

ADMINISTRATIVE PANEL DECISION

Boehringer Ingelheim Pharma Gmbh & Co. KG v. Yang Zhi Chao (杨智超)
Case No. D2022-2058

1. The Parties

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

Respondent is Yang Zhi Chao (杨智超), China.

2. The Domain Names and Registrar

The disputed domain names <boehringeringelheimjpetrebates.com> and <boehringeringelheimjpetrebates.com> (the “Domain Names”) are registered with eName Technology Co., Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on June 7, 2022. On June 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On June 9, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on June 10, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint in English on June 13, 2022.

On June 10, 2022, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On June 13, 2022, Complainant submitted a request that English be the language of the proceeding. 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 Respondent in English and Chinese of the Complaint, and the proceedings commenced on June 17, 2022. In accordance with the

Rules, paragraph 5, the due date for Response was July 7, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on July 8, 2022.

The Center appointed Kimberley Chen Nobles as the sole panelist in this matter on July 22, 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

Complainant is a pharmaceutical group of companies founded around 1855 by Albert Boehringer in Ingelheim am Rhein, Germany. Complainant has since become a global research-driven pharmaceutical enterprise with approximately 52,000 employees and net sales of EUR 20.6 billion in 2021. Its three key business areas are: Human Pharma, Animal Health and Biopharmaceutical Contract Manufacturing.

Complainant owns numerous registered trademarks including the terms BOEHRINGER INGELHEIM in numerous countries, including:

- International trademark n°221544 for BOEHRINGER-INGELHEIM, registered on July 2, 1959, designating numerous countries; and
- International trademark n°568844 for BOEHRINGER INGELHEIM registered on March 22, 1991, designating numerous countries, including China, where Respondent resides.

Complainant also owns and operates multiple domain names with the mark BOEHRINGER INGELHEIM, such as <boehringeringelheim.com> and <boehringeringelheimpetrebates>, the latter of which has been registered and used since August 14, 2019.

The Domain Names were registered on June 2, 2022 and each resolve to a parked page with links, such as "Pet Health Insurance", "Rebate Programs" and "Boehringer Ingelheim Animal Health", which redirect to third party commercial sites featuring pet health and pet rebate programs.

5. Parties' Contentions

A. Complainant

Complainant contends that (i) the Domain Names are identical or confusingly similar to Complainant's trademarks; (ii) Respondent has no rights or legitimate interests in the Domain Names; and (iii) Respondent registered and is using the Domain Names in bad faith.

In particular, Complainant contends that it has trademark registrations for BOEHRINGER INGELHEIM and that Respondent registered and is using the Domain Names with the intention to confuse Internet users looking for *bona fide* and well-known BOEHRINGER INGELHEIM products and services.

Complainant notes that it has no affiliation with Respondent, nor authorized Respondent to register or use domain names, which includes Complainant's trademarks, and that Respondent has no rights or legitimate interests in the registration and use of the Domain Names. Rather, Complainant contends that Respondent has acted in bad faith in acquiring and setting up the Domain Names, when Respondent clearly knew of Complainant's rights.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

6.1. Preliminary Procedural Issue – Language of the Proceeding

The Rules, in paragraph 11(a), provide that unless otherwise agreed by the parties or specified otherwise in the registration agreement between the respondent and the registrar in relation to the disputed domain name, the language of the proceeding shall be the language of the registration agreement, subject to the authority of the panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

Complainant submitted its Complaint in English. In its Complaint, email dated June 13, 2022 and amended Complaint, Complainant requested that the language of the proceeding be English. According to the information received from the Registrar, the language of the Registration Agreement for the Domain Names is Chinese.

Complainant contends that: each of the Domain Names is registered in Latin characters and not Chinese script, that English is the language most widely used in international relations and is one of the working languages of the Center, that proceeding in Chinese would require Complainant to retain specialized translation services, and the time and costs required for translation of the proceedings would unfairly burden Complainant and delay the proceedings and adjudication of this matter. Complainant further states that the Center has communicated with Respondent in Chinese and Respondent has been provided the opportunity to respond in Chinese.

In exercising its discretion to use a language other than that of the Registration Agreements for the Domain Names, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both Parties, taking into account all relevant circumstances of the case, including matters such as the Parties' ability to understand and use the proposed language, time, and costs.

The Panel accepts Complainant's submissions regarding the language of the proceeding. The Panel notes that the Center notified the Parties in Chinese and English of the language of the proceeding as well as notified Respondent in Chinese and English of the Complaint. Respondent chose not to comment on the language of the proceeding nor did Respondent choose to file a Response.

