

ADMINISTRATIVE PANEL DECISION

bioMérieux v. Craig Martin

Case No. D2022-3953

1. The Parties

1.1 The Complainant is bioMérieux, France, represented by Plasseraud IP, France (the “Complainant”).

1.2 The Respondent is Craig Martin, United States of America (“the United States”) (the “Respondent”).

2. The Domain Name and Registrar

2.1 The disputed domain name <biomérix.org> [<xn--biomriex-e4a.org>] (the “Disputed Domain Name”) is registered with Google LLC (the “Registrar”).

3. Procedural History

3.1 The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 21, 2022. On October 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On October 24, 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 (Contact Privacy Inc. Customer 7151571251) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 25, 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 the first amended Complaint on October 26, 2022. In response to the Center’s invitation to rectify the amended Complaint in accordance with paragraph 3(b)(xiii) of the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), the Complainant filed the second amended Complaint on November 8, 2022.

3.2 The Center verified that the Complaint together with the second amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules, and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

3.3 In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 29, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 7, 2022.

3.4 The Center appointed Ike Ehiribe as the sole panelist in this matter on December 21, 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.

4. Factual Background

4.1 The Complainant is a French multinational biotechnology company with its headquarters located at Marcy L'Etoile in France. The Complainant is listed on the NYSE Euronext Paris stock exchange and is active in the field of diagnostic solutions with its products mainly utilised for the diagnosis of infectious diseases. The Complainant was founded in 1963 and operates in more than 160 countries through a network of 43 subsidiaries around the world and a large network of distributors. In the year 2021, the Complainant's revenues rose to EUR 3.38 billion. The Complainant owns many trademark registrations for the word BIOMERIEUX and the device BIOMÉRIEUX in well over 200 hundred countries around the world including countries such as Canada, the United States, Switzerland, France, Japan, Australia *etc.* See, for instance, International Trademark registration number 1478156 for BIOMÉRIEUX (device) registered on June 4, 2018, and the United States registration number 3906321 for BIOMERIEUX (word) registered on January 18, 2011, as indicated in Annex 8 attached to the Complaint. In addition, many UDRP Panels have recognised the Complainant's proprietary rights in the BIOMERIEUX trademark in cases such as: *bioMerieux and bioMerieux, Inc. v. Holdings Ozweb*, WIPO Case No. [D2010-0779](#), and *bioMerieux v. Nish Patel - Ready Asset*, WIPO Case No. [D2014-0899](#) where the Panel held as follows:

- "The Panel finds the Complainant's contention that it is well-known in the diagnostic field to be founded and that the Complainant has established that its mark BIOMERIEUX is well-known."

The Complainant has also provided a list of domain names at Annex 9 including the BIOMERIEUX mark through which the Complainant conducts its business in various countries and on the Internet, *inter alia*, through websites at "www.biomerieux.com" or "www.biomerieux.org".

4.2 The Respondent is reportedly based in Bartow, Florida in the United States. According to the Whois database the Disputed Domain Name was created on August 24, 2022. The Disputed Domain Name does not resolve to an active website.

5. Parties' Contentions

A. Complainant

5.1 The Complainant contends that the Disputed Domain Name is confusingly similar to the Complainant's well-known BIOMERIEUX trademark considering that the Disputed Domain Name wholly reproduces the trademark in its entirety. The Complainant refers to a number of previous UDRP decisions to assert that the likelihood of confusion is not eliminated by the addition of accents, the presence of which increases the intellectual resemblance without altering the visual and phonetic resemblances. See in this regard *Accor v. Proxilog SARL*, WIPO Case No. [D2010-1210](#), or *Kshcolat Limited v Nurinet*, WIPO Case No. [D2010-0577](#). The Complainant further argues that the only difference between the Disputed Domain Name and the Complainant's trademark is the addition of the generic Top-Level Domain ("gTLD") ".org". The Complainant in this regard asserts in accordance with well-established case law that the gTLD will not be taken into account when conducting a confusing similarity inquiry following section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

5.2 The Complainant asserts further, that the Respondent equally has no rights or legitimate interests in respect of the Disputed Domain Name considering that the Disputed Domain Name does not correspond to the name of the Respondent or any trademark owned by the Respondent. Secondly, it is argued that the Complainant never gave its consent to the Respondent to use its trademark in a domain name registration or

in any other manner. Thirdly, the Complainant argues that the Respondent has failed to provide any evidence of any fair or noncommercial or *bona fide* use of the Disputed Domain Name in connection with goods and services considering that the Disputed Domain Name does not re-direct to any web page. Therefore, following previous decisions in *Dr Martens International Trading GmbH and Dr. Maertens Marketing GmbH v. Godaddy.com.inc.*, WIPO Case No. [D2017-0246](#), and *AB Electrolux v. Saheed Ali*, WIPO Case No. [D2018-1068](#), the Complainant submits that an inactive website evidences the absence of legitimate noncommercial or fair use of the Disputed Domain Name, particularly, where the Disputed Domain Name is identical or confusingly similar to the Complainant's trademark.

