

**DECISION OF THE THIRD-PARTY DECIDER**

**Boehringer Ingelheim International GmbH / Martin Kohlhauser**

**Case no. 44373: jardiance.be**

**1. The parties**

- 1.1. Complainant: **Boehringer Ingelheim International GmbH;**  
with registered office at 55216 Ingelheim, Postfach 200  
(Germany);

*Represented by:*

Anne Morin (Nameshield),  
with office at 49100 Angers, Rue des Arènes 27 (France)

- 1.2. Licensee: **Martin Kohlhauser (ooo Stratos Consult);**  
residing at 127410 Moscow, Altufewskoe shosse d41 (Russia)

**2. Domain name**

Domain name: "jardiance.be"  
Registered on: October 7, 2014

hereafter referred to as "the domain name".

**3. Background to the case**

On March 27, 2015, the Complainant filed a complaint with the Belgian Centre for Arbitration and Mediation (CEPANI)

On April 10, 2015, the Licensee filed by e-mail a response with CEPANI.

On April 29, 2015, CEPANI appointed the Third-Party Decider.

On April 30, 2015, the Licensee forwarded his e-mail of April 20, 2015 (with a 'clarification') to the Third-Party Decider.

On May 6, 2015, pursuant to Article 12 of CEPANI Rules for Domain Name Dispute Resolution, the deliberations were closed.

#### **4. Factual information**

The Complainant is an international pharmaceutical enterprise.

The Complainant has developed a drug, called 'Jardiance', which apparently was approved for the treatment of type 2 diabetes in adults by the US Food and Drug Administration on August 1<sup>st</sup>, 2014.

The Complainant is (since September 3, 2008) the owner of the 'Jardiance' international trademark no 981336, registered in several countries of which the European Community and thus Belgium.

The Licensee registered the domain name on October 7, 2014.

The Licensee is working for ooo Stratos Consult, a consulting company for Russian companies willing to enter the EU market. The Domain Name has been registered for a customer called 'ZAO Sargantow', the developer of an interactive online gaming platform 'Jardiance'. The Licensee has offered the Claimant 50.000 euro for the other jardiance domain names (such as .de, .uk, .fr and .it).

When entering the domain name, no website is active.

#### **5. Position of the parties**

##### **5.1. Position of the Complainant**

The Claimant states that the domain name is identical to its trademark 'Jardiance'.

The Claimant is of the opinion that the Licensee has no rights and legitimate interest in the domain name. More particularly, the Complainant argues that (i) the Licensee is not known as 'Jardiance', and (ii) the name of the game is not 'Jardiance' but 'Diablo III', a video-game developed and published by Blizzard Entertainment to which the Licensee is not affiliated with.

The Claimant is also of the opinion that the Licensee did register the domain name in bad faith. Among others, the Complainant invokes the fact that (i) giving the distinctiveness and reputation of its trademark, the domain name must have been registered by the Licensee with full knowledge of the Complainant's activity, (ii) domain names e.g. jardian.be and jardiana.be are not registered by the Licensee and still available and (iii) the website in relation with the disputed domain name jardiance.be is inactive.

Consequently, Complainant asks the transfer in its favour of the domain name.

##### **5.2. Position of the Licensee**

The Licensee argues that it is consulting "ZAO Sargantow", the developer of a Russian interactive online gaming platform 'Jardiance' (apparently registered under

Russian law since 6<sup>th</sup> November 2011). Jardian is the name of the family leader in this game.

In an attempt to penetrate with this game the EU-market, it has acquired the jardiance domain names .be, .dk, .ch and .at.

## 6. Discussion and findings

Pursuant to Article 16.1 of the *CEPANI rules for domain name dispute resolution*, the Third-party decider shall rule on domain name disputes with due regard for the Policy and the CEPANI rules for domain name dispute resolution.

Pursuant to Article 10b(1) of the Terms and conditions of domain name registrations under the ".be" domain operated by DNS BE, the Complainant must provide evidence of the following:

- *" the licensee's domain name is identical or confusingly similar to a trademark, a tradename, a social name or corporation name, a geographical designation, a name of origin, a designation of source, a personal name or name of a geographical entity in which the Complainant has rights; and*
- *the licensee has no rights or legitimate interests in the domain name; and*
- *the licensee's domain name has been registered or is being used in bad faith."*

### 6.1. Identical or similar to

The Complainant is the owner of the 'Jardiance' international trademark no 981336, registered in several countries of which the European Community and thus Belgium.

The domain name is thus identical to the trademark of the Complainant.

The Third-Party Decider therefore concludes that the first condition is met.

### 6.2. Rights and legitimate interests

Pursuant to Article 10 b) 3 of the Policy, the Licensee can demonstrate his rights or legitimate interests to the Domain Name. The same article of the Policy gives a non-exhaustive list of such circumstances:

- *Prior to any notice of the dispute, the registrant used the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services or made demonstrable preparations for such use; or*
- *The registrant (as an individual, business, or other organization) had been commonly known by the domain name, even if he has no trademark; or*
- *The registrant is making a legitimate and non-commercial or fair use of the domain name, without intent to misleadingly divert consumers for commercial gain or to tarnish the trademark, trade name, social name of corporation name, geographical designation, name of origin, designation of source, personal name or name of the geographical entity at issue.*

It is standing case law that the Complainant can technically not prove the absence of something, i.e. a 'negative fact' and that therefore the onus shifts to the Licensee to assert certain facts supporting a right/legitimate interest (F. PETILLION and B. LIEBEN, "Overzicht van de .be beslissingen in de ADR procedures van Cepina (2001-2006)", *Computerrecht* 2008, 74-87, n° 7.1 to 7.5 and cases quoted; B. DOCQUIR, 'Le contentieux des noms de domaine', *J.T.* 2007, 61-71, n° 18 and cases quoted). Once the Licensee has done so the onus shifts back to the Complainant and it is then on the Complainant to provide proof that the facts asserted by the Licensee are not true.

