

ADMINISTRATIVE PANEL DECISION

Genentech, Inc. v. hc ac, luc lo. cd
Case No. D2024-3030

1. The Parties

The Complainant is Genentech, Inc., United States of America (“United States”), represented by F. Hoffmann-La Roche AG, Switzerland.

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

2. The Domain Names and Registrar

The disputed domain names <genentech-fcc.com>, <genentechi.store> and <genentech-pro.icu> 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 July 25, 2024. On July 25, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On July 26, 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 (REDACTED FOR PRIVACY, luc lo. cd) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 26, 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 July 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 July 31, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 20, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 23, 2024.

The Center appointed Kateryna Oliinyk as the sole panelist in this matter on August 27, 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, together with its affiliated companies, engaged in research and development of pharmaceutical products. The Complainant is a biotechnology company dedicated to pursuing groundbreaking science to discover and develop medicines for people with serious and life-threatening diseases. Fortune Magazine has chosen the Complainant to appear on their Best Companies List for several times.

The Complainant and F. Hoffmann-La Roche AG form part of a larger corporate entity, the Roche Group, which is one of the world's leading research-focused healthcare groups.

The Complainant is the owner of the United States Trademark Registration No. 1278624 for GENENTECH, registered on May 22, 1984, in respect of goods in International Class 5.

The Complainant operates domain names <genentech.com>, created on May 28, 1997 and <gene.com>, created on September 22, 1987.

The creation dates of the disputed domain names are as follows:

Disputed domain names	Creation date
<genentechi.store>	January 31, 2024
<genentech-pro.icu>	April 23, 2024
<genentech-fcc.com>	May 11, 2024

According to the evidence submitted with the Complaint, the disputed domain names <genentechi.store> and <genentech-fcc.com> previously resolved to websites offering investment opportunities, and the disputed domain name <genentech-pro.icu> resolved to inactive website.

On the date of initiation of these administrative proceedings the disputed domain names resolved to inactive websites. As of the date of this Decision operation of the disputed domain name <genentechi.store> is resumed and this disputed domain name resolves to the website offering investment opportunities.

On July 17, 2024 the Complainant sent the cease and desist letter related to the disputed domain names through the Registrar which remained unanswered.

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.

Identical or confusingly similar

The Complainant states that the disputed domain names incorporate the Complainant's GENENTECH trademark in its entirety, and that the disputed domain names are confusingly similar with the Complainant's trademark. The addition of the letter "i", a hyphen followed by the term "pro", respectively a hyphen followed by the letters "fcc" does not sufficiently distinguish the respective disputed domain names from the Complainant's GENENTECH trademark. Addition of the Top Level Domains is viewed as the standard registration reequipment.

Rights or legitimate interests

The Complainant contends that the Respondent lacks any rights or legitimate interests in the disputed domain names.

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 trademark. 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.

Passive holding of the disputed domain name <genentech-pro.icu> does not confer any rights or legitimate interests in this disputed domain name.

Registration and use in bad faith

The Complainant contends that the Respondent knew of the Complainant's trademark when registering the disputed domain names, as all the disputed domain names reproduce the Complainant's GENENTECH trademark.

Consequently, the Complainant asserts that the Respondent registered and used the disputed domain names with the intention to attract, for commercial gain, Internet users to the websites by creating a likelihood of confusion with the Complainant's GENENTECH trademark.

The Complainant further asserts that the Respondent has 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 websites that were linked to the disputed domain names were associated or operated by the Complainant.

The Respondent was already engaged in the similar administrative proceedings, see. *Genentech v. hc ac, luc lo. cd*, WIPO Case No. [D2024-0321](#), showing identical pattern with the similar domain names (genentech.e.icu, genentechi.cyou, genentechl.cyou, genentechl.top, genentechs.icu, genentechu.com) that resolved to a website offering investment opportunities, and the panel in that case issued the decision in favour of the Complainant.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "[a] 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 4(a) of the Policy directs that the Complainant must prove each of the following:

- i. that the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- ii. that the Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- iii. that the disputed domain names have been registered and are being used in bad faith.

