

## **ADMINISTRATIVE PANEL DECISION**

Genentech, Inc. v. hh hhh, ds df  
Case No. D2023-2521

### **1. The Parties**

The Complainant is Genentech, Inc., United States of America (“United States”), internally represented.

The Respondents are hh hhh, Hong Kong, China, and ds df, Hong Kong, China.

### **2. The Domain Names and Registrar**

The disputed domain names <genentechmf.com>, <genentechmfmk.com>, <genentechmf1.com>, <genentechmf2.com>, <genentechmf3.com>, and <genentechmf4.com> are registered with Gname.com Pte. Ltd. (the “Registrar”).

### **3. Procedural History**

The Complaint in English was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 12, 2023. On June 12, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On July 13, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Redacted by Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 15, 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 amendment to the Complaint in English on June 15, 2023.

On June 15, 2023, the Center sent an email in English and Chinese to the Parties regarding the language of the proceeding. The Complainant submitted its request that English be the language of the proceeding on June 15, 2023. The Respondents did not comment on the language of the proceeding.

The Center verified that the Complaint together with the amendment to the 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 Respondents in English and Chinese of the Complaint, and the proceedings commenced on June 23, 2023. In accordance with the

Rules, paragraph 5, the due date for Response was July 13, 2023. The Respondents did not submit any response. Accordingly, the Center notified the Respondents' default on July 14, 2023.

The Center appointed Jonathan Agmon as the sole panelist in this matter on July 20, 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, Genentech, Inc., together with its affiliated companies, is a biotechnology company in the business of developing medicines for people with serious and life-threatening diseases and is engaged in the research and development of pharmaceutical products. It has appeared on Fortune Magazine's Best Companies List multiple times.

In March 2009, Complainant merged with F. Hoffmann-La Roche AG ("Roche") and became a member of the Roche Group, which is one of the world's leading research-focused healthcare groups.

The Complainant is the owner of various GENENTECH trademark in the United States, including but not limited to the following:

- United States Patent and Trademark Office Trademark Registration No. 1278624 for GENENTECH, registered on May 22, 1984.

The Complainant also states that it owns the domain names <genentech.com> and <gene.com>, of which, the former resolves to the latter.

The Complainant provided evidence that the Respondents registered the disputed domain names on April 17, 2023. The disputed domain names resolved to websites where the Respondents offer for unauthorized sale and/or investment two of the Complainant's goods. The websites prominently displayed the Complainant's GENENTECH trademark, and mimicked the similar blue color scheme of the Complainant's official website. The disputed domain names currently do not resolve to any active websites.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant argues that the disputed domain names are confusingly similar to the Complainant's registered GENENTECH mark as the Respondents have intentionally registered six confusingly similar domain names that incorporate the Complainant's mark in its entirety.

The Complainant also argues that the Respondents lack any rights or legitimate interests in the marks or the disputed domain names as it has not licensed or permitted the Respondents to use any of its trademarks or register the disputed domain names and that the Respondents registered and continues to use the disputed domain names in bad faith.

##### **B. Respondents**

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

## 6. Discussion and Findings

### 6.1 Preliminary Issues: Consolidation of Proceedings

The Complainant has requested that the six disputed domain names be consolidated under one unitary administrative proceeding.

Neither the Policy nor the Rules expressly provides for or prohibits the consolidation of multiple respondents. In this regard, section 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") states that:

"Where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario.

Panels have considered a range of factors, typically present in some combination, as useful to determining whether such consolidation is appropriate, such as similarities in or relevant aspects of (i) the registrants' identity(ies) including pseudonyms, (ii) the registrants' contact information including email address(es), postal address(es), or phone number(s), including any pattern of irregularities, (iii) relevant IP addresses, name servers, or webhost(s), (iv) the content or layout of websites corresponding to the disputed domain names, (v) the nature of the marks at issue (e.g., where a registrant targets a specific sector), (vi) any naming patterns in the disputed domain names (e.g., <mark-country> or <mark-goods>), (vii) the relevant language/scripts of the disputed domain names particularly where they are the same as the mark(s) at issue, (viii) any changes by the respondent relating to any of the above items following communications regarding the disputed domain name(s), (ix) any evidence of respondent affiliation with respect to the ability to control the disputed domain name(s), (x) any (prior) pattern of similar respondent behavior, or (xi) other arguments made by the complainant and/or disclosures by the respondent(s)."

The Complainant has presented evidence that five of the disputed domain names, namely <genentechmf.com>, <genentechmf1.com>, <genentechmf2.com>, <genentechmf3.com>, and <genentechmf4.com> were registered under identical pseudonyms, each possessing identical email addresses, each possessing identical, incomplete addresses, and each possessing an identical telephone number. These five domain names were registered on April 17, 2023.

The Complainant has presented evidence that the disputed domain name <genentechmfmk.com> was registered under a pseudonym. Its pseudonym, email address, address, and telephone number differ from the above five disputed domain names. It was, however, registered on the same date as the other five disputed domain names, April 17, 2023.

The disputed domain names bear resemblance in terms of naming nomenclature, consisting of the prefix "genentech", followed by various suffixes, with five bearing the most prominent suffixes, "mf", "mf1", "mf2", "mf3", and "mf4". The remaining suffix is "mfmk", which also bears similarity to the other five suffixes.

The six disputed domain names resolve to six webpages with identical layouts and formats. The webpages are also in the same language, English.

The Panel is of the view that there are sufficient similarities between the disputed domain names and the registrant details, such as the use of pseudonyms, and incomplete addresses. Further, five of the registrant contact details are identical for five of the disputed domain names. The nomenclature of the disputed domain names are also very similar. Finally, all six disputed domain names resolve to identical websites. The Panel therefore finds that it is more likely than not that the six domain names are under the control of the same individual or group of individuals, and will permit the consolidation of the proceedings under one unitary proceeding as it would be equitable and procedurally efficient to do so. The Respondents are hereinafter referred to as the "Respondent".

