

Decision for dispute CAC-UDRP-105869

Case number	CAC-UDRP-105869
Time of filing	2023-10-12 09:25:52
Domain names	boehringer-ingelhiems.com

Case administrator

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

Organization	Boehringer Ingelheim Pharma GmbH & Co.KG
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Complainant representative

Organization	NAMESHIELD S.A.S.
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Respondent

Name	opio bros
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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 registered owner of the International trademark for BOEHRINGER INGELHEIM, No. 221544, registered on July 21, 1959, ("the BOEHRINGER INGELHEIM mark").

FACTUAL BACKGROUND

The Complainant is a prominent German pharmaceutical company that owns the International trademark for BOEHRINGER INGELHEIM, No.221544, registered on July 21, 1959. The Respondent registered the domain name <boehringer-ingelheim.com> on October 6, 2023 and in the course of doing so, made several spelling alterations to the Complainant's trademark and caused the domain name to resolve to an inactive website. The Complainant is concerned at this infringement of its trademark and has brought this proceeding to have the domain name transferred from the Respondent to itself.

PARTIES CONTENTIONS

A COMPLAINANT

The Complainant made the following contentions.

1. The Complainant is a prominent German pharmaceutical company that has been in business since 1885.
2. It owns a large portfolio of trademarks including the International trademark for BOEHRINGER INGELHEIM, No.221544, registered on July 21, 1959, (“the BOEHRINGER INGELHEIM mark”).
3. The Complainant also owns many domain names that reflect the BOEHRINGER INGELHEIM mark, such as <boehringer-ingelheim.com>, registered on September 1, 1995, which it uses in its business.
4. The Respondent registered the domain name <boehringer-ingelheim.com> (“the disputed domain name”) on October 6, 2023 and caused it to resolve to an inactive website.
5. The disputed domain name is confusingly similar to the BOEHRINGER INGELHEIM mark, as it merely inverts the letters “i” and “e” of the trademark and adds the letter “s”. Thus, in registering the domain name, the Respondent has engaged in typosquatting which, as has been demonstrated in many prior UDRP decisions, shows confusing similarity.
6. The Respondent has also added the gTLD “.com” which cannot negate a finding of confusing similarity between a domain name and a trademark.
7. The Respondent has no right or legitimate interest in the disputed domain name. In that regard, the Complainant must first establish a *prima facie* case and, if it is successful, the onus of proof reverts to the Respondent to disprove that case.
8. The *prima facie* case in this proceeding is established by the evidence that the Respondent is not commonly known by the domain name, it is not related to the Complainant in any way, and it does not carry out any activity or have any business with the Respondent. Moreover, the Complainant has not authorized the Respondent to register the disputed domain name or to make any use of the BOEHRINGER INGELHEIM mark.
9. Moreover, the Respondent’s act of typosquatting in registering the domain name cannot give rise to a right or legitimate interest in the domain name.
10. The domain name points to an inactive webpage which also cannot give rise to a right or legitimate interest in the domain name.
11. The disputed domain name was registered and is being used in bad faith, the Complainant provides following arguments:
 - the disputed domain name is confusingly similar to the BOEHRINGER INGELHEIM mark;
 - it must be inferred that the Respondent registered and used the disputed domain name with full knowledge of the mark and that the Respondent intentionally designed it to be confusingly similar to the mark;
 - the disputed domain name points to an inactive webpage;
 - given the fame of the Complainant and its mark, it is impossible to conceive of a legitimate and lawful use to which the disputed domain name could be put; and
 - MX servers are configured, suggesting that the domain name may be actively used for e-mail purposes which would itself be a

use in bad faith.

12. Finally, it is submitted that as the Complainant has made out all of the elements that it must prove, it is entitled to the relief it seeks, namely the transfer of the domain name from the Respondent to the Complainant.

B RESPONDENT

The Respondent did not file a Response in this proceeding.

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

DISCUSSION AND FINDINGS

This is a mandatory administrative proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”) of the Internet Corporation for Assigned Names and Numbers (“ICANN”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the CAC Supplemental Rules.

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In that regard, the Panel also notes that the onus is on the complainant to make out its case and past UDRP panels have consistently said that a complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

The Panel therefore turns to discuss the various issues that arise for decision on the facts as they are known.

For the complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

- (i) The 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 domain name; and
- (iii) The domain name has been registered and is being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.

