

ADMINISTRATIVE PANEL DECISION

Boehringer Ingelheim Pharma GmbH & Co.Kg v. Mrs. Toy Rösler
Case No. D2022-1094

1. The Parties

The Complainant is Boehringer Ingelheim Pharma GmbH & Co.Kg, Germany, represented by Nameshield, France.

The Respondent is Mrs. Toy Rösler, Germany.

2. The Domain Name and Registrar

The disputed domain name <boehringer-ingelheim.site> is registered with IONOS SE (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on March 31, 2022. On March 31, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 1, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on April 11, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on April 11, 2022.

On April 11, 2022, the Center transmitted an email in English and German to the Parties regarding the language of the proceeding. The Complainant confirmed its request that English be the language of the proceeding on April 11, 2022. The Respondent did not comment on the language of the proceeding.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on April 22, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 12, 2022. The Respondent did not submit any response. Accordingly,

the Center notified the Respondent's default on May 30, 2022.

The Center appointed Tobias Malte Müller as the sole panelist in this matter on June 7, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

It results from the Complainant's undisputed allegations that it is a family-owned pharmaceutical group of companies with roots going back to 1885. Today, the Complainant is one of the world's 20 leading pharmaceutical companies, with roughly 52,000 employees worldwide and EUR 19.6 billion in net sales (2020).

Furthermore, the Complainant is the registered owner of International trademark registration no. 221544, BOEHRINGER-INGELHEIM, registered on July 2, 1959, amongst others goods in Class 5, designating various countries. This mark has duly been renewed.

The disputed domain name was registered on March 26, 2022.

Furthermore, the undisputed evidence provided by the Complainant proves that the disputed domain name resolves to an inactive page ("This site can't be reached") and MX servers are configured.

5. Parties' Contentions

A. Complainant

Firstly, the Complainant request that the English be the language of the present administrative proceeding for the following reasons: (1) English is the language most widely used in international relations and is one of the working languages of the Center, and (2) in order to proceed in German, the Complainant would have had to retain specialized translation services at a cost very likely to be higher than the overall cost of these proceedings. The use of German in this case would therefore impose a burden on the Complainant which must be deemed significant in view of the low cost of these proceedings.

Secondly, the Complainant contends that the disputed domain name is identical to its trademark BOEHRINGER-INGELHEIM. The addition of the Top-Level Domain ("TLD") ".site" is not sufficient to escape the finding that the disputed domain name is identical.

Thirdly, the Complainant states that the Respondent has no rights or legitimate interests in the disputed domain name. In particular, the Complainant submits that the Respondent has not been commonly known by the disputed domain name. Furthermore, the Respondent is not affiliated with nor authorized by the Complainant in any way, in particular, no license or authorization has been granted to the Respondent to apply for registration of the disputed domain name. Finally, the disputed domain name resolves to an inactive page, so that the Respondent does not make any use of disputed domain name.

Fourthly, the Complainant contends that the Respondent registered and uses the disputed domain name in bad faith. The trademark BOEHRINGER-INGELHEIM enjoys a reputation, so that it is reasonable to infer that the Respondent has registered and used the domain name with full knowledge of the Complainant's trademark. Furthermore, the Respondent has not demonstrated any activity in respect of the disputed domain name, and it is not possible to conceive any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate. Finally, although the domain name appears to be unused, it has been set up with MX records, which suggests that it may be actively used for email purposes.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements in order to obtain an order that the 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;
- (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 is satisfied that the registrant of record for the disputed domain name is the Respondent and will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

A. Language of the proceedings

Panels have recognized that a preliminary determination by the WIPO Center may be necessary where a party requests for the proceeding to be administered in a language other than that of the registration agreement. In the case at hand, the Complainant requests for the proceedings to be administered in English language.

The Panel acknowledges that the WIPO Center notified both parties in German and English language of the discrepancy between the language of the registration agreement and the Complaint. The Complainant formally submitted a motivated request that the proceedings be conducted in English language.

Paragraph 10 of the UDRP Rules vests the Panel with authority to conduct the proceedings in a manner it considers appropriate while also ensuring both that the parties are treated with equality, and that each party is given a fair opportunity to present its case. The Respondent did not reply to this request, as she did not actively participate in these proceedings.

Against this background, the Panel also notes: (i) English is a common business language; (ii) the TLD ".site" has a supranational character; and (iii) that translating the Complaint and the annexes would cause significant expenses and delay while the Respondent is not participating in this proceeding. The Panel would have accepted a Response in English or German, but no Response was submitted.

Taking account of the Panel's ability to understand both languages at issue and further taking into account the interest of fairness and to preserve continuity in the case, the Panel decides English to be the language of the present proceeding.

B. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must first of all establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to said mark.

