

## ADMINISTRATIVE PANEL DECISION

Genentech, Inc. v. hc ac, luc lo. cd  
Case No. D2024-0321

### 1. The Parties

The Complainant is Genentech, Inc., United States of America (“United States”), internally represented.

The Respondent is hc ac, luc lo. cd, Australia.

### 2. The Domain Name and Registrar

The disputed domain names <genenteche.icu>, <genentechi.cyou>, <genentechl.cyou>, <genentechl.top>, <genentechs.icu>, and <genentechu.com> are registered with Gname.com Pte. Ltd. (the “Registrar”).

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 25, 2024. On January 25, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 26, 2024, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 29, 2024 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 amendment to the Complaint on January 30, 2024.

The Center verified that the Complaint together with the amendment to 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 February 8, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 28, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 29, 2024.

The Center appointed Reyes Campello Estebaranz as the sole panelist in this matter on March 13, 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 Complainant is part of a larger corporate entity, the Roche Group, which is one of the world's leading research-focused healthcare groups.

The Complainant is a biotechnology company engaged for more than 45 years in research and development of pharmaceutical products for serious and life-threatening diseases. It produced the first antibody for cancer and the first medicine for primary progressive multiple sclerosis, and it has appeared on Fortune Magazine's Best Companies List multiple times. The Panel, under its general powers, has consulted the Complainant's corporate website at "www.gene.com".

The Complainant owns various trademark registrations for the brand GENENTECH, including United States Trademark Registration No. 1278624, GENENTECH, word, registered on May 22, 1984, in class 5, (hereinafter referred as the "GENENTECH mark").

The Complainant also owns the domain names <genentech.com> (registered on May 28, 1997) and <gene.com> (registered on September 22, 1987), of which, the latter resolves to its corporate website.

The disputed domain names were registered on December 4, 2023, and they are currently apparently inactive resolving in Internet browser error messages. According to the evidence provided by the Complainant, the disputed domain names previously resolved to the same website, in English language, which included twice the GENENTECH mark at its heading, and offered unauthorized "investment" in one of the Complainant's pharmaceutical products, namely POLIVY. The heading of this website also included, below one of the representations of the GENENTECH mark, the text "A Member of the Roche Group". This website did not include any reference related to its owner or that of the respective disputed domain names, and did not inform about its lack of relationship with the Complainant and its trademark.

On January 17, 2024, the Complainant's representative sent a cease-and-desist communication to the Respondent through the Registrar. The Respondent did not reply to this communication.

#### **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 that the disputed domain names are confusingly similar to the GENENTECH mark, as each of them incorporates this trademark in its entirety, and the addition of the letter "e", "i", "l", "s" or "u", does not sufficiently distinguish the disputed domain names from the mark.

The Respondent has no rights or legitimate interests in respect of the disputed domain names. The Respondent has no connection with the Complainant and no license or consent to use the GENENTECH mark. The disputed domain names have been used in connection to a website offering investment opportunities in the Complainant's products, generating confusion or affiliation, and impersonating the Complainant, probably with the intention to engage in a phishing scheme. The use of a domain name for illegal activities can never confer rights or legitimate interests.

The disputed domain names were registered and are being used in bad faith. The Respondent has intentionally attempted to attract, for commercial gain Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website. The Respondent used a privacy shield, did not respond to the cease-and-desist letter, and deliberately used the disputed domain names to capitalize on the Complainant's goodwill in the GENENTECH mark, mislead the consumers, and confuse them by making them believe that the website that was linked to the disputed domain names was associated or operated by the Complainant. A prior case, *Genentech v. hh hhh, Hong Kong, China & ds df, Hong Kong, China*, WIPO Case No. [D2023-2521](#), shows an identical pattern with similar domain names (<gentechmf.com>, <gentechmfk.com>, <gentechmfl.com>, <gentechmf2.com>, <gentechmf3.com>, and <gentechmf4.com>) that resolved to a website offering investment opportunities in the Complainant's products.

## **B. Respondent**

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

## **6. Discussion and Findings**

The Complainant has made the relevant assertions as required by the Policy and the dispute is properly within the scope of the Policy. The Panel has authority to decide the dispute examining the three elements in paragraph 4(a) of the Policy, taking into consideration all of the relevant evidence, annexed material and allegations, and performing some limited independent research under the general powers of the Panel articulated, inter alia, in paragraph 10 of the Rules.

### **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 names. 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, namely the GENENTECH mark. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the GENENTECH mark is reproduced within each of the disputed domain names adding a letter after the mark (either the letter "e", "i", "l", "s" or "u"). The Panel finds the mark is recognizable within all the disputed domain names. Although the addition of other terms here, the letter "e", "i", "l", "s" or "u", may bear on assessment of the second and third elements, the Panel finds the addition of such letters does not prevent a finding of confusing similarity between the disputed domain names and the GENENTECH mark for the purposes of the Policy. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7 and 1.8.

