

## **ADMINISTRATIVE PANEL DECISION**

### **BIOCODEX SAS v. Toni Carl**

### **Case No. D2022-0353**

#### **1. The Parties**

The Complainant is BIOCODEX SAS, France, represented by Nameshield, France.

The Respondent is Toni Carl, Portugal.

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

The disputed domain name <biocodax.com> is registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the “Registrar”).

#### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on February 1, 2022. On February 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 2, 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 February 2, 2022 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 in English on February 3, 2022.

On February 2, 2022, the Center transmitted an email communication to the Parties in English and Japanese regarding the language of the proceeding. On February 3, 2022, the Complainant 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 February 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 28, 2022. The Respondent did not submit

any response. On March 1, 2022, the Center informed the Parties that it would proceed to panel appointment.

The Center appointed Teruo Kato as the sole panelist in this matter on March 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**

According to the Complainant, the Complainant was founded in 1953 and is an independent multinational pharmaceutical company with its headquarters located in Gentilly near Paris, France and serves patients in more the 120 countries with focuses on microbiota care, women's health, and orphan diseases.

The Complainant owns the International trademark registration No. 1203687 for BIOCODEX, registered on March 27, 2014, covering goods and services in class 05 (Pharmaceutical and sanitary products; dietetic substances for medical use, food for babies; disinfectants), designating various jurisdiction including Portugal, where the Respondent is registered to be located.

Additionally, the Complainant owns, among others, the domain name <biocodex.com>, which resolves to the Complainant's website.

The disputed domain name <biocodax.com> was registered on December 2, 2021.

The Respondent is Toni Carl, whose address is given as in Portugal.

As evidenced in the Complaint, the disputed domain name resolves to an error page and has been used in a phishing scheme.

The Complainant requests that the disputed domain name be transferred to the Complainant.

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

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

The Complainant contends that it is the owner of trademark BIOCODEX.

The Complainant also contends that the disputed domain name is confusingly similar to the Complainant's BIOCODEX trademark.

The Complainant further contends that the Respondent is not a licensee, an authorized agent of the Complainant, or in any other way authorized to use the Complainant's trademark BIOCODEX and that the Respondent is not commonly known by the disputed domain name as an individual, business, or other organization, and that the Respondent does not make any *bona fide* use or trade under the disputed domain name.

The Complainant also contends that the Respondent registered and is using the disputed domain name in bad faith.

##### **B. Respondent**

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

## 6. Discussion and Findings

### 6.1 Preliminary Issue: Language of the Proceeding

Pursuant to paragraph 11(a) of the Rules, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to authority of the Panel to determine otherwise having regard to the circumstances of the administrative proceeding. The Panel notes that in the present case the Registrar has confirmed that the language of the Registration Agreement is Japanese.

The Complainant has filed the Complaint in English, and requests that the language of the proceeding be English on the grounds, among others, that the disputed domain name is composed of Roman characters (ASCII) and not in Japanese script, that the Respondent is located in Portugal and it has contacted the Complainant's customers in the English language, and that the use of Japanese as the language of the proceeding would impose an excessive cost burden on the Complainant.

On February 2, 2022, the Respondent was invited by the Center, in both Japanese and English, to indicate any objection to the proceeding being conducted in English by February 7, 2022. The Respondent did not respond to this by the specified deadline nor later.

On February 8, 2022, the Center informed the Respondent, in both Japanese and English, that the Center has decided, under the circumstances of this case, to: 1) accept the Complaint as filed in English; 2) accept a Response in either English or Japanese; 3) appoint a Panel familiar with both languages mentioned above, if available. Accordingly, the Panel would have accepted a Response in Japanese, but none was submitted by the Respondent.

In the circumstances, in accordance with paragraph 11(a) of the Rules, the Panel decides that English be the language of the proceeding. The Panel further finds that such determination would not cause any prejudice to either Party and would ensure that the proceeding takes place with due expedition.

### 6.2 Substantive Issues

#### A. Identical or Confusingly Similar

The Panel must determine whether (a) the Complainant has a trademark or service mark; and (b) whether the disputed domain name is identical or confusingly similar to that trademark or service mark.

The Complainant submitted evidence of its BIOCOCODEX trademark registration, and the Panel is satisfied that the Complainant is the owner of the International trademark registration No. 1203687 for BIOCOCODEX.

As to the confusing similarity element for the purposes of the Policy, the Panel has proceeded to compare the disputed domain name to the trademark rights which have been provided.

Section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)) states that "[t]he applicable Top Level Domain ('TLD') in a domain name (e.g., 'info', '.com', '.club') is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test". The Panel finds no reason why this established practice should not be applied to the present case.

Apart from the TLD ".com", the Complainant contends that the disputed domain name contains its trademark BIOCOCODEX in its entirety with the letter "e" being substituted by the letter "a", and it submits that "[t]his is thus a clear case of "typosquatting", i.e. the disputed domain name contains an obvious misspelling of the Complainant's trademark: BIOCOCODAX instead of BIOCOCODEX®".

The Panel notes that section 1.7 of the [WIPO Overview 3.0](#) states that "[w]hile each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a

dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.”

