

## **ADMINISTRATIVE PANEL DECISION**

BioNTech SE v. Derek Joffrion

Case No. D2023-4970

### **1. The Parties**

The Complainant is BioNTech SE, Germany, represented by MSA IP – Milojevic Sekulic & Associates, Serbia.

The Respondent is Derek Joffrion, United States of America (“United States”).

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

The disputed domain name <biontechgenetics.com> 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 November 29, 2023. On November 29 and 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 12, 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 14, 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 3, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 23, 2024. The Respondent sent multiple email communications to the Center on November 30, December 1, December 13, December 15, December 17, 2023, and January 7, January 9, January 10, January 11, January 17, and January 20, 2024. Accordingly, the Center notified the Parties of the Commencement of Panel Appointment Process on January 24, 2024.

The Center appointed John Swinson as the sole panelist in this matter on January 29, 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 biotechnology company that was founded in 2008 and develops novel therapies for cancer and other serious diseases. The Complainant developed a vaccine in relation to COVID-19 infections.

According to the Complainant, the Complainant's most notable product is the COVID-19 vaccine which is produced together with pharmaceutical company Pfizer, and which is commonly known as the BioNTech/Pfizer COVID-19 vaccine or the Pfizer/BioNTech COVID-19 vaccine and is sold under the trademark COMIRNATY.

Fast Company magazine listed the Complainant as the world's most innovative company in 2021 (where the first place was shared together with Pfizer and Moderna) and the most innovative biotechnology company of 2021 (again, the first place is shared with Pfizer and Moderna).

The Complainant owns several trademark registrations for BIONTECH including United States Trademark No. 5712036, BIONTECH was registered on April 2, 2019.

The Complainant's website is located at "www.biontech.com".

The Respondent did not provide any details about the Respondent, other than that he was a "regular dude" and not a lawyer.

According to the Registrar's records, the Respondent has an address in Louisiana, United States.

The disputed domain name was registered on September 26, 2023.

The disputed domain name redirects to a parking page of afternic.com which states, "This domain is available for sale!" and offers an online form to "Get a price in less than 24 hours". The disputed domain name is also offered on the website of afternic.com for the price of GBP 396,762.41.

In correspondence between the Parties before this Complaint was filed, the Respondent requested that the Complainant make an offer and specify "a fair number for what it's worth and we can go from there" to sell the disputed domain name, while claiming "We're all here to make money and I'm no different". The Respondent also wrote: "The people you represent have not only had ample time to purchase such a domain but also the funding, they have no excuse at this point. So they can go get [expletive] as far as I'm concerned" and "if you play dumb and cheap we'll be at war". The Complainant did not respond.

Additionally, upon receiving the information that the Complaint had been filed, the Respondent contacted the Complainant and the Center directly with several aggressive and obscene emails from November 30, 2023 to January 20, 2024. In essence, the Respondent claimed that the Respondent was entitled to continue to own the disputed domain name because he registered it, that the disputed domain name can be considered as his art and creative work, and hence that the Respondent is authorized to use the disputed domain name in any way he wants, even to sell it.

## **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 that the Complainant's BIONTECH trademark is well-known, including in the United States, and that the Respondent registered the disputed domain name for resale and to take advantage of the Complainant's fame. The Complainant also submits that the disputed domain name is so obviously connected with the Complainant's well-known trademark that its very use by someone with no connection to the trademark suggests opportunistic bad faith.

### **B. Respondent**

The Respondent contends that the Complainant has not satisfied the second and third elements required under the Policy for a transfer of the disputed domain name. The Respondent did not address the first element of the Policy.

The Respondent filed a formal Response plus submitted arguments in several emails. The Panel will consider the formal Response and the emails as a combined Response.

Some of the Respondent's arguments were expressed in colourful language. Some of the Respondent's emails contain arguments that were irrelevant, for example making arguments about the Complainant's industry in general. In some emails, the Respondent made arguments that were opaque (for example, addressing the United States fair use defense).

In summary, the Respondent's contentions include (a) the Respondent created the disputed domain name; (b) the Complainant had ample opportunity to register the disputed domain name but did not do so; (c) the disputed domain name was created using the Respondent's artistic skills; and (d) the disputed domain name has not been used and will not be used commercially by the Respondent.