In the case at hand the Complainant indicated why it believes that the Licensee has no rights or legitimate interest to the domain name (see above 5.1).

The Licensee attempts to demonstrate the contrary (see above 5.2).

\* \* \*

The Third-Party Decider is of the opinion that the Licensee fails to prove his rights or legitimate interests to the Domain Name.

To date, the Licensee did not use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services.

The Licensee is more in particular not at all known by the domain name. Neither does the Licensee allege to be known as such. In addition, the Licensee does not prove to work in agency of the developers of a game 'Jardiance', nor does the Licensee prove in any way the very existence of such a game called 'Jardiance'.

The argument of the Complainant according to which the Licensee would intend to refer to the game 'Diablo III' developed by Blizzard Entertainment, with which the Licensee would have no discernable relation, is not relevant in the opinion of the Third-Party Decider. The Licensee refers explicitly to a game with the name 'Jardiance' as opposed to the game 'Diablo III'. The Third Party Decider does take note that in aforementioned game 'Diablo III' there is a character bearing the name 'Jardian'.

Finally, the Licensee has not demonstrated that, prior to any notice of the present dispute, it was making a legitimate and non-commercial or fair use of the Domain Name.

According to the Third-Party Decider, therefore, the second condition is met.

### 6.3. Registration in bad faith

Article 10 b) 2 of the Policy gives a non-exhaustive list that can demonstrate the registration or use in bad faith of the domain name.

Bad faith must be reasonably proven and deducted from assumption.

In the case at hand the Complainant indicated why it believes that the Licensee has registered or is using the domain name in bad faith (see above 5.1).

\* \* \*

The Third-Party Decider is of the opinion that the Complainant does not provide any evidence that the registration of the domain name was made (or the domain name is being used) in bad faith. The circumstances listed under Article 10 b) 2 of the Policy, in any case, do not seem to be fulfilled.

First of all, there are no circumstances indicating that the domain name was registered primarily for the purpose of selling or otherwise transferring the Domain Name to the Complainant. To the contrary, the willingness of the Licensee to purchase the remaining 'Jardiance' domain names in possession of the Complainant (such as 'Jardiance.uk', 'Jardiance.de') is apparent from the e-mail correspondence of the Licensee.

Secondly, there are no circumstances indicating that the domain name was registered

- In order to prevent the owner of the trademark from reflecting this name in a corresponding domain name, or
- Primarily for the purpose of disrupting the business of a competitor

The Licensee can certainly not be considered as a Complainant's competitor, and it is in no way demonstrated that the Licensee is attempting to inhibit the Complainant in using its brand or registered trademark.

The Third-Party Decider moreover believes that the Russian-based Licensee was not – or could reasonably not have been – aware of the Complainants' existence, or its jardiance trademark.

Thirdly, the Third-Party Decider is confident that the Licensee did not intentionally use the domain name to attract, for commercial gain, internet-users to its website or other on-line location, by creating a likelihood of confusion with the Complainant trademark. Besides the fact that the Complainant does not affirm this, the latter indeed confirms that the domain name is not active. Hence, this domain name technically cannot attract or link internet-users to a website.

Fourthly, the argument of the Complainant according to which the Licensee has not registered any other domain name than 'Jardiance.be', is no indication for the registration in bad faith of the domain name in case, namely 'Jardiance.be'.

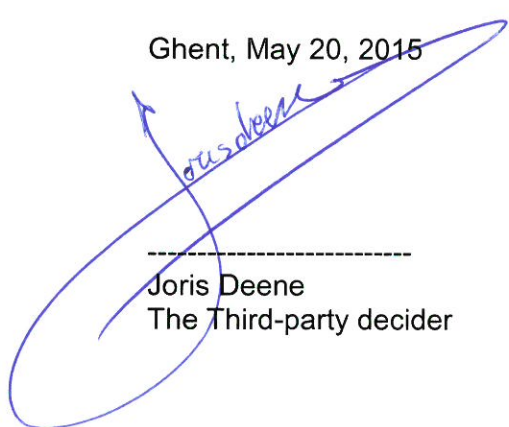
Finally – although one can reasonably believe that the Licensee planned to develop a website for Belgian Jardiance players – the Third Party Decider deplores the fact that the Licensee is still waiting for the right opportunity to develop said website. However, waiting for the right opportunity to develop a business or website, is alone insufficient to presume bath faith. Moreover, the domain name was only registered on October 27, 2014 and the complaint by the Complainant dates from March 27, 2015 (only five months after the registration, which cannot be considered an abnormally long period of non-use).

As a result the Third-Party Decider concludes that the third condition is not met.

## 7. Decision

Consequently, pursuant to Article 10(e) of the *Terms and conditions of domain name registrations under the ".be" domain operated by DNS BE*, the Third-party Decider hereby denies the request that the registration of the Domain Name "jardiance.be" be transferred to Complainant.

Ghent, May 20, 2015



-----  
Joris Deene  
The Third-party decider