

ADMINISTRATIVE PANEL DECISION

bioMérieux v. 李南霞 (li nan xia)

Case No. D2024-2171

1. The Parties

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

The Respondent is 李南霞 (li nan xia), China.

2. The Domain Name and Registrar

The disputed domain name <biomerieux-test.asia> is registered with Alibaba Cloud Computing Ltd. d/b/a HiChina (www.net.cn) (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on June 4, 2024. On June 4, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 5, 2024, 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.

On June 5, 2024, the Center informed the parties in Chinese and English, that the language of the registration agreement for the disputed domain name is Chinese. On June 7, 2024, the Complainant submitted an amendment to the Complaint in English requesting English to be the language of the proceeding. The Respondent did not submit any comment on the Complainant’s submission.

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 in English and Chinese of the Complaint, and the proceedings commenced on June 11, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 1, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 2, 2024.

The Center appointed C. K. Kwong as the sole panelist in this matter on July 9, 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 a French multinational biotechnology company established in 1963. The Complainant is the registered owner of trademarks consisting of or embodying the word “biomerieux”. These registrations include the following International Trademark registrations which extend to China, namely:

- (a) No. 933598 registered on June 12, 2007 in Classes 1, 5, 9, and 10;
- (b) No. 1392389 registered on October 25, 2017 in Classes 35, 37, 41, 42, and 44.

The Complainant has by itself or through its subsidiaries registered the domain name <biomerieux.com> on May 31, 1996 (Annex 9 to the Complaint) which it principally uses to operate a website for promoting its products, as well as corresponding domain names ending with geographical indication such as <biomerieux-usa.com> for the United States of America, and local country code Top-Level Domain (“ccTLD”) <biomerieux.com.cn> for China.

The uncontradicted evidence produced by the Complainant shows that the use and registration of its BIOMERIEUX mark occurred at least well over 16 years before the registration of the disputed domain name <biomerieux-test.asia> on May 21, 2024. The disputed domain name does 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.

The Complainant is a French multinational biotechnology company, which is a leader in the field of diagnostic solutions. The Complainant was founded in 1963 serving over 160 countries by 43 subsidiaries around the world with a large network of distributors and EUR 3.7 billion in sales in 2023.

The Complainant has rights in the BIOMERIEUX trademark. The disputed domain name has reproduced the BIOMERIEUX trademark in its entirety and only added the generic dictionary term “test” while “.asia” generic Top-Level Domain (“gTLD”) may be ignored.

The disputed domain name does not correspond to the name of the Respondent nor to any trademark registered in the name of the Respondent. According to searches conducted, there is no published and/or registered trademark BIOMERIEUX or BIOMERIEUX-TEST (or BIOMERIEUX TEST) in the name of “li nan xia” (Annex 11 to the Complaint).

The Complainant has never given its consent for the Respondent to use its trademark BIOMERIEUX in a domain name registration or in any other manner.

There is no evidence of any fair noncommercial or bona fide use of the disputed domain name as the disputed domain name is not used and does not redirect to any webpage (Annex 13 to the Complaint).

The trademark BIOMERIEUX is a fanciful designation which is intrinsically highly distinctive and exclusively relates to the Complainant. All the trademarks BIOMERIEUX registered worldwide exclusively belong to the

Complainant or an entity within its group of companies. Its registrations for and use of the trademark BIOMERIEUX existed well before the registration of the disputed domain name by the Respondent.

The trademark BIOMERIEUX is extremely well-known for decades. The Respondent must be fully aware of the existence of the Complainant and of its prior rights on the BIOMERIEUX trademark at the date of registration of the disputed domain name.

The word “test” which is added to the BIOMERIEUX trademark within the disputed domain name correspond exactly to the nature of the principal business activities of the Complainant of providing diagnostic tests solutions.

The combination of this word “test” with the Complainant’s well-known and fanciful trademark is clear evidence that the Respondent was targeting the Complainant.

A search for the BIOMERIEUX trademark in China, the country where the Respondent seems to be located, would have revealed the Complainant’s trademark rights. A mere search conducted on “biomerieux test” on Google generates results related to the Complainant’s BIOMERIEUX trademark (Annex 12 to the Complaint).

The fact that the disputed domain name does not resolve to an active website does not prevent a finding of bad faith.