The Panel is also mindful of the need to ensure that the proceeding is conducted in a timely and cost-effective manner. Complainant may be unduly disadvantaged by having to translate the Complaint into Chinese and to conduct the proceeding in Chinese.

Having considered all the circumstances of this case, the Panel determines that English be the language of the proceeding.

6.2. Substantive Issues

Under paragraph 4(a) of the Policy, to succeed Complainant must satisfy the Panel that:

- (i) the Domain Names are identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Names; and
- (iii) the Domain Names were registered and are being used in bad faith.

Section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") states that failure to respond to the complainant's contentions would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true.

Thus, although in this case Respondent has failed to respond to the Complaint, the burden remains with Complainant to establish the three elements of paragraph 4(a) of the Policy by a preponderance of the evidence. See, e.g., *The Knot, Inc. v. In Knot We Trust LTD*, WIPO Case No. [D2006-0340](#).

A. Identical or Confusingly Similar

Ownership of a trademark registration is generally sufficient evidence that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. See [WIPO Overview 3.0](#), section 1.2.1. Complainant provided evidence of its rights in the BOEHRINGER INGELHEIM trademarks, as noted above. Complainant has also submitted evidence, which supports that the BOEHRINGER INGELHEIM trademarks are widely known and a distinctive identifier of Complainant's products and services. Complainant has therefore proven that it has the requisite rights in the BOEHRINGER INGELHEIM trademarks.

With Complainant's rights in the BOEHRINGER INGELHEIM trademark established, the remaining question under the first element of the Policy is whether the Domain Names, typically disregarding the Top-Level Domain ("TLD") in which it is registered (in this case, ".com"), is identical or confusingly similar to Complainant's trademark. See, e.g., *B & H Foto & Electronics Corp. v. Domains by Proxy, Inc. / Joseph Gross*, WIPO Case No. [D2010-0842](#).

Here, the Domain Names are confusingly similar to Complainant's BOEHRINGER INGELHEIM trademarks. These trademarks, which are fanciful and inherently distinctive, are recognizable in each of the Domain Names. In particular, each of the Domain Names includes Complainant's trademark BOEHRINGER INGELHEIM in its entirety, with the addition of the letter "j" and the term "petrebates" in the case of the Domain Name <boehringeringelheimjpetrebates.com> or the addition of the letter "n" and the term "petrebates" in the case of the Domain Name <boehringeringelheimpetrebates.com>. The addition of the letter "j" or "n" and the term "petrebates" after or in the BOEHRINGER INGELHEIM trademark in the respective Domain Names as noted does not prevent a finding of confusing similarity between the Domain Names and the BOEHRINGER INGELHEIM trademarks.

Thus, the Panel finds that Complainant has satisfied the first element of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make a *prima facie* showing that a respondent possesses no rights or legitimate interests in a disputed domain name. See, e.g., *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#). Once a complainant makes such a *prima facie* showing, the burden of production shifts to the respondent, though the burden of proof always remains on the complainant. If the respondent fails to come forward with relevant evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.

From the record in this case, it is evident that Respondent was, and is, aware of Complainant and its BOEHRINGER INGELHEIM trademarks, and does not have any rights or legitimate interests in the Domain Names. Complainant has confirmed that Respondent is not affiliated with Complainant, or otherwise authorized or licensed to use the BOEHRINGER INGELHEIM trademarks or to seek registration of any domain name incorporating the trademarks. Respondent is also not known to be associated with the BOEHRINGER INGELHEIM trademarks and there is no evidence showing that Respondent has been commonly known by the Domain Names.

In addition, Respondent has not used the Domain Names in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. Rather, Complainant asserts that each of the Domain Names redirect to a website with commercial links related to animal health industry, including the pet rebate industry, which has not been rebutted by Respondent. One of the links in particular, features "Boehringer Ingelheim Animal Health" and redirects to third party commercial sites, in direct competition with Complainant's business activities in the animal health industry.

Such use does not constitute a *bona fide* offering of goods or services or a legitimate noncommercial or fair use and cannot under the circumstances confer on Respondent any rights or legitimate interests in the Domain Names. See, e.g., *Intesa Sanpaolo S.p.A. v. Charles Duke / Oneandone Private Registration*, WIPO Case No. [D2013-0875](#).

