

ADMINISTRATIVE PANEL DECISION

BioNTech SE v. anthony kyle
Case No. D2022-4903

1. The Parties

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

The Respondent is anthony kyle, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <getcomirnaty.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 December 21, 2022. On December 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 21, 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 January 6, 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 January 6, 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 January 9, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 29, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 31, 2023.

The Center appointed Miguel B. O’Farrell as the sole panelist in this matter on February 10, 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 is a biotechnology company founded in 2008 that focuses on developing cancer therapeutics, as well as vaccines for infectious diseases, including COVID-19 (together with Pfizer) which is known in the media as the Pfizer/BioNTech Covid-19 and is sold under the trademark COMIRNATY.

The Complainant owns various trademark registrations for COMIRNATY in several jurisdictions, including the following:

- International Trademark Registration No. 1544862 COMIRNATY, registered on June 23, 2020, in class 5;
- European Union Trademark Registration No. 018247442 COMIRNATY, registered on October 7, 2020, in class 5;
- United States Trademark Registration No. 6312239 COMINARTY, registered on April 6, 2021, in class 5;
- German Trademark Registration No. 302020107258 COMIRNATY, registered on June 11, 2020, in class 5;
- United Kingdom Registration No. UK00918247442 COMIRNATY, registered on October 7, 2020.

In addition, the Complainant and Pfizer, Inc. (the Complainant's partner in development and distribution of COMIRNATY Covid-19 vaccine) are the registrants of a number of domain names, many of which include the COMIRNATY trademark, such as: <comirnaty.com> registered on May 28, 2020; <comirnaty.net> registered on May 28, 2020; <comirnaty.eu> registered on August 19, 2020, and many more.

The disputed domain name <getcomirnaty.com> was registered on August 23, 2021, through a privacy shield and, while currently it does not resolve to an active website, it used to redirect to the website of Moderna TX which is another company in the field of therapies and pharmaceutical products based on mRNA technology.

5. Parties' Contentions

A. Complainant

The Complainant and its COMIRNATY trademark are constantly present in traditional and online media in virtually all countries in the world, as can be seen from the media articles submitted and also in many countries well before the Respondent registered the disputed domain name in 2021. On a global scale, currently, more than one billion doses of the COMIRNATY vaccine have been administered throughout the world.

The fame of the COMIRNATY trademark has been previously recognized in many UDRP panel decisions.

The Complainant claims that the disputed domain name is confusingly similar with the COMIRNATY trademark in which the Complainant has rights and that the Respondent has no rights or legitimate interests in the disputed domain name, which was registered and is being used in bad faith.

More specifically, the Complainant has not licensed the Respondent to use its trademark and there is no relationship between the Parties that would justify the registration of the disputed domain name by the Respondent.

Nothing suggests that the Respondent is commonly known by the disputed domain name.

The Respondent registered the disputed domain name at a time when the COMINARTY trademark had already gained well-known status. Consequently, the Respondent could not have been unaware of the

Complainant and its business when registering the disputed domain name.

The Respondent registered the disputed domain name to trade-off the goodwill and reputation of the Complainant's COMINARTY trademark and create a false association, sponsorship or endorsement with or of the Complainant and has therefore acted with bad faith.

Finally, the Complainant requests the Panel to issue a decision ordering that the disputed domain name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the disputed domain name, the Complainant must prove each of the following, namely that:

- (i) the disputed domain name is identical or confusingly similar with 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 name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

A. Identical or Confusingly Similar

As set forth in section 1.7 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") the standing test for confusing similarity involves a reasoned but relatively straightforward comparison between the trademark and the disputed domain name to determine whether the disputed domain name is confusingly similar with the trademark. The test involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

The Panel considers that the disputed domain name is confusingly similar with the Complainant's COMINARTY trademark.

The disputed domain name incorporates the Complainant's trademark COMINARTY with the inclusion of the term "get" up front, which does not prevent a finding of confusing similarity.

The ".com" generic Top-Level Domain ("gTLD") is viewed as a standard registration requirement and is generally disregarded under the first element confusing similarity test, as set forth in section 1.11 of [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the trademark COMINARTY in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy are fulfilled.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights to or legitimate interests in a domain name by demonstrating any of the following non-exclusive defenses:

- (i) before any notice to it of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

- (ii) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers.

Although the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a disputed domain name, it is well established, as it is put in section 2.1 of [WIPO Overview 3.0](#), that a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name. Once 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 deemed to have satisfied the second element.

There is no evidence in the present case that the Respondent has been commonly known by the disputed domain name, enabling it to establish rights or legitimate interests therein.

Furthermore, there is no evidence in the file to prove any of the circumstances mentioned in paragraph 4(c) of the Policy, nor any other circumstances to suggest that the Respondent has rights or legitimate interests in the disputed domain name.

Likewise, and as further discussed under section 6.C of this Decision, it does not seem that the Respondent is making any legitimate noncommercial or fair use of the disputed domain name, but rather that it intends to use the disputed domain name for the purpose of deriving unfair monetary advantage by confusing Internet users and leading them to believe that the site to which the disputed domain name resolves is an official site of the Complainant.

As established in section 2.5 of [WIPO Overview 3.0](#): “Fundamentally, a respondent’s use of a domain name will not be considered ‘fair’ if it falsely suggests affiliation with the trademark owner; the correlation between a domain name and the complainant’s mark is often central to this inquiry.” Here, the nature of the disputed domain name carries a risk of implied affiliation.

The Panel finds that the Complainant has made out a *prima facie* case, a case calling for an answer from the Respondent. The Respondent has not responded and the Panel is unable to conceive of any basis upon which the Respondent could sensibly be said to have any rights or legitimate interests in respect of the disputed domain name.

The Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name and that the requirements of paragraph 4(a)(ii) of the Policy have been fulfilled.

C. Registered and Used in Bad Faith

The Panel is satisfied that the Respondent must have been aware of the Complainant’s trademark COMINARTY mentioned in section 4 above (Factual Background) and also the Complainant’s domain name <cominarty.com> when it registered the disputed domain name on August 23, 2021. By that time, the Complainant had widely and intensely used the trademark COMINARTY.

By registering the disputed domain name, the Respondent was targeting the Complainant and its business by incorporating the Complainant’s trademark COMINARTY in its entirety and adding the descriptive word “get”, with the intention to confuse Internet users and capitalize on the fame of the Complainant’s trademark for its own benefit.

The fact that there is a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent’s choice of the disputed domain name, the nature of the disputed domain name, the prior use of the disputed domain name to redirect to a website with links to a company competing with the Complainant, are all indicative of bad faith.

In the circumstances, the fact that the disputed domain name does not currently resolve to an active webpage does not avoid a finding of bad faith on the basis of the “passive holding” doctrine of section 3.3 of [WIPO Overview 3.0](#).

The Panel finds that the Respondent registered and is using the disputed domain name in bad faith.

For the above reasons, the Panel finds that the requirements of paragraph 4(a)(iii) of the Policy have been fulfilled.

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 <getcomirnaty.com> be transferred to the Complainant.

/Miguel B. O’Farrell/

Miguel B. O’Farrell

Sole Panelist

Date: February 24, 2023