

## **ADMINISTRATIVE PANEL DECISION**

BioNTech SE v. Ravindra Bala  
Case No. D2024-2718

### **1. The Parties**

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

The Respondent is Ravindra Bala, United States of America (“United States”).

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

The disputed domain names <biontechs.com>, <biontechservices.com>, and <wwwbiontech.com> are registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 3, 2024. On July 3, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On July 4, 2024, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 July 12, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 1, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 2, 2024.

The Center appointed Kateryna Oliinyk as the sole panelist in this matter on August 12, 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 was founded in 2008 and is a biotechnology company which develops and manufactures active immunotherapies, which include pharmaceutical candidates based on messenger RNA (mRNA) for use, inter alia as vaccines against infectious diseases. The Complainant has a strong global media presence and has acquired worldwide renown in the past three years because of its BIONTECH COVID-19 vaccine.

The Complainant is the owner of a number of trademarks for its BIONTECH trademark, including the following:

- European Union Trademark Registration No. 008964447 for BIONTECH, registered on December 22, 2010, duly renewed and covering goods and services in International Classes 1, 5, 42, and 44;
- European Union Trademark Registration No. 016241465 for BIONTECH, registered on November 9, 2017, and covering goods and services in International Classes 1, 5, 9, 10, 16, 31, 41, 42, and 44;
- International Trademark Registration No. 1478253 for BIONTECH (word/device), registered on April 5, 2019, covering goods and services in International Classes 1, 5, 42, and 44;
- International Trademark Registration No. 1370266 for BIONTECH, registered on July 10, 2017, and covering goods and services in International Classes 1, 5, 16, 31, 42, and 44;
- United States Trademark Registration No. 5712036 for BIONTECH, registered on April 2, 2019, and covering goods and services in International Classes 1, 5, 16, 31, 42, and 44.

In addition, the Complainant is the registrant of a number of domain names, many of which incorporate its BIONTECH trademark. These domain names include the following:

- <biontech.com> created on May 29, 1998;
- <biontech.de> created on October 10, 2007;
- <biontech.cn> created on January 31, 2019;
- <biontech.info> created on February 27, 2009;
- <biontech.net> created on February 27, 2009;
- <biontech.us> created on May 8, 2019;
- <biontech-covid19.com> created on June 5, 2020; and
- <biontechglobal.com> created on April 20, 2020.

A number of prior UDRP panels in domain name disputes have recognized the well-known character of the BIONTECH trademark factoring the Complainant's extensive presence in media during the COVID-19 pandemic (January 2020 – May 2023) and recognition of its vaccine.

The disputed domain names were created on March 31, 2022, with configured redirection to the webpage with the only notice that the disputed domain names are for sale and with indication of the e-mail address for the contacts.

The Respondent was a party as respondent in no less than eight previous UDRP proceedings, all of which were decided in favour of the complainants.

#### **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.

### **Identical or Confusingly Similar**

The Complainant contends that the disputed domain names and the BIONTECH trademark are confusingly similar.

The Complainant claims that all the disputed domain names incorporate the Complainant's BIONTECH trademark in its entirety as the second-level domain (SLD) in combination with the letter "s", generic term "services" and "www" prefix respectively, within the generic top-level domain (gTLD) ".com".

The Complainant further contends that the BIONTECH trademark remains recognizable within the disputed domain names and incorporation of a well-known trademark may be sufficient to establish that the disputed domain names are confusingly similar to the Complainant's BIONTECH trademark.

The Complainant also contends that the addition of the letter "s", generic term "services" and "www" prefix to the Complainant's BIONTECH trademark in the disputed domain names, respectively, does not prevent confusing similarity.

The Complainant further claims that the gTLD ".com" in the disputed domain names should be viewed as a standard registration requirement and disregarded.

### **No Rights or Legitimate Interests**

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain names.

According to the Complainant's contentions, the Respondent is not commonly known by the disputed domain names, has not used or prepared to use the disputed domain names in connection with a bona fide offering of goods or services, and has not been authorized, licensed, or otherwise permitted by the Complainant to register and/or use the disputed domain names.

The Complainant also highlights that the Respondent was a party as respondent in no less than eight UDRP proceedings, all of which were decided in favor of the complainants. It has already been established by a previous panel that the Respondent has engaged in a bad faith pattern of cybersquatting of domain names corresponding to the registered trademarks of third-party brand owners. That indicates the lack of legitimate interest in the disputed domain names on the side of respondent.

The Complainant further asserts that the Respondent is clearly targeting the Complainant by creating the disputed domain names which include the Complainant's BIONTECH trademark and that the Respondent is trying to capitalize on the Complainant's global fame through sale of the disputed domain names, which cannot under any circumstances be observed as a bona fide offering of goods or services.

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

The Complainant submits that the Respondent registered and is using the disputed domain names in bad faith. The Respondent must have been aware of the Complainant's BIONTECH trademark when it registered the disputed domain names.

The Complainant further contends that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.

The Complaint also asserts that the Respondent's history of bad faith registrations of well-known trademarks leaves no doubt in respect of bad faith registrations in this case as well. Having in mind the number of previous UDRP cases and their outcomes, the Complainant states that the Respondent's behavior constitutes a pattern of conduct of preventing trademark holders from reflecting the mark in a corresponding domain name.

