

Decision for dispute CAC-UDRP-103730

Case number **CAC-UDRP-103730**

Time of filing **2021-04-13 00:00:00**

Domain names **boehringerengelheimpetrebates.com, boehringerilheimpetrebates.com**

Case administrator

Organization **Denisa Bilík (CAC) (Case admin)**

Complainant

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

Complainant representative

Organization **Nameshield (Enora Millocheau)**

Respondent

Organization **Fundacion Comercio Electronico**

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 names.

IDENTIFICATION OF RIGHTS

The Complainant proved to own the following trademarks:

- i) IR Reg. no. 221544 for the trademark "Boehringer-Ingelheim." registered on July 2nd, 1959 in classes 1, 2, 3, 4, 5, 6, 16, 17, 19, 29, 30, 32;
- ii) IR Reg. no. 568844 for the trademark "Boehringer Ingelheim" registered on March 22nd 1991 in classes 1, 2, 3, 4, 5, 9, 10, 16, 30, 31.

The Complainant submitted evidence attesting to the registration of the domain name <boehringerengelheimpetrebates.com>.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant, Boehringer Ingelheim Pharma GmbH & Co.KG, is active in the field of human pharmaceuticals, animal health and biopharmaceuticals. According to the Complainant submissions, Boehringer Ingelheim Pharma GmbH & Co.KG, is one of the world's 20 leading pharmaceutical companies, with roughly 52,000 employees worldwide and 19.6 billion euros in net sales.

The Complainant owns the trademark "BOEHRINGER INGELHEIM" protected in several countries, including the IR Registration no. 221544 dating back to July 2nd 1959 and the IR Registration no. 568844 dating back to March 22nd 1991

The Complainant also owns the domain name <boehringeringelheimpetrebates.com> registered on December 19th, 2019.

The disputed domain names were registered on April 6th, 2021 and they are not active.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant claims that the disputed domain names are confusingly similar to its prior trademarks and domain name as the addition/substitution of some letters is not sufficient to exclude a finding of confusing similarity.

The Complainant supports its allegations citing several UDRP decisions which confirmed that misspelling of the complainant's trademark does not prevent domain names from being confusingly similar to the trademarks.

Finally, the Complainant contends that TLD are disregarded when assessing confusing similarity as they are considered as standard registration requirements.

The Complainant claims that the Respondent has no rights nor legitimate interest in registering the disputed domain names. According to the Complainant assertions, there is no evidence that the Respondent is known as the disputed domain names or is, in some way, authorized to use the BOEHRINGER INGELHEIM trademark.

The Complainant points out that the disputed domain names are not used and such circumstance excludes the finding of a "bona fide offering of goods or services" or a "legitimate non-commercial or fair use" for the purposes of the Policy.

As regards registration and use in bad faith, the Complainant claims that since the BOEHRINGER INGELHEIM trademark is widely known, it is reasonable to infer that the Respondent has registered the disputed domain names with full knowledge of the Complainant's rights.

Registration in bad faith could be also inferred by the fact that the domain names are very similar to the domain name <boehringeringelheimpetrebates.com>, used by the Complainant to offer rebates on pet health products.

The disputed domain names are inactive and according to the Complainant's submissions it is not conceivable a use of <BOEHRINGERINGELHEIMPETREBASTES.COM> / <BOEHRINGERINGILHEIMPETREBATES.COM> which will not exploit the reputation and distinctiveness of the Complainant's trademarks.

RESPONDENT:

The Respondent did not file an administrative reply to the Complaint.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 have been registered and are 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

1. The disputed domain names are confusingly similar to a trademark in which the Complainant has rights.

The Complainant has successfully proved to be the owner of the trademark BOEHRINGER INGELHEIM (IR. reg. nos. 221544 and 568844) and of the domain name <boehringerengelheimpetrebates.com>.

