



DISPUTE RESOLUTION SERVICE

D00019303

Decision of Independent Expert

Regeneron Pharmaceuticals, Inc.

and

Richard Gere

1. The Parties:

Complainant: Regeneron Pharmaceuticals, Inc.
Address: 777 Old Saw Mill River Road
Tarrytown, NY 10591-6707
New York
United States

Respondent: Richard Gere
Address: 20 Highleys Drive
Leicester
East Midlands
LE2 5TL
United Kingdom

2. The Domain Name:

bioregeneron.co.uk (the "Domain Name")

3. Procedural History:

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

Definitions used in this decision have the same meaning as set out in the Nominet UK Dispute Resolution Service Policy Version 4, October 2016 (the "Policy") unless the context or use indicates otherwise.

4 December 2017	Dispute received
5 December 2017	Complaint validated and notification of complaint sent to the parties
26 December 2017	Response reminder sent
2 January 2018	No response received and notification of no response sent to the parties
12 January 2018	Summary/full fee reminder sent
12 January 2018	Expert decision payment received

4. Factual Background

The Complainant was incorporated on 11 January 1988 and is registered in New York State. It is a biotechnology and pharmaceutical company listed on Nasdaq. It develops and markets medicines for serious diseases.

The Respondent did not reply to the Complaint and so there are no facts before me setting out the Respondent's business or otherwise.

The Respondent registered the Domain Name on 24 April 2017.

5. Parties' Contentions

The Complaint

Complainant's Rights

The Complainant's assertions of rights in the name REGENERON are:

1. The Complainant is a biotechnology company delivering life transforming medicines for serious diseases. It is well-known within its field and regularly collaborates with other well-known companies such as Bayer and Sanofi.
2. The name REGENERON was coined by the Complainant. It is an entirely invented word formed as a combination of the words "regenerating" and "neurons" with the word "gene" in the middle.
3. The Complainant has 5500+ employees worldwide, five FDA approved medicines, 29 years of scientific leadership and in 2017 was voted tenth most innovative company by Forbes. It is a significant presence within the biotechnology field. The Complainant provides evidence and its 2016 Annual Report to verify these claims.
4. The name REGENERON is both the Complainant's company name and a registered trade mark. The Complainant is the proprietor of the following registered United Kingdom and European Union Trade Marks all of which predate the registration of the Domain Name:

- a. EUTM Registration No. 14638225 REGENERON in Class 42;
 - b. EUTM Registration No. 15696644 REGENERON in Class 5;
 - c. EUTM Registration No. 15696669 REGENERON in Class 5;
 - d. UKTM Registration No. 1532963 REGENERON in Class 5;
 - e. UKTM Registration No. 1533019 REGENERON in Class 42;
 - f. UKTM Registration No. 2637891 REGENERON in Classes 5, 42 & 44.
5. The Complainant also owns a global portfolio of trade mark applications and registrations for its REGENERON trade mark, a summary of which are provided with the Complaint.
 6. The Complainant is the proprietor of a number of domain names that include REGENERON including:
 - a. www.regeneron.com (registered on 10 July 1997); and
 - b. www.regeneron.co.uk (registered on 1 March 2016).

The Complainant provides evidence of several other domain names.

7. The Complainant has been trading continuously under its REGENERON trade mark since it was first used in the USA in 1988. Results of a search using the Internet Archive Wayback Machine provided with the Complaint evidences the Complainant's continuous internet presence, under the REGENERON mark, dating back to at least as early as the year 2000.

Abusive Registration

The Complainant's assertions of Abusive Registration are:

1. There is no relationship between the Complainant and the Respondent and the Complainant has not authorised the Respondent to use its trade mark REGENERON. The Domain Name is not currently in use.
2. The Domain Name in the hands of the Respondent is abusive for the following reