

PANEL DECISION

BioNTech SE v. ITtrust Domain Services LTD

Case No. DEU2022-0035

1. The Parties

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

The Respondent is ITtrust Domain Services LTD, Ireland.

2. The Domain Name, Registry and Registrar

The Registry of the disputed domain name <biontechpharma.eu> is the European Registry for Internet Domains (“EURid” or the “Registry”). The Registrar of the disputed domain name is Key-Systems GmbH.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 16, 2022. On November 16, 2022, the Center transmitted by email to the Registry a request for registrar verification in connection with the disputed domain name. On November 17, 2022, the Registry 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 .eu Alternative Dispute Resolution Rules (the “ADR Rules”) and the World Intellectual Property Organization Supplemental Rules for .eu Alternative Dispute Resolution Rules (the “Supplemental Rules”).

In accordance with the ADR Rules, Paragraph B(2), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 30, 2022. In accordance with the ADR Rules, Paragraph B(3), the due date for Response was December 20, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 4, 2023.

The Center appointed Benoit Van Asbroeck as the sole panelist in this matter on January 17, 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 ADR Rules, Paragraph B(5).

4. Factual Background

The Complainant is a biotechnology company. It is best known for the COVID-19 vaccine it developed in cooperation with Pfizer: the BioNTech/Pfizer (or Pfizer/BioNTech) Covid-19 vaccine.

The Complainant owns registered trademarks in the mark BIONTECH including, *inter alia*:

- European Union Trademark No. 008964447 for BIONTECH, registered on December 22, 2010, in International Classes 1, 5, 42, and 44;
- European Union Trademark No. 016241465 for BIONTECH, registered on November 9, 2017, in International Classes 1, 5, 9, 10, 16, 31, 41, 42, and 44;
- German Trademark No. 302008081376 for BIONTECH, registered on August 21, 2008, in International Class 5;
- German Trademark No. 302010012512 for BIONTECH, registered on September 13, 2010, in International Classes 1, 42, and 44.

The Complainant also owns the following domain names comprising the mark BIONTECH:

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

The disputed domain name was registered on May 16, 2022 and it currently resolves to an inactive webpage. Previously, the disputed domain name resolved to a website impersonating the Complainant which prominently featured a BIONTECH logo that closely resembles the Complainant's BIONTECH logo and contained an online shop for various performance enhancement products, in particular anabolic/androgenic steroids, marketed under the name "BIONTECH". The disputed domain name has also been used to create email accounts.

5. Parties' Contentions

A. Complainant

The Complainant asserts that each of the three elements specified in Article 4(4) of Regulation (EU) 2019/517 (the "Regulation") and Paragraph B(11)(d) of the ADR Rules are present. The three elements being: (i) the disputed domain name is identical or confusingly similar to a name in respect of which a right is recognised or established by the national law of a Member State and/or European Union law and; either; (ii) the disputed domain name has been registered by the Respondent without rights or legitimate interest in the name; or (iii) the disputed domain name has been registered or is being used in bad faith.

- (i) The disputed domain name is identical or confusingly similar to a name in respect of which a right is recognised or established by the national law of a Member State and/or European Union law

The Complainant contends that its BIONTECH trademark is widely used and known, as has also been confirmed by previous euDRP panels. Furthermore, the Complainant claims that the disputed domain name is confusingly similar to its BIONTECH trademark as it incorporates the Complainant's trademark BIONTECH in combination with the words "pharma" and the ".eu" country code Top-Level Domain ("ccTLD"). The

addition of the word “pharma” (which closely corresponds to the Complainant’s field of activity) does not prevent a finding of confusing similarity according to the Complainant. Finally, the Complainant asserts that the ccTLD “.eu” in the disputed domain name can be disregarded under the confusing similarity test.

- (ii) The disputed domain name has been registered by the Respondent without rights or legitimate interest in the name

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name since it is not affiliated with the Complainant in any way and has not been authorized by the Complainant to use and register its BIONTECH trademark or to seek registration of any domain name incorporating said mark. In addition, the Complainant asserts, the Respondent did not demonstrate use of, or demonstrable preparations to use, the disputed domain names in connection with a *bona fide* offering of goods or services. On the contrary, the Complainant points out, the disputed domain name used to resolve to a fraudulent website impersonating the Complainant and especially the Complainant’s BIONTECH logo and trademark. Finally, the Complainant states, the Respondent is not commonly known by the name “BIONTECH” nor in any way affiliated with the Complainant.

