

ADMINISTRATIVE PANEL DECISION

Genentech, Inc. v. Fubin Yin
Case No. D2023-0551

1. The Parties

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

The Respondent is Fubin Yin, Lao People’s Democratic Republic.

2. The Domain Names and Registrar

The disputed domain names <genentech.homes>, <genentech.ink>, <genentech.me>, and <genentech.wiki> (the “Disputed Domain Names”) are registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 7, 2023. On February 7, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On February 8, 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 February 8, 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 February 8, 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 February 9, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 1, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 3, 2023.

The Center appointed Mariya Koval as the sole panelist in this matter on March 8, 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, founded in 1976, is an American biotechnology corporation headquartered in South San Francisco, California. The Complainant's core business is discovering and developing medicines for people with serious and life-threatening diseases, including the first targeted antibody for cancer and the first medicine for primary progressive multiple sclerosis. In 2009, the Complainant became an independent subsidiary of Roche Group - a Swiss multinational healthcare company. As of 2021, the Complainant employed 13,539 employees. Fortune Magazine has chosen the Complainant to appear on their Best Companies List for several times.

The Complainant is the owner of the GENENTECH trademark (the "GENENTECH Trademark") United States Registration No. 1278624, registered on May 22, 1984, in respect of goods in class 5.

The Complainant operates domain names <genentech.com> (registered on May 28, 1997) and <gene.com> (registered on September 22, 1987).

The Disputed Domain Names were registered on December 10, 2022. As at the date of this Decision the Disputed Domain Names <genentech.homes> and <genentech.ink> resolve to the parked pages with different pay-per-click ("PPC") links to third party websites, primarily competitive with the Complainant; the Disputed Domain Names <genentech.me> and <genentech.wiki> resolve to inactive websites.

According to the evidence submitted with the Complaint (Annex 7 to the Complaint), the Disputed Domain Names <genentech.me> and <genentech.wiki> previously resolved to websites offering investment opportunities, and the Disputed Domain Names <genentech.homes> and <genentech.ink> resolved to the parked pages with PPC links to third party websites.

5. Parties' Contentions

A. Complainant

The Complainant asserts that the Disputed Domain Names, reproducing the entirety of the GENENTECH Trademark, are confusingly similar to the Complainant's GENENTECH Trademark, making it possible for customers to believe that the Disputed Domain Names are related to the Complainant.

The Complainant further contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names. The Complainant has exclusive and prior rights in the GENENTECH Trademark, which precede the Respondent's registration of the Disputed Domain Names. The Respondent has no connection or affiliation with the Complainant and has not received any license or consent, express or implied, to use the Complainant's GENENTECH Trademark.

The Complainant also contends that the Disputed Domain Names <genentech.me> and <genentech.wiki> resolved to the webpages offering investment opportunities. The purpose of registering the Disputed Domain Names is to engage in a phishing scheme pretending to represent the Financial Department of the Complainant. It is obvious from the websites that the mentioned Disputed Domain Names are being used in an active and commercial way. The Respondent was deliberately using the said Disputed Domain Names with a connection to the Complainant's GENENTECH Trademark in order to confuse the consumers by making them believe that the websites behind the links are recommended by the Complainant and respectively operated by him. Potential "investors" were attracted for example via WhatsApp messages, whereas the Respondent pretended to be an employee of the Complainant selling "investments". Moreover, when comparing the abovementioned websites of both the Complainant and the Respondent, one can clearly recognize that the Respondent was obviously intentionally using the Complainant's GENENTECH Trademark, not only at the same position of the website (top left corner) but also using the same colour, namely blue.

The Respondent did not reply to the cease and desist letter sent with respect to the Disputed Domain Name <genentech.me> and hence has not availed itself of the opportunity to present any case of legitimate interest that he might have.

The Complainant claims that the Disputed Domain Names were registered and are being used in bad faith in view of the following:

- the Respondent could not ignore the GENENTECH Trademark because the Respondent's registration of the Disputed Domain Names is well after the Complainant's Trademark registration;
- the Disputed Domain Names just consist of the reproduction of the Complainant's GENENTECH Trademark with the addition of country code Top-Level Domains ("ccTLD") ".me" and new generic Top-Level Domains ("gTLD") ".homes", ".ink" and ".wiki". Therefore, the Disputed Domain Names were undoubtedly registered with the intent to create an impression of an association with the Complainant's GENENTECH Trademark;
- the choice of the Respondent is not a coincidence: the Disputed Domain Names contain the GENENTECH Trademark and resolved to websites selling investment opportunities (<genentech.me> and <genentech.wiki>), respectively sponsored PPC links (<genentech.homes> and <genentech.ink>);
- the Respondent also used a privacy shield and did not respond to the Complainant's cease and desist letter;
- the Respondent is deliberately using the Disputed Domain Names with a connection to the Complainant's GENENTECH Trademark in order to capitalize on the Complainant's goodwill in its Trademark, mislead the consumers and confuse them by making them believe that the websites behind the links are recommended respectively operated by the Complainant.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, in order for the Complainant to succeed it must satisfy the Panel that:

- (i) the Disputed Domain Names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names; and
- (iii) the Disputed Domain Names were registered and are being used in bad faith.

A. Identical or Confusingly Similar

The Panel is satisfied that the Complainant owns exclusive rights in the GENENTECH Trademark, which sufficiently predate the registration of the Disputed Domain Names.

