

ADMINISTRATIVE PANEL DECISION

Genentech, Inc. v. Oak
Case No. D2023-3799

1. The Parties

The Complainant is Genentech, Inc., United States of America ("United States"), represented by F. Hoffmann-La Roche AG, Switzerland.

The Respondent is Oak, China.

2. The Domain Names and Registrar

The disputed domain names <genentechmfpe.com>, <genentechmf0.com>, <genentechmf5.com>, <genentechmf6.com>, <genentechmf7.com>, <genentechmf8.com>, and <genentechmf9.com> are registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on September 12, 2023. On September 12, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On September 13, 2023, 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 September 18, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 8, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 10, 2023.

The Center appointed Ganna Prokhorova as the sole panelist in this matter on October 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 Rules, paragraph 7.

4. Factual Background

The Complainant is a biotechnology company in the business of developing medicines for people with serious and life-threatening diseases and is engaged in the research and development of pharmaceutical products.

The Complainant, along with F. Hoffmann-La Roche AG, who filed the Complaint as the Complainant's representative in the present case, is part of a larger corporate entity known as the Roche Group, which is one of the world's leading research-focused healthcare groups.

The Complainant is the owner of various GENENTECH trademarks, including the United States Registration No. 1278624 for GENENTECH, registered on May 22, 1984, for goods in Class 5.

The Complainant owns the domain names <genentech.com> and <gene.com>.

The disputed domain names were all registered on August 23, 2023. The disputed domain names previously resolved to websites where the Respondent offered for sale and/or investment the Complainant's pharmaceutical products. The disputed domain names currently do not resolve to any active websites.

On September 4, 2023, the Complainant sent a demand letter through email to the Respondent requesting the latter to transfer the disputed domain names. The letter remained unanswered.

5. Parties' Contentions

A. Complainant

The Complainant asserts that each of the elements enumerated in paragraph 4(a) of the Policy and the corresponding provisions in the Rules have been satisfied. In particular, the Complainant asserts that:

- (1) the disputed domain names are confusingly similar to the Complainant's GENENTECH trademark, since they incorporate this mark in its entirety. The addition of the letters respectively figures "mf", "mfpe" and "0", "5", "6", "7", "8", and "9" does not sufficiently distinguish the disputed domain names from the Complainant's trademark;
- (2) the Respondent has no rights or legitimate interests in the disputed domain names. The disputed domain names resolve to webpages offering investment opportunities. The purpose of registering the disputed domain names is to engage in a phishing scheme pretending to represent the financial department of the Complainant. The Respondent is deliberately using disputed domain names with a connection to the Complainant's GENENTECH mark in order to confuse the consumers by making them believe that the websites behind the links are recommended by the Complainant respectively operated by the Complainant. The Respondent did not reply to the cease and desist letter of the Complainant and has not availed itself of the opportunity to present any case of legitimate interest that it might have; and
- (3) the Respondent has registered and is using the disputed domain names in bad faith. The Respondent could not ignore the GENENTECH trademark because the Respondent's registration of the disputed domain names is well after the Complainant's trademark registrations. The disputed domain names just consists of the reproduction of the Complainant's GENENTECH mark and resolve to websites selling investment opportunities, thus, were undoubtedly registered in bad faith with the intent to create an impression of an association with the Complainant's GENENTECH mark.

The Complainant requests the transfer of the disputed domain names.

B. Respondent

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

6. Discussion and Findings

The Complainant has requested that the seven disputed domain names be consolidated under one unitary administrative proceeding.

Paragraph 3(c) of the UDRP Rules provides that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder.

The Complainant has presented evidence that all seven disputed domain names were registered on the same date, under identical name (pseudonym), each possessing identical email addresses, each possessing identical addresses, and each possessing an identical telephone number, which is sufficient to consolidate the disputed domain names in one case.

The burden for the Complainant under paragraph 4(a) of the Policy is to prove that:

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

The Complainant must prove in this administrative proceeding that each of the aforementioned three elements is present in order to obtain the transfer of the disputed domain names.

In accordance with paragraph 14(a) of the Rules, if the Respondent does not submit a Response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the Complaint.

The Panel will further analyze the potential concurrence of the above circumstances. Moreover, the Panel has taken note of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") and, where appropriate, will decide consistent with the consensus views captured therein.

A. Identical or Confusingly Similar

According to paragraph 4(a)(i) of the Policy, it should be established that the disputed domain names are identical or confusingly similar to a mark in which the Complainant has rights.

The Panel confirms that for the purposes of paragraph 4(a)(i) of the Policy, the Complainant has satisfied the threshold requirement of having relevant trademark rights for GENENTECH.

With the Complainant's rights in GENENTECH trademark established, the remaining question under the first element of the Policy is whether the disputed domain names are identical or confusingly similar to the Complainant's marks.

