

ADMINISTRATIVE PANEL DECISION

bioMérieux v. Mary Hellen
Case No. D2022-4412

1. The Parties

The Complainant is bioMérieux, France, represented by Plasseraud IP, France.

The Respondent is Mary Hellen.

2. The Domain Name and Registrar

The disputed domain name <biomserieux.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 18, 2022. On November 18, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 18, 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 (Privacy Service Provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 21, 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 on November 24, 2022.

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 November 25, 2022. In accordance with the Rules, paragraph 5, the due date for the Response was December 15, 2022. The Respondent did not submit any Response. Accordingly, the Center notified the Respondent’s default on December 19, 2022.

The Center appointed Jon Lang as the sole Panelist in this matter on December 21, 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 is a French multinational biotechnology company listed on the NYSE Euronext Paris Stock Exchange. Its products are mainly used for diagnosing infectious diseases and are also used for detecting micro-organisms in agri-food, pharmaceutical and cosmetic products. The Complainant was founded in 1963, has 43 subsidiaries around the world, and a large network of distributors. In 2021, its revenues reached EUR 3.38 billion with 90% of sales outside of France.

The Complainant is the owner of rights in the name BIOMERIEUX - it constitutes its Company name and it has many registered trademarks throughout the world; including International Trademark BIOMERIEUX n° 1392389, registered on October 25, 2017 (in various classes, and covering several jurisdictions including the United States of America), and United States Trademark BIOMERIEUX n° 5830553, registered on August 13, 2019, again in various classes.

The Complainant and its subsidiaries also own many domain names which include “biomerieux” alone or with other elements, such as <biomerieux.com> registered on May 31, 1996, and <biomerieuxusa.com> registered on April 4, 2001. The Complainant conducts business on the Internet where its BIOMERIEUX trademark has a strong presence, operating websites, notably at “www.biomerieux.com”, but also at local level in numerous countries where it has a presence.

The disputed domain name (hereafter the “Domain Name”) was registered on November, 12 2022. The public Whois record for the Domain Name did not reveal any information regarding the Respondent’s actual identity, the Registrant Organization being listed as “Privacy service provided by Withheld for Privacy ehf”. The Registrant’s actual identity was advised by the Center on November 21, 2022 (following receipt of the Registrar’s email of November 18, 2022). The Domain Name resolves to a parking page displaying Pay-Per-Click (“PPC”) advertisements.

5. Parties’ Contentions

A. Complainant

The following is a summary of the main assertions of the Complainant:

The Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The generic Top-Level-Domain (“gTLD”) may be ignored for the purposes of assessing confusing similarity because it only performs a technical function. The relevant comparison to be made is at the second-level, *i.e.*, “biomserieux” which reproduces entirely the BIOMERIEUX trademark but with a single slight modification - the addition of the letter “s” between “biom” and “erieux”. Such addition is discreetly in the middle of the sign, has very limited impact and does not alter the overall perception of the sign as being extremely similar to the BIOMERIEUX trademark.

Moreover, given the proximity of the letters “s” and “e” on a keyboard, an Internet user could easily and unwittingly type the letter “s” when typing the letter “e”, thus entering the Domain Name when typing the

Complainant's trademark or own main domain name.

A domain name comprising a trademark with a random letter inserted is regarded as confusingly similar to the relevant mark for the purposes of the Policy.

Furthermore, the Respondent's choice of gTLD, ".com" increases confusing similarity given that the Complainant hosts its main website at <biomerieux.com>. Given that the gTLD's coincide, the similarity between <biomerieux.com> and <biomserieux.com> is significantly heightened.

The Respondent has no rights or legitimate interests in respect of the Domain Name.

The Domain Name does not correspond to the name of the Respondent and the Complainant has not found any registered trademark corresponding to the Domain Name in the name of the Respondent, a search having been performed on all worldwide trademark databases available online.

The Domain Name appears confusingly similar to the Complainant's BIOMERIEUX trademark and the Complainant has never given its consent for the Respondent to use its trademark or any similar sign in a domain name registration or in any other manner.

The BIOMERIEUX trademark is not only intrinsically extremely distinctive and globally well known, but it is exclusively associated with the Complainant. A Google search on "biomserieux" solely and exclusively provides results relating to the Complainant. The search engine itself suggests that the Internet user has made a typographic error when searching on "biomserieux" and proposes a search on "biomerieux".

There can be no legitimate reason for the Respondent to have registered the Domain Name. Any legitimate interest of the Respondent in the Domain Name is all the more inconceivable given that the Complainant's rights are globally well known.

There is no evidence of any fair or noncommercial or *bona fide* use of the Domain Name in connection with goods and services because it resolves to a parking page displaying PPCI advertisements. Such commercial use of the Domain Name cannot constitute a *bona fide* offering of goods or services because it capitalizes on the reputation and goodwill of the Complainant's BIOMERIEUX trademark.