The Disputed Domain Names completely reproduce the Complainant's GENENTECH Trademark in combination with the ccTLD ".me" and new gTLD ".homes", ".ink" and ".wiki". According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.11, the applicable gTLD in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

Previous UDRP panels have recognized that incorporation of a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to the complainant's registered mark; see *bridport & cie S.A v. Privatewhois.net, Private Whois bridportadvisory.com*, WIPO Case No. [D2011-2262](#).

Accordingly, the Panel finds that the Disputed Domain Names are identical to the Complainant's GENENTECH Trademark pursuant to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant contends that the Respondent is not affiliated with the Complainant in any way and it has not been authorized by the Complainant to use and register the GENENTECH Trademark. The Disputed Domain Names completely incorporate the Complainant's Trademark, which at the same time is also the Complainant's company name. According to the [WIPO Overview 3.0](#), section 2.5.1, "UDRP panels have found that domain names identical to a complainant's trademark carry a high risk of implied affiliation".

In accordance with section 2.1 of the [WIPO Overview 3.0](#) while the overall burden of proof in UDRP proceedings is on the Complainant, the Complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests. If 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 Disputed Domain Name. If the Respondent fails to come forward with such relevant evidence, the Complainant is generally deemed to have satisfied the second element.

There is no evidence that the Respondent appears to own any GENENTECH trademark, nor is the Respondent commonly known by the Disputed Domain Names. Furthermore, the Panel concludes that in view of the reputation of the GENENTECH Trademark it is highly unlikely that anybody could legitimately adopt the Disputed Domain Names for commercial use other than for an intent to create confusion with the Complainant.

Furthermore, the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Names. Namely, the Disputed Domain Names <genentech.homes> and <genentech.ink> resolve to the parked pages with different PPC links to third party websites, primarily competitive with the Complainant; the Disputed Domain Names <genentech.me> and <genentech.wiki> resolve to inactive websites. According to the evidence submitted with the Complaint (Annex 7 to the Complaint), at the date of the Complaint the Disputed Domain Names <genentech.me> and <genentech.wiki> resolved to websites offering investment opportunities, where the users' personal data were defrauded. Moreover, the Respondent pretended to be an employee of the Complainant selling "investments", attracting potential "investors" via, among others, WhatsApp messenger. In pursuance of section 2.13.1 of the [WIPO Overview 3.0](#) "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". Taking into consideration all circumstances of this case, the Panel considers that it is obvious that the Respondent registered the Disputed Domain Names with the sole intention of commercial gain by creating a likelihood of confusion with the Complainant's GENENTECH Trademark as to the source of the communication sent using the Disputed Domain Names. The Panel cannot consider such use of the Disputed Domain Names as *bona fide* offering goods or services, or a legitimate noncommercial or fair use.

The Respondent did not respond to the Complaint and did not participate in this proceeding, accordingly, the Respondent has failed to present any evidence to support any rights or legitimate interests in the Disputed Domain Names.

In view of the foregoing, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names and that the Complainant succeeds under the second element of paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out a non-exhaustive list of circumstances that indicate bad faith conduct on the part of the respondent, namely:

- “(i) circumstances indicating that the respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent’s documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) the respondent has registered the disputed domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the disputed domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent’s website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the respondent’s website or location or of a product or service on the respondent’s website or location.”

The Panel concludes that the Respondent has registered and is using the Disputed Domain Names in bad faith.

The Panel finds that the Complainant’s first registration for the GENENTECH Trademark predates the registration of the Disputed Domain Names by almost 40 years. The Disputed Domain Names are identical to the Complainant’s GENENTECH Trademark.

The Respondent should have known about the Complainant’s Trademark rights, as such knowledge is readily obtainable through at least a simple browser search (see *Caesars World, Inc. v. Forum LLC*, WIPO Case No. [D2005-0517](#); and *Compart AG v. Compart.com / Vertical Axis Inc.*, WIPO Case No. [D2009-0462](#)).

The Disputed Domain Names <genentech.homes> and <genentech.ink> redirect to the parked pages with different PPC links to third party websites competitive with the Complainant. This use of the designated Disputed Domain Names incorporating the GENENTECH Trademark by an unauthorized third party to redirect Internet users to competitor’s websites is evidence of bad faith under paragraph 4(b)(iv) of the Policy.

The Disputed Domain Names <genentech.me> and <genentech.wiki> resolved to websites offering investment opportunities, where the users’ personal data were defrauded. In accordance with the [WIPO Overview 3.0](#), section 3.4, UDRP 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 (in some such cases, the respondent may host a copycat version of the complainant’s website). 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.

Therefore, the Panel finds that, taking into consideration all circumstances of this case, the Disputed Domain Names more than likely appear to have been registered and used in bad faith, with well awareness of the Complainant’s GENENTECH Trademark and with the only intention to benefit from the ownership of the Disputed Domain Names, that was likely to confuse the Internet users into thinking they were related to the Complainant.

Therefore, having examined all the circumstances of the case the Panel finds that the Respondent registered and is using the Disputed Domain Names in bad faith, and accordingly that the paragraph 4(a)(iii) of the Policy has been satisfied by the Complainant.

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 <genentech.homes>, <genentech.ink>, <genentech.me>, and <genentech.wiki> be transferred to the Complainant.

/Mariya Koval/

Mariya Koval

Sole Panelist

Date: March 22, 2023