

ADMINISTRATIVE PANEL DECISION

bioMérieux v. Humble Jacobs

Case No. D2022-0201

1. The Parties

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

The Respondent is Humble Jacobs, Portugal.

2. The Domain Name and Registrar

The disputed domain name <bio-merieux.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 21, 2022. On January 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 22, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on January 26, 2022 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 January 28, 2022.

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 January 31, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 20, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 23, 2022.

The Center appointed Mihaela Maravela as the sole panelist in this matter on March 1, 2022. 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.

The language of the proceeding is English, being the language of the Registration Agreement, as per paragraph 11(a) of the Rules.

4. Factual Background

According to the evidence provided by the Complainant, and uncontested by the Respondent, the Complainant is a French company acting in the medical field and a leader in microbiology, providing diagnostic solutions which determine the source of disease and contamination to improve patient health and ensure consumer safety. It operates under the trademark BIOMERIEUX, which coincides with its company name. The Complainant is present in more than 160 countries, by means of its 43 subsidiaries around the world.

The Complainant has registered several trademarks consisting of BIOMÉRIEUX or BIOMERIEUX including the European Union trademark registration No. 17912668 registered on October 20, 2018, covering goods in classes 1, 5, 9, 10, 35, 37, 41, 42, and 44 and the International trademark registration No. 933 598, registered on June 12, 2007, covering goods in classes 1, 5, 9, and 10.

The Complainant has several domain names which incorporate the trademark BIOMERIEUX including <biomerieux.com> and <biomerieux.net>, registered respectively on May 31, 1996, and October 20, 2000.

The disputed domain name was registered on January 2, 2022, and does not resolve to an active website.

5. Parties' Contentions

A. Complainant

The Complainant argues that its rights over the company name, trademarks and domain names predate the registration of the disputed domain name. The Complainant also argues that the disputed domain name only differs from its BIOMERIEUX trademarks by the addition (i) of a hyphen between "bio" and "merieux", which is not able to distinguish or differentiate the disputed domain name from the Complainant's trademarks and (ii) and the generic Top-Level Domain (gTLD) ".com" which does not avoid a finding of confusing similarity.

As regards the second element, the Complainant argues that the Respondent has not been known under the disputed domain name, he has never asked for, and has never been given, any permission by the Complainant to use the Complainant's trademark BIOMERIEUX in any way. The Respondent is neither using the disputed domain name in connection with a *bona fide* offering of goods or services nor making a legitimate noncommercial or fair use of the disputed domain name. According to the Complainant, the disputed domain name was registered and used with a fraudulent purpose, as just one day after the registration of the disputed domain name, the Respondent pretended to be an employee of the Complainant and asked one of its distributors to make a payment in a different bank account. Such a use of the disputed domain name is evidence that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

In what concerns the third element, the Complainant argues that the disputed domain name was registered in bad faith as the Complainant's trademark BIOMERIEUX is highly distinctive and well-known in the medical field for decades. An additional argument is that the Respondent sent an email from the disputed domain name pretending to be one of the employees of the Complainant. For the same reasons, the use of the disputed domain name is in bad faith, because the only purpose of the Respondent is a fraudulent goal, by sending emails from the disputed domain name for commercial gain.

B. Respondent

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

6. Discussion and Findings

Preliminary Matters

No communication has been received from the Respondent in this case. However, given that the Complaint was sent to the relevant address disclosed by the Registrar, the Panel considers that this satisfies the requirement in paragraph 2(a) of the UDRP Rules to "employ reasonably available means calculated to achieve actual notice". Accordingly, the Panel considers it can proceed to determine the Complaint based on the statements and documents submitted by the Complainant as per paragraph 15(a) of the Rules and to draw inferences from the Respondent's failure to file any Response. While the Respondent's failure to file a Response does not automatically result in a decision in favor of the Complainant, the Panel may draw appropriate inferences from the Respondent's default.

Substantive Matters

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following elements:

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

A. Identical or Confusingly Similar

The Complainant has proved its rights over the BIOMERIEUX trademark.

The disputed domain name incorporates the trademark BIOMERIEUX in its entirety, with the only difference that in the disputed domain name a hyphen is added between the two parts of the trademark, which does not in the view of the Panel prevent the Complainant's trademark from being recognizable within the disputed domain name. Many UDRP panels have found that a disputed domain name is confusingly similar where the relevant trademark is recognizable within the disputed domain name. See section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

It is well accepted by UDRP panels that a gTLD, such as ".com", is typically ignored when assessing whether a domain name is identical or confusing similar to a trademark. See section 1.11 of the [WIPO Overview 3.0](#).

This Panel concludes that the disputed domain name is confusingly similar to the Complainant's trademarks and therefore finds that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, any of the following circumstances, if found by the Panel, may demonstrate the respondent's rights or legitimate interests in the disputed domain name:

(i) before any notice to it of the dispute, the respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or

(ii) the respondent has been commonly known by the disputed domain name, even if it has acquired no trademark or service mark rights; or

(iii) the respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The consensus view of UDRP panels on the burden of proof under paragraph 4(a)(ii) of the Policy is summarized in section 2.1 of the [WIPO Overview 3.0](#), which states: "[...] 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element."

According to the unrebutted evidence put forward by the Complainant, the disputed domain name has been used to impersonate one of its employees for the purpose of soliciting undue payments. Panels have categorically held that use of a domain name for illegal activity (e.g., phishing, impersonation, or other types of fraud) can never confer rights or legitimate interests (section 2.13.1 of the [WIPO Overview 3.0](#)).

Also, there is no evidence that the Respondent is commonly known by the disputed domain name.

Furthermore, the nature of the disputed domain name carries a risk of implied affiliation and cannot constitute a fair use as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

The Panel considers that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent failed to rebut that *prima facie* case because he did not respond to the Complainant's contentions.

With the evidence on file, the Panel finds that the requirement of paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith.

The disputed domain name was registered many years after the Complainant has obtained registration of its BIOMERIEUX trademarks. From the evidence put forward by the Complainant and not rebutted by the Respondent, the disputed domain name was used to impersonate one of the Complainant's employees with the purpose of soliciting payments that are not due. Under these circumstances, the Panel considers that the Respondent has registered the disputed domain name with knowledge of the Complainant and its trademark and that it targeted that trademark.

As regards the use of the disputed domain name, UDRP panels have established that the use of a domain name to perpetuate fraud constitutes bad faith (See section 3.4 of the [WIPO Overview 3.0](#)). Also, the Respondent seems to have provided false physical address details in the Whois. This is an indicator of bad faith (section 3.2.1. of the [WIPO Overview 3.0](#)).

In the Panel's view, the circumstances of the case represent evidence of registration and use in bad faith of the disputed domain name. The Respondent failed to bring evidence as to the contrary. Consequently, the Panel concludes that the condition of paragraph 4(a)(iii) of the Policy is fulfilled.

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, <bio-merieux.com> be transferred to the Complainant.

/Mihaela Maravela/

Mihaela Maravela

Sole Panelist

Date: March 15, 2022