

ADMINISTRATIVE PANEL DECISION

**Boehringer Ingelheim Pharma Gmbh & Co.Kg v. Registration Private,
Domains By Proxy, LLC
Case No. DAI2023-0009**

1. The Parties

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

The Respondent is Registration Private, Domains By Proxy, LLC, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <boehringer-ingelheim.ai> is registered with 1API GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 26, 2023. On April 26, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 27, 2023, 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 (Unknown) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 5, 2023 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 May 5, 2023.

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 May 10, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 30, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 16, 2023.

The Center appointed Alistair Payne as the sole panelist in this matter on August 10, 2023. 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

The Complainant is a global pharmaceutical enterprise with over 53,000 employees. It was founded in 1885 in Germany and in 2022, net sales of the Complainant's group amounted to about EUR 24.1 billion.

The Complainant owns a large portfolio of trade marks including the wording "BOEHRINGER INGELHEIM" in several countries, such as the international trade mark BOEHRINGER-INGELHEIM under number 221544, registered since July 2, 1959 and International trade mark BOEHRINGER INGELHEIM under number 568844 registered since March 22, 1991. It also owns a range of domain names including <boehringer-ingleheim.com> registered since September 1, 1995.

The disputed domain name was registered on April 18, 2023 and resolves to a GoDaddy place keeper page advertising it as being for sale.

5. Parties' Contentions

A. Complainant

The Complainant states that the disputed domain name is identical to its trade mark BOEHRINGER-INGELHEIM and that the ".ai" Top Level Domain ("TLD") does not change the overall impression given by the disputed domain name.

The Complainant asserts that the Respondent is not identified in the Whois database as the disputed domain name. It notes that 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.

The Complainant contends that the Respondent is not affiliated with nor authorised by the Complainant in any way. The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant says that it does not carry out any activity for, nor has any business with the Respondent. It also says that neither a licence nor an authorisation has been granted to the Respondent to make any use of the Complainant's BOEHRINGER-INGELHEIM trade marks, or apply for registration of the disputed domain name.

Furthermore, says the Complainant, the disputed domain name resolves to a GoDaddy page at which the domain name is offered for sale. The Complainant contends this general offer to sell the disputed domain name is evidence of the Respondent's lack of rights or legitimate interests.

The Complainant states that the disputed domain name is identical to its trade mark BOEHRINGER-INGELHEIM. The Complainant is one of the world's 20 leading pharmaceutical companies, with over 53,000 employees worldwide and EUR 24.1 billion in net sales and accordingly has a very substantial reputation attaching to its mark internationally. Further, the Complainant's trade mark BOEHRINGER-INGELHEIM is highly distinctive according to the Complainant.

The Complainant notes that all the results of a Google search of the denomination "BOEHRINGER-INGELHEIM" refer to the Complainant. Consequently, it says that given the distinctiveness of the Complainant's trade marks 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 trade mark.

Furthermore, says the Complainant, the disputed domain name is offered for sale. The Complainant claims that the Respondent has failed to make an active use of the disputed domain name and that the Respondent has registered the disputed domain name only in order to sell it back for out of pocket costs, which evinces bad faith registration and use.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has demonstrated that it owns registered trade mark rights for BOEHRINGER-INGELHEIM. The disputed domain name is identical to the disputed domain name before the TLD element, and therefore the Panel finds that the Complaint succeeds under this section of the Policy.

B. Rights or Legitimate Interests

The Complainant has asserted that the Respondent is not identified in the Whois database as the disputed domain name and is not commonly known by it and that its BOEHRINGER-INGELHEIM trade mark is extremely well reputed internationally. The Complainant has also contended that the Respondent is not affiliated with, nor authorised by, the Complainant in any way and that the Respondent has no rights or legitimate interests in the disputed domain name. It has also asserted that it does not carry out any activity with and has no other business with the Respondent and that it has granted neither a licence, nor an authorisation, to the Respondent to make any use of the Complainant's trade marks or apply for registration of the disputed domain name. The Complainant has also noted that the disputed domain name resolves to a GoDaddy page at which the domain name is offered for sale which it has contended is evidence of the Respondent's lack of rights or legitimate interests.

The Panel 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. As the Complainant's case has not been rebutted by the Respondent, the Panel finds for these reasons that the Complainant has successfully made out its case and that the Complaint also succeeds under this section of the Policy.

C. Registered and Used in Bad Faith

The disputed domain name was registered on April 18, 2023, many decades after the Complainant's registration of its original BOEHRINGER-INGELHEIM trade mark. The Complainant's business under this mark is very significant internationally and is generally recognised as one of the major pharmaceutical brands worldwide. It is also a highly distinctive trade mark. In these circumstances the Respondent must have been aware of the Complainant and its BOEHRINGER-INGELHEIM trade mark when it registered the disputed domain name in April 2023.

The disputed domain name resolves to a GoDaddy place keeper page at which it is advertised as being for sale. Previous panels have found that factors that have been considered relevant in applying the passive holding in bad faith doctrine, where there is no apparent use of the disputed domain name, 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.

As noted above the Complainant's BOEHRINGER-INGELHEIM is highly distinctive and very well reputed internationally. The Respondent has failed to respond to the Complaint and has used a privacy service to

conceal its identity which even following the Center's verification check has not been disclosed. In the circumstances of such a well reputed mark that has been used internationally for many decades, the Panel finds that it is highly implausible that the Respondent could seek to put the disputed domain name to any good faith use. This is all the more so in circumstances that the disputed domain name resolves to a place keeper page which advertises it as being for sale for an unspecified price. It appears that the Respondent has most likely registered the disputed domain name with a view to re-selling it at a profit in excess of the registration costs.

Accordingly, the Panel finds that the disputed domain name has been registered and used in bad faith and that the Complaint also succeeds under this element 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.ai> be transferred to the Complainant.

/Alistair Payne/

Alistair Payne

Sole Panelist

Date: August 24, 2023