

Decision for dispute CAC-UDRP-106760

Case number **CAC-UDRP-106760**

Time of filing **2024-07-30 19:25:37**

Domain names **biomerlieux.com**

Case administrator

Name **Olga Dvořáková (Case admin)**

Complainant

Organization **bioMérieux**

Complainant representative

Organization **Plasseraud IP**

Respondent

Name **Webbing Susan**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant submitted evidence that it is the owner of the following trademarks:

- International trademark “**BIOMERIEUX**” (wordmark), registration nr. 933598, registered on June 12, 2007, in classes 1, 5, 9 and 10;
- International trademark “**BIOMERIEUX**” (wordmark), registration nr. 1392389, registered on October 25, 2017, in classes 35, 37, 41, 42 and 44;
- International trademark “**BIOMERIEUX**” (combined mark), registration nr. 1478156, registered on June 4, 2018, in classes 1, 5, 9, 10, 35, 37, 41, 42, 44;
- EU trademark “**BIOMERIEUX**” (combined mark), registration nr. 017912668, registered on October 20, 2018, in classes 1, 5, 9, 10, 35, 37, 41, 42 and 44;
- French trademark “**BIOMERIEUX**” (combined mark), registration nr. 4416795, registered on April 27, 2018, in classes 1, 5, 9, 10, 35, 37, 41, 42 and 44.

These trademarks are hereafter referred to as the “**Trademarks**”.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant is a French multinational biotechnology company. The products of the Complainant are used for diagnostic solutions for infectious diseases, detection of microorganism in agri-food, pharmaceutical and cosmetic products. The Complainant claims to be present in 160 countries through 43 subsidiaries and a large network of distributors. In addition, the Complainant states to have been the leader in the field of in vitro diagnostics for over 60 years.

The Complainant states to be the owner of several trademarks comprising the word “BIOMERIEUX”. The Complainant submitted evidence that it is indeed the owner of such international, European, and national trademarks. These trademarks are listed above and referred to in this decision as the “Trademarks”. The Complainant has referred to several decisions of previous UDPR panels in which the well-known character of the Trademarks has been acknowledged.

Further, the Complainant claims to be the owner (direct or through subsidiaries) of several domain names including the term “biomérieux”. The Complainant has submitted evidence that it is the owner of, amongst other, the following domain names: <biomerieux.com>, <biomerieux.net>, <biomerieux.org>, <biomerieuxusa.com> and <biomerieuxkorea.com>.

The disputed domain name <biomerlieux.com> was registered on July 25, 2024.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

1. Language of the proceedings

The Complaint mentioned that to the best of the Complainant’s knowledge, the language of the Registration Agreement is Japanese. The Complainant requested that the language of the proceeding should be English, based upon various reasons.

Since the Registrar Verification of 31 July 2024 by the Registrar mentioned that the language of the Registration Agreement is English, the Panel decides that the language of the proceeding should be English.

2. Confusing similarity

The disputed domain name consists of the Complainant's Trademarks "BIOMERIEUX" with the addition of the letter "L".

The Panel remarks that Section 1.7 of WIPO Overview 3.0, states that, *"in cases where a domain name contains the whole of a trademark, or where at least one dominant feature of the relevant trademark is recognisable in the domain name, the domain name shall normally be considered confusingly similar to that trademark for the purposes of UDRP status"*.

The Panel is of the opinion that the addition of the letter "L" does not prevent a finding of confusing similarity under the first element of paragraph 4(a) of the Policy. It seems to the Panel that the addition of the letter "L" is an intentional misspelling of the Trademarks, with the letters "l" and "I" being similar and adjacent keyboard letters.

This is supported by section 1.9 of WIPO Overview 3.0, which states: *"A domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element.[...] Examples of such typos include (i) adjacent keyboard letters, (ii) substitution of similar-appearing characters (e.g., upper vs lower-case letters or numbers used to look like letters), (iii) the use of different letters that appear similar in different fonts, [...]"*.

The gTLD ".com" may be disregarded when it comes to considering whether a domain name is confusingly similar to a trademark in which the Complainant has rights.

For these reasons, the Panel concludes that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights within the meaning of paragraph 4(a)(i) of the Policy.

2. Rights or legitimate interests

As regards paragraph 4(a)(ii) of the Policy, while the overall burden of proof rests with the Complainant, it is commonly accepted that this should not result in an often-impossible task of proving a negative. Therefore, numerous previous panels have found that the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of proof shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to come forward with such appropriate allegations or evidence, the Complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy. If the Respondent does come forward with some allegations or evidence of relevant rights or legitimate interests, the panel then must weigh all the evidence, with the burden of proof always remaining on the Complainant.

The Complainant argues that:

- The Respondent is not known under the disputed domain name.
- The Respondent does not hold any legitimate rights, such as a trademark or a tradename, in "BIOMERLIEUX". The Respondent notes in that regard that there are no other trademarks that start with "BIOMERLIEUX".
- The disputed domain name is confusingly similar to the Trademarks. The Complainant has not given its consent to use the Trademarks or any similar signs in any way.
- There is no evidence of a fair or non-commercial or bona fide use of the disputed domain name since the disputed domain name resolves to a parking page.
- The Respondent has only registered the disputed domain name because it is similar to the Trademarks. In that regard, the Complainant notes that the Trademarks are distinctive, globally well-known, and exclusively linked to the Complainant. This is for example shown by the fact that a Google search with the terms "BIOMERIEUX" and "BIOMERLIEUX" solely leads to the Complainant.
- The Respondent argues that the disputed domain name impersonates or suggests sponsorship or endorsement by the Complainant.

