

ADMINISTRATIVE PANEL DECISION

BioNTech SE v. Irina Fillingham
Case No. D2024-2703

1. The Parties

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

The Respondent is Irina Fillingham, United Kingdom (“UK”).

2. The Domain Name and Registrar

The disputed domain name <biontechsolution.com> is registered with Tucows 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 name. On July 2, 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.

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 July 9, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 29, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 30, 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 “BioTech/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 “BioTech/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 (“EU”). 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), UK trademark registration No. UK00908964447, registered on December 22, 2010, duly renewed and covering goods and services in classes 1, 5, 42 and 44;
- BIONTECH (word), EUTM 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, Turkey, and UK.

In addition, the Complainant is the owner of various domain names incorporating the BIONTECH trademark, among which <biontech.com>, registered on May 29, 1998, and <biontech.de>, registered on October 10, 2007.

The disputed domain name was registered on April 5, 2024, and does not resolve to an active webpage. The Respondent set up mail exchanges “MX records” on the disputed domain name. On April 9, 2024, the Complainant sent a request for revealing the Registrant’s identity to the Registrar of the disputed domain name and the Registrar informed the Complainant of the registrant’s identity on June 1, 2024. On June 3, 2024, the Complainant sent a cease and desist letter to the Respondent in order to obtain an amicable transfer of the disputed domain name. The Respondent did not reply to the Complainant’s letter. The Complainant also made an attempt with the email service provider to obtain the takedown of the mail servers configured on the disputed domain name, but without success.

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 name is confusingly similar to the Complainant’s mark. The disputed domain name incorporates the BIONTECH mark entirely followed by the descriptive term “solution”. The BIONTECH mark is clearly recognizable within the disputed domain name and the addition of the term “solution” cannot prevent a finding of confusing similarity of the disputed domain name with the Complainant’s mark.

The Complainant further maintains that the Respondent lacks rights or legitimate interests in the disputed domain name. 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 name. The Respondent is not a licensee of the Complainant. As the disputed domain name does not resolve to an active webpage, the Respondent did not demonstrate use of, or demonstrable preparations to use the disputed domain name in connection with goods or services. To the best of the Complainant's knowledge, the Respondent is not commonly known by the disputed domain name and does not own any trademark registration for a BIONTECH or BIONTECH SOLUTION mark. The Respondent has configured MX records for the disputed domain name, which, in the case at issue, cannot amount to a legitimate or fair use of the disputed domain name. Indeed, there is a concrete possibility that the Respondent uses the disputed domain name to send phishing emails. Internet users receiving emails from an email address with the extension "@biontechsolution.com" could believe that they originate from the Complainant and could disclose their personal data and sensitive information.

Finally, the Complainant maintains that the disputed domain name has been registered and is 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 name. 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 passive holding cannot prevent a finding of bad faith under the passive holding doctrine. In this respect, the Complainant refers to the well-known character of the Complainant's mark, the Respondent's failure to respond to the Complaint, and the fact that the Respondent concealed its identity behind a privacy service provider. Moreover, the configuration of MX records on the disputed domain name constitutes use in bad faith since it represents a real risk that the Respondent may be engaged in a phishing scheme aimed at deceiving the Internet users into believing that they were dealing with the Complainant. Given the confusing similarity of the disputed domain name to the Complainant's mark it is difficult to imagine any good faith use of the mail server attached to the disputed 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 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.

Although the addition of other terms here, "solution", may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Accordingly, 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.

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 name. Moreover, the case file does not contain any evidence that the Respondent is commonly known by the disputed domain name.

The Panel also finds that the disputed domain name is not used in connection with a bona fide offering of goods or services. The disputed domain name resolves to an inactive webpage and there is no evidence in the file that the Respondent is actively using the disputed domain name in connection with a bona fide offering of goods or services or is preparing to use the disputed domain name in this connection.

Moreover, in the Panel’s view, the Respondent is not making a legitimate fair use of the disputed domain name. The disputed domain name incorporates the Complainant’s BIONTECH mark, followed by the descriptive term “solution” that is strictly connected to the Complainant’s activity, considering that the Complainant offers therapy and vaccine solutions to fight diseases and epidemics. Therefore, the disputed domain name is highly misleading for the Complainant’s consumers who could easily associate it with the Complainant. Even where a domain name consists of a trademark plus an additional term (as opposed to a trademark alone), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner.

In light of the above, 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 run by the Complainant using the keyword “biontech”. In light of this, the Panel opines that the Respondent could not ignore the Complainant and its BIONTECH trademark at the time of the registration of the disputed domain name. The knowledge of the Complainant’s mark at the time of the registration of the disputed domain name is also confirmed by the addition of the descriptive term “solution” to the disputed domain name. This term is strictly connected with the Complainant’s activity for the reasons mentioned above. The registration the disputed domain name, 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.

As far as use in bad faith is concerned, Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes that the Complainant’s mark enjoys wide reputation, and that the Respondent failed to submit a Response. Taking also into consideration the composition of the disputed domain name, the Panel finds that no good faith use of the disputed domain name is plausible and that the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Furthermore, MX records are set up for the disputed domain name, which would enable the Respondent to send misleading emails under a domain name that is confusingly similar to the Complainant’s mark. Lastly, the Respondent failed to reply to the Complainant’s cease and desist letter, which is further indication of bad faith.

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 name <biontechsolution.com> be transferred to the Complainant.

/Angelica Lodigiani/

Angelica Lodigiani

Sole Panelist

Date: August 26, 2024