- (iii) The disputed domain name has been registered or is being used in bad faith

The Complainant argues that the disputed domain name has been registered and is being used in bad faith. With respect to registration, the Complainant claims that it is implausible that the Respondent was unaware of the Complainant when it registered the disputed domain name. The Respondent knew or should have known of the Complainant and its trademark rights. Furthermore, according to the Complainant, the fact that the Respondent has lost numerous euDRP cases before also demonstrates their bad faith since it shows that the Respondent has engaged in a pattern of conduct to prevent holders of names in respect of which a right is recognized or established by national and/or European Union law, or a public body, from reflecting their names in corresponding domain names. With respect to use of the disputed domain name, the Complainant contends that prior use of the disputed domain name for use of disputed domain name for fraudulent purposes is a clear indicator for use of the disputed domain name in bad faith. Finally, relying on the doctrine of passive holding, the Complainant also argues that the fact that the disputed domain name no longer resolves to the fraudulent website does not prevent a finding of bad faith use.

B. Respondent

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

6. Discussion and Findings

The Panel notes that while the Respondent has been duly notified, it did not reply to the Complainant’s contentions within the time period established by the ADR Rules. Pursuant to Paragraph B(10) of the ADR Rules the Panel shall nonetheless proceed to a decision on the Complainant’s complaint and it may consider this failure to comply as grounds to accept the claims of the Complainant.

Article 4(4) of the Regulation and Paragraph B(11)(d) of the ADR Rules require that in order for its complaint to succeed, the Complainant must prove that the disputed domain is identical or confusingly similar to a name in respect of which a right is recognised or established by the national law of a Member State and/or European Union law and; either

- (a) has been registered by the Respondent without rights or legitimate interests in the name; or
- (b) has been registered or is being used in bad faith.

The Complainant has argued and submitted evidence that the circumstances under both points (a) and (b) above exist. While, as noted above, the Regulation and ADR Rules only require the existence of the

circumstances under points (a) or (b), the Panel will therefore discuss both the circumstances raised by the Complainant under points (a) and (b) in reaching its decision.

A. Identical or Confusingly Similar to a name in respect of which a right or rights are recognized or established by national law of a Member State and/or European Union law

The Complainant is required to establish: (1) that it owns a right or rights that are recognized or established by national law of a Member State and/or European Union law in a name and, if so, (2) that the disputed domain name is identical or confusingly similar to this name.

Firstly, the Panel finds that the Complainant has clearly evidenced that it owns rights in BIONTECH that are recognized or established by national law of a Member State and/or European Union law since it is the owner of registered EU and German trademark rights in BIONTECH.

Secondly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's registered trademarks since it incorporates the BIONTECH mark in its entirety (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7, as well as for instance *L'Oréal, Lancôme Parfums et Beauté & Cie v. Jack Yang*, WIPO Case No. [D2011-1627](#); *Rapidshare AG, Christian Schmid v. InvisibleRegistration.com, Domain Admin*, WIPO Case No. [D2010-1059](#); and *The Stanley Works and Stanley Logistics, Inc. v. Camp Creek Co., Inc.*, WIPO Case No. [D2000-0113](#)).¹ Moreover, since the trademark BIONTECH is recognizable within the disputed domain name, the addition of the descriptive term "pharma" does not prevent the Panel's finding of confusing similarity under the first element (see [WIPO Overview 3.0](#), section 1.8, as well as for instance *Ansell Healthcare Products Inc. v. Australian Therapeutics Supplies Pty, Ltd.*, WIPO Case No. [D2001-0110](#); *Nintendo of America Inc. v. Fernando Sascha Gutierrez*, WIPO Case No. [D2009-0434](#); *M/s Daiwik Hotels Pvt. Ltd v. Senthil Kumaran S, Daiwik Resorts*, WIPO Case No. [D2015-1384](#); and *BHP Billiton Innovation Pty Ltd v. Oloyi*, WIPO Case No. [D2017-0284](#)).

