadline, nor did the Respondent provide any further communication regarding the proceedings subsequent to their informal enquiry email of December 20, 2024 reproduced above. As such, no administratively compliant Response was received within the Response deadline or thereafter.

Accordingly, 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

THREE ELEMENTS THE COMPLAINANT MUST ESTABLISH UNDER THE POLICY

According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that a disputed domain name should be transferred or cancelled:

(i) the disputed domain name is identical or confusingly similar to a trademark 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 in bad faith.

The Panel has examined the evidence available to it and has come to the following conclusions concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

(A) THE COMPLAINANT'S RIGHTS AND THE CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAME TO THE COMPLAINANT'S RIGHTS

Sufficient evidence has been submitted by the Complainant of its trademark rights in the term BOEHRINGER in several classes in numerous territories around the world. Such trademark rights were created and registered long prior to November 1, 2024, the creation date of the disputed domain name. A nationally or regionally registered trademark confers on its owner sufficient rights to satisfy the requirement of having trademark rights for the purposes of standing to file a UDRP case. Accordingly, the Panel finds that the Complainant possesses rights in its BOEHRINGER trademark such that it has standing under the Policy.

UDRP panels have held that where the asserted trademark is recognizable within a disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under paragraph 4(a)(i) of the Policy. See, e.g., LEGO Juris A/S v. DBA David Inc/ DomainsByProxy.com, Case No. D2011-1290 (WIPO, September 20, 2011) ("the mere addition of the words ‚Ninjago' and ‚Kai' is not sufficient to exclude the likelihood of confusion between the disputed domain name and the Complainant's trademark.").

In the present case, in assessing confusing similarity, the Panel finds the disputed domain name is confusingly similar to the Complainant's trademark, because it incorporates the entirety of the BOEHRINGER trademark, and differs from such mark merely by adding the "GO" term. This addition does not prevent a finding of confusing similarity in light of the prominence of the distinctive BOEHRINGER mark within the disputed domain name.

The TLD – in this case ".com" - may usually be ignored for the purpose of determination of identity or confusing similarity between a domain name and the Complainant's trademark as it is technical requirement of registration (see paragraph 1.11.1 WIPO Overview 3.0).

Accordingly, the Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy and the disputed domain name is confusingly similar to the Complainant's mark.

(B) THE RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAME

The second element of the Policy requires that the Complainant establishes that the Respondent has no rights or legitimate interests in the disputed domain name. The approach generally adopted by panels, when considering the second element, is that if a complainant makes out a prima facie case, the burden of proof shifts to the respondent to rebut it (see WIPO Overview 3.0., Paragraph 2.1). ("While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of 'proving a negative', requiring information that is often primarily within the knowledge or control of the respondent. As such, where a 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element."). However, the burden of proof still remains with the complainant to make out its prima facie case on a balance of probabilities. Moreover, the wording of paragraph 4(a)(ii) of the Policy requires a complainant to establish that the respondent has no rights or legitimate interests in the domain name in issue. Simply establishing that the complainant also has rights in the domain name in issue is insufficient.

As an initial point on the second element, the Complainant states that the Respondent is not licensed, nor authorized to use the Complainant's BOEHRINGER trademark in the disputed domain name or elsewhere, nor related in any way to the Complainant.

Paragraph 4(a)(ii) of the Policy contemplates examining the available facts to determine whether a respondent has rights or legitimate interest in the domain name. Paragraph 4(c) sets out circumstances under which a respondent may demonstrate that it does have such rights or interests.

The first circumstance, under Paragraph 4(c)(i), is where "before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services". Here, the disputed domain name resolves to a website purporting to display the Complainant's upcoming events, which there are none, while using the BOEHRINGER trademark without any license or authorization. The website has the prominent heading "Upcoming Events" and a search bar to "Search for an event" while concurrently stating that there are "No events found". Accordingly, due to the lack of authorization from the Complainant and any legitimate content, the Panel finds no evidence of a bona fide offering or goods or services or demonstrable preparations to use per Policy 4(c)(i) and Respondent has not established rights or legitimate interests with respect to the disputed domain name thereunder.