The Respondent stated: "Me looking for the right buyer who sees the value in my art, is not bad at all. That's how an artist makes money. You put something together from nothing and sell it."

## **6. Discussion and Findings**

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

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

The onus of proving these elements is on the Complainant.

### **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.

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 mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, “genetics”) may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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.

The Respondent registered the disputed domain name and immediately offered it for sale.

The Respondent gave no explanation of why or how he selected the disputed domain name. The Respondent did not state if he is connected to biotech or genetics in any way.

Apparently, according to the Respondent, the Respondent registered the disputed domain name for no particular purpose. The Respondent stated, in an email to the Center: “I might turn it into a blog or something, but I’ve only owned it a few months, and I don’t know anything about domains, so I’m learning, and that’s also why it’s just been sitting there not doing anything.” This statement should be read in light of all the circumstances, including that the Respondent listed the disputed domain name for sale on Afternic soon after registration.

The disputed domain name comprises the Complainant’s trademark. The disputed domain name is not a dictionary term. The Panel also notes that additional term within the disputed domain name is closely related to the Complainant’s business activities, which include using genetic information in developing a portfolio of immunotherapies and exploring new medical treatments, including cancer immunotherapies and vaccines against infectious diseases. Accordingly, the composition of the disputed domain name is such to carry a direct inference of association with the Complainant. Contrast the situation discussed in detail in *Sage Global Services Limited v. Narendra Ghimire, Deep Vision Architects*, WIPO Case No. [DAI2023-0010](#).

Therefore, the Panel can conclude, based on the materials before the Panel, that the Respondent has no intention to develop a legitimate activity through the disputed domain name and that the Respondent is trying to capitalize on the Complainant's reputation through sale of the disputed domain name incorporating the Complainant's BIONTECH trademark. These facts do not demonstrate that the Respondent has rights or legitimate interests in the disputed domain name.

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, it is apparent that the Respondent registered the disputed domain name with the purpose of selling the disputed domain name. While registering a domain name for the purpose of selling at a profit is not per se contrary to the Policy, registering a domain name to resell because it has value due to another's trademark is contrary to the Policy.

Here, the Complainant provided detailed evidence of the Complainant's rights and reputation in the BIONTECH trademark, including in the United States where the Respondent is located. Since COVID-19, the Complainant's reputation has increased significantly. The trademark BIONTECH is a somewhat unusual combination of terms/letters/words. In the Respondent's correspondence with the Center, the Respondent states (in an informal email) "I didn't know who this company was before hand" but does not explicitly state that he was not aware of the BIONTECH trademark when he registered the disputed domain name. Moreover, use of the term "genetics" in the disputed domain name further suggests that the Respondent was aware of the Complainant's trademark.

The Respondent listed the disputed domain name for sale for the price of GBP 396,762.41. This is a substantial amount. The Panel infers that the only likely buyer at this price is the Complainant.

"... the very high prices at which the disputed domain name has been offered for sale on the website to which it has resolved ... are clearly indicative of the Respondent's belief that a company might be willing to pay a sum approximating or approaching the exceptionally high sum sought by the Respondent and the very high asking price for the disputed domain name tends to affirm the likelihood of targeting by the Respondent. ... the only conceivable buyer of the disputed domain name at the level of consideration sought by the Respondent is the Complainant or, conceivably, a competitor of it." *Automobili Lamborghini S.p.A. v. Domain Administrator*, See *PrivacyGuardian.org / Richard Blair*, WIPO Case No. [D2022-1570](#).

The Panel can infer, based on the evidence before the Panel, that the Respondent registered the disputed domain name with the intent of selling it to the Complainant.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1. Here, the Panel finds that paragraph 4(b)(i) applies.

Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, and (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use. [WIPO Overview 3.0](#), section 3.3. Having reviewed

the available record, the Panel notes the distinctiveness or reputation of the Complainant's trademark, and the composition of the disputed domain name, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

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 <biontechgenetics.com> be transferred to the Complainant.

*/John Swinson/*

**John Swinson**

Sole Panelist

Date: February 12, 2024