It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a "reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name". [WIPO Overview 3.0](#), section 1.7. This test typically 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 disputed domain names comprise the Complainant's GENENTECH trademark in its entirety followed by additional letters "mf", "mfpe" and numbers "0", "5", "6", "7", "8", and "9". Prior panels have recognized that confusing similarity is established for purposes of the Policy where the disputed domain name incorporates the complainant's trademark in its entirety. Furthermore, in cases where the relevant trademark is recognizable within the disputed domain name, the addition of other terms does not prevent a finding of confusing similarity under the first element. See [WIPO Overview 3.0](#), sections 1.7 and 1.8.

The generic Top-Level Domain ("gTLD"), such as ".com", may be disregarded for purposes of comparison under the first element, as it is viewed as a standard registration requirement. See [WIPO Overview 3.0](#), section 1.11.1.

Therefore, the Panel finds that the disputed domain names are confusingly similar to the Complainant's trademarks and that the requirement of paragraph 4(a)(i) of the Policy is met in this case.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

It is well established that, as it is put in [WIPO Overview 3.0](#), section 2.1, while the overall burden of proof in the proceedings is on the complainant, proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. Therefore, the Panel agrees with prior UDRP panels that the complainant is required to make out a *prima facie* case before the burden of production on this element shifts to the respondent to show that it has rights or legitimate interests in the disputed domain name.

The Complainant has made out a *prima facie* case showing that the Respondent has no rights or legitimate interests in the disputed domain names, notably by demonstrating rights in the GENENTECH trademark, which precede the Respondent's registration of the disputed domain names, and confirming that the Respondent is neither affiliated with, nor has it been licensed or permitted to use the Complainant's GENENTECH trademark or any domain names incorporating the GENENTECH trademark.

According to the case file, there is nothing to suggest any *bona fide* use that might confer rights or legitimate interests in the disputed domain names on the Respondent. Nor is there any evidence of the Respondent having made demonstrable preparations to use the disputed domain names in connection with a *bona fide* offering of goods or services.

To the contrary, the disputed domain names currently resolve to inactive web pages. However, the case file also shows that the disputed domain names previously resolved to webpages with indication of the Complainant's trademark GENENTECH (top left corner), where the Respondent offered for sale and/or investment the Complainant's pharmaceutical products, creating a confusion among the consumers by making them believe that the websites behind the links are recommended by the Complainant and respectively operated by the latter. These assertions and evidence in the case file are sufficient to establish a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names.

Consequently, the burden of production shifts to the Respondent to rebut the Complainant's *prima facie* showing by providing relevant evidence that he or she has rights or legitimate interests in the disputed domain names. The Respondent, however, has failed to file a response to prove his or her rights or legitimate interests in the disputed domain names under paragraph 4(c) of the Policy.

As such, the Panel finds that the Complainant has established that the Respondent does not have rights or legitimate interests in the disputed domain names, and that the element under paragraph 4(a)(ii) of the Policy has been established.

C. Registered and Used in Bad Faith

The third element of paragraph 4(a) of the Policy refers to the question of whether the disputed domain names have been registered and are being used in bad faith by the Respondent.

The Complainant has submitted evidence that the Respondent registered the disputed domain names long after the Complainant registered its GENENTECH trademark. Given the accumulation of good will and distinctiveness of the Complainant's mark over the course of its almost 40-year history, and the fact that the GENENTECH mark appears to be distinctive, it is highly unlikely that the Respondent did not know of the Complainant and its GENENTECH mark prior to the registration of the disputed domain names. This is also evident from the webpages, which all prominently display the Complainant's trademark at the top of the respective webpages.

Therefore, under this Panel's view, the Respondent's choice of the disputed domain names cannot have been accidental and must have been influenced by the fame of the Complainant and its earlier trademark. Prior UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or well known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See *Carrefour SA v. Registration Private, Domains By Proxy, LLC / 3232 33232*, WIPO Case No. [D2022-1952](#).

In addition, the disputed domain names incorporate the entirety of the Complainant's GENENTECH mark along with various additional suffixes 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 sites (see *Genentech, Inc. v. hhh, ds df*, WIPO Case No. [D2023-2521](#)). To this end, prior UDRP panels have established that attracting Internet traffic by using a domain name that is identical or confusingly similar to create a likelihood of confusion with a registered trademark may be evidence of bad faith under paragraph 4(b)(iv) of the Policy.

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.

Consequently, the Panel considers that the disputed domain names were registered and are being used in bad faith. In light of the above, the third element under paragraph 4(a)(iii) of the Policy has been established.

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 <genentechmfpe.com>, <genentechmf0.com>, <genentechmf5.com>, <genentechmf6.com>, <genentechmf7.com>, <genentechmf8.com>, <genentechmf9.com> be transferred to the Complainant.

/Ganna Prokhorova/

Ganna Prokhorova

Sole Panelist

Date: October 18, 2023