The second circumstance, under Paragraph 4(c)(ii), concerns cases where the respondent is commonly known by the domain name. Here, according to the registrar verification, the Respondent's name is "Kelly Stam", of the organization "Shepherd" – which has no similarity or connection to the disputed domain name. There is no evidence that the Respondent is commonly known by the disputed domain name. As such, this second circumstance of legitimate rights or interests under the Policy is not applicable to the Respondent.

Regarding the third circumstance, under Paragraph 4(c)(iii) of the Policy, there is no evidence that the Respondent is making a legitimate non-commercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's BOEHRINGER trademark. According to the evidence submitted, the disputed domain name merely resolves to the event related website, displaying the Complainant's trademark and, purportedly, upcoming events. As such, none of the accepted categories of fair use - such as news reporting, commentary, political speech, education etc. – are found to apply and thus the Panel does not find any legitimate non-commercial or fair use on the part of the Respondent.

Accordingly, the Complainant has sufficiently made out its prima-facie case on the second element of the Policy. Thus, the burden of proof is shifted to the Respondent to rebut the Complainant's case. Here, because the Respondent has not participated in these proceedings, there is no such rebuttal to consider, and the Complainant prevails.

(C) THE DISPUTED DOMAIN NAME HAS BEEN REGISTERED AND IS BEING USED IN BAD.

The third element requires the Complainant to show that the disputed domain name has been registered and used in bad faith under paragraph 4(a)(iii) of the Policy. Further, Paragraph 4(b) of the Policy sets out a non-exhaustive list of four circumstances, any one of which may be evidence of the registration and use of a domain name in bad faith.

The four specified circumstances are:

(i) circumstances indicating that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) The Respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or

(iii) The Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product.

As noted above, there is no evidence that the Respondent is commonly known by the disputed domain name and the Complainant confirms that the Respondent has not been authorized by the Complainant to use the Complainant's trademark(s) and/or register the disputed domain name. Nor is there any business or other association between the Complainant and the Respondent.

Panels have consistently found that the registration of a domain name that is confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith (see Section 3.1.4 WIPO Overview 3.0). The Complainant's BOEHRINGER trademark is a distinctive ten-letter string and enjoys considerable reputation within the pharmaceutical sector. The Complainant was formed in 1885 and has been in business since, employing approximately 53,500 people and reporting net sales amounting to 25.6 billion euros. Prior panels have confirmed the notoriety of the Complainant's mark, see, e.g. WIPO Case No. D2019-0208, Boehringer Ingelheim Pharma GmbH & Co. KG v. Marius Grau, ´´Because of the very distinctive nature of the Complainant's trademark [BOEHRINGER INGELHEIM] 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." The same logic applies in the instant case, and this Panel finds that the because of the established status of the Complainant including its online and significant international presence, the Respondent either knew, or should have known, that the disputed domain name would be confusingly similar to the Complainant's trademarks and that they registered the disputed domain name with knowledge of the Complainant's trademark.

The evidence of targeting by the Respondent is compelling. The disputed domain name comprises of the Complainant's distinctive BOEHRINGER trademark with the addition of the term "go". According to the screenshot submitted, the disputed domain name resolves to a website purportedly displaying the Complainant's upcoming events, which there are none, while using the BOEHRINGER trademark. Thus, the evidence clearly demonstrates that the Respondent had the Complainant in mind when registering and using the disputed domain name.

As a final point, the Panel may take into consideration the Respondent's silence throughout these proceedings.

In light of the above analysis, the Panel concludes that the Complainant has made out its case that the disputed domain name was registered and are being used in bad faith, and thus has satisfied the requirements under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **boehringergo.com**: Transferred

PANELLISTS

Name	**Claire Kowarsky**

DATE OF PANEL DECISION 2025-01-06

Publish the Decision