## 6.2 Substantive Issues

### A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. The Complainant has provided evidence that it owns the GENENTECH registered trademark.

The disputed domain names comprise the Complainant's GENENTECH mark in its entirety with the additions of various suffixes.

It is established that in cases where the relevant trademark is recognizable within the disputed domain names, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements. (See [WIPO Overview 3.0](#), section 1.8). Thus, the disputed domain names, which in this case incorporate the Complainant's mark in their entirety and contain additional elements such as the various suffixes "mf", "mfk", "mfk1", "mf2", "mf3" and "mf4" do not avoid a finding of confusingly similarity between the Complainant's mark and the disputed domain names.

Further, it is well established that the addition of a generic Top-Level Domain ("gTLD") ".com" is typically disregarded under the first element when considering the confusing similarity between the Complainant's trademark and the disputed domain names (see [WIPO Overview 3.0](#), section 1.11.1).

Consequently, the Panel finds that the Complainant has shown that the disputed domain names are confusingly similar to a trademark in which the Complainant has rights.

### B. Rights or Legitimate Interests

Once the complainant establishes a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain names, the burden of production shifts to the respondent to show that it has rights or legitimate interests in respect to the disputed domain names (see [WIPO Overview 3.0](#), section 2.1).

In the present case, the Complainant has demonstrated *prima facie* that the Respondent lacks rights or legitimate interests in respect of the disputed domain names and the Respondent has failed to assert any such rights or legitimate interests.

The Complainant has provided evidence that it owns trademark registrations of the GENENTECH mark long before the date that the disputed domain names were registered and that the Complainant is not affiliated with nor has it licensed or otherwise permitted the Respondent to use the Complainant's trademark (see *LEGO Juris A/S v. DomainPark Ltd, David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host master*, WIPO Case No. [D2010-0138](#)).

Further, the Respondent did not submit a Response in the present case and did not provide any explanation or evidence to show rights or legitimate interests in the disputed domain names which would be sufficient to rebut the Complainant's *prima facie* case. In the particular circumstances of the present case, the Respondent's use of the disputed domain names to purportedly offer the Complainant's goods for unauthorized sale and investment which appear to pass it off as the Complainant financial department does not represent a *bona fide* offering of goods or services. Such use of the disputed domain names impersonating the Complainant can never confer rights or legitimate interests on the Respondent.

The Panel is therefore of the view that the Respondent has no rights or legitimate interests in respect of the disputed domain names and accordingly, paragraph 4(a)(ii) of the Policy is satisfied.

### **C. Registered and Used in Bad Faith**

The complainant must also show that the respondent registered and is using the disputed domain names in bad faith (see Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy provides circumstances that may evidence bad faith under paragraph 4(a)(iii) of the Policy.

The Complainant has submitted evidence that the Respondent registered the disputed domains names long after the Complainant registered its GENENTECH trademark. Given the accumulation of good will and distinctiveness of the Complainant's mark over the course of its almost 40-year history, and the fact that the GENENTECH mark appears to be distinctive, it is highly unlikely that the Respondent did not know of the Complainant and its GENENTECH mark prior to the registration of the disputed domain names. This is also evident from the webpages, which all prominently display the Complainant's trademark at the top of the respective webpages.

In addition, the disputed domain names incorporate the entirety of the Complainant's GENENTECH mark along with various additional suffixes which the Panel finds is an attempt by the Respondent to confuse and/or mislead Internet users seeking or expecting the Complainant. Previous UDRP panels ruled that in such circumstances "a likelihood of confusion is presumed, and such confusion will inevitably result in the diversion of Internet traffic from the Complainant's site to the Respondent's site" (see *Edmunds.com, Inc v. Triple E Holdings Limited*, WIPO Case No. [D2006-1095](#)). To this end, prior UDRP panels have established that attracting Internet traffic by using a domain name that is identical or confusingly similar to create a likelihood of confusion with a registered trademark may be evidence of bad faith under paragraph 4(b)(iv) of the Policy.

Further, the Respondent's websites purport to offer for unauthorized sale and/or investment two of the Complainant's goods, two medications produced by the Complainant's company, ROZLYTREK and SUSVIMO. Previous UDRP panels have held that use of a trademark-related domain name to advertise or offer unauthorized, and/or competing products constitutes bad faith under UDRP 4(b)(iv) (See *Bayerische Motoren Werke AG v. Domains by Proxy, LLC / Alfred Kolinz, bmwupdate*, WIPO Case No. [D2017-2450](#); *Bayerische Motoren Werke AG (BMW) v. Balog Sebastian*, WIPO Case No. [D2017-1407](#))

In addition, the Respondent did not submit a Response in this proceeding. Under the circumstances of this case, this is an additional indication of the Respondent's bad faith, which was considered by the Panel.

Based on the evidence presented to the Panel, including the confusing similarities between the disputed domain names and the Complainant's marks, the fact that the disputed domain names were used to impersonate the Complainant, and the fact that no Response was submitted by the Respondent in response to the Complaint, the Panel draws the inference that the disputed domain names were registered and are being used in bad faith.

Accordingly, having regard to the circumstances of this particular case, the Panel finds that the Complainant has met its burden under paragraph 4(a)(iii) 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 names, <genentechmf.com>, <genentechmfmk.com>, <genentechmf1.com>, <genentechmf2.com>, <genentechmf3.com>, and <genentechmf4.com>, be transferred to the Complainant.

*/Jonathan Agmon/*

**Jonathan Agmon**

Sole Panelist

Date: August 3, 2023