



**CANADIAN INTERNATIONAL INTERNET DISPUTE RESOLUTION CENTRE**  
**DOMAIN NAME DISPUTE**  
**ADMINISTRATIVE PANEL**  
**DECISION**

CIIDRC case number:	<b>21377-CDRP</b>	Decision date: October 12, 2023
Domain Name:	<b>biontech.ca</b>	
Panel:	<b>John Rogers</b>	
Complainant:	<b>BioNTech SE</b>	
Complainant's Representative	<b>Stefan Bojovic of MSA IP</b>	
Registrant:	<b>Hany Elraggal / menage total inc (sic)</b>	

## 1. PROCEDURAL HISTORY

The Canadian International Dispute Resolution Centre ("CIIDRC") is a recognized service provider pursuant to the Domain Name Dispute Resolution Policy (the "Policy") and Rules (the "Rules") of the Canadian Internet Registration Authority ("CIRA").

On September 5, 2023, the Complainant filed a complaint (the "Complaint") with CIIDRC. In the Complaint, the Complainant sought an order in accordance with the Policy and the Rules directing that the registration of the domain name <biontech.ca> (the "Domain Name") be transferred to the Complainant.

CIIDRC determined the Complaint to be in administrative compliance with the requirements of Paragraph 3.2 of the Rules and by way of an emailed letter dated September 6, 2023 (the "Transmittal Letter") forwarded a copy of the Complaint to the Registrant at the email address for the Registrant as set out in the WHOIS database to serve as notice of the Complaint to the Registrant in accordance with Paragraphs 2.1 and 4.3 of the Rules. The Transmittal Letter determined the date of the commencement of proceedings in accordance with Paragraph 4.4 of the Rules to be September 6, 2023. The Transmittal Letter advised the Registrant that in accordance with the provisions of Paragraph 5 of the Rules, a response (the "Response") to the Complaint was to be filed within 20 days of the date of commencement of proceedings, or September 26, 2023.

The Registrant has failed to file a Response, and the undersigned by letter from CIIDRC dated October 6, 2023, was selected as the Single Member Panel (the "Panel") to determine this matter. The undersigned has confirmed to CIIDRC that he can act impartially and independently as the Panel in this matter.

The undersigned determines that he has been properly appointed and constituted as the Panel to determine the Complaint in accordance with the Rules.

## 2. FACTS ALLEGED BY THE PARTIES

The facts put forward by the Complainant in the Complaint might be summarized as follows:

1. The Complainant was founded in 2008 and is a next generation biotechnology company 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 for use, inter alia, as individualized cancer immunotherapies and as vaccines against infectious diseases.
2. Together with the US pharmaceutical company Pfizer, and in response to the growing global health crisis, "Project Lightspeed" was commenced, which project developed a successful vaccine in relation to COVID-19, known in the media as BioNTech/Pfizer COVID-19 vaccine. This vaccine has been approved and used in 149 countries throughout the world with over one billion doses of it having been administered.
3. The Complaint includes with the Complaint numerous examples of online and print media recognition of the Complainant and the name "BIONTECH" following the Complainant's announcement of the approvals of the BioNTech/Pfizer COVID-19 trials and its global use.
4. The Complainant is the owner of numerous trademarks around the world for the BIONTECH trademark, including the Canadian Registration No. TMA 1085307 (the "Canadian Trademark"), which trademark was registered on October 19, 2020.
5. In addition, the Complainant is the owner of domain names incorporating the BIONTECH trademark, including <biotech.com>, registered on May 29, 1998, and <biotech.de>, registered on October 10, 2007.
6. The Registrant registered the Domain Name on November 13, 2020, which date was less than a month after the registration of the Canadian Trademark and 4 days after the Complainant globally announced the first positive interim analysis from the global Phase 3 study showing the BioNTech/Pfizer COVID-19 vaccine to be over 90% effective in preventing COVID-19.
7. The Complainant has never assigned, granted, licenced, sold transferred or in any way authorized the Registrant to use the BIONTECH trademark or its trade name.
8. The Complainant became aware of the presence of the Domain Name in December 2022 and when it attempted to access the relevant website, it was redirected to the domain name <menagetotal.com>, which domain name resolved to the website of a company by the name of "Menage Total Commercial and Residential Cleaning Services", a company offering cleaning services in and around the city of Montreal in the Province of Quebec, Canada.
9. In response to a cease and desist letter dated December 21, 2022 sent by email to the email address for the Registrant, the Complainant received the following response:

"Hii I can sell it for 50 000\$  
If not you can do what you can  
I buy it from online and  
Anyone in the world can do that  
Thank you".

10. Following this communication between the Complainant and the Registrant, the Domain Name now redirects to a Rebel.ca parking page.