Moreover, a significative portion of the sponsored links displayed on the website to which the Domain Name resolves have a clear sexual orientation. Therefore, not only does the Domain Name unduly capitalize on the Complainant's well-known rights, but it also tarnishes its image and reputation. It will also outrage Internet users looking for the Complainant online but who are diverted to the Respondent's website. The Domain Name is not being used in any type of legitimate business or service.

The Domain Name carries a high risk of implied affiliation with the Complainant. It effectively impersonates the Complainant, or suggests sponsorship or endorsement by the Complainant. This cannot constitute fair use.

The Domain Name was registered and is being used in bad faith.

As for registration in bad faith, the Complainant holds several US registered trademarks and as the Respondent appears to be located in the United States of America, the Respondent shall be considered as having constructive notice of the Complainant's prior rights.

The Respondent actually knew of the existence of the BIOMERIEUX trademark – it is a fanciful designation and to the best of the Complainant's knowledge, it does not constitute a dictionary word or suggestive term. It is intrinsically highly distinctive and exclusively related to the Complainant. The Respondent registered the

Domain Name with the BIOMERIEUX trademark in mind.

All BIOMERIEUX trademarks registered worldwide exclusively belong to the Complainant or to companies of its group, some of which have existed since the 1980's, i.e. well before registration of the Domain Name by the Respondent. The BIOMERIEUX trademark is extremely well-known, not only in the medical field, but also amongst the general public. Registration of the Domain Name could not have been a coincidence. The Respondent's choice of Domain Name cannot be reasonably explained other than as a reference to the Complainant and its trademark. Indeed, BIOMERSIEUX does not have any meaning *per se*.

Before registering a domain name one has to take minimum precautions to ensure that it does not infringe third party rights. Either the Respondent did not take these minimum precautions or did so, was aware of the Complainant's rights but nevertheless registered the Domain Name. In either case, bad faith is demonstrated.

Previous UDRP decisions have held that incorporation of a well-known trademark into a domain name tends to support a finding of bad faith registration and use.

The Domain Name is almost identical to the main domain name of the Complainant, <biomerieux.com> and to the Complainant's trademark (the only difference being the addition of the single letter "s"). This is a clear-cut case of typo-squatting.

The Respondent hid its identity and contact information through a privacy service. Once its identity was revealed, research carried out into the name ("Mary Hellen") and given address, phone number and email address, suggests that such registrant information may be false.

As for use in bad faith, the Domain Name resolves to a parking page containing sponsored links. A respondent cannot disclaim responsibility for content appearing on the website associated with its domain name (and nor would such links *ipso facto* vest the respondent with rights or legitimate interests). The fact that the Respondent may not have directly profited, would not in itself prevent a finding of bad faith.

It appears that the Domain Name is being used to capitalize on the goodwill in the Complainant's rights given that it closely imitates the distinctive and very well-known BIOMERIEUX trademark which exclusively relates to the Complainant. Given the very high risk of implied affiliation with the Complainant and circumstances outlined above, any use of the Domain Name in good faith by the Respondent is implausible.

On the balance of probabilities, the Domain Name is being used in bad faith for financial benefit each time an Internet user types <biomserieux.com> instead of <biomerieux.com>. Moreover, the nature of the activities promoted through the PPC links on the website to which the Domain Name resolves, tarnishes the reputation and image of the Complainant, as described earlier.

Lastly, MX records have been set up on the Domain Name and as a consequence, the Respondent can send messages through the email address [...]@biomserieux.com. Therefore the Respondent may use the Domain Name to send fraudulent emails e.g. for phishing. The Complainant is active in the field of health and data collected by it (in particular personal data) is extremely confidential. Given the closeness of the Domain Name to the BIOMERIEUX trademark and the Complainant's most strategic domain name (<biomerieux.com>) which is also used for hosting email addresses, the clear absence of rights of the Respondent, the high risk of implied affiliation and the fact that the BIOMERIEUX trademark is exclusively related to the Complainant, it is more than likely that emails sent from [...]@biomserieux.com would fraudulently impersonate the Complainant. This represents an unbearable threat hanging over the head of the Complainant and those it deals with, from business partners to individuals, in particular, patients.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy requires a complainant to prove: (i) that a respondent has registered a domain name which is identical or confusingly similar to a trademark or service mark in which a complainant has rights; (ii) that the respondent has no rights or legitimate interests in respect of the domain name; (iii) that the domain name has been registered and is being used in bad faith. A complainant must prove each of these three elements to succeed.

A. Identical or Confusingly Similar

The Complainant is the owner of trademark registrations for the BIOMERIEUX trademark. The Complainant clearly has rights for the purposes of the Policy.

