

ADMINISTRATIVE PANEL DECISION

BioNTech SE v. jin
Case No. D2023-2021

1. The Parties

The Complainant is BioNTech SE, United States of America (“United States” or “U.S.”), represented by MSA IP – Milojevic Sekulic & Associates, Serbia.

The Respondent is jin, China.

2. The Domain Name and Registrar

The disputed domain name <biontech.shop> is registered with Sav.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 5, 2023. On May 5, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 8, 2023, 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 (Redacted for Privacy), and contact information in the Complaint. The Center sent an email communication to the Complainant on May 10, 2023 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 May 14, 2023.

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 May 22, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 11, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 12, 2023.

The Center appointed William A. Van Caenegem as the sole panelist in this matter on June 28, 2023. 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 identity of the Respondent was initially masked by a privacy service but was revealed by the registrar at the request of the Center.

4. Factual Background

The Complainant is a biotechnology company founded in 2008 based in Germany and the developer in collaboration with Pfizer of a COVID-19 vaccine.

The Complainant is the owner of a number of trademark registrations including European Union ("EU") Trademark No. 008964447, BIONTECH, registered on December 22, 2010, covering goods and services in classes 1, 5, 42 and 44; EU Trademark No. 016241465, BIONTECH, registered on November 9, 2017 and covering goods and services in classes 1, 5, 9, 10, 16, 31, 41, 42 and 44; International Registration No. 1478253, "BIONTECH" (word/device), registered on April 5, 2019, covering goods and services in classes 1, 5, 42 and 44; International Registration No. 1370266, BIONTECH, registered on July 10, 2017 and covering goods and services in classes 1, 5, 16, 31, 42 and 44; and United States Trademark No. 5712036, BIONTECH, registered on April 2, 2019 and covering goods and services in classes 1, 5, 16, 31, 42 and 44.

The Complainant also owns a number of domain names including <biontech.com> registered on May 29, 1998; <biontech.de> registered on October 10, 2007; <biontech.info> registered on February 27, 2009; <biontech.net> registered on February 27, 2009; <biontech.us> registered on May 8, 2019; <biontech-covid19.com> registered on June 5, 2020; and <biontechglobal.com> registered on April 20, 2020. The disputed domain name was registered on April 8, 2023, and resolves to a parking page where it is offered for sale (without indication of a minimum price), interested parties being invited to contact the domain owner to negotiate a purchase.

5. Parties' Contentions

A. Complainant

The Complainant contends that given its extensive presence in the media in relation to the COVID-19 health crisis and recognition of its vaccine, the BIONTECH trademark has gained well-known status within a short period of time. The Complainant points to reporting of its BIONTECH trademark around the world, both online and in traditional form.

The Complainant says that its COVID vaccine is commonly known as the BioNTech/Pfizer or Pfizer/BioNTech vaccine and that as of March 22, 2023, more than 430 million doses of this vaccine have been administered in the U.S. alone. As of April 22, 2023, more than 660 million doses of the Complainant's BioNTech/Pfizer vaccine have been administered in the EU. On a global scale, currently, more than one billion doses of BioNTech/Pfizer vaccine have been administered, the Complainant asserts. The vaccine is sold under another trademark.

The Complainant says that it has benefited from extensive press coverage for its company and trademark and that a number of prior Panels have recognized the well-known character of the BIONTECH trademark. The Complainant cites a number of decisions to that effect.

The Complainant points out that the disputed domain name incorporates its trademark BIONTECH without any additional terms, and the generic Top-level domain ("gTLD") ".shop" should be viewed as a standard registration requirement. Therefore, the disputed domain name should be considered as identical with the Complainant's BIONTECH trademark.

The Complainant maintains that as it has used its BIONTECH trademark around the world, that mark has gained global fame and the public has learned to perceive the goods and services offered under this mark as being those of the Complainant. Accordingly, the Complainant says, the disputed domain name creates a

clear likelihood of confusion and impression of association with the Complainant's BIONTECH trademark.

The Complainant says that it is not affiliated with the Respondent in any way and that the latter has not been authorized to use and register its trademark or to seek registration of any domain name incorporating it. The Complainant points to previous UDRP Panel decisions that have found that in the absence of any license or permission from a complainant the use of a widely-known trademark, can not reasonably be claimed to be in good faith. The Complainant contends that the Respondent's name consists of a most unlikely structure, of only one three-letter word, and is most likely contrived. The rest of the Respondent's contact information, revealed upon submission of the complaint, also appears to be false and non-sensical, as it points towards a Hong Kong, China address, consisting of two letter abbreviations, and not indicating any existing address or location. According to the Complainant, providing false contact information is among relevant factors weighed by Panels when judging whether a respondent's use of a domain name constitutes a legitimate fair use (pointing to section 2.5.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition "[WIPO Overview 3.0](#)").

The Complainant also says that the Respondent did not demonstrate use of, or demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services. Indeed, the disputed domain name resolves to a "parked" page that contains notice that the disputed domain name is for sale, and for that reason, the Complainant says, it is clear that the Respondent has no intention to develop a legitimate activity by way of the disputed domain name. The Complainant asserts that to the best of its knowledge, the Respondent is neither commonly known by the name "Biontech" nor in any way affiliated with the Complainant. Moreover, since the disputed domain name consists exclusively of what the Complainant calls its well-known BIONTECH trademark, the Respondent cannot reasonably pretend it was intending to develop a legitimate activity through the disputed domain name.