The Respondent did not file an administratively compliant (or any) response. The Respondent did not provide evidence that it has rights or legitimate interests in the disputed domain name (the Respondent could, inter alia, have provided evidence of the factors mentioned in paragraph 4(c) of the Policy, but failed to do so).

The Panel finds that the Respondent does not have any rights or legitimate interests in the disputed domain name from the following facts:

- There is no evidence at all that the Respondent is or has been commonly known by the disputed domain name or by the term(s) "BIOMERIEUX" or "BIOMERLIEUX".
- There is no evidence that the Respondent has made demonstrable preparations to use the disputed domain name in connection with a bona fide offering of goods or services.
- There is no evidence that the Respondent is making a legitimate non-commercial or fair use of the disputed domain name.
- The Respondent did not show to have any trademark rights or other rights in the term(s) "BIOMERIEUX" or "BIOMERLIEUX".

- The Respondent does not seem to have any consent or authorisation by the Complainant to use the Trademark(s) or variations thereof and does not seem to be related in any way to the Complainant.

In sum, on the balance of probabilities, and in the absence of any evidence to the contrary or any administratively compliant response being put forward by the Respondent, the Panel finds that the Complainant has made a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Panel concludes that the Respondent does not have rights or legitimate interests in the disputed domain name.

3. **Bad faith**

The Complainant argues the following:

- The Respondent had the Trademarks in mind when registering the disputed domain name. The Respondent is located in the United States, where the Complainant holds several registered trademarks. The Trademarks are highly distinctive and exclusively relate to the Complainant. The disputed domain name was registered on July 25, 2024. The first Trademarks of the Complainant exist since the 1980's and have been well-known for decades.
- If the Respondent was not aware of the Trademarks, then the Respondent did not take the necessary precautions to ensure the disputed domain name did not infringe upon third parties' rights. A mere Google search reveals the Complainant's rights.
- The term "BIOMERIEUX" is not a dictionary word and does not have a meaning by itself. The only reason the Complainant chose the disputed domain name was because of the identity of the Complainant.
- The registration of the disputed domain name is a clear-cut case of typosquatting, and therefore in itself bad faith.
- The absence of rights and legitimate interests in relation to the high risk of implied affiliation with the prior rights of the Complainant are also supportive of a finding of bad faith.
- The Respondent has communicated false contact details when registering the disputed domain name. +1 is the phone code for the US, but 173 is not the phone code for the city of Odessa in Florida.
- The Respondent seems to be engaged in a pattern of registering several domain names that infringe third parties' rights. A pattern of abusive domain name registration constitutes an additional bad faith factor.
- There is a finding of bad faith on the ground of the doctrine of passive holding. The Trademarks are intrinsically distinctive and globally well-known. The Trademarks are exclusively related to the Complainant. No third party has rights in this sign. The disputed domain name seems to be a clear-cut case of typo squatting. The TLD .com clearly refers to the Complainant's domain name <biomerieux.com>. The Respondent provided false contact details and is engaged in a pattern of abusive domain name registrations.
- There is a risk of confusion, due to the fact that the presence of the added letter "L" is imperceptible.
- The Respondent has set up MX records on the disputed domain name, creating the risk that the disputed domain name is used to send fraudulent e-mails such as messages containing spam or phishing attempts.
- The Respondent has also configured a SPF (Sender Policy Framework) record with the disputed domain name, which reveals a patent and genuine intent to use the disputed domain name to exchange e-mails and maximize the deliverability of the emails sent from the disputed domain name.

The Panel is convinced that the Respondent has registered and used the disputed domain name to intentionally attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Trademarks.

- The disputed domain name consists of the Trademarks with the mere addition of the letter “L”. As stated above, this seems to be a clear form of typo squatting. The disputed domain name solely adds an adjacent letter to the Trademarks, therefore creating a risk of confusion with the Trademarks and the Complainant.
- The registration of the Complainant’s Trademarks predates the registration of the disputed domain name.
- At least two of the international Trademarks of the Complainant are registered in the United States, i.e. the country where the Respondent is located.
- The Complainant made a case that its Trademarks are well-known in the United States, i.e. the country where the Respondent is located, and the Respondent did not refute this claim. A Google search of the term "BIOMERIEUX" clearly points to the Complainant. The terms “BIOMERIEUX” or “BIOMERLIEUX” have no dictionary meaning. In light of this, it seems highly unlikely that the Respondent would not have been aware of the existence of the Complainant and its Trademarks and of the unlawful character of the disputed domain name at the time of its registration and use. The Panel concludes that the Respondent knew or at the very least should have known of the existence of the Complainant and its Trademarks.
- The Respondent seems to be engaged in a pattern of registering domain names similar to registered trademarks or existing domain names of third parties, with only minimal differences. The Respondent did not refute or contest the arguments of the Complainant in this regard and did not provide any explanation about these other domain name registrations.
- The Complainant has sent a cease-and-desist letter to the Respondent, before filing the Complaint, but the Respondent did not respond to this letter nor took any action.

In the absence of any evidence to the contrary (or any administratively compliant response) being put forward by the Respondent, the Panel believes from the facts in this case that the Respondent had the Trademark(s) of the Complainant in mind when registering and subsequently using the disputed domain name.

From these facts, the Panel concludes that the Respondent had actual knowledge of the Trademarks of the Complainant. The Respondent must have had the Trademark(s) of the Complainant in mind when registering and using the disputed domain name. It appears that the Respondent tried to profit from the name and success of the Complainant with the disputed domain name.

For all the reasons stated above, the Panel concludes that the Complainant did prove that the disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(1)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **biomerlieux.com**: Transferred

PANELLISTS

Name **Bart Van Besien**

DATE OF PANEL DECISION **2024-08-28**

Publish the Decision