

ADMINISTRATIVE PANEL DECISION

Boehringer Ingelheim International GmbH v. janis yan
Case No. D2023-5034

1. The Parties

The Complainant is Boehringer Ingelheim International GmbH, Germany, represented by Nameshield, France.

The Respondent is janis yan, China.

2. The Domain Name and Registrar

The disputed domain name <jardiance.world> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 4, 2023. On December 4, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 4, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 8, 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 December 11, 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 January 2, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 22, 2024. The Respondent sent an email communication to the Center on January 2, 2024. The Center notified the commencement of Panel appointment process on January 23, 2024. Following a request for suspension of the proceeding received from the Complainant, the proceeding was suspended on January 24, 2024, and subsequently reinstated on February 27, 2024.

The Center appointed Deanna Wong Wai Man as the sole panelist in this matter on March 1, 2024. 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 German family-owned pharmaceutical group of companies with roots going back to 1885. It was founded in Ingelheim am Rhein. The Complainant is an international research-driven pharmaceutical company and has become one of the top 20 companies in the pharmaceutical industry with over 53,000 employees. In 2022, the net sales of the BOEHRINGER group of companies amounted to about 24.1 billion euros. The Complainant particularly uses the mark JARDIANCE (Empagliflozin) for a prescription medication which is used to treat diabetes type 2 and its complications.

The Complainant is the owner of an international trademark portfolio covering the JARDIANCE trademark, including but not limited to:

- International Trademark registration No. 981336 for JARDIANCE registered on September 3, 2008;
- United States of America Trademark registration No. 3595152 for JARDIANCE registered on March 24, 2009;
- United Kingdom Trademark registration No. UK00800981336 for JARIDANCE registered on October 5, 2009.

The Complainant also has a strong online presence and uses as its official domain name for the JARDIANCE-branded products the domain name <jardiance.com> registered on April 30, 2008.

The disputed domain name was registered on November 29, 2023, and is therefore of a later date than the abovementioned trademarks of the Complainant. The Complainant submits evidence that the disputed domain name directs to an active website containing what are purported to be pay-per-click links to third party websites.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends the disputed domain name is identical to its trademark for JARDIANCE, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered, and is being used in bad faith to divert Internet users to the Respondent's website for commercial gain.

The Complainant argues that its trademark JARDIANCE is well-known, intensely used and famous, and refers to a number of prior UDRP panel decisions which have recognized its rights in the JARDIANCE trademarks and their strong reputation and fame, such as *Boehringer Ingelheim International GmbH v. 杨智强 (Zhi Qiang Yang)*, WIPO Case No. [D2023-0132](#). The Complainant essentially contends that the disputed domain name is identical to the Complainant's intensively used trademarks, as it incorporates the Complainant's JARDIANCE trademark, with no other relevant addition than the generic top-level domain. The Complainant also provides evidence that the disputed domain name directs to a website containing what are purported to be pay-per-click links to third party websites. The Complainant argues that such use

confers no legitimate interest in the disputed domain name on the Respondent. The Complainant also argues that the Respondent had or can be expected to have had prior notice of the Complainant's trademarks at the time the disputed domain name was registered. Finally, the Complainant also provides evidence that the Respondent connected the disputed domain name to MX servers, which means that the Respondent may be using the disputed domain name for mailing purposes. The Complainant essentially contends that the registration and use of the disputed domain name in such circumstances constitutes registration and use in bad faith.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

The Respondent did not reply to the Complainant's contentions. The only communication received from the Respondent in this procedure was its informal email communication of January 2, 2024, by which the Respondent requested, in Chinese, information about the account to which the disputed domain name was to be transferred.

No further communications or Response were received from the Respondent in this proceeding.

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain name with no other additions. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Moreover, upon review of the facts and evidence submitted, the Panel notes that the disputed domain name directs to a website containing what are purported to be pay-per-click links to third party websites. The Panel also notes that there are no elements in this case that point to the Respondent having made any reasonable and demonstrable preparations to use the disputed domain name in connection with a bona fide offering of goods or services. In the Panel's view, these elements show that the Respondent's intention was not to make any use of the disputed domain name as a bona fide provider of goods or services, or to make legitimate noncommercial use or fair use of the disputed domain name. Instead, it shows the Respondent's clear intention to mislead and divert Internet users for commercial gain to this website offering pay-per-click links, by taking unfair advantage of the goodwill and reputation of the Complainant's trademarks for JARDIANCE.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent has registered a domain name which is identical to the Complainant's prior, intensely used and distinctive trademark (see in this regard also previous decisions under the Policy which have recognized the Complainant's rights in this same trademark such as *Boehringer Ingelheim International GmbH v. 杨智强 (Zhi Qiang Yang)*, WIPO Case No. [D2023-0132](#)). The Panel deducts from this fact that by registering the disputed domain name, the Respondent deliberately and consciously targeted the Complainant's prior trademarks for JARDIANCE. The Panel finds that this creates a presumption of bad faith. In this regard, the Panel refers to the [WIPO Overview 3.0](#), section 3.1.4, which states "[p]anel has consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith." The Panel also notes that the Complainant's trademarks in this case predate the registration date of the disputed domain name by several years, and that the Respondent could not have been reasonably unaware of them. The Panel considers that the Respondent has intentionally and opportunistically targeted the Complainant's trademark for JARDIANCE. The Panel deducts from these efforts to consciously target the Complainant's prior registered trademarks that the Respondent knew, or at least should have known, of the existence of the Complainant's trademarks at the time of registering the disputed domain name. The Panel also notes that even a cursory Internet search at the time of registration of the disputed domain name would have made it clear to the Respondent that the Complainant owned prior rights in its trademarks for JARDIANCE. In the Panel's view, these elements clearly indicate bad faith on the part of the Respondent in registration of the disputed domain name, and the Panel therefore finds that it has been demonstrated that the Respondent registered the disputed domain name in bad faith.

As to use of the disputed domain name in bad faith, the Complainant provides evidence that the disputed domain name directs to a website containing what are purported to be pay-per-click links to third party websites. The Panel concludes that such use constitutes an intentional attempt to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's marks as to the source, affiliation, or endorsement of the disputed domain name. This constitutes direct evidence of the Respondent's bad faith under paragraph 4(b)(iv) of the Policy. The Panel therefore finds that it has been demonstrated that the Respondent has used and is using the disputed domain name in bad faith.

Finally, the Panel has also reviewed the Complainant's evidence containing the mail exchanger (MX) records for the disputed domain name, which indicate that the Respondent may have connected this disputed domain name to email servers. The Panel finds that this creates a grave risk that the Respondent may be using this disputed domain name for misrepresentations and/or phishing and spamming activities (see in this sense also previous UDRP decisions such as *Carrefour v. WhoisGuard, Inc., WhoisGuard Protected / Robert Jurek, Katrin Kafut, Purchasing clerk, Starship Tapes & Records*, WIPO Case No. [D2017-2533](#)).

Based on the available record, the Panel finds that the Complainant has established the third 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 <jardiance.world> be transferred to the Complainant.

/Deanna Wong Wai Man/

Deanna Wong Wai Man

Sole Panelist

Date: March 7, 2024