The Complainant is active in the health industry. As the disputed domain name directly refers to the Complainant’s activities in the field of diagnostics/tests, any unauthorized use of the disputed domain name would generate an unacceptable risk of mistaken identity both for the Complainant and for its clients and patients. Such risk is extremely common and harmful in the health industry as the data collected (in particular personal data) are extremely confidential, in particular when they relate to a test/diagnostic.

The Respondent provided the Registrar with a doubtful address which was found to be the address of a Police Station with a zip code “100000” which does not appear to be a zip code for the city of Wuhan in Hubei (see Annexes A, B and C to the amendment filed on June 7, 2024) where the Respondent resides.

B. Respondent

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

6. Discussion and Findings

Having considered the records in the case file, the Panel is satisfied that the Center has discharged its responsibility under paragraph 2(a) of the Rules to employ reasonably available means calculated to achieve actual notice to the Respondent of the Complaint.

6.1 Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons. These reasons include:

1. The disputed domain name consists of Latin characters (ASCII);

2. The disputed domain name is registered in the “.asia” gTLD which is an English term;
3. The choice of the English word “test” within the disputed domain name suggests that the Respondent is able to communicate in English. Proceeding in Chinese would incur additional costs and expenses, delay the proceeding which would enable the Respondent to continue owning the disputed domain name with possibility of using it for a deceptive purpose which is dangerous;
4. English is the most widely language used in international relations.

The Respondent did not make any specific submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties’ ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

6.2 The Three Elements

In rendering its decision, the Panel must adjudicate the dispute in accordance with paragraph 15(a) of the Rules which provides that, “[t]he Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”. Paragraph 14(b) of the Rules further provides that, “if a Party, in the absence of exceptional circumstances, does not comply with any provisions of, or requirement under these Rules or any requests from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate”.

The said three elements are considered below.

A. Identical or Confusingly Similar

(a) 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 3.0](#), section 1.7.

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

(c) The entirety of the mark BIOMERIEUX is reproduced 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. The addition of the word “test” does not prevent a finding of the confusing similarity of the disputed domain name and the Complainant’s BIOMERIEUX trademark. It is well-established practice to disregard the gTLD “.asia”, when assessing whether a domain name is identical or confusingly similar to the mark in issue.

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.

There is no legitimate explanation on the record as to why it was necessary for the Respondent to adopt the word “Biomerieux” in the disputed domain name.

The Complainant has also confirmed that it has not licensed the Respondent to use its trademark BIOMERIEUX in any way.

Using the Complainant’s BIOMERIEUX trademark with the word “test” as a suffix in the disputed domain name cannot constitute fair use as it suggests sponsorship or endorsement by or affiliation with the Complainant. In this connection, it is noted that the Respondent has provided a doubtful address to the Registrar and has not filed a response. [WIPO Overview 3.0](#), section 2.5.1.

Having reviewed the available records, 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.

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.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

The Complainant has registered its BIOMERIEUX trademark as detailed in Section 4 above and has been using it for at least 16 years before the registration of the disputed domain name by the Respondent in 2024.

The incorporation of the distinctive BIOMERIEUX trademark entirely letter by letter as part of the disputed domain name without any explanation and the prior substantial and extensive use of the Complainant’s BIOMERIEUX mark worldwide including China where the Respondent apparently resides, lead to the conclusion that the Respondent must have been aware of the existence of the Complainant and its trademark BIOMERIEUX at the time of the registration of the disputed domain name.

Although the disputed domain name resolves to an inactive website, as discussed in [WIPO Overview 3.0](#), section 3.3, it does not prevent a finding of bad faith in the circumstances of this case.

Based on the available record, the Panel cannot conceive of any use by the Respondent of the disputed domain name that would not be a bad faith use. Some degree of deception or confusion would seem to be inevitable in any use by the Respondent of the disputed domain name. The use of the term “Biomerieux” together with the word “test” in the disputed domain name is likely to create confusion with the Complainant’s

mark as to the source, sponsorship, affiliation or endorsement of the website to which the disputed domain name may resolve or of a product or service offered on such websites or online locations where the disputed domain name leads to.

The Panel finds that the disputed domain name has been registered and used in bad faith under paragraph 4(a)(iii) 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 <biomerieux-test.asia> be transferred to the Complainant.

/C. K. Kwong/

C. K. Kwong

Sole Panelist

Date: July 23, 2024