

ADMINISTRATIVE PANEL DECISION

bioMérieux v. Yasutake Aoki (青木 康剛), PIA Co., Ltd. (株式会社 PIA)
Case No. D2022-2717

1. The Parties

The Complainant is bioMérieux, France, represented by Plasseraud IP, France.

The Respondent is Yasutake Aoki (青木 康剛), PIA Co., Ltd. (株式会社 PIA), Japan.

2. The Domain Name and Registrar

The disputed domain name <biomerieux50.com> is registered with Nakazawa Trading Co., Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on July 25, 2022. On July 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 4, 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 August 5, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On the same day, the Center transmitted an email communication to the Parties in English and Japanese regarding the language of the proceeding. The Complainant filed an amended Complaint in English and Japanese on August 12, 2022, and also submitted a request that English be the language of the proceeding. 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 in English and Japanese of the Complaint, and the proceedings commenced on August 15, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 4, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 5, 2022.

On September 6, 2022, both the Complainant and the Center received an email communication from the Respondent, in which the Respondent appeared to be willing to settle the dispute by transferring the disputed domain name. On September 7, 2022, the Complainant informed the Center that they would like to continue the proceeding.

The Center appointed Douglas Clark as the sole panelist in this matter on September 9, 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

The Complainant is a French biotechnology company founded in 1963. It is mostly active in the field of diagnostic solutions and its products is mainly used for diagnosing infectious diseases. They are also used for detecting microorganisms in agri-food, pharmaceutical and cosmetic products.

The Complainant is also the owner of several trade mark registrations for BIOMERIEUX, including the following:

Trade Mark	Trade Mark No.	Registration Date	Classes	Jurisdiction
	3198902	December 11, 2002	1,5, 9, 10	France
	912430	January 3, 2007	1,5, 9, 10	International (including Japan)
BIOMERIEUX	933598	June 12, 2007	1,5, 9, 10	International (including Japan)
BIOMERIEUX	1392389	October 15, 2017	35, 37, 41, 42, 44	International
	1478156	June 4, 2018	1, 5, 9, 10, 35, 37, 41, 42, 44	International

The Complainant or its affiliated company is the owner of multiple domain names including “biomerieux”, such as:

Domain Name	Registration Date
biomerieux.com	May 31, 1996
biomerieux.fr	June 3, 1996
biomerieux-usa.com	March 31, 2000
biomerieux.net	October 20, 2000
biomerieux.org	October 20, 2000
biomerieuxusa.com	April 4, 2001
biomerieuxindustry.com	March 10, 2006
biomerieux.jp	June 15, 2009
bioméerieux.com	April 16, 2010
biomerieux.co.jp	May 20, 2011
biomerieux.biz	January 12, 2013
biomerieux-asean.com	February 8, 2013
biomerieuxconnection.com	August 16, 2013

The disputed domain name <biomerieux50.com> was registered on February 8, 2015. It was previously owned by the Complainant and used for the 50th anniversary of the Complainant in 2013 and then allowed to expire.

At the date of this Complaint, the disputed domain name resolved to a website dealing with pharmaceutical topics. At the date of this decision, the disputed domain name resolved to an inactive website.

5. Parties' Contentions

A. Complainant

The Complainant contends that:

(a) The disputed domain name is confusingly similar to its trade mark. The disputed domain name is almost identical to the Complainant's trademark other except for the addition of the number "50". The use of the generic Top-Level Domain ("gTLD") ".com" in the disputed domain name does not eliminate the overall notion that the designation is connected to the trade mark and the likelihood of confusion that the disputed domain name and the trade mark are associated;

(b) The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not affiliated with the Complainant in any way and the Complainant has never granted any authorization or license to use the Complainant's trade mark. The Respondent is not commonly known by the disputed domain name, and has not made a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name; and

(c) The disputed domain name was registered and is being used in bad faith. The Complainant has used its trade mark for over 10 years and has registered multiple domain names using the BIOMERIEUX trade mark. Based on the use of the disputed domain name, the Respondent registered and is using the disputed domain name to attract Internet users for commercial gain, creating a likelihood of confusion with the Complainant's trade mark.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

Apart from the Respondent's email communication as described under the Section 3. above, the Respondent did not formally reply to the Complainant's contentions.

6. Discussion and Findings

6.1 Preliminary Issues – Delay in Filing the Complaint

The Complainant has submitted that the disputed domain name was registered on February 8, 2015. The time between the creation date of the disputed domain name and the date of filing the Complaint is significant. The disputed domain name was registered in 2015 and the Complaint was filed seven years later. This raises the question of whether the Complainant has delayed in bringing the proceedings, and whether this is a matter that counts against the Complainant's claim.

