

Decision for dispute CAC-UDRP-103710

Case number	CAC-UDRP-103710
-------------	-----------------

Time of filing	2021-04-01 11:01:36
----------------	---------------------

Domain names	boehringer-usa.com
--------------	--------------------

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)
--------------	---

Complainant

Organization	Boehringer Ingelheim Pharma GmbH & Co.KG
--------------	--

Complainant representative

Organization	Nameshield (Enora Millocheau)
--------------	-------------------------------

Respondent

Organization	ICMO
--------------	------

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 owns a large portfolio of trademarks including the wording "BOEHRINGER" in several countries, such as the international trademark BOEHRINGER® n° 799761 registered since December 2, 2002 and the European trademark BOEHRINGER® n° 2932853 registered since March 2, 2005.

The Complainant also owns a number of domain names including "BOEHRINGER", such as <boehringer.com> registered and used since January 12, 2000.

FACTUAL BACKGROUND

The Complainant is a 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. BOEHRINGER INGELHEIM has become a global research-driven pharmaceutical enterprise and has today about 51,000 employees. The three business areas of BOEHRINGER INGELHEIM are human pharmaceuticals, animal health and biopharmaceuticals. In 2019, net sales of the BOEHRINGER INGELHEIM group amounted to about EUR 19 billion.

The disputed domain name <boehringer-usa.com> was registered on March 25, 2021 and resolves to a parking page with commercial links.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The disputed domain name is confusingly similar to the Complainant's trademark BOEHRINGER®.

The substitution of the letter "R" by the letter "N" constitutes an obvious, or intentional misspelling of the trademark BOEHRINGER® and therefore does not suffice to distinguish the domain name from the Complainant's trademark.

Moreover, the addition of the hyphen and the abbreviation "USA" do not change the overall impression of the designation as being connected to the Complainant's trademark.

For instance WIPO Case No. D2020-0868, ArcelorMittal (Société Anonyme) v. El Manuel Es Pura Bellesa, Acero <mitalmexico.com> ("the Panel accepts that the word "mexico" is a geographical term and does not suffice to prevent a finding of confusing similarity between the disputed domain name and the MITTAL Mark").

The addition of the generic Top-Level Domain suffix ".COM" does not change the overall impression of the designation as being connected to the trademark BOEHRINGER®. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademarks and its domain names.

WIPO Case No. D2006-0451, F. Hoffmann-La Roche AG v. Macalve e-dominios S.A. ("It is also well established that the specific top level of a domain name such as ".com", ".org" or ".net" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar.").

The Respondent does not have any rights or legitimate interest in the disputed domain name.

According to the WIPO Case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd., a Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Complainant asserts 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.

For instance Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com> ("Here, the WHOIS information of record identifies Respondent as "Chad Moston / Elite Media Group." The Panel therefore finds under Policy 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy 4(c)(ii).").

The Complainant contends that the Respondent is not affiliated with nor authorized by the Complainant in any way. The Complainant does not carry out any activity for, nor has any business with the Respondent. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademarks BOEHRINGER®, or apply for registration of the disputed domain name by the Complainant.

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

- Forum Case No. FA 970871, Vance Int'l, Inc. v. Abend (concluding that the operation of a pay-per-click website at a confusingly similar domain name does not represent a bona fide offering of goods or services or a legitimate noncommercial or fair use, regardless of whether or not the links resolve to competing or unrelated websites or if the respondent is itself commercially profiting from the click-through fees); and

- WIPO Case No. D2007-1695, Mayflower Transit LLC v. Domains by Proxy Inc./Yariv Moshe ("Respondent's use of a domain name confusingly similar to Complainant's trademark for the purpose of offering sponsored links does not of itself qualify as a bona fide use.").

The disputed domain name has been registered and is being used in bad faith

Past panels have confirmed that the Complainant's trademark BOEHRINGER® is widely known:

- CAC Case No. 101761, Boehringer Ingelheim Pharma GmbH & Co.KG v. Private Registry Authority ("In the view of the Panel, the Respondent must have been aware of the famous trademarks [BOEHRINGER] of the Complainant when registering the disputed domain name."); and

- CAC Case No. 101199, BOEHRINGER INGELHEIM PHARMA GMBH & CO.KG v. Cameron David Jackson <boehringer.xyz> ("Given the notoriety of the Complainant's trademark [BOEHRINGER], it seems impossible for the Respondent to use the domain name in good faith").

All the results of an Internet search of the term "BOEHRINGEN USA" refer to the Complainant.

Consequently, given the distinctiveness of the Complainant's trademarks and its reputation, it is reasonable to infer that the Respondent has registered and used the disputed 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 website which is evidence of bad faith.

For instance WIPO Case No. D2018-0497, StudioCanal v. Registration Private, Domains By Proxy, LLC / Sudjam Admin, Sudjam LLC ("In that circumstance, whether the commercial gain from misled Internet users is gained by the Respondent or by the Registrar (or by another third party), it remains that the Respondent controls and cannot (absent some special circumstance) disclaim responsibility for, the content appearing on the website to which the disputed domain name resolve [...] so the Panel presumes that the Respondent has allowed the disputed domain name to be used with the intent to attract Internet users for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, affiliation, or endorsement of the Respondent's website to which the disputed domain name resolves. Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith.").

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

The disputed domain name registered in 2021 is confusingly similar to the Complainant's BOEHRINGER mark (registered, inter alia, as an international trade mark for pharmaceuticals since 2002) merely substituting an 'N' for the second 'R' and adding a hyphen, the geographical term 'USA' and the gTLD .com which do not prevent said confusing similarity.

The disputed domain name has been used for commercial pay per click links which is not a bona fide offering of goods or services or a legitimate non commercial or fair use. It is registration and use in bad faith diverting Internet users for commercial gain.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOEHRINGER-USA.COM**: Transferred
-

PANELLISTS

Name	Dawn Osborne
------	---------------------

DATE OF PANEL DECISION	2021-04-23
------------------------	------------

Publish the Decision