The Complainant is the owner of International trademark registration no. 221544, BOEHRINGER-INGELHEIM, registered on July 2, 1959 and duly renewed.

The disputed domain name exactly consists of this trademark, including the hyphen. Furthermore, it is acknowledged by UDRP panels, that the applicable TLD may be disregarded in determining identity or confusing similarity, as it is viewed as a standard registration requirement. This practice of disregarding the TLD in determining identity or confusing similarity is applied irrespective of the particular TLD, including with regard to the so-called “new gTLDs” (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.11.1), such as the “.site” TLD in the case at hand.

Therefore, the Panel concludes that the disputed domain name is identical to the Complainant’s trademark pursuant to the Policy, paragraph 4(a)(i).

C. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent’s rights or legitimate interests in the disputed domain name. In the Panel’s view, based on the unrebutted allegations stated above, the Complainant has made a *prima facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

No content is displayed on the website to which the disputed domain name resolves. Such use can neither be considered a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue in the sense of paragraph 4(c)(i) and (iii) of the Policy (see, e.g., *Sanofi, Genzyme Corporation v. Domain Privacy*, WIPO Case No. [D2016-1193](#); *Volkswagen AG v. Nowack Auto und Sport – Oliver Nowack*, WIPO Case No. [D2015-0070](#); *Deutsche Lufthansa AG v. Mustermann Max, Muster AG*, WIPO Case No. [D2015-1320](#)). In addition, the construction of the disputed domain name is also to be taken in consideration, and this Panel finds that it most likely that the Respondent selected the disputed domain name with the intention to take advantage of the Complainant’s registered trademark by registering a domain name identically consisting of that trademark, thus misleading Internet users through the implied affiliation (See section 2.5.1 of the [WIPO Overview 3.0](#)).

Finally, the Panel does not dispose of any elements that could lead the Panel to the conclusion that the Respondent is commonly known by the disputed domain name or that she has acquired trademark rights pursuant to paragraph 4(c)(ii) of the Policy.

It is acknowledged that once the Panel finds such *prima facie* case is made, the burden of production shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the disputed domain name. Since the Respondent in the case at hand failed to come forward with any allegations or evidence in this regard, this Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant is therefore deemed to have satisfied paragraph 4(a)(ii) of the Policy.

D. Registered and Used in Bad Faith

Pursuant to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, “in particular but without limitation”, be evidence of the disputed domain name’s registration and use in bad faith.

According to the Complainant's undisputed allegations, the Respondent does not actively use the disputed domain name. With comparative reference to the circumstances set out in paragraph 4(b) of the UDRP deemed to establish bad faith registration and use, prior UDRP panels have found that the apparent lack of active use (e.g., to resolve to a website) of the domain name without any active attempt to sell or to contact the trademark holder (passive holding), does not as such prevent a finding of bad faith under the doctrine of passive holding (see *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) and *Natixis v. Laura Molenaar*, WIPO Case No. [D2021-3494](#) with further references). The Panel must therefore examine all the circumstances of the case to determine whether the Respondent is acting in bad faith. Factors that have been considered relevant in applying the passive holding doctrine include:

- (i) the degree of distinctiveness or reputation of the complainant's mark;
- (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use;
- (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement); and
- (iv) the implausibility of any good faith use to which the domain name may be put (see [WIPO Overview 3.0](#), section 3.3 and *Actelion Pharmaceuticals, Ltd v. Whois Agent, Whois Privacy Protection Service, Inc / Jean-Paul Clozel*, supra).

In the case at hand, the Panel finds that the circumstances surrounding the registration and use of the disputed domain name suggest that the Respondent was aware that she has no rights or legitimate interests in the disputed domain name, and that it has been registered and is being used in bad faith (see *Natixis v. Laura Molenaar*, loc cit.). These circumstances are the following:

- (i) the distinctiveness and reputation of the trademark BOEHRINGER-INGELHEIM, which has existed since 1959;
- (ii) the disputed domain name identically consists of the trademark BOEHRINGER-INGELHEIM;
- (iii) the Respondent's failure to respond to the Complaint;
- (iv) the fact that the disputed domain name has been connected to active MX records, so that there is a risk that the Respondent is engaged in a phishing scheme.

In addition, due to these circumstances surrounding the registration and use of the disputed domain name, this Panel concludes that the Respondent knew or should have known the trademark BOEHRINGER-INGELHEIM when she registered the disputed domain name, and that there is no plausible legitimate active use that the Respondent could make of the disputed domain name.

In the light of the above, the Panel finds that the disputed domain name has been registered and is being used in bad faith. The Complainant is therefore deemed to also have satisfied the third element, paragraph 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name, <boehringer-ingelheim.site> be transferred to the Complainant.

/Tobias Malte Müller/

Tobias Malte Müller

Sole Panelist

Date: June 21, 2022