Ignoring the generic Top-Level Domain ("gTLD") ".com" (as the Panel may do for comparison purposes), the Domain Name comprises the BIOMERIEUX trademark except that a letter "s" has been inserted between "biom" and "erieux" to form the word "biomserieux". Accordingly, the BIOMERIEUX trademark and the Domain Name are not identical and thus the issue of confusing similarity must be considered. Application of the confusing similarity test under the UDRP typically involves "a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name" (section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#))). Section 1.7 of the [WIPO Overview 3.0](#) goes on to provide "[...] in cases where a domain name incorporates the entirety of a trademark, [...] the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing". In addition, a domain name which consists of a misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element (section 1.9 of the [WIPO Overview 3.0](#)).

Here, the addition of the letter "s" does not alter the visual impression created by the Domain Name, *i.e.*, that the Domain Name consists of the Complainant's BIOMERIEUX trademark reproduced in its entirety. The BIOMERIEUX trademark is thus recognizable within the Domain Name. However, given the addition of the letter "s", the Domain Name and mark cannot be said to be identical, but the Domain Name is certainly confusingly similar to the Complainant's BIOMERIEUX trademark.

The Panel finds that the Domain Name is confusingly similar to the BIOMERIEUX trademark for the purposes of the Policy and thus paragraph 4(a)(i) of the Policy has been established.

B. Rights or Legitimate Interests

By its allegations, the Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name. Accordingly, the burden of production shifts to the Respondent to come forward with arguments or evidence demonstrating that it does in fact have such rights or legitimate interests. The Respondent has not done so and accordingly, the Panel is entitled to find, given the *prima facie* case made out by the Complainant, that the Respondent indeed lacks rights or legitimate interests in the Domain Name. Despite the lack of any answer to the Complaint, however, the Panel is entitled to consider whether there would be anything inappropriate in such a finding.

A respondent can show it has rights or legitimate interests in a domain name in various ways even where it is not licensed by or affiliated with a complainant. For instance, it can show that it has been commonly known by the domain name or that it 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.

Here, however, the Respondent is neither known by the Domain Name nor has it been licensed by the Complainant, and given the nature of the website to which the Domain Name resolves, *i.e.* a parking page displaying PPC advertisements, it cannot be said that there is legitimate noncommercial use. As to an absence of an intent to mislead (for commercial gain), the Respondent's choice of Domain Name suggests the very opposite – the only element of the Domain Name (apart from the gTLD) is the Complainant's BIOMERIEUX trademark with the addition of the letter "s", thus creating a misspelling of the trademark. However, it is a misspelling with very limited visual impact such that the Domain Name could readily be mistaken for a precise reproduction of the BIOMERIEUX trademark. This is a clear case of typo-squatting.

Moreover, given the nature of a significant portion of the sponsored links displayed on the website to which the Domain Name resolves, there is a clear risk of tarnishment of the BIOMERIEUX trademark.

A respondent can also show that it is using a domain name in connection with a *bona fide* offering of goods or services. However, it seems clear that the Respondent set out to acquire a domain name that would create a misleading impression of being owned by, or at least associated with the Complainant, which has then been used to resolve to a website containing links to third-party sites. In these circumstances, it would be difficult to accept that such use could amount to a *bona fide* offering of goods or services for the purposes of the Policy.

More generally, given the inherently deceptive nature of the Domain Name, it is difficult to conceive of any use that would be regarded as fair.

The Respondent has not come forward with a Response and it can only be assumed that there is nothing the Respondent could say that might support an assertion that it does in fact have rights or legitimate interests. The contentions of the Complainant have been made out but not answered and accordingly, the Panel finds that the Complainant has fulfilled the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy describes a number of non-exclusive scenarios which may evidence a respondent's bad faith. They include, for instance, a respondent registering a domain name in order to prevent an owner of the trademark or service mark to which it is said to be confusingly similar or identical, from reflecting the mark in question in a corresponding domain name (provided that the respondent has engaged in a pattern of such conduct). A respondent registering a domain name primarily for the purposes of disrupting the business of a competitor is another scenario, as is a respondent intentionally attempting to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation or endorsement of its website or of products or services on it. The Panel finds that this latter scenario encapsulates the circumstances of this Complaint.

Despite this finding, it should be noted that a complainant does not have to demonstrate a precise literal application of any of the paragraph 4(b) scenarios. They are non-exclusive and illustrative only, and as long as there is evidence demonstrating that a respondent is seeking to take unfair advantage of, or to abuse a complainant's trademark, such behaviour would satisfy the general principle underlying the bad faith requirement of the Policy. In this proceeding, there is ample evidence of both.

Given the finding above there is little purpose in exploring all aspects of the Respondent's behaviour save to say that the act of typo-squatting (in which the Respondent has clearly engaged) is exactly the sort of abusive

conduct to which the Policy is directed and is in and of itself evidence of bad faith.

In all the circumstances, the Panel finds that, for the purposes of the Policy, there is evidence of both registration and use of the Domain Name in bad faith.

7. Decision

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name, <biomserieux.com>, be transferred to the Complainant.

/Jon Lang/

Jon Lang

Sole Panelist

Date: January 4, 2023