5.3 On the question of bad faith registration and use the Complainant has advanced the following submissions. First of all, considering that the Respondent who is based in the United States registered the Disputed Domain Name on August 24, 2022, the Complainant submits that the Respondent had the Complainant's BIOMERIEUX trademark in mind when effecting the registration and therefore the Respondent shall be considered as having constructive notice of the Complainant's prior rights. In this regard, the Complainant relies on previous UDRP decisions to submit that the incorporation of well-known trademarks into a domain name tends to support a finding of bad faith registration and use. See *CSC Brands LP v. Shen Zhong Chao*, WIPO Case No. [D2018-2485](#). Secondly, the Complainant contends that the Respondent's bad faith use is further supported by the Respondent's initial concealment of his identity and contact information through a privacy service and the provision of false contact information to the Registrar. Thirdly, the Complainant refers again to the fact that the Disputed Domain Name does not resolve to an active website and contends that this situation does not prevent a finding of bad faith use under the doctrine of passive holding following section 3.3 of the [WIPO Overview 3.0](#) and previous UDRP decisions involving the Complainant and its BIOMERIEUX trademark such as: *bioMerieux v. John Koontz*, WIPO Case No. [D2017-0299](#), and *bioMerieux v. Oneandone Private Registration, 1 & 1 Internet Inc. /Name Redacted*, WIPO Case No. [D2019-2566](#). Fourthly, the Complainant asserts that MX records have been set up on the Disputed Domain Name such that the Respondent is able to send emails through the email address at "[...][@biomerieux.org](mailto:[]@biomerieux.org)" and therefore may use the Disputed Domain Name to dispatch fraudulent emails such as messages containing spam or phishing attempts. The Complainant submits that this feature is indicative of bad faith use of the Disputed Domain Name following a number of previous UDRP decisions. See *Statoil ASA v. Domain Admin, Privacy Protection Service Inc D/B/A Privacy Protect.Org/Nicolas Kerry*, WIPO Case No. [D2017-0046](#). Fifthly, the Complainant contends that the Respondent has also set up a Sender Policy Framework (SPF record) on the Disputed Domain Name which as it is put, squarely evidences that the Respondent genuinely intends to use the Disputed Domain Name to send emails that would more than likely fraudulently impersonate the Complainant. In this regard, the Complainant relies on the decision in *American Society of Hematology Inc. v. Domain Admin, Privacy Protect LLC (PrivacyProtect.org) / Pranaey H*, WIPO Case No. [D2021-1381](#).

B. Respondent

5.4 The Respondent did not reply to the Complainant's contentions. In the circumstances, the Panel shall draw adverse inferences from the failure or refusal of the Respondent to reply to those contentions as it considers appropriate.

6. Discussion and Findings

6.1 Under paragraph 4(a) of the Policy, to succeed in the administrative proceedings the Complainant must prove that: (1) the Disputed Domain Name is identical and or confusingly similar to the trademark or service mark of the Complainant; (2) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and (3) the Disputed Domain Name has been registered and is being used in bad faith.

6.2 As expressly stated in the Policy the Complainant must establish the existence of each of these three elements in any UDRP proceeding.

A. Identical or Confusingly Similar

6.3 This Panel finds and accepts that the Complainant is a well-known bio-technology company active in the field of diagnostic solutions. It is based in France, with operations in more than 160 countries and the registered owner of numerous trademark registrations of the BIOMERIEUX and BIOMÉRIEUX trademarks as listed in Annex 8 attached to the Complaint.

6.4 The Panel therefore finds that upon a visual examination of the Disputed Domain Name, the said Disputed Domain Name is identical to the textual components of the Complainant's BIOMÉRIEUX trademark. See section 1.10 of the [WIPO Overview 3.0](#). The Panel also finds that the mere addition of the gTLD ".org" does absolutely nothing to prevent a finding of confusing similarity. See section 1.11 of the [WIPO Overview 3.0](#).

6.5 The Panel is therefore satisfied that the Complainant has established the confusing similarity requirement being the first element of the Policy.

