

ADMINISTRATIVE PANEL DECISION

Genentech, Inc. v. ww ww, woermabiscrhtdr
Case No. D2023-5287

1. The Parties

The Complainant is Genentech, Inc., United States of America (“United States”), represented by F. Hoffmann-La Roche AG, Switzerland.

The Respondent is ww ww, woermabiscrhtdr, Guam, United States.

2. The Domain Names and Registrar

The disputed domain names <genentechmfb.com>, <genentechmfp.com>, <genentechmfq6.com>, <genentechmfr.com>, and <genentechmfy.com> are registered with Gname.com Pte. Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 20, 2023. On December 20, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On December 21, 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 for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 12, 2024, 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 on January 15, 2024.

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 Respondent of the Complaint, and the proceedings commenced on January 18, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 7, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 14, 2024.

The Center appointed Gary Saposnik as the sole panelist in this matter on February 21, 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, 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.

The Complainant and F. Hoffmann-La Roche AG form part of a larger corporate entity, the Roche Group, which is one of the world's leading research-focused healthcare groups.

The Complainant is the owner of various GENENTECH trademarks 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 Respondent registered the disputed domain names <genentechmfp.com>, <genentechmfb.com>, <genentechmfr.com>, and <genentechmfy.com> on November 23, 2023, and that the Respondent registered the disputed domain name <genentechmfq6.com> on November 21, 2023. The disputed domain names resolved to websites featuring the Complainant's mark and where the Respondents offered purported investment opportunities for a number of the Complainant's goods. The disputed domain names currently do not resolve to any active 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 names.

Notably, the Complainant contends that the disputed domain names are confusingly similar to the Complainant's registered GENENTECH mark as the Respondents have intentionally registered five confusingly similar domain names that incorporate the Complainant's mark in its entirety.

The Complainant also argues that the Respondent lacks any rights or legitimate interests in the trademark or the disputed domain names as it has not licensed or permitted the Respondent to use any of its trademarks or register the disputed domain names and that the Respondents registered and continue to use the disputed domain names in bad faith. The Complainant claims that the Respondent did not reply to the cease-and-desist letter sent and has not availed itself of the opportunity to present any case of legitimate interest that it might have.

The Complainant alleged that the purpose of registering the disputed domain names is to engage in a phishing scheme pretending to represent the Financial Department of the Complainant. The Complainant further alleges that the Respondent is deliberately using the disputed domain names with a connection to the Complainant's GENENTECH mark in order to confuse consumers by making them believe that the website

behind the links is recommended by the Complainant and respectively operated by the Complainant. The Complainant alleges that the Respondent websites used the GENENTECH mark in the same position and same color as the Complainant's website.

B. Respondent

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

6. Discussion and Findings

Consolidation: Multiple Respondents

The Complaint was originally filed with arguments concerning the consolidation of the single Complaint against the potential multiple registrants of the disputed domain names. Therein, the Complainant alleges that the domain name registrants are the same entity or mere alter egos of each other, or under common control. The Complainant requests the consolidation of the Complaint against the multiple disputed domain name registrants pursuant to paragraph 10(e) of the Rules.

Ultimately, upon the Registrar's disclosure of the Respondent information, the multiple disputed domain names were disclosed to have been registered by a single registrant. Said disclosure was subject to the amendment to the Complaint received on January 15, 2024, amending the Complaint to reflect the disclosed Respondent.

Accordingly, in view of the single Respondent disclosed for the multiple disputed domain names, the Panel finds that consolidation is proper.

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 entirety of the mark is reproduced within the disputed domain names. Accordingly, the disputed domain names are 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, "mfp", "mfb", "mfr", "mfy", and "mfq6", may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names 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.

In the present case, the Complainant has provided evidence of prior rights in the trademark GENENTECH, which long preceded the Respondent's registration of the disputed domain names. The Respondent is not connected nor affiliated with the Complainant and has not received any license or consent, express or implied, to use the Complainant's GENENTECH mark.

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 names. 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 names such as those enumerated in the Policy or otherwise.

Panels have held that the use of a domain name for illegal activity here, claimed as applicable to this case: phishing, impersonation/passing off, or other types of fraud, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1. *MultiPlan, Inc. v. WhoisGuard Protected, WhoisGuard, Inc./Lilly Walton*, WIPO Case No. [D2021-1123](#).

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 registered the disputed domain names many years after the Complainant registered its GENENTECH trademark. With the distinctiveness of the Complainant's GENENTECH mark, the inclusion of the mark in its entirety in each of the disputed domain names, along with the Complainant's mark and products displayed on each of the websites that the disputed domain names resolved to, 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. Although the Complainant alleges that it sent a cease and desist letter to the Respondent, the evidence shows that the letter was sent to the Registrar of the disputed domain names. There is no evidence that the Registrar forwarded the letter to the Respondent, nor evidence that the letter was received by the Respondent. Nevertheless, given the findings above and particularly the Respondent's reported location in an overseas territory of the United States, the country of origin for the Complainant, it seems more likely than not that the Respondent was aware of the Complainant at the time of registration of the disputed domain names.

Similar to a previous UDRP case decided in favor of the Complainant (*Genentech, Inc. v. hh hhh, ds df*, WIPO Case No. [D2023-2521](#), with registered similar domains <genentechmf.com>, <genentechmfmk.com>, <genentechmf1.com>, <genentechmf2.com>, <genentechmf3.com>, <genentechmf4.com>), the disputed domain names incorporate the entirety of the Complainant's GENENTECH mark along with various additional suffixes. As in the prior decision involving the Complainant, the Respondent used an identical pattern with the websites including investment opportunities related the Complainant's products. This Panel also finds this is an attempt by the Respondent to confuse and/or mislead Internet users seeking the Complainant. As in the decision cited above and other prior UDRP decisions, 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. *Associated Newspapers Limited v. WhoisGuard, Inc/Arvind Walar*, WIPO Case No. [D2019-3057](#).

While 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, 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.

Panels have held that the use of a domain name for illegal activity here, claimed as applicable to this case: phishing, impersonation/passing off, or other types of fraud, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

Based on a totality of the record and evidence submitted to the Panel, including the confusing similarities between the disputed domain names and the Complainant's mark, the fact that the disputed domain names were used to impersonate the Complainant in a pattern of conduct, and the fact that no Response was submitted by the Respondent in response to the Complaint, the Panel determines that the disputed domain names were registered and are being used in 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 names, <genentechmfb.com>, <genentechmfp.com>, <genentechmfq6.com>, <genentechmfr.com>, <genentechmfy.com>, be transferred to the Complainant.

/Gary Saposnik/

Gary Saposnik

Sole Panelist

Date: March 6, 2024