The Complainant also points out that the Respondent in any event is not authorized or licensed to use the BIONTECH trademark, nor to seek registration of any domain name incorporating it. Previous UDRP Panels have found that in the absence of any license or permission from a complainant to use a widely-known trademark, no actual or contemplated *bona fide* or legitimate use of the domain name can reasonably be Claimed. The Complainant adds that due to the exceptional media presence of the Complainant throughout the COVID-19 pandemic, it is difficult to imagine that the Respondent did not have the Complainant in mind when registering the disputed domain name. Bad faith has previously been found, the Complainant says, 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.

The Complainant then points out that by virtue of paragraph 2 of the UDRP Policy, when someone registers a domain name, they represent and warrant to the registrar that, to their knowledge, the registration of the domain name will not infringe the rights of any third party. This means that it was the Respondent's duty, according to the Complainant, to verify that the registration of the disputed domain name would not infringe the rights of any third party. In any case, a quick search for BIONTECH trademarks would have revealed to the Respondent the existence of the Complainant and its trademarks. Therefore, the Complainant says, the Respondent's failure to do so is a contributory factor establishing its bad faith. A simple search via Google or any other search engine using the keyword "biontech" demonstrates that all the results on the first page relate to the Complainant, its activities or news about it. Further, the use of false contact details and namely casts doubt on the Respondent's *bona fides*, supporting an inference of bad faith registration for the respondent to rebut, a contention the Complainant sources in section 3.2.1 of [WIPO Overview 3.0](#).

The Complainant also points out that the disputed domain name resolves to an "epik" parking page offering it for sale which indicates that the Respondent has registered or has acquired it for the purpose of selling it to the Complainant, its competitors or third parties. Alternatively given that the disputed domain name resolves to a parking page, the Complainant says that it could be argued that it is passively held by the Respondent. Such passive holding does not preclude a finding of bad faith, the Complainant asserts, since previous panels have held that passive holding of a disputed domain name can satisfy the requirements of paragraph 4(a)(iii) of the Policy, depending on all the circumstances of a respondent's behaviour (referring to *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

Finally, the Complainant says that it is likely that the Respondent registered the disputed domain name to prevent the Complainant from using its BIONTECH trademark in the disputed domain name and especially to prevent it from registering a domain name corresponding to its company name within the “.shop” gTLD. The Complainant says that according to a former Panel, this type of conduct constitutes evidence of Respondent’s bad faith (referencing *L’oreal v. Chenxiangsheng*, WIPO Case No. [D2009-0242](#)).

In conclusion, the Complainant contends that it seems likely that the Respondent’s primary motive in registering and using the disputed domain name was to capitalize on or otherwise take advantage of the Complainant’s trademark rights.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

Since the gTLD “.shop” is to be ignored for the sake of comparison, the disputed domain name is identical to the BIONTECH registered trademark of the Complainant.

Therefore, the Panel holds that the disputed domain name is identical to the BIONTECH registered trademark of the Complainant.

B. Rights or Legitimate Interests

The Respondent has not answered any of the Complainant’s contentions, . The disputed domain name does not resolve to any website that might conceivably warrant the recognition of rights or legitimate interests, instead being offered for sale from a parking page. There is no indication that the Respondent has any entitlements resulting from legitimate use of the term “Biontech” in trade or commerce, nor is the Respondent known by that name or anything remotely similar. The Complainant has not authorized any use of its distinctive trademark by the Respondent, including its identical reproduction in a registered domain name. In other words, there is nothing before the Panel that points to any legitimate interests or rights vesting in the Respondent who registered the disputed domain name containing the distinctive and widely known trademark BIONTECH in identical form with total disregard of its owner’s rights.

Therefore, the Panel holds that the Complainant has made out an unrebutted *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

The Complainant has pointed to the extensive coverage that the name and trademark BIONTECH have received during the COVID pandemic. The trademark itself is distinctive and its renown is worldwide, as was the pandemic in whose context it was deployed. It is highly improbable that the Respondent was unaware of the legal rights the Complainant has in the Biontech business name and trademark. In any case, a quick and easy Internet search would have revealed the Complainant’s exclusive and unassailable rights in the term “Biontech”, and the Respondent should have undertaken such a search. However, given that the disputed domain name was offered for sale, it can in any case safely be inferred that the Respondent was perfectly aware of the rights and value attaching to the BIONTECH trademark of the Complainant upon registration. Even an entirely passive holding without any attempt to monetize the disputed domain name would implicate bad faith use, given the nature of the disputed domain name, the widespread use and consequential consumer knowledge in many jurisdictions of the BIONTECH trademark.

Therefore, the Panel holds that the disputed domain name was registered and used in bad faith.

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 <biontech.shop> be transferred to the Complainant.

/William A. Van Caenegem/

William A. Van Caenegem

Sole Panelist

Date: July 12, 2023.