Considering that the Respondent did not reply to the Complainant's contentions, in order to determine whether the Complainant has met its burden as stated in paragraph 4(a) of the Policy, the Panel bases its Decision on the statements and documents submitted in accordance with the Policy and the Rules.

Under paragraph 5(f) and paragraph 14(b) of the Rules, if a respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint, and where a party does not comply with any provision of the Rules, the Panel "shall draw such inferences therefrom as it considers appropriate".

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 GENENTECH trademark is recognizable within the disputed domain names. The addition of the letter "i", a hyphen followed by the term "pro", respectively a hyphen followed by the letters "fcc" does not sufficiently distinguish the respective disputed domain names from the Complainant's GENENTECH trademark. Accordingly, the disputed domain names are confusingly similar to the GENENTECH trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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.

According to section 2.13.1 of the [WIPO Overview 3.0](#) panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent.

In this case the Panel, and the disputed domain name <genentechi.store> resumed to operate after some period of non-use. The Panel infers that the Respondent is using the disputed domain name to impersonate the Complainant in the furtherance of a phishing scheme. Panels have held that the use of a domain name for illegal activity such as impersonation, phishing, or other types of fraud can never confer rights or

legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1. In the circumstances, none of the factors listed at paragraph 4(c) of the Policy can be said to apply.

The mere passive holding of the disputed domain name <genentech-pro.icu> does not establish rights or legitimate interests, specifically factoring the broad case context and evidence that the disputed domain names are under the control of the Respondent and it may active each of them in any time.

The Respondent has not come forward to submit a Response.

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 incorporated the Complainant's GENENTECH trademark in its entirety in the disputed domain names, which were created well after first registration and use of the Complainant's GENENTECH trademark.

Given the confusing similarity between the disputed domain names and the Complainant's GENENTECH trademark, coupled with the content of the Respondent's websites under the disputed domain names <genentechi.store> and <genentech-fcc.com>, it is evident that the Respondent was aware of the Complainant and its GENENTECH trademark as at the date of registration of the disputed domain names and registered it in order to take unfair advantage of it.

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 use to which the Respondent has put the disputed domain names <genentechi.store> and <genentech-fcc.com> falls within paragraph 4(b)(iv) of the Policy in that both disputed domain names used to resolve to websites which used the Complainant's GENENTECH trademark and which features content intended to mislead Internet users into thinking that it is operated by, or with the authority of, the Complainant. Such a belief will be reinforced because of the confusing similarity between the disputed domain name and the Complainant's GENENTECH trademark. Furthermore, the Respondent used a privacy shield and did not respond to Complainant's cease and desist letter sent prior to initiation of these administrative proceedings. These factors collectively point to bad faith registration and use of the disputed domain names.

Panels have held that the use of a domain name for illegal activity here, claimed phishing, impersonation/passing off, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain names <genentechi.store> and <genentech-fcc.com> constitutes bad faith under the Policy.

To the extent that the disputed domain name <genentech-fcc.com> no longer resolves to an active website, and that the disputed domain name <genentech-pro.icu> is passively held. It is next necessary to consider whether the currently inactive status of the disputed domain names prevent a finding of bad faith under the doctrine of passive holding. The factors usually considered material to such an assessment have been set out in a number of earlier decisions of UDRP panels, including in *Johnson & Johnson v. Daniel Wistbacka*, WIPO Case No. [D2017-0709](#). Each of these considerations points to the Respondent's passive holding of the disputed domain name being in bad faith. Specifically; (i) the Complainant's GENENTECH trademark is distinctive and well-established, (ii) the Respondent has failed to submit a response to the cease and desist letter and to the Complaint or provide any evidence of good-faith use, (iii) the Respondent has taken steps to conceal its identity through use of a privacy service, and (iv) there is no conceivable good faith use to which the disputed domain name could be put by the Respondent.

The Panel has also established that the Respondent has engaged in a pattern of trademark-abusive domain name registrations, that also supports the finding of bad faith on the part of the Respondent.

The Panel therefore finds the Respondent to have registered and used the disputed domain names in bad faith.

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 <genentech-fcc.com>, <genentechi.store> and <genentech-pro.icu> be transferred to the Complainant.

/Kateryna Oliinyk/

Kateryna Oliinyk

Sole Panelist

Date: September 19, 2024