The Complainant also submits that the Respondent is trying to benefit from the fame of the Complainant's BIONTECH trademark and assumes that the Respondent's primary motive in registering and using the disputed domain names was to capitalize on or otherwise take advantage of Complainant's trademark rights.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions

## **6. Discussion and Findings**

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires the Complainant to prove each of the following in order to bring a successful Complaint:

- i. that the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- ii. that the Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- iii. that the disputed domain names have been registered and are being used in bad faith.

Considering that the Respondent did not reply to the Complainant's contentions, in order to determine whether the Complainant has met its burden as stated in paragraph 4(a) of the Policy, the Panel bases its decision on the statements and documents submitted and in accordance with the Policy and the Rules.

Under paragraph 14(b) of the Rules, where a Party does not comply with any provision of the Rules, the Panel "shall draw such inferences therefrom as it considers appropriate".

### **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 disputed domain names incorporate the Complainant's BIONTECH trademark in its entirety as the SLD in combination with the letter "s", the term "services" and the "www" prefix respectively, within the gTLD ".com".

The Panel finds the mark is recognizable 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.

Section 1.11.1 of [WIPO Overview 3.0](#) states: “The applicable TLD 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”. The gTLD “.com” will therefore be discounted in the Panel’s consideration of confusing similarity.

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 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.

The uncontested evidence is that the Respondent has not made, and is not currently making, a legitimate noncommercial or fair use of the disputed domain names, without intent for commercial gain to misleadingly divert consumers pursuant to paragraph 4(c)(iii) of the Policy. Nor, alternatively, does paragraph 4(c)(i) of the Policy apply. In that regard, the Complainant contends that the redirection of the disputed domain names to a website offering the disputed domain names for sale does not constitute a bona fide offering of goods or services, rather the Respondent is attempting to unfairly capitalize on the reputation and goodwill of the Complainant’s BIONTECH trademark.

The uncontested evidence also indicate that the Respondent has engaged in a pattern of trademark-abusive domain name registrations that cannot support a claim to rights or legitimate interests.

The Panel also notes that the Respondent has failed to provide any evidence or submit any arguments to demonstrate that it has any rights or legitimate interests in the disputed domain names or rebut the Complainant’s prima facie case.

This Panel accepts that the Complainant has made out a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names and, in the absence of a Response by the Respondent, the Panel finds that the Complainant has satisfied the requirement under paragraph 4(a)(ii) of the Policy.

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.

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.

On the issue of registration, it is most unlikely that the Respondent registered the disputed domain names without knowledge of the BIONTECH trademark.

The Panel finds that at the time of registration of the disputed domain names in March 2022, the Complainant already had its BIONTECH trademark registered in various countries, including the United States, where the Respondent is located. The Panel agrees that the BIONTECH trademark is well-known and reputable amongst the general public. This well-known status has been considered and confirmed in numerous previous UDRP decisions. It would not be plausible for the Respondent to claim that it is unaware of the Complainant's BIONTECH trademark which is incorporated in its entirety in the disputed domain names and is inherently distinctive and has gained a high degree of recognition during the COVID pandemic. The Panel is prepared to infer that the Respondent knew or should have known that its registration would be confusingly similar to the Complainant's BIONTECH trademark ([WIPO Overview 3.0](#), section 3.2). In view of the foregoing, the Panel finds that at the time of registration of the disputed domain names, the Respondent must have been aware of the existence, goodwill, and reputation of the Complainant and its BIONTECH trademark.

On the issue of use, the Complainant's evidence shows that the disputed domain names redirect Internet users to a "for sale" page. In *Trip.com, Inc. v. Daniel Deamone*, WIPO Case No. [D2001-1066](#), the Panel stated: *"There is nothing inherently wrongful in the offer or sale of domain names, without more, such as to justify a finding of bad faith under the Policy. However, the fact that domain name registrants may legitimately and in good faith sell domain names does not imply a right in such registrants to sell domain names that are identical or confusingly similar to trademarks or service marks of others without their consent. Although Respondent's offer of the Domain Name for sale was not made specifically to Complainant or its competitor, offers for sale to the public may nevertheless constitute evidence of bad faith under the Policy [...] The offering for sale of a domain name, even to a third party, supports bad faith."*

As such, particularly taking into account the reputation of the BIONTECH trademark and its high degree of recognition, as mentioned above, the Panel finds that, inasmuch as the disputed domain names are for sale to the general public, it is most likely that the Respondent has registered the disputed domain names primarily for the purpose of selling the disputed domain names for commercial gain or other such purposes inhering to the Respondent's benefit, which is evidence of bad faith. [WIPO Overview 3.0](#), section 3.1.1.

Furthermore, according to the uncontested evidence, the Respondent has been engaging in a pattern of registering domain names corresponding to marks held by the Complainant or third parties, which is further evidence of bad faith.

In the absence of any evidence to the contrary, this Panel accepts the Complainant's evidence and finds that the Respondent has incorporated the Complainant's BIONTECH trademark in the disputed domain names along with additional elements, which nonetheless do not preclude confusion between the Complainant's trademark and the disputed domain names, without the Complainant's consent or authorization, for the purpose of capitalizing on the reputation of the trademark and infringing upon the Complainant's trademark rights.

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 <biontechs.com>, <biontechservices.com>, and <wwwbiontech.com> be transferred to the Complainant.

*/Kateryna Oliinyk/*

**Kateryna Oliinyk**

Sole Panelist

Date: August 26, 2024