The Panel finds that in both domain names the Complainant's trademark BOEHRINGER INGELHEIM is fully recognizable. The Panel agrees that the addition of the element "petrebastes" / "petrebates" does not exclude the risk of confusion given that in both domain names the initial element is identical or highly similar to the Complainant's trademark. It is of relevance that the elements "petrebastes" / "petrebates" are identical / highly similar to "petrebates" used in the Complainant's domain name <boehringerengelheimpetrebates.com>. This fact increases rather than excludes the likelihood of confusion of the public.

According to a consolidated case law in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in it, the confusing similarity threshold is met.

Furthermore, the addition of ".com" is generally disregarded in view of its technical function.

As a consequence, the Panel finds that the disputed domain names are confusingly similar to the Complainant's trademarks, for the purposes of the First Element of the Policy.

2. The Respondent lacks rights or legitimate interests in the disputed domain names.

Pursuant to paragraph 4(a)(ii) of the Policy, a complainant is required to make out a prima facie case that a respondent lacks rights or legitimate interests in the domain name. Once such a prima facie case is made, the respondent carries the burden of demonstrating its 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.

In this case, the Panel finds that the Complainant's submitted evidence and allegations are sufficient to establish a prima facie case of Respondent's lack of rights and legitimate interests in the disputed domain names.

According to the information provided by the Complainant and not contested by the Respondent, Fundacion Comercio Electronico is not commonly known by the disputed domain name nor it is authorized to use the Complainant's trademarks.

Additionally, the disputed domain names are not used. Therefore, the disputed domain names are not used for a bona fide offering of goods or services nor for legitimate non-commercial/ fair purposes.

For these reasons, the Panel takes the view that the Respondent lacks rights or legitimate interests in the disputed domain names for the purposes of the Policy.

3. The disputed domain names have been registered and are being used in bad faith.

The Panel finds the following circumstances as material in order to establish the Respondent's bad faith in the registration of the disputed domain names:

(i) the disputed domain names were registered well after the Complainant acquired rights on the trademark BOEHRINGER INGELHEIM;

(ii) the Complainant's trademark is widely known as confirmed by previous Panels (CAC Case No. 102864). The reputation of the trademark BOEHRINGER INGELHEIM makes it very improbable that the Respondent was not aware of the Complainant's exclusive rights on the trademark at the time of the registration of the disputed domain names. This probability is even lower given that the disputed domain names are also composed by the element "petrebates" which is also reproduced in the Complainant's domain name <boehringerengelheimpetrebates.com>;

(iii) the disputed domain names are clear and obvious misspellings of the Complainant's trademark and domain names (i.e. typosquatting). Previous panels found that typosquatting discloses an intention on the part of the respondent to confuse users seeking or expecting to find a website related to the complainant.

Currently, the disputed domain name is not used. It is consensus view among the UDRP panels, that non-use of a domain name does not prevent a finding of use in bad faith (WIPO Case No. 2000-0003). In this case, the Panel considers the following circumstances as material to conclude that the disputed domain name is used in bad faith:

(i) the high degree of distinctiveness and reputation of the Complainant's trademark which makes it very improbable that the disputed domain name could be used in good faith;

(ii) the Respondent had the chance to explain the reason of the registration/use of the disputed domain name both in and outside this administrative proceeding but failed to do so;

(iii) the disputed domain names are also composed by the element "PETREBATES" / "PETREBASTES" which is identical / highly similar to the "petrebates" used by the Complainant in its domain name <boehringerengelheimpetrebates.com>. This fact suggests that the Respondent's intention was to specifically create confusion with the Complainant's animal health business.

All above considered the Panel finds the evidence submitted as sufficient to prove use and registration in bad faith of the disputed domain names for the purposes of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOEHRINGERINGELHEIMPETREBASTES.COM**: Transferred
2. **BOEHRINGERINGILHEIMPETREBATES.COM**: Transferred

PANELLISTS

Name	Andrea Mascetti
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DATE OF PANEL DECISION 2021-05-13

Publish the Decision