Finally, as for the applicable Top-Level Domain ("TLD"), *i.e.*, the suffix ".eu", the Panel holds that this can be disregarded under the first element confusing similarity test (see Section 1.11.1 of the [WIPO Overview 3.0](#), as well as for instance *CANAL + FRANCE v. Franck Letourneau*, WIPO Case No. [DTV2010-0012](#); *Bentley Motors Limited v. Domain Admin / Kyle Rocheleau, Privacy Hero Inc.*, WIPO Case No. [D2014-1919](#); and *SAP SE v. Mohammed Aziz Sheikh, Sapteq Global Consulting Services*, WIPO Case No. [D2015-0565](#)).

On the basis of the foregoing findings, and according to Article 4(4) of the Regulation and Paragraph B(11)(d) of the ADR Rules, this Panel finds and concludes that the disputed domain name is confusingly similar to a name in respect of which a right or rights are recognized or established by national law of a Member State and/or European Union law.

B. Rights or Legitimate Interests

Paragraph B(11)(e) of the ADR Rules non-exhaustively lists three circumstances that if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate the Respondent's rights to or legitimate interests in the disputed domain name for the purposes of Paragraph B(11)(d)(1)(ii) of the ADR Rules:

- (1) prior to any notice of the dispute, the Respondent has used the domain name or a name corresponding to the domain name in connection with the offering of goods or services or has made demonstrable preparation to do so;
- (2) the Respondent, being an undertaking, organization or natural person, has been commonly known by the domain name, even in the absence of a right recognized or established by national and/or European Union law;

¹ Considering the substantive similarities between the ADR Rules and the Uniform Domain Name Dispute Resolution Policy (the "UDRP"), the Panel also refers to UDRP case law and analysis, where appropriate.

- (3) the Respondent is making legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name in respect of which a right is recognized or established by national law and/or European Union law.

In addition, Paragraph B11(d)(1) of the ADR Rules provides that the Complainant has the burden of proof that the disputed domain name has been registered by the Respondent without rights or legitimate interest in the name. However, it is a well-established view in UDRP and euDRP case law that a *prima facie* case advanced by a complainant is generally sufficient to satisfy this burden and the burden of production then shifts to the respondent to provide relevant evidence demonstrating rights or legitimate interests in the disputed domain name.

In the present case, taking into consideration the Respondent's default, the Panel finds that the Complainant has made out an unrebutted *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, in view of the circumstances of this case, including the following factors.

The Panel agrees with the Complainant that there is no evidence that the Respondent is using the disputed domain name in connection with a *bona fide* offering of goods or services. On the contrary, as the Complainant has demonstrated, while the disputed domain name currently does not resolve to an active website, the Respondent previously used the disputed domain name to impersonate the Complainant. The evidence provided by the Complainant clearly shows that the disputed domain name used to resolve to a fraudulent website that prominently featured the BIONTECH trademark and a logo that closely resembles the BIONTECH logo. The website contained an online shop with performance enhancement products that bear the mark BIONTECH and the same BIONTECH logo resembling that of the Complainant, while the products sold in fact do not originate from the Complainant. Moreover, the website did not accurately and prominently disclose the lack of relationship between the Respondent and the Complainant. It is clear that such past use of the disputed domain name has likely misled consumers and may have also harmed the reputation of the Complainant and the BIONTECH mark. As is clear from sections 2.2, 2.5 and 2.8 of the [WIPO Overview 3.0](#), UDRP panels have consistently found that such use of a domain name can neither be considered legitimate non-commercial or fair use of the domain name nor a *bona fide* offering of goods or services.

Furthermore, the Complainant asserts that the Respondent is not affiliated with the Complainant in any way nor has the Complainant licensed, authorized, or permitted the Respondent to register domain names incorporating the Complainant's trademarks. The Panel has taken note of the Complainant's confirmation in this regard and has not seen any evidence that would suggest the contrary. In the absence of any license or permission from the Complainant to use its trademarks, no actual or contemplated *bona fide* or legitimate use of the disputed domain name could reasonably be claimed (see, e.g., *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#); and *LEGO Juris A/S v. DomainPark Ltd, David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host master*, WIPO Case No. [D2010-0138](#)).

