

ADMINISTRATIVE PANEL DECISION

BioNTech SE v. CongGang Cao
Case No. D2024-2695

1. The Parties

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

The Respondent is CongGang Cao, China.

2. The Domain Names and Registrar

The disputed domain names <biontechgroup.com> and <biontechinc.com> are registered with Spaceship, Inc., (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 2, 2024. On July 2, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On July 4, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names 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 July 10, 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 amended Complaint on July 15, 2024.

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 July 16, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 5, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 6, 2024.

The Center appointed Angelica Lodigiani as the sole panelist in this matter on August 12, 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 German company, founded in 2008 and operating in the field of biotechnology. The Complainant focuses on developing cancer therapeutics and vaccines against infection diseases. The Complainant, along with the United States of America (“US”) pharmaceutical company Pfizer, has developed the “BionTech/Pfizer” vaccine against COVID-19. Because of the joint development of this vaccine, the Complainant has gained a strong global media presence and a widespread reputation, as shown by its massive and global presence on the most important media and the prestigious recognitions awarded to the Complainant in many countries worldwide. As of April 25, 2023, the “BionTech/Pfizer” vaccine has been approved and used in 140 countries and as of March 22, 2023, more than 430 million doses of this vaccine have been administered in the US, and more than 660 million in the European Union. On a global scale, more than one billion doses have been administered throughout the world.

The Complainant is the owner of a number of BIONTECH trademarks, registered in various jurisdictions, among which the following:

- BIONTECH (word), European Union Trade Mark No. 008964447, registered on December 22, 2010, duly renewed and covering goods and services in classes 1, 5, 42 and 44;
- BIONTECH (word), International Registration No. 1370266, registered on July 10, 2017, covering goods and services in classes 1, 5, 16, 31, 42 and 44 and designating Australia, Türkiye, and United Kingdom; and
- BIONTECH (figurative), International Registration No. 1478253, registered on April 5, 2019, covering goods and services in classes 1, 5, 42 and 44, designating China amongst other jurisdictions.

In addition, the Complainant is the owner of various domain names incorporating the BIONTECH trademark, among which <biontech.com>, registered on May 29, 1998.

The Respondent is a Chinese individual allegedly located in China. The disputed domain names have been registered on March 28, 2022. At the time of the filing of the Complaint, the disputed domain names were offered for sale on two domain name marketplaces. On May 31, 2024, the Complainant sent to the Respondent, through an online form on the Registrar’s website, a cease and desist letter, but failed to receive a reply. On the same day, the Complainant requested the Registrar of the disputed domain names to reveal the name of the registrant of the disputed domain names. However, the Complainant’s requests were not satisfied.

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 names.

Notably, the Complainant contends that the disputed domain names are confusingly similar to the Complainant’s mark. The disputed domain names incorporate the BIONTECH mark entirely followed by the descriptive terms “group” and “inc”, the latter being a common abbreviation for incorporated businesses. The BIONTECH mark is clearly recognizable within the disputed domain names and the addition of the terms “group” and “inc” cannot prevent a finding of confusing similarity of the disputed domain names with the Complainant’s mark.

The Complainant further maintains that the Respondent lack rights or legitimate interests in the disputed domain names. The Complainant is not affiliated with the Respondent and did not authorize the Respondent to use and register its BIONTECH mark as part of the disputed domain names. The Respondent is not using and did not demonstrate preparations to use the disputed domain names in connection with a bona fide offering of goods or services. The disputed domain names resolved to domain name marketplaces, where

the disputed domain name <biontechgroup.com> was offered for sale at a price of USD 75,000, while no specific price was indicated for the disputed domain name <biontechinc.com>. Therefore, the Complainant finds it clear that the Respondent intends to capitalize on the Complainant's global fame through the sale of the disputed domain names, which under the circumstance cannot amount to a bona offering of goods or services.

Moreover, the Complainant points out that the Respondent was also the respondent in two other UDRP proceedings, which were decided in favor of the complainant. This behavior is an indication of a lack of legitimate interest by the Respondent. Accordingly, the Respondent is not making a legitimate noncommercial or fair use of the disputed domain names.

Finally, the Complainant maintains that the disputed domain names have been registered and are being used in bad faith. In view of the extensive reputation of the Complainant and of its BIONTECH mark, it is implausible that the Respondent was not aware of the Complainant's mark at the time of the registration of the disputed domain names. A simple internet search using the keyword "biontech", would have revealed that this term is univocally related to the Complainant. Bad faith exists where a domain name is so obviously connected with a well-known trademark that its very use by someone with no connection to the trademark suggests opportunistic bad faith.