Identical or Confusingly Similar

The Complainant has adduced evidence that the Panel accepts, that the Complainant is the registered owner of the International trademark for BOEHRINGER INGELHEIM, No. 221544, registered on July 21, 1959, (“the BOEHRINGER INGELHEIM mark”).

It will be seen therefore that the trademark was registered well before the disputed domain name was registered, which was on October 6, 2023. The Complainant has verified that the Respondent is the registrant of the disputed domain name.

The Panel therefore finds that the Complainant “has” a trademark, which the Policy requires it to prove and which it has done.

The Panel next finds that the disputed domain name is confusingly similar to the BOEHRINGER INGELHEIM mark for the following reasons.

First, the domain name includes the entirety of the BOEHRINGER INGELHEIM mark. Accordingly, it is clear that the domain name has been inspired by and is an attempt to copy the trademark. It is also clear and has been held many times in prior UDRP decisions that when internet users see an entire trademark used in a domain name in this way, they naturally conclude that the domain name is an official domain name of the trademark owner or at least that it is being used with the permission of the trademark owner.

Secondly, the domain name is not a complete duplication of the trademark, as it inverts the letters “i” and “e” of the trademark and adds the letter “s”. Thus, in registering the domain name and as the Complainant rightly submits, the Respondent has engaged in typosquatting which, as has been demonstrated in many prior UDRP decisions, shows confusing similarity with the trademark.

Thirdly, the fact that the domain name has been created by making such minor changes to the trademark, which are nevertheless, apparent for everyone to see, suggests instantly that the Respondent is about some activity designed to do damage to the Complainant by some means involving use of the domain name. In fact, it can be assumed that the Respondent was hoping that internet users who came across the domain name would not notice that the spelling of the trademark had been changed and would assume that the domain name was the official domain name of the Complainant and that it was being used for a legitimate purpose, neither of which, of course, is true.

Internet users would also conclude that the domain name would lead to an official website of the Complainant, which is also not true.

Finally, the “.com” suffix which the Respondent has added, is disregarded for the purposes of assessing confusing similarity, as it could not negate the clear impression that the domain name is confusingly similar to the trademark, which it clearly is.

Taken as a whole, the internet user would look at the domain name and conclude that it is similar to the trademark, because virtually the entirety of the trademark goes to make up the major portion of the domain name, and also that it was confusingly similar, because it gives rise to a question mark as to whether it really is an official domain name or the Complainant or not.

The Panel therefore finds that the disputed domain name is confusingly similar to the BOEHRINGER INGELHEIM mark and that this conclusion is supported by the prior UDRP decisions cited by the Complainant.

The Complainant has thus made out the first of the three elements that it must establish.

Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

But by virtue of paragraph 4(c) of the Policy, it is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [respondent] 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; or
- (ii) you [respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you [respondent] are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Thus, if a respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the domain name, the complainant will have failed to discharge its onus and the complaint will fail.

It is also well-established that a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests and that when such a *prima facie* case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent cannot do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

The Panel, after considering all of the evidence submitted with the Complaint, finds that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name.

That *prima facie* case is made out from the following considerations.

- The Complainant has clearly established its rights in the BOEHRINGER INGELHEIM mark.
- It is clear from the spelling alterations that the Respondent must have devised the domain name with the intention of creating a domain name that would be confusingly similar to the Complainant’s famous trademark and in the hope that it would mislead and deceive at least some internet users. Such an intention could not conceivably give rise to a right or legitimate interest in the domain

name.

- The evidence of the Complainant is that the Respondent is not related in any way to the Complainant's business, is not affiliated with the Complainant or authorized by it in any way to use the BOEHRINGER INGELHEIM trademark and does not carry out any activity for, nor has any business with, the Complainant.
- The evidence shows that the Respondent is not commonly known by the domain name under paragraph 4(c)(ii) of the Policy.
- The evidence is that no licence nor authorisation has been granted by the Complainant to the Respondent to make any use of the trademark or to register the disputed domain name.
- The disputed domain name resolves to an error page and there is no evidence that the Respondent has or has had a plan of any sort to use the domain name. Thus, it can be assumed that the Respondent registered it for a bad motive such as to try to sell it.
- None of this conduct is *bona fide* or legitimate and none of it comes within any of the criteria for a right or legitimate interest in a domain name that are set out in paragraph 4(c) (i) – (iii) of the Policy. Nor is there any evidence to show that the Respondent could in any other way show a right or legitimate interest in the domain name.

