

## **ADMINISTRATIVE PANEL DECISION**

BioNTech SE v. Jerry Robinson Hawkes

Case No. D2023-4093

### **1. The Parties**

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

The Respondent is Jerry Robinson Hawkes, Ireland.

### **2. The Domain Name and Registrar**

The disputed domain name <biontechvax.com> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 29, 2023. On September 29, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 2, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 3, 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 October 6, 2023.

The Center verified that the Complaint [together with 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 October 10, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 30, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 31, 2023.

The Center appointed Peter Burgstaller as the sole panelist in this matter on November 2, 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.

#### 4. Factual Background

The Complainant is a biotechnology company and develops and manufactures active immunotherapies, which include pharmaceutical candidates based on messenger RNA (mRNA) for use, *inter alia* as vaccines against infectious diseases. The Complainant has a strong global media presence and has acquired worldwide renown in the past three years because of its BIONTECH COVID-19 vaccine (Annexes 2, 7 - 12 to the Complaint).

The Complainant owns various registered trademarks for its mark BIONTECH around the world, *inter alia*

- European Union ("EU") trademark BIONTECH (word), Reg. No. 008964447, registered on December 22, 2010, in classes 1, 5, 42 and 44;
- EU trademark BIONTECH (word), Reg. No. 016241465, registered on November 9, 2017, in classes 1, 5, 9, 10, 16, 31, 41, 42 and 44;
- International trademark BIONTECH (word/device), Reg. No. 1478253, registered on April 5, 2019, in classes 1, 5, 42 and 44;
- International trademark BIONTECH, Reg. No. 1370266, registered on July 10, 2017, in classes 1, 5, 16, 31, 42 and 44;
- United States of America ("US") Trademark BIONTECH, Reg. No. 5712036, registered on April 2, 2019, in classes 1, 5, 16, 31, 42 and 44 (Annex 5 to the Complaint).

Moreover, the Complainant owns several domain names, *inter alia* <biontech.com>, registered on May 29, 1998, or <biontech.info> and <biontech.net>, both registered on February 27, 2009 (Annex 6 to the Complaint).

A number of prior panels in domain name disputes have recognized the well-known character of the BIONTECH trademark.

The disputed domain name was registered on February 12, 2021 (Annex 3 to the Complaint); it resolved to a website with Pay-Per-Click ("PPC") links (Annex 3 to the Complaint); currently, the disputed domain name still resolves to a parking site with pay-per-click links to other websites on which various products were offered for sale, *inter alia* nutritional supplements and clothing (Panelist's own research on November 11, 2023).

#### 5. Parties' Contentions

##### A. Complainant

The Complainant was founded in 2008 and it is pioneering the development of novel therapies for cancer and other serious diseases. It develops and manufactures active immunotherapies for patient-specific approaches to the treatment of diseases, which include pharmaceutical candidates based on messenger RNA (mRNA) for use, *inter alia*, as individualized cancer immunotherapies and as vaccines against infectious diseases. The company focuses on developing cancer therapeutics, including individualized immunotherapy, as well as vaccines for infectious diseases, including COVID-19 (together with US pharmaceutical company Pfizer).

The Complainant has a strong global media presence especially because it is one of the few companies which have developed a vaccine in relation to COVID-19 infections in response to the growing global health crisis.

The Complainant has registered various trademarks and domain names containing the mark BIONTECH around the world.

The disputed domain name is identical or confusingly similar to the registered trademark in which the Complainant has rights: The disputed domain name incorporates the Complainant's trademark BIONTECH with addition of the term "vax" which is common abbreviation in English language for "vaccine". The additional term within the disputed domain name is closely related to the Complainant's business activity of vaccine development. The disputed domain name creates a clear likelihood of confusion with the Complainant's BIONTECH trademark, since it is likely that the disputed domain name could mislead Internet users into thinking that they are, in some way, associated with the Complainant and therefore the disputed domain name is confusingly similar to the BIONTECH trademark in which the Complainant has rights.

The Respondent has no rights or legitimate interests in respect of the disputed domain name: The Complainant has not authorized the Respondent to use its BIONTECH mark for any reason or in any manner, including in or as part of the disputed domain name. Likewise, the Complainant is not affiliated or otherwise connected with the Respondent. The Complainant has found no evidence that the Respondent has been commonly known by the disputed domain name or by the term "biontechvax". Further, the Complainant has found nothing to suggest that the Respondent holds any trademark rights on the disputed domain name or has used the disputed domain name in connection with any legitimate noncommercial or fair use, without intent for commercial gain.