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 names.

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 names. 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 names such as those enumerated in the Policy or otherwise.

The Respondent has not provided its name in the registration of the disputed domain names, but simply four letters or initials ("hc ac") that share no similarity with the term "genentech" or any the combinations of this term with the letters "e", "i", "l", "s" or "u" ("geneteche", "genentechi", "genentechl" or "genentechu"), nor does its company name "luc lo. cd".

The Panel notes that the disputed domain names are apparently inactive resolving to Internet browser messages, and, according to the evidence provided by the Complainant, they previously resolved to the same website that included twice the GENENTECH mark at its heading and purportedly offered unauthorized investment in one of the Complainant's pharmaceutical products, namely POLIVY. This website did not include any information about its owner or that of the disputed domain names and/or any reference to its lack of relationship with the Complainant and its trademarks. Such use generates confusion or affiliation with the Complainant and its trademark, so the Panel finds it cannot be considered a bona fide offering of goods or services under the Policy.

The Panel finds the Respondent's website impersonated the Complainant, including at its heading the GENENTECH mark followed by the indication "A Member of the Roche Group", in an effort to give the impression that the site belonged to the Complainant or one of its affiliated companies. Furthermore, the Panel considers uncommon the so-called "investment" on pharmaceutical products, as they are not financial products, and considers more likely, on a balance of probabilities, the Respondent's site truly offered the sale of these products, which, due to the lack of relationship of the Parties, may be counterfeit or illegal pharmaceuticals. In any event, panels have held that the use of a domain name for illegal activity here, claimed probable sale of counterfeit goods or illegal pharmaceuticals, phishing, impersonation/passing off, or other types of fraud, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

The Panel further considers that due to the nature of the disputed domain names, which incorporate the GENENTECH mark in its entirety, they carry a risk of implied affiliation, which makes impossible to conceive any bona fide offering of goods or services or any legitimate noncommercial or fair use of the disputed domain names. [WIPO Overview 3.0](#), section 2.5.

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 the Respondent knew about the Complainant and its GENENTECH mark and targeted this mark with the registration and use of the disputed domain names. The disputed domain names include the GENENTECH mark in its entirety, and they resolved to a website that included twice this mark at its heading, indicating "GENETECH, A Member of the Roche Group".

Additionally, the Panel notes the extensive presence of the Complainant and the GENENTECH mark over the Internet, and its reputation in the pharmaceutical industry. The Complainant's company name and trademark GENENTECH has acquired reputation in the pharmaceutical industry over more than 45 years of research and development of pharmaceutical products, and the Complainant's group, the Roche Group, is well known in the pharmaceutical industry.

The Panel finds the Respondent's website impersonated the Complainant or one of its affiliated companies, and purportedly offered for sale or for "investment" one of its pharmaceutical products with no authorization, most probably counterfeit or illegal pharmaceuticals. Panels have held that the use of a domain name for illegal activity (counterfeit or illegal pharmaceuticals, phishing, impersonation/passing off, or other types of fraud) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

Furthermore, the Panel finds the current apparent non-use of the disputed domain names does not cure the bad faith registration and prior use of the disputed domain names. Panels have found that the non-use of a domain name (including a blank page) would not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3.

The Panel further notes that the Respondent has concealed its identity in the registration of the disputed domain names, and it has provided only four letters or initials instead of a complete name.

Therefore, having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain names constitutes bad faith under the Policy.

Finally, the Panel notes that this case share similarities with a prior case alleged by the Complainant, *Genentech v. hh hhh, Hong Kong, China & ds df, Hong Kong, China, supra*, and also with two other prior cases, *Genentech, Inc. v. Fubin Yin*, WIPO Case No. [D2023-0551](#), and *Genentech, Inc. v. Oak*, WIPO Case No. [D2023-3799](#). All these cases, from the same year 2023, refer to domain names that were (totally or partially) used in connection to websites that offered "investment opportunities" in the Complainant's pharmaceutical products, and the nature of the domain names was similar, all incorporating the GENENTECH mark with some additional suffix (letters or numerals). The Panel considers the Respondent in all these cases may be linked or under a common control, showing a pattern of bad faith that targets the Complainant and its GENENTECH mark, which is already demonstrative by the registration of the six disputed domain names in the present case alone.

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 names <genenteche.icu>, <genentechi.cyou>, <genentechl.cyou>, <genentechl.top>, <genentechs.icu>, <genentechu.com> be transferred to the Complainant.

*/Reyes Campello Estebarez/*

**Reyes Campello Estebarez**

Sole Panelist

Date: March 22, 2024