UDRP Panels have recognized that mere delay between the registration of a domain name and the filing of a complaint neither bars a complainant from filing such case, nor from potentially prevailing on the merits. A delay in bringing a complaint does not provide a defense *per se* under the Policy. (See section 4.17 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").)

The Panel finds that the delay is not a matter that affects the Complainant's claim.

6.2 Preliminary Issues – Language of the Proceeding

According to paragraph 11(a) of the Rules, unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative 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.

In this case, the language of the Registration Agreement for the disputed domain name is Japanese. There is no agreement between the Complainant and the Respondent regarding the language of the proceeding. The Respondent did not respond as to the language of the proceeding. The Complainant has filed its amended Complaint in English with a Japanese translation and has requested that English be the language for the proceeding under the following grounds:

- English is the most widely used language in international relations and one of the working languages of the Center;
- The Complainant has no knowledge of Japanese;
- Some elements of the website of the Registrar are redacted/translated into English;
- The Complainant has contacted the Registrar in English using an assumed identity and has received a response in English;
- The disputed domain name contains Roman characters and not in Japanese script; and
- The Respondent holds multiple domain names, most of which are in Roman characters.

In accordance with paragraph 11(a) of the Rules and taking into consideration paragraphs 10(b) and (c) of the Rules, the Panel hereby determines that the language of the proceeding shall be in English after considering the following circumstances:

- the Center has notified the Respondent of the proceeding in both English and Japanese;
- the Respondent has not commented on the language of the proceeding and has not submitted any response although the amended Complaint was also filed in Japanese;
- the Respondent sent an email communication on September 6, 2022 in English and Japanese apparently indicating its willingness to settle the dispute.

Further, this Panel decided in *Zappos.com, Inc. v. Zufu aka Huahaotrade*, WIPO Case No. [D2008-1191](#), that a respondent's failure to respond to a preliminary determination by the Center as to the language of the proceeding "should, in general, be a strong factor to allow the Panel to decide to proceed in favour of the language of the Complaint".

6.3 Substantive Issues

The Complainant must satisfy all three elements of paragraph 4(a) of the Policy in order to succeed in its action:

- (i) the disputed domain name is identical or confusingly similar to a trade 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.

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name <biomerieux50.com> is confusingly similar to the Complainant's trade mark. The disputed domain name reproduces the BIOMERIEUX trade mark in its entirety save for the addition of the number "50" which does not prevent a finding of confusing similarity. The gTLD ".com" is generally disregarded when considering the first element. (See section 1.11 of the [WIPO Overview 3.0](#).)

The Complainant has therefore satisfied the first element under paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

The Complainant asserts that the Respondent has no business with and is in no way affiliated with the Complainant. The Respondent is not authorized nor licensed to use the Complainant's BIOMERIEUX trade mark or to apply for registration of the disputed domain name. The Respondent has not used the disputed domain name for a *bona fide* offering of goods or services nor for a legitimate noncommercial or fair use. There is no evidence that the Respondent is commonly known by the name "Biomerieux" or "Biomerieux50".

Section 2.1 of the [WIPO Overview 3.0](#) provides:

"While 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 often impossible 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element."

The Panel finds that the Complainant has made a *prima facie* case that the Respondent lacks rights or legitimate interests, which has not been rebutted by the Respondent. Accordingly, the Respondent has no rights or legitimate interests in regard to the disputed domain name.

The Complainant has therefore satisfied the second element under paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Based on the given evidence, the disputed domain name was registered and is being used in bad faith.

The disputed domain name was registered long after the Complainant has registered the BIOMERIEUX trade mark and the use of the Complainant's BIOMERIEUX trade mark cannot be a coincidence. The Complainant has registered the BIOMERIEUX trade mark for at least more than 20 years and panels in previous UDRP proceedings have recognized the Complainant's trade mark as well known. The Panel is satisfied that the Respondent was aware of the Complainant and its BIOMERIEUX trade mark when it registered the disputed domain name.

The Respondent has registered and used the disputed domain name to attract Internet users to the website for commercial gain in accordance with paragraph 4(b)(iv) of the Policy. The disputed domain name resolved to a website dealing with pharmaceutical topics, which is the field the Complainant primarily operates in, and some topics contained links for promoting third party services. In addition, the Respondent has been involved in the cybersquatting of multiple domain names apart from the disputed domain name.

For the above reasons, the Panel finds that the disputed domain name was registered and is being used in bad faith.

The Complainant has therefore satisfied the third element under 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 disputed domain name <biomerieux50.com> be transferred to the Complainant.

/Douglas Clark/

Douglas Clark

Sole Panelist

Date: September 23, 2022