Moreover, the Panel agrees with the Complainant that there is no evidence that the Respondent has been commonly known by the disputed domain name.

Finally, it should also be mentioned that the nature of the disputed domain name, which incorporates the Complainant's trademark in its entirety plus a term that is descriptive of the Complainant's products, carries a risk of implied affiliation as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

For all the foregoing reasons, the Panel finds that the disputed domain name has been registered by the Respondent without rights or legitimate interests in the name.

C. Registered or Used in Bad Faith

As mentioned above, under Article 4(4) of the Regulation and Paragraph B(11)(d) of the ADR Rules a complaint will succeed if a complainant either proves that the Respondent registered the disputed domain name without rights or legitimate interests in the name or that the registration or use of the disputed domain

name are in bad faith. Since the Panel has already found that the Respondent lacks rights or legitimate interests in the disputed domain name there is strictly speaking no need for a discussion of bad faith registration or use. The Panel will nonetheless briefly discuss the circumstances and evidence presented by the Complainant.

The Panel will first discuss the Respondent's registration of the disputed domain name. The Panel believes that the Respondent knew or, at least, should have known at the time of registration that the disputed domain name included the Complainant's BIONTECH trademark. The Panel agrees with the Complainant that knowledge of the BIONTECH trademark may be inferred from the fact that this trademark is widely known and, the Panel would add, the relevant trademark registrations existed for a long time prior to the Respondent's registration of the disputed domain name (see section 3.2.2 of the [WIPO Overview 3.0](#) and e.g., *SembCorp Industries Limited v. Hu Huan Xin*, WIPO Case No. [D2001-1092](#); and *American Funds Distributors, Inc. v. Domain Administration Limited*, WIPO Case No. [D2007-0950](#)). Moreover, as the Complainant rightfully points out, it was the Respondent's duty to verify that the registration of the disputed domain name would not infringe the rights of any third party before registering the disputed domain name. Indeed, a simple Google search of "biontech" would have revealed the existence of the Complainant and its trademarks.

As for the use of the disputed domain name, the Panel agrees with the Complainant that using a domain name for a fraudulent website impersonating the Complainant, as further detailed above, is an indicator of bad faith use. Such use, which at its heart relies on exploiting user confusion for commercial gain, cannot constitute *bona fide* use as it may confuse the public about the business origin, sponsorship, affiliation, or endorsement of the website associated with the disputed domain name or the products sold on it. The fact that the disputed domain name no longer resolves to this website and therefore the use of the disputed domain name in the abovementioned fraudulent activity may now have stopped, does not prevent this finding. As also pointed out by the Complainant, it is a well-established view of UDRP panels, including in *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), and *Jupiters Limited v. Aaron Hall*, WIPO Case No. [D2000-0574](#), that the non-use of a domain name does not prevent a finding of bad faith under the doctrine of passive holding (see also Section 3.3 of the [WIPO Overview 3.0](#)). The Panel agrees with this view and finds that since the BIONTECH trademark is widely known, the Respondent has not submitted any evidence of good faith use and the Respondent has used the disputed domain name in bad faith before, it is implausible that the disputed domain name will be put to any good faith use in the future.

In light of the above, the Panel finds that the disputed domain name was registered and is being used by the Respondent in bad faith and that therefore the condition set out in Article 4(4)(b) of the Regulation and Paragraph B(11)(d)(1)(iii) of the ADR Rules has also been satisfied.

7. Decision

For the foregoing reasons, in accordance with Paragraph B(11) of the ADR Rules, the Panel orders that the disputed domain name <biontechpharma.eu> be transferred to the Complainant. Since the Complainant is an undertaking established in Germany, a Member State of the European Union, they satisfy the general eligibility criteria for registration set out in Article 3 of Regulation (EU) 2019/517².

/Benoit Van Asbroeck/

Benoit Van Asbroeck

Sole Panelist

Date: January 31, 2023

² The decision shall be implemented by the Registry within thirty (30) days after the notification of the decision to the Parties, unless the Respondent initiates court proceedings in a Mutual Jurisdiction, as defined in Paragraph A(1) of the ADR Rules.