

ADMINISTRATIVE PANEL DECISION

F. Hoffmann-La Roche AG v. Frank Lyons

Case No. D2024-1433

1. The Parties

The Complainant is F. Hoffmann-La Roche AG, Switzerland, internally represented.

The Respondent is Frank Lyons, Nigeria.

2. The Domain Name and Registrar

The disputed domain name <uk-roche.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 April 4, 2024. On April 5, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 6, 2024, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 April 9, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 29, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 30, 2024.

The Center appointed Catherine Slater as the sole panelist in this matter on May 2, 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, together with its affiliated companies, is one of the world's leading research-focused healthcare groups in the fields of pharmaceuticals and diagnostics. It operates globally in more than 100 countries.

The Complainant has many registrations worldwide for the word ROCHE ("the Complainant's Mark") including:

- International Trade Mark 340483 registered on November 14, 1967; and
- International Trade Mark 346223 registered on June 19, 1968.

The Complainant also has International Trade Mark 832631 registered on April 8, 2004. This latter registration is for the word "Roche" encased within a hexagon shape ("the Hexagon Mark").

The Complainant owns and uses the domain names <roche.com> and <roche.co.uk>.

The disputed domain name was registered on March 8, 2024. At the date of this Decision, the disputed domain name did not resolve to an active website. According to the Complainant's evidence, the disputed domain name has been used for a phishing scheme reproducing the Hexagon Mark.

On March 25, 2024, the Complainant sent a cease-and-desist letter to the Respondent. The Respondent did not reply.

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 name.

Notably, the Complainant contends that the disputed domain name is confusingly similar to the Complainant's Mark since it incorporates the Complainant's Mark in its entirety and the addition of the geographic term "UK", and the use of a hyphen does not sufficiently distinguish the disputed domain name from ROCHE. It further contends that since the Complainant is a major pharmaceutical and diagnostics enterprise and ROCHE is a very well-known mark the likelihood of confusion is increased.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. In this regard, it contends that its rights in the Complainant's Mark predate the registration of the disputed domain name. Further, that the disputed domain name re-directs to a "parked-free" website and is being used to engage in an email scam and phishing scheme. In support of this latter contention the Complainant annexes two emails utilizing email addresses ending "@uk-roche.com" and purported to be sent by the Complainant's UK-based finance department. The Complainant says that the Respondent is therefore attempting to create a likelihood of confusion amongst Internet users and/or to free ride on the goodwill of the Complainant's Mark for illegitimate commercial gain. The Respondent has failed to respond to the Complainant's cease-and-desist letter in order to put forward any case of legitimate interests that it might have.

The Complainant contends the disputed domain name was registered in bad faith since the Respondent would undoubtedly have been aware of the Complainant's Mark and selected the disputed domain name to take advantage of its associated notoriety and goodwill. Further, that the disputed domain name is being used in bad faith because it points to a "parked-free website" and has been used to engage in an email scam

and phishing scheme. As such, the Respondent's primary motive was to deceive the Complainant's clients and capitalize on/take advantage of the Complainant's Mark by creating initial interest confusion.

B. Respondent

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

6. Discussion and Findings

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 trade mark 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 trade mark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms, here "uk-", may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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 name. 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 name such as those enumerated in the Policy or otherwise.

Indeed, the Panel finds that use made of the disputed domain name is the opposite of legitimate. The Respondent has used the disputed domain name to engage in a phishing campaign and this demonstrates a lack of legitimate rights or interests. The Panel discusses the Respondent's conduct in more detail below.

Panels have held that the use of a domain name for illegal activity here, claimed phishing or impersonation/passing off, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

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.

Panels have held that the use of a domain name for illegal activity here, claimed phishing 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 name constitutes bad faith under the Policy.

In the present case, the Panel notes that the Respondent has composed the disputed domain name by combining the Complainant's Mark with "UK" which is the commonly used abbreviation for the United Kingdom. The reason for registering that composition is revealed by the use to which the Respondent has then put the disputed domain name, namely a phishing campaign reliant upon convincing others that e-mails are sent are from the Complainant's operation in the United Kingdom.

The Complainant has submitted in evidence two e-mails sent from an address ending "@uk-roche.com". The first email purports to be sent by a Purchasing Manager at a UK address of the Complainant. The email also contains the Hexagon Mark. The email requests a quote for the supply of defibrillators. The second email is shorter and is simply signed by an individual identified as a Purchasing Manager and requests a quote for the supply of radios. The Complainant has redacted the name of the Purchasing Manager (for privacy purposes) but states that the name used is one of their actual employees.

In short, at the time of registering the disputed domain name the Respondent clearly knew of the Complainant and its operations in the United Kingdom and deliberately chose to register a name incorporating the Complainant's Mark together with the abbreviation for the United Kingdom. It has then gone on to use the disputed domain name to create and send emails with the clear purpose of impersonating (or at least giving the impression of a business connection with) the Complainant in order to conduct a phishing scam where the likely intention is either to obtain the sensitive business information of a third party or to obtain goods without making payment.

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 name <uk-roche.com> be transferred to the Complainant.

/Catherine Slater/

Catherine Slater

Sole Panelist

Date: May 15, 2024