## **2.2 The Registrant**

The Registrant has not filed a Response.

Paragraph 5.8 of the Rules states that if the Registrant does not submit a Response, the Panel shall decide the proceeding based on the Complaint.

## **3. CONTENTIONS OF THE PARTIES**

### **3.1 The Complainant**

The Complainant submits that the purpose for registering the Domain Name was primarily for the purpose of selling the Domain Name to the Complainant for an amount in excess of the Registrant's actual costs in registering or acquiring the Domain Name.

### **3.2 The Registrant**

As noted above, a Response has not been filed.

### **3.3 The Remedy Sought**

The Complainant seeks an order from the Panel in accordance with Paragraph 4 of the Policy and Paragraph 12 of the Rules that the Domain Name be transferred to the Complainant.

## **4. DISCUSSION AND FINDINGS**

### **4.1 Eligibility**

Paragraph 1.4 of the Policy requires that in order to initiate the Complaint, the Complainant, at the time of the initiation of the Complaint, must satisfy the Canadian Presence Requirements for Registrants v 1.3 ("Canadian Presence Requirements").

Paragraph 2(17) of the Canadian Presence Requirements provides qualification for the owner of a trademark registered in Canada in the Canadian Intellectual Property Office if the complainant is the owner of that trademark and the domain name in issue consists of or includes the exact word component of the trademark.

The Panel finds that the Complainant is the owner of the Canadian Trademark and that the BIONTECH trademark is the exact word component included in the Domain Name.

Therefore, the Panel finds that the Complainant has satisfied the provisions of paragraph 1.4 of the Policy and is entitled to initiate the Complaint.

### **4.2 The Policy**

The purpose of the Policy, as stated in Paragraph 1.1 of the Policy, is to provide a forum in which cases of bad faith registration of .ca domain names can be dealt with relatively inexpensively and quickly.

Paragraph 4.1 of the Policy puts the onus on the Complainant to demonstrate this "bad faith registration" by proving on a balance of probabilities that:

1. The Canadian Trademark qualifies as a "Mark" as defined in Paragraph 3.2 of the Policy,

2. the Complainant had "Rights" in the Canadian Trademark prior to the date of registration of the Domain Name and continues to have "Rights" in the Canadian Trademark,
3. the Domain Name is "Confusingly Similar" to the Canadian Trademark as the concept of "Confusingly Similar" is defined in Paragraph 3.3 of the Policy,
4. The Registrant does not have a "legitimate interest" in the Domain Name as the concept of "legitimate interest" is defined in Paragraph 3.4 of the Policy, and
5. the Registrant has registered the Domain Name in "bad faith" in accordance with the definition of "bad faith" contained in Paragraph 3.5 of the Policy.

If the Complainant is unable to satisfy this onus, bad faith registration is not demonstrated, and the Complaint fails.

#### **4.3 That the Domain Name is Confusingly Similar to a Mark in which the Complainant has Rights**

##### Mark

In the matter at hand, the relevant portions of Paragraph 3.2 of the Policy states that for the purpose of the Policy a "Mark" is:

- (a) trademark, including the word elements of a design mark, or a trade name that has been used in Canada by a person, or the person's predecessor in title, for the purpose of distinguishing the wares, services or business of that person or predecessor or a licensor of that person or predecessor from the wares, services or business of another person;

The evidence before the Panel is that the Canadian Trademark was registered in the Canadian Intellectual Property Office on October 19, 2020 prior to the registration of the Domain Name by the Registrant on November 13, 2020 and that the Canadian Trademark continues to be used in Canada by the Complainant.

The Panel finds that the Complainant has established that the Canadian Trademark qualifies as a "Mark" for the purposes of Paragraph 3.2(a) of the Policy.

##### Rights

Paragraph 3.1 of the Policy requires that the Complainant has "Rights" in the Canadian Trademark. Unfortunately, the term "Rights" is not defined in the Policy.

However, given the evidence before the Panel of the Complainant's ownership and use in Canada of the Canadian Trademark by the Complainant, the Panel finds that the Complainant has "Rights" in the Canadian Trademark for the purpose of Paragraph 3.1 of the Policy.

##### Confusingly Similar

The Policy in Paragraph 3.3 provides that the Domain Name will be found to be "Confusingly Similar" to the Canadian Trademark only if the Domain Name so nearly resembles the Canadian Trademark in appearance, sound or the ideas suggested by the Canadian Trademark as likely to be mistaken for the Canadian Trademark.

As Paragraph 1.2 of the Policy defines the Domain Name for the purpose of this proceeding to exclude the .ca suffix, the portion of the Domain Name consisting of "BIONTECH" is the portion of the Domain Name relevant for consideration.

