

ADMINISTRATIVE PANEL DECISION

Ferring B.V. v. 王先生 (wang xian sheng)
Case No. D2022-0540

1. The Parties

The Complainant is Ferring B.V., Netherlands, represented by Jacobacci Avocats, France.

The Respondent is 王先生 (wang xian sheng), China.

2. The Domain Name and Registrar

The disputed domain name <firmagonpromise.com> is registered with Hongkong Domain Name Information Management Co., Limited (the “Registrar”).

3. Procedural History

The Complaint in English was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 16, 2022. On February 17, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 25, 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 27, 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 March 1, 2022.

On February 25, 2022, the Center sent an email in English and Chinese to the Parties regarding the language of the proceeding. The Complainant confirmed its request that English be the language of the proceeding on February 27, 2022. 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 Chinese of the Complaint, and the proceedings commenced on March 3, 2022. In accordance with the

Rules, paragraph 5, the due date for Response was March 23, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 24, 2022.

The Center appointed Jonathan Agmon as the sole panelist in this matter on March 28, 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

The Complainant, Ferring B.V., is part of the FERRING group ("FERRING"), a biopharmaceutical group, specializing in reproductive medicine and women's health, in particular, gastroenterology and urology. FERRING was founded 71 years ago and owns subsidiaries operating in nearly 65 countries and markets its products in 110 countries around the world. In China alone, FERRING operates three subsidiaries respectively dedicated to research and development, manufacturing and marketing and sales. In 2020, FERRING made a global turnover of nearly EUR 2 billion. FERRING markets a medicine named "FIRMAGON" which is a hormone therapy (known as androgen deprivation therapy) for the treatment of advanced prostate cancer. The FIRMAGON medicine has been approved in 74 countries for years, including in China. FIRMAGON is widely commercialized and in 2021, it made over EUR 106 million in sales globally, amongst which EUR 19 million were attributed to sales in Asia Pacific.

The Complainant is the owner of numerous trademark registrations for FIRMAGON around the world, including but not limited to:

- International Registration No. 699553, registered on August 17, 1998, designating China; and
- European Union Trademark Registration No. 000889725, registered on March 21, 2000.

The Complainant owns numerous domain names containing FIRMAGON, such as, <firmagon.com>, which is its main website on which information on its pharmaceutical products are displayed.

The disputed domain name, <firmagonpromise.com>, was registered on November 10, 2021, and resolved to a website displaying pornographic content.

5. Parties' Contentions

A. Complainant

The Complainant argues that the disputed domain name is confusingly similar to the Complainant's registered FIRMAGON mark as the disputed domain name comprises of the FIRMAGON mark in its entirety with the addition of the generic word "promise" and the generic Top-Level Domain ("gTLD") ".com".

The Complainant also argues that the Respondent has no rights or legitimate interests in respect of the disputed domain name as it has not licensed or permitted the Respondent to use any of its trademarks or register the disputed domain name. The Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services, or made serious preparation for that purpose, and is not making a legitimate noncommercial or fair use of the disputed domain name.

The Complainant further argues that the disputed domain name was registered and is being used in bad faith as it contains pornographic content.

B. Respondent

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

6. Discussion and Findings

6.1 Language of Proceeding

Paragraph 11 of the Rules provides that: “(a) Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.”

The language of the Registration Agreement for the disputed domain name is Chinese.

The Complainant requested that the language of the proceeding be English.

The Respondent did not comment on the language of the proceeding.

The Panel cites the following with approval:

“Thus, the general rule is that the parties may agree on the language of the administrative proceeding. In the absence of this agreement, the language of the Registration Agreement shall dictate the language of the proceeding. However, the Panel has the discretion to decide otherwise having regard to the circumstances of the case. The Panel’s discretion must be exercised judicially in the spirit of fairness and justice to both parties taking into consideration matters such as command of the language, time and costs. It is important that the language finally decided by the Panel for the proceeding is not prejudicial to either one of the parties in his or her abilities to articulate the arguments for the case.” (See *Groupe Auchan v. xmxzl*, WIPO Case No. [DCC2006-0004](#)).

The Panel finds that in the present case, the following should be taken into consideration upon deciding on the language of the proceeding:

- (i) the disputed domain name is in Latin script, rather than Chinese characters;
- (ii) the disputed domain name incorporates the English word, “promise”;
- (iii) the Respondent was involved in previous UDRP proceedings in English and did not object to the language of the proceedings therein;
- (iv) the Complainant is located in Netherlands and the Complainant’s representative is located in France and both do not have knowledge of Chinese;
- (v) the Complainant may be unduly disadvantaged by having to conduct the proceeding in the Chinese language; and
- (vi) the Respondent did not object to the Complainant’s request that English be the language of the proceeding.

Upon considering the above, the Panel determines that English be the language of the proceeding.

6.2 Substantive Issues

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. The disputed domain name <firmagonpromise.com> contains the Complainant's FIRMAGON mark in its entirety..

It is also well-established that the addition of a term would not prevent a finding of confusing similarity between a disputed domain name and a complainant's mark. (See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8; *Wal-Mart Stores, Inc. v. Kuchora, Kal*, WIPO Case No. [D2006-0033](#); and *Hoffmann-La Roche Inc. v. Andrew Miller*, WIPO Case No. [D2008-1345](#).) Here, the addition of the word "promise" to the FIRMAGON mark does not avoid a finding of confusing similarity.