B. Rights or Legitimate Interests

6.6 The Panel is equally satisfied that the Respondent has failed to establish that it has rights or legitimate interests in the Disputed Domain Name within the ambit of paragraphs 4(a)(ii) and 4(c) of the Policy. The Panel finds that the Respondent is not commonly known by the Disputed Domain Name. In addition, there is no evidence to suggest that the Respondent has been permitted or licensed or authorised to use the Complainant's BIOMERIEUX or BIOMÉRIEUX trademark to register a domain name or in any other manner. Thirdly, the Panel is satisfied from the evidence adduced by the Complainant that there is no evidence of any fair or noncommercial or *bona fide* use of the Disputed Domain Name in connection with goods and services considering that the Disputed Domain Name does not redirect to any webpage following the decision in *AB Electrolux v. Saheed Ali, supra*. Thus, the Complainant is correct to assert that an inactive website evidences the absence of legitimate noncommercial or fair use of the Disputed Domain Name, particularly, when the Disputed Domain Name is identical to the Complainant's BIOMÉRIEUX trademark. Moreover, the identical nature of the Disputed Domain Name carries a high risk of implied affiliation that cannot constitute fair use given that it effectively impersonates or suggests sponsorship or endorsement by the Complainant, contrary to the fact. See section 2.5.1 of the [WIPO Overview 3.0](#).

6.7 In the circumstances the Panel is satisfied that the Complainant has established the Respondent's lack of rights and legitimate interests in the Disputed Domain Name being the second element Policy and as stipulated in paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

6.8 On the question of bad faith registration and use, the Panel has considered a number of irrefutable factors as submitted by the Complainant which leave the Panel with no other choice but to conclude that the Respondent engaged in bad faith with respect to the Disputed Domain Name with the singular intention of exploiting the Complainant's international reputation and goodwill in the BIOMERIEUX and BIOMÉRIEUX trademarks. In doing so, the Panel relies on the so-called "passive holding" doctrine enshrined under section 3.3. of the [WIPO Overview 3.0](#), which states that the non-use of a domain name may not necessarily prevent a finding of bad faith when weighing the totality of the circumstances.

6.9 In the first instance, the Panel finds that the Respondent must have been aware of the existence of the Complainant and its prior rights in the BIOMERIEUX and BIOMÉRIEUX trademarks before deciding to register the Disputed Domain Name on August 24, 2022. The Complainant in this regard submits that the Respondent should be considered as having constructive notice of the Complainant's prior rights and refers to the intrinsically highly distinctive nature of the BIOMERIEUX and BIOMÉRIEUX trademark being well known in the medical field as evidence that the Respondent deliberately targeted the Complainant's trademark at the date of registration. The Panel finds that the Complainant's submission in this regard is well founded. Further in this regard the Complainant has relied on the decision in *CSC Brands LP v. Shen*

Zhong Chao, supra., amongst other previous decisions to submit that the incorporation of a well-known trademark into a domain name tends to support a finding of bad faith registration and use.

Secondly, the Complainant has referred to distinct aspects of the Respondent's conduct as indicative of the Respondent's intentional bad faith. The first aspect is the fact that initially, the Respondent concealed his identity and contact information through a privacy service. The second aspect is the subsequent revelation by the Registrar that the Respondent as registrant of the Disputed Domain Name provided parts of contact information which turned out to be false and/or incorrect in breach of the registration agreement. Thirdly, the registration and non-use of the identical Disputed Domain Name, which evidently carries a risk of confusion as to the affiliation to the Complainant. Fourthly, the Complainant has adduced evidence to demonstrate that from the technical configuration of the Disputed Domain Name, MX records have been set up on the Disputed Domain Name which also confirm a possible intention to use the Disputed Domain Name to send emails though the email address at "[...][@biomérieux.org](mailto:[...]@biomérieux.org)". The Panel finds that such emails would certainly be confusing given the identical nature of the Disputed Domain Name as compared to the Complainant's BIOMÉRIEUX trademark and most unlikely to be for legitimate purposes. See in this regard, *Statoil ASA v. Domain Admin.Privacy Protection Service Inc. D/B/A Privacy Protection.org / Nicolas Kerry*, WIPO Case No. [D2017-0046](#). Fifthly, and still on the technical configuration of the Disputed Domain Name, the Complainant asserts that the Respondent in addition has set up an SPF record on the Disputed Domain Name which in essence allows the receiving mail server to check that a mail is submitted by an IP address and/or email server authorised by that domain name's administrators. This Panel equally accepts that this feature is indicative of the Respondent's likely intention to send fraudulent emails if the Respondent has not done so already. See in this regard *American Society of Hematology, Inc.v. Domain Admin, Privacy Protect, LLC(PrivacyProtect.org/ Pranaey,H. supra.* Sixthly, as indicated in paragraph 5.4 above, the Panel has drawn adverse inferences from the failure of the Respondent to reply to the submissions of the Complainant in this matter.

Accordingly, the Respondent's passive holding of the Disputed Domain Name does not prevent a finding of bad faith and the Complainant has satisfied the third element of the Policy.

7. Decision

7.1 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, <biomérieux.org> [[\[<xn--biomrieux-e4a.org>](mailto:[xn--biomrieux-e4a.org])], be transferred to the Complainant.

/Ike Ehiribe/

Ike Ehiribe

Sole Panelist

Date: January 4, 2023