The test to be applied when considering confusing similarity is one of first impression and imperfect recollection. Will a person as a matter of first impression, knowing only the complainant's corresponding trademark, and having imperfect recollection of this trademark, likely mistake the disputed domain name for the complainant's trademark based upon the appearance, sound or the idea suggested by the trademark?

The Panel finds that the Complainant has met the onus placed upon it by Paragraph 3.3 of the Policy and has demonstrated that the Domain Name so nearly resembles the Canadian Trademark in appearance, sound or the ideas suggested by the Canadian Trademark as to be likely to be mistaken for the Canadian Trademark.

#### **4.4 That the Registrant has No Legitimate Interest in the Domain Name**

Paragraph 4.1 of the Policy requires that to succeed in the Complaint, the Complainant must provide some evidence that the Registrant has no legitimate interest in the Domain Name as the concept of "legitimate interest" is provided for in Paragraph 3.4 of the Policy. Again, the Panel notes that since the Response has not been filed, this issue will be decided based on the Complaint per Paragraph 5.8 of the Rules

Paragraph 3.4 of the Policy provides that the Registrant has a legitimate interest in a domain name if:

- a) the domain name was a Mark, the Registrant used the Mark in good faith and the Registrant had Rights in the Mark;
- b) the Registrant used the domain name in Canada in good faith in association with any wares, services or business and the domain name was clearly descriptive in Canada in the English or French language of:
  - (i) the character or quality of the wares, services or business;
  - (ii) the conditions of, or the persons employed in, production of the wares, performance of the services or operation of the business; or
  - (iii) the place of origin of the wares, services or business;
- c) the Registrant used the domain name in Canada in good faith in association with any wares, services or business and the domain name was understood in Canada to be the generic name thereof in any language;
- d) the Registrant used the domain name in Canada in good faith in association with a non-commercial activity including, without limitation, criticism, review or news reporting;
- e) the domain name comprised the legal name of the Registrant or was a name, surname or other reference by which the Registrant was commonly identified; or
- f) the domain name was the geographical name of the location of the Registrant's non-commercial activity or place of business.

In Paragraph 3.4(d) "use" by the Registrant includes, but is not limited to, use to identify a website.

It is to be noted that with respect to the matter at hand, in Paragraphs 3.4(a), (b), (c), and (d), there is a requirement that the Registrant acts "in good faith". There is no evidence before the Panel that the Registrant used the Domain Name in good faith. Rather, there is a strong suggestion in the evidence before the Panel that the Registrant uses the Domain Name for the purpose of offering the Domain Name for sale to the Complainant.

Therefore, the provisions of these paragraphs do not apply.

The Registrant's name is not included in the Domain Name, nor is there evidence before the Panel that the Registrant had any relationship with the Complainant and the Canadian Trademark to suggest that the Domain Name was a geographical reference to the location of the Registrant's non-

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commercial activity or place of business. Therefore, the provisions of Paragraph 3.4(e) and Paragraph 3.4(f) do not apply.

The Panel finds that the Complainant has provided some evidence that the Registrant has no legitimate interest in the Domain Name.

#### **4.5 That the Registrant has Registered the Domain Name in Bad Faith**

Under Paragraph 3.5 of the Policy, the Registrant will be considered to have registered or acquired the Domain Name in bad faith if, and only if, the Complainant can demonstrate that the Registrant in effecting the registration of the Domain Name was motivated by any one of the four general intentions set out in Paragraph 3.5.

Of these intentions, the form of intention contained in Paragraph 3.5(a) is the one most applicable to the matter at hand.

Paragraph 3.5(a) provides as follows:

- (a) the Registrant registered the domain name, or acquired the Registration, primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant, or the Complainant's licensor or licensee of the Mark, or to a competitor of the Complainant or the licensee or licensor for valuable consideration in excess of the Registrant's actual costs in registering the domain name, or acquiring the Registration;

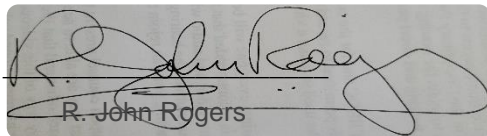
Based upon the evidence before the Panel with respect to both the Registrant's lack of submitting the Response and to the Registrant's response to the Complainant's cease and desist letter of December 21, 2022, the Panel finds that the Complainant has satisfied the provisions of Paragraph 3.5 (a) of the Policy by establishing that that the Registrant registered the Domain Name or acquired the Domain Name primarily for the purpose of selling the same to the Complainant.

#### **5. Decision and Order**

For the above reasons, in accordance with Paragraph 4 of the Policy and Paragraph 12 of the Rules, the Panel orders that the domain name <biontech.ca> be transferred to the Complainant.

Made as of October 12, 2023.

SIGNATURE OF PANEL



R. John Rogers