Further, it is well established that the addition of a gTLD ".com" does not avoid confusing similarity between the Complainant's trademark and the disputed domain name. (See [WIPO Overview 3.0](#), section 1.11.1.)

Consequently, the Panel finds that the Complainant has shown that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

Once the complainant establishes a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name, the burden of production shifts to the respondent to show that it has rights or legitimate interests in respect to the disputed domain name (see [WIPO Overview 3.0](#), section 2.1).

In the present case, the Complainant has demonstrated *prima facie* that the Respondent lacks rights or legitimate interests in respect of the disputed domain name and the Respondent has failed to assert any such rights or legitimate interests.

The Complainant has provided evidence that it owns trademark registrations long before the date that the disputed domain name was registered and that it is not affiliated with nor has it licensed or otherwise permitted the Respondent to use the Complainant's trademark (see *LEGO Juris A/S v. DomainPark Ltd, David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host master*, WIPO Case No. D2010-0138).

The Complainant also provided evidence that the Respondent is not commonly known by the disputed domain name (see [WIPO Overview 3.0](#), section 2.3).

Further, the Respondent did not submit a Response in the present case and did not provide any explanation or evidence to show rights or legitimate interests in the disputed domain name which is sufficient to rebut the Complainant's *prima facie* case.

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

The complainant must also show that the respondent registered and is using the disputed domain name in bad faith (see Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy provides circumstances that may evidence bad faith under paragraph 4(a)(iii) of the Policy.

The Complainant has submitted evidence showing that the disputed domain name resolved to a website containing pornographic content. It is well-established that the use of a domain name that corresponds to another's mark, for posting of pornographic content and/or related services, constitute evidence of bad faith registration and use of a domain name (see *Coral Trademarks, Ltd. v. Eastern Net, Inc.*, WIPO Case No. [D2000-1295](#) ("The posting of pornographic contents on a web site under a domain name that corresponds to

a third party's mark is a bad faith use of a domain name"); *America Online, Inc. v. Viper*, WIPO Case No. [D2000-1198](#) ("The use of AOL as part of a domain name offering pornographic products and services certainly 'tarnishes' Complainant's existing marks, which is also evidence of bad faith"); *Valor Económico S.A. v. Daniel Allende*, WIPO Case No. [D2001-0523](#) ("Complainant has proved that Respondent linked the <valoreconomico.net> web page to adult content or pornographic sites. This is a typical bad faith use of the domain name."); *ABB Asea Brown Boveri Ltd. v. Quicknet*, WIPO Case No. [D2003-0215](#) ("The use of ABB as part of a domain name offering pornographic material certainly tarnishes the Complainant's existing marks, which is also evidence of bad faith."); *Six Continents Hotels, Inc. v. Seweryn Nowak*, WIPO Case No. [D2003-0022](#) ("Preliminary, it is commonly understood, under WIPO case law, that whatever the motivation of Respondent, the diversion of the domain names to a pornographic site is itself certainly consistent with the finding that the Domain Name was registered and is being used in bad faith.") Similarly, the Panel finds that the use of the disputed domain name in the present case constitutes evidence of bad faith registration and use of the disputed domain name.

Further, the disputed domain name is confusingly similar to the Complainant's FIRMAGON mark which the Panel finds is an attempt by the Respondent to confuse and/or mislead Internet users seeking or expecting the Complainant. Previous UDRP panels ruled that in such circumstances "a likelihood of confusion is presumed, and such confusion will inevitably result in the diversion of Internet traffic from the Complainant's site to the Respondent's site" (see *Edmunds.com, Inc v. Triple E Holdings Limited*, WIPO Case No. D2006-1095). To this end, prior UDRP panels have established that attracting Internet traffic by using a domain name that is identical or confusingly similar to a registered trademark may be evidence of bad faith under paragraph 4(b)(iv) of the UDRP. Further, the Complainant submitted evidence that FIRMAGON is a coined term with no meaning and therefore distinctive in nature. Given the evidence presented to the Panel, the Panel finds that it is highly likely that the Respondent was aware of the Complainant at the time of registering the disputed domain name and specifically targeted the Complainant and its goodwill.

In addition, the Respondent did not submit a Response in this proceeding. Under the circumstances of this case, this is an additional indication of the Respondent's bad faith, which was considered by the Panel. The Panel has also taken into consideration the fact that the Respondent failed to respond to the cease-and-desist letter issued prior to the proceedings and the Respondent's antecedent conduct and involvement in numerous past UDRP proceedings as respondent, which are further indications of the Respondent's bad faith.

Accordingly, given the particular circumstances of this case and the distinctive nature of the trademark, based on the balance and the evidence presented to the Panel, including the registration of the disputed domain name long after the registration of the Complainant's trademark, the confusing similarity between the disputed domain name and the Complainant's trademark, the Respondent's use of the disputed domain name and the failure of the Respondent to submit a response, and the fact that there is no plausible good faith use the Respondent can put the disputed domain name to, the Panel draws the inference that the disputed domain name was registered and is being used in bad faith.

Accordingly, having regard to the circumstances of this particular case, the Panel finds that the Complainant has met its burden under paragraph 4(a)(iii) 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, <firmagonpromise.com>, be transferred to the Complainant.

/Jonathan Agmon/
Jonathan Agmon

Sole Panelist
Date: April 11, 2022