These facts give rise to the *prima facie* case made out by the Complainant.

The Respondent has not filed a Response or made any other answer to the claims of the Complainant and is in default. Accordingly, the *prima facie* case has not been rebutted and the Complainant has made out the second of the three elements that it must establish.

Registered and Used in Bad Faith

The Complainant must prove on the balance of probabilities both that the disputed domain name was registered in bad faith and that it is being used in bad faith.

Paragraph 4(b) of the Policy sets out four circumstances, any one of which is evidence of the registration and use of a domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive. The four specified circumstances are:

- (i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the 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 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 or service on the site or location.

There is no need to repeat all of the details set out already, but the conduct of the Respondent in registering the domain name clearly amounts to bad faith registration, and its conduct since the registration by retaining the domain name, having it resolve to an inactive website, leaving it at risk of being sold to another party and putting the Complainant at risk of its being used to its detriment and to tarnish its trademark, clearly amount to bad faith use.

Specifically, the Panel finds for the following reasons that the domain name was registered and has been used by the Respondent in bad faith:

- the domain name is confusingly similar to the BOEHRINGER INGELHEIM mark. The Panel agrees with the Complainant's submission to this effect, as copying the trademark and making slight spelling changes to it to deceive internet users, shows that the Respondent was motivated by bad faith from the beginning.
- it must be inferred that the Respondent registered and used the domain name with full knowledge of the mark and that the Respondent intentionally designed it to be confusingly similar to the mark. The Complainant's trademark is famous and it is simply unbelievable that the Respondent could have plucked the domain name out of the air. Thus, it must be concluded that the Respondent set about misappropriating the Complainant's mark, knowing what it was doing and with the intention of doing harm to the Complainant and making money for itself, probably by selling the domain name if it could. Thus, the Respondent had actual knowledge of the Complainant and its trademark which has long been a ground for finding bad faith registration and, by retaining the domain name, its use. The Panel therefore finds that it is highly likely that the Respondent chose the trademark, made the spelling alterations and registered the domain name to invoke the existence and activities of the Complainant for an improper purpose and therefore in bad faith.
- the domain name points to an inactive webpage. The Panel finds that this also shows bad faith, as it shows that the Respondent did not have any legitimate use in mind when it registered the domain name.
- given the fame of the Complainant and its mark, it is impossible to conceive of a legitimate and lawful use to which the domain name could be put.
- MX servers are configured, suggesting that the domain name may be actively used for e-mail purposes which would itself be a use in bad faith. This is self-evidently true and again raises the suspicion that the Respondent always had a nefarious use in mind for the domain name.
- The conduct of the Respondent brings the case within the provisions of paragraph 4(b) (i) of the Policy, that being the most likely explanation for registering the domain name and for retaining it.

- The same considerations bring the case within the provisions of paragraph 4(b) (iii) of the Policy showing that the domain name was registered to disrupt the business of the Complainant.
- The conduct of the Respondent leads to the conclusion that in registering the domain name deceptively and without any authority to do so, it must have intended to create a likelihood of confusion, with the intention of attracting internet users who might think that the domain name was an official domain name of the Complainant and that it would lead to an official website of the Complainant. Thus, the matter comes within the provisions of paragraph 4(b) (iv) of the Policy.

All of the facts therefore tend in the direction of the Respondent having registered and used the domain name in bad faith and none of them trend in the direction of good faith. There is no conceivable ground for concluding that the Respondent was acting in good faith, as the Respondent was clearly targeting the Complainant.

Finally, and with respect to general bad faith, and having regard to the totality of the evidence, the Panel finds that, in view of Respondent's registration of the disputed domain name, retaining it, and using it, albeit only by causing it to resolve to an inactive website, the Respondent registered and used it in bad faith within the generally accepted meaning of that expression.

Accordingly, the Complainant has shown the third of the three elements that it must establish.

On all of the above issues, the Complainant has cited numerous prior UDRP decisions that support its contentions.

The Complainant has therefore made out its case and is entitled to the relief it seeks.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	Neil Brown
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DATE OF PANEL DECISION 2023-11-07

Publish the Decision