Finally, the disputed domain name was registered and is being used in bad faith: Because of the fame of the Complainant and its BIONTECH mark, it is not possible to conceive of a plausible situation in which the Respondent would have been unaware of the Complainant and the Complainant's BIONTECH mark when the disputed domain name was registered. Further, the disputed domain name reproduces in full the well-known BIONTECH mark, without the consent or authorization of the Complainant together with the suffix "vax" which is the abbreviation for vaccine and rather strengthens the impression that the Respondent must have been aware of the Complainant and its business.

The disputed domain name resolves to a parking page with sponsored links (PPC) and such use indicates that the disputed domain name is used in order to make a commercial gain by abusing the Complainant's reputation, which constituted bad faith use under the Policy. Moreover, the Respondent registered the disputed domain name to prevent the Complainant from using its BIONTECH trademark in the disputed domain name and specially to prevent the Complainant from registering the disputed domain name corresponding to its company name in combination with word "vax" which refers to the Complainant's field of activity.

## **B. Respondent**

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

## **6. Discussion and Findings**

According to paragraph 4(a) of the Policy, the Complainant must prove that

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

## **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. This test typically involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

In the case at issue, the Complainant submitted evidence, which incontestably and conclusively establishes rights in the mark BIONTECH.

The disputed domain name is confusingly similar to the BIONTECH mark in which the Complainant has rights since the Complainant's BIONTECH mark is clearly recognizable in the disputed domain name. It has long been established under UDRP panel decisions that where the relevant trademark is recognizable within the disputed domain name, the mere addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) will not prevent a finding of confusing similarity under the first element of the Policy (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

This is the case at hand: The addition of the term "vax" as suffix to the BIONTECH mark in the disputed domain name does not prevent a finding of confusing similarity.

Finally, it has also long been held that generic Top-Level Domains are generally disregarded when evaluating the confusing similarity under the first element (see section 1.11.1 of the [WIPO Overview 3.0](#)).

Therefore, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

## **B. Rights or Legitimate Interests**

While the overall burden of proof in UDRP proceedings is on the complainant, UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element (see section 2.1 of the [WIPO Overview 3.0](#)). Here, the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, which has not been rebutted by the Respondent.

Furthermore, the nature of the disputed domain name, comprising the Complainant's distinctive mark in its entirety together with the term "vax", which is a term to refer to "vaccination", as suffix falsely suggests an affiliation with the Complainant that does not exist (see section 2.5.1 of the [WIPO Overview 3.0](#)).

The use of the disputed domain name to host a parked page comprising PPC links cannot be found as a bona fide offering of goods or services as such are considered to capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users. [WIPO Overview 3.0](#), section 2.9.

Noting the above, and in the absence of any Response or allegations from the Respondent, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

### C. Registered and Used in Bad Faith

As stated in many decisions rendered under the Policy (e.g. *Robert Ellenbogen v. Mike Pearson*, WIPO Case No. [D2000-0001](#)) both conditions, registration and use in bad faith, must be demonstrated; consequently, the Complainant must show that:

- the disputed domain name was registered by the Respondent in bad faith, and
- the disputed domain name is being used by the Respondent in bad faith.

(i) The Complainant has rights and is the owner of the well-known, famous and distinctive registered trademark BIONTECH, which is registered and used in many jurisdictions around the world. Moreover, the Complainant registered and is using various domain names containing BIONTECH e.g., <biontech.com>, <biontech.info> or <biontech.net> among others, for many years.

It is inconceivable for this Panel that the Respondent registered and used the disputed domain name without knowledge of the Complainant's rights, which leads to the necessary inference of bad faith.

[WIPO Overview 3.0](#), section 3.2.2. This finding is supported by the fact that the disputed domain name incorporates the Complainant's distinctive trademark BIONTECH entirely.

Moreover, the disputed domain name contains the term "vax" as suffix to the BIONTECH mark, which in fact even strengthens the impression that the Respondent must have known of the Complainant's mark when registering the disputed domain name, since the "vax" is the abbreviation of vaccination which refers to a relevant business of the Complainant.

Therefore, the Panel is convinced that the disputed domain name was registered in bad faith by the Respondent.

(ii) The Complainant has put forward evidence that the disputed domain name resolved to a website which contained PPC links to other websites which offered products for sale *inter alia* nutritional supplements or clothing. In doing so, the Respondent has intentionally attempted to attract Internet users to its websites for commercial gain, by creating a likelihood of confusion with the Complainant's famous and distinctive trademarks as to the source, sponsorship, affiliation or endorsement of its website according to paragraph 4(b)(iv) of the Policy – this constitutes bad faith use of the disputed domain name.

Hence, the Panel is convinced that the disputed domain name was registered and used in bad faith under paragraph 4(a)(iii) of the Policy; the fact that the Respondent failed to respond to the Complaint also supports this finding in the circumstances of this case.

### 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, <biontechvax.com>, be transferred to the Complainant.

/Peter Burgstaller/

**Peter Burgstaller**

Sole Panelist

Date: November 16, 2023