

ADMINISTRATIVE PANEL DECISION

F. Hoffmann-La Roche AG v. Bull Shaft
Case No. D2023-5302

1. The Parties

The Complainant is F. Hoffmann-La Roche AG, Switzerland, internally represented.

The Respondent is Bull Shaft, United States of America.

2. The Domain Name and Registrar

The disputed domain name <roobie.com> is 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 December 21, 2023. On December 21, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 22, 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 January 10, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 30, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 13, 2024.

The Center appointed Willem J. H. Leppink as the sole panelist in this matter on February 16, 2024. 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 following facts are undisputed.

The Complainant is together with its affiliated companies one of the world's leading research-focused healthcare groups in the fields of pharmaceuticals and diagnostics and having global operations in more than 100 countries.

The trademark ROCHE serves as house-mark of the Complainant and is protected as a registered trademark in a multitude of countries worldwide, e.g., International Registrations Nos. 340483 and 346223 for the word mark ROCHE, for which the priority dates are August 15, 1967, and June 19, 1968, respectively, for products and services related to the activities of the Complainant.

The Complainant's main website can be found at "www.roche.com".

The disputed domain name was registered October 16, 2023. At the time of filing the Complaint, the disputed domain name resolved to a parked page and at the time of this Decision, the disputed domain name did not resolve to any active website.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends the following.

The Complainant's trademark ROCHE is well known. The disputed domain name is an intentional misspelling of the Complainant's trademark ROCHE. The Complainant learned of the fraudulent intent of the registration of disputed domain name, as the Respondent engaged in an email scam (using a fake email address associated with the disputed domain name) pretending to be the Finance Department of the Complainant and requesting payment of nearly USD 400,000.

In light of this, the Respondent must have undoubtedly been aware of the existence of the Complainant's trademark ROCHE.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. A domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element. This stems from the fact that the domain name contains sufficiently recognizable aspects of the relevant mark. [WIPO Overview 3.0](#), section 1.9. Although the actual use of the domain name is usually disregarded by panels when assessing confusing similarity under the first element, in some instances, panels have however taken note of e.g., the content of the website associated with a domain name to confirm confusing similarity. Here, the Panel takes this into consideration as it appears that the Respondent sought to target the Complainant's trademark through the use of the disputed domain name for a fraudulent email scheme impersonating the Complainant. [WIPO Overview 3.0](#), section 1.15.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Panels have held that the use of a domain name for illegal activity, here, claimed trying to persuade the recipient of an email to pay, whilst impersonating the Complainant, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent, given the clear intention of the Respondent to impersonate the Complainant to persuade the recipient of an email to pay a large sum of money, was aware of the Complainant and its trademark ROCHE and was thus in bad faith when using the disputed domain name and must also have been in bad faith when registering the disputed domain name.

The Respondent in that way intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's mark.

Although the Respondent has clearly used the disputed domain name in bad faith through sending out fraudulent emails, the disputed domain name does not resolve to an active website. To the extent necessary the Panel considers that such non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. The Panel has considered the totality of the circumstances in each case, including: (i) the degree of distinctiveness or reputation of the Complainant's mark, (ii) the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the Respondent's use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3.

Again, also in relation to bad faith, panels have held that the use of a domain name for illegal activity as described above, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

The Panel finds that the Complainant has established the third element 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 <rocbie.com> be transferred to the Complainant.

Willem J. H. Leppink/

Willem J. H. Leppink

Sole Panelist

Date: February 29, 2024