As far as use in bad faith is concerned, the Complainant points out that, at the time of the filing of the Complaint, the disputed domain names were offered for sale at the conditions previously indicated. Thus, the Complainant maintains that the disputed domain names were registered in order to sell them to the Complainant, to its competitors, or to third parties and the Respondent is trying to benefit from the fame of the Complainant's marks, or otherwise taking advantage of the Complainant's trademark rights. The fact that the disputed domain names do not lead to active websites, cannot preclude a finding of bad faith under the doctrine of passive holding. In this respect, the Complainant refers to the well-known character of the Complainant's mark, the Respondent's failure to provide a response or to provide evidence of actual or contemplated good-faith use of the disputed domain names, and the fact that the Respondent concealed its identity behind a privacy service provider. Finally, the Complainant contends that it is likely that the Respondent registered the disputed domain names to prevent the Complainant from using its BIONTECH mark in the disputed domain names and specially to prevent the Complainant from registering domain names corresponding to its company name in combination with the descriptive terms "group" and "inc", under the generic Top-Level Domain ("gTLD") ".com". The fact that the Respondent was already the respondent in at least two other UDRP proceedings where the complainant prevailed constitutes a pattern of conduct of preventing trademark owners from reflecting their marks in a corresponding domain name.

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 names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, “group” and “inc”, in the respective disputed domain names, may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 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 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 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.

In particular, the Panel notes that the Respondent is not affiliated with the Complainant and is not a Complainant’s licensee. The Complainant did not authorize the Respondent to make use of its BIONTECH mark within the disputed domain names. Moreover, the case file does not contain any evidence that the Respondent is commonly known by the disputed domain names. The Panel also finds that the disputed domain names are not used in connection with a bona fide offering of goods or services or a legitimate noncommercial or fair use. The disputed domain names do not resolve to an active website. At the time of the filing of the Complaint, the disputed domain names redirected to the domain name marketplaces where the disputed domain names were offered for sale. In light of the reputation of the Complainant’s marks and the nature of the disputed domain names, which incorporate the BIONTECH mark entirely, and therefore carry a high risk of implied affiliation, the offer for sale of the disputed domain names cannot amount to a legitimate noncommercial or fair use and cannot confer rights or legitimate interests to the Respondent. [WIPO Overview 3.0](#), section 2.5.1.

Accordingly, 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 Complainant’s BIONTECH mark enjoys wide reputation, especially arising from the development of the BioNTech/Pfizer vaccine at a time when the entire world was holding its breath due to the advance of a terrible pandemic that was claiming huge victims across the world. It is therefore not a surprise that being one of the few developers of COVID-19 vaccines in the world, the name and trademark BIONTECH gained a substantial and immediate worldwide recognition. The strict and univocal association of the BIONTECH mark with the Complainant is also confirmed by the results of the cursory Internet search ran by the Complainant using the keyword “biontech”. In light of the extensive

reputation of the Complainant's BIONTECH mark, the Panel opines that the Respondent could not ignore the Complainant and its mark at the time of the registration of the disputed domain names. The registration of the disputed domain names, incorporating the Complainant's BIONTECH well-known mark, being aware of such mark and without rights or legitimate interests, amounts to registration in bad faith.

With respect to use in bad faith, the Panel notes that, at the time of the filing of the Complaint, the disputed domain names did not resolve to an active website, but were offered for sale. The disputed domain name <biontechgroup.com> was offered for sale at a price of USD 75,000, while no specific price was indicated for the disputed domain name <biontechinc.com>. Panels have found that the practice as such of registering a domain name for subsequent resale would not by itself support a claim that the respondent registered the domain name in bad faith with the primary purpose of selling it to a trademark owner (or its competitor). [WIPO Overview 3.0](#), section 3.1.1. To evaluate whether the offer for sale of the disputed domain names amounts to bad faith, the Panel needs to assess the overall circumstances of the case, including the identity or confusing similarity to a highly renowned trademark, a pattern of abusive registrations by the Respondent, the Respondent's likely knowledge of the Complainant's rights, etc. In the case at issue, the Panel has already found that the BIONTECH mark enjoys wide reputation, and that the Respondent was likely aware of the Complainant's mark at the time of the registration of the disputed domain names. Moreover, the Respondent was also the respondent in at least two other UDRP proceedings, which ended in favor of the complainant. In addition, the Panel notes that the disputed domain names were registered in March 2022, i.e., more than two years before the filing of the UDRP Complaint. During this time, the disputed domain names were likely inactive and offered for sale, which indicates that the Respondent had no real intention to ever use the disputed domain names, but only to profit from the reputation of the Complainant's mark through the sale of the disputed domain names.

Lastly, the Panel notes that the Respondent did not reply to the Complainant's cease and desist letter and therefore lost its chance to settle this dispute amicably and that it concealed its identity behind a privacy service provider, thus rendering more difficult for the Complainant to exercise its trademark rights. The fact that the Respondent has provided what appears to be faulty or incomplete address when registering the disputed domain names (the Center was not able to send out Written Notice by courier service) further indicates bad faith (noted to be in breach of its registration agreement).

In view of the above, the Panel finds that the Respondent acquired the disputed domain names primarily for the purpose of selling, renting, or otherwise transferring them to the Complainant, or to a competitor of the Complainant, or to any other third party, for valuable consideration likely in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain names.

Accordingly, 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 <biontechgroup.com> and <biontechinc.com> be transferred to the Complainant.

/Angelica Lodigiani/

Angelica Lodigiani

Sole Panelist

Date: August 26, 2024.