Further, the nature of the Domain Names comprising the Complainant's trademark and additional letters and the term "petrebates", indicates an awareness of the Complainant.

Accordingly, Complainant has provided evidence supporting its *prima facie* claim that Respondent lacks any rights or legitimate interests in the Domain Names. Respondent has failed to produce countervailing evidence of any rights or legitimate interests in the Domain Names. Thus, the Panel concludes that Respondent does not have any rights or legitimate interests in the Domain Names and Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that Respondent's actions indicate that Respondent registered and is using the Domain Names in bad faith.

Paragraph 4(b) of the Policy provides a non-exhaustive list of circumstances indicating bad faith registration and use on the part of a domain name registrant, namely:

"(i) circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your 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 your web site or location or of a product or service on your web site or location."

The Panel finds that Complainant provided ample evidence to show that registration and use of the BOEHRINGER INGELHEIM trademarks long predate the registration of the Domain Names. Complainant is also well established and known. Indeed, the record shows that Complainant's BOEHRINGER INGELHEIM trademarks and related products and services are widely known and recognized. Therefore, Respondent was likely aware of the BOEHRINGER INGELHEIM trademarks when it registered the Domain Names, or knew or should have known that each of the Domain Name was confusingly similar to Complainant's trademarks. See [WIPO Overview 3.0](#), section 3.2.2; see also *TTT Moneycorp Limited v. Privacy Gods / Privacy Gods Limited*, WIPO Case No. [D2016-1973](#).

The Panel therefore finds that Respondent's awareness of Complainant's trademark rights at the time of registration suggests bad faith. See *BOEHRINGER INGELHEIM GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. [D2011-2209](#); *Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite*, WIPO Case No. [D2001-1070](#); *BellSouth Intellectual Property Corporation v. Serena, Axel*, WIPO Case No. [D2006-0007](#).

Further, the registration of the Domain Names incorporating Complainant's BOEHRINGER INGELHEIM trademark in its entirety suggests Respondent's actual knowledge of Complainant's rights in the BOEHRINGER INGELHEIM trademarks at the time of registration of the Domain Names and its effort to opportunistically capitalize on the registration and use of the Domain Names. Complainant owns the domain names <boehringeringelheim.com> and <boehringeringelheimpetrebates.com>, the latter of which redirects to Complainant's official website <boehringeringelheim.com>. In addition, while each of the Domain Names includes Complainant's trademark BOEHRINGER INGELHEIM in its entirety, followed by the addition of the letter "j" and the term "petrebates" in the case of the Domain Name <boehringeringelheimjpetrebates.com> or the insertion of the letter "n" between "i" and "n" in "BOEHRINGERINGELHEIM" and the term "petrebates" in the case of the Domain Name <boehringeringelheimnpetrebates.com>, each of which is directly associated with Complainant's BOEHRINGER INGELHEIM trademarks and business activities, and directly evokes Complainant's activities in the field of animal health and pet rebate industry, further indicating Respondent's actual knowledge of Complainant and its trademarks, and that Respondent's registration of the Domain Names is in bad faith.

Moreover, Respondent registered and is using the Domain Names to confuse and mislead consumers looking for *bona fide* and well-known BOEHRINGER INGELHEIM products and services of Complainant or authorized partners of Complainant. The use of the BOEHRINGER INGELHEIM mark as the dominant part of the Domain Names is intended to capture Internet traffic from Internet users who are looking for Complainant's products and services. Such use and association of the Domain Names to divert users to a webpage featuring pet health and pet rebate-themed links, such as "Pet Health Insurance", "Rebate Programs" and in particular, "Boehringer Ingelheim Animal Health" could result in causing confusion with Complainant's business activities. It may confuse Internet users who are looking for Complainant's legitimate website and deceive Internet users into thinking that Respondent is somehow connected to Complainant, which is not the case.

In the present circumstances, considering the distinctiveness and reputation of the BOEHRINGER INGELHEIM trademarks, the failure of Respondent to submit a response or to provide any evidence of actual or contemplated good faith use, and the implausibility of any good faith use to which the Domain Names may be put, the Panel finds that Respondent has registered and is using the Domain Names in bad faith and Complainant succeeds under the third element of paragraph 4(a) 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 Domain Names <boehringeringelheimjpetrebates.com> and <boehringeringelheimnpetrebates.com> be transferred to Complainant.

/Kimberley Chen Nobles/

Kimberley Chen Nobles

Sole Panelist

Date: August 5, 2022