Furthermore, the Panel notes that section 1.9 of the [WIPO Overview 3.0](#) states “[a] domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element”. In the circumstances, the Panel sees no reason why this established practice should not be applied to the present case and holds that the disputed domain name is confusingly similar to the Complainant’s trademarks.

Accordingly, the Panel finds that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

## **B. Rights or Legitimate Interests**

Under paragraph 4(c) of the Policy, any of the following circumstances, if found by the Panel, may demonstrate a respondent’s rights or legitimate interests in a domain name:

(i) before any notice to it of the dispute, the respondent’s use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

(iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The consensus view of UDRP panels is that the burden of proof in establishing no rights or legitimate interests in respect of a domain name rests with the complainant in making out a *prima facie* case that the respondent lacks rights or legitimate interests. Once such *prima facie* case is made, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (see section 2.1 of the [WIPO Overview 3.0](#)).

In the present case, the Complainant contends with relevant evidence that “[t]he Respondent is not known by the Complainant. The Complainant contends that Respondent is not affiliated with nor authorized by the Complainant in any way. The Complainant contends that Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant does not carry out any activity for, nor has any business with the Respondent. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant’s trademark BIOCDEX®, or apply for registration of the disputed domain name.”

Further, the Complainant contends that “the disputed domain name [...] has been used in a phishing scheme (Annex 7). Indeed, the Complainant asserts that Respondent uses the disputed domain name to pass itself off as one of the employees of BIOCDEX, in order to receive products in place of the Complainant.”

The Panel examined the evidence submitted by the Complainant and is satisfied that it shows an email message dated December 15, 2021 sent in the name of “Export Sales Administration Attache, Customer Service” of the Complainant with its contact details at its signature place, which included the email address “[...]@biocodex.fr” but that the sender’s email address is stated as “[...]@biocodax.com” (emphasis added), which is directly derived from the disputed domain name.

Further, the said email message appears to have been sent to a company in Brazil recognizable as active in the pharmaceutical sector and the same was copied to five further email addresses of that Brazilian company, as well as to two staff of the Respondent, whose email addresses are connected to the disputed

domain name. The Panel is of a view that this probably is a deliberate attempt by the Respondent to make the recipient customer believe the authenticity of that email message.

The said email messages states that “Dear [...], When is the payment date for invoice [...] ? N.B. We are having a huge amount of payment lodgment from customers on our Iban [...] Find attached our new Subsidiary account IBAN for invoice [...] payment. Please advise that you have received our new Subsidiary account IBAN for invoice [...] remittance. Thanks for payment in advance. Best regards”

The Panel holds that this communication is clearly intended to fraudulently impersonate the Complainant for undue financial gain or otherwise take unfair advantage of the Complainant. Accordingly, the Panel is satisfied that the Complainant has established a *prima facie* case of no rights or legitimate interests.

By not submitting a Response, the Respondent has failed to overturn such *prima facie* case and has also failed to invoke any of the defenses as set out in paragraph 4(c) of the Policy.

Further, the Panel notes section 2.13.1 of the [WIPO Overview 3.0](#), which states (emphasis added):

“Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, *phishing*, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent.”

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

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

To fulfill the third requirement, the Complainant must prove that the disputed domain name was registered and is being used in bad faith.

In the present case the Panel notes that the trademark BIOCODEx was registered and extensively used internationally, including Portugal where the Respondent resides, long before the disputed domain name was registered on December 2, 2021. The Panel therefore holds that the Respondent was most likely to have known of the Complainant, its products, and trademarks prior to registering the disputed domain name and that the Respondent registered the disputed domain name in bad faith, and also notes the fraudulent use of the disputed domain name affirms such a finding.

As to the use in bad faith, as already considered in section B above, the email addresses directly deriving from the disputed domain name were used in the Respondent’s apparent attempt to fraudulently obtain funds from one of the customers of the Complainant.

In this regard the Panel note section 3.4 of the [WIPO Overview 3.0](#), which states (emphasis added):

“Panels have held that the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include *sending email, phishing, identity theft*, or malware distribution. [...] Many such cases involve the respondent’s use of the domain name *to send deceptive emails, e.g.*, to obtain sensitive or confidential personal information from prospective job applicants, or to solicit payment of fraudulent invoices by the complainant’s actual or prospective customers.”

The Panel holds that the facts of the present case correspond to the situations outlined above, and the Panel sees no reason why this established practice should not be applied to the present case.

The Panel also notes that (i) that the disputed domain name is a typo of a widely-known mark owned by the Complainant, and (ii) that no Response has been filed by the Respondent. The Panel holds that these facts may further infer bad faith on the part of the Respondent (see section 3.2.1 of the [WIPO Overview 3.0](#)).

In the circumstances, the Panel is satisfied with the Respondent's bad faith in registration and use of the disputed domain name.

The Panel therefore concludes that the third requirement of the Policy has been met.

## **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 <biocodax.com> be transferred to the Complainant.

*/Teruo Kato/*

**Teruo Kato**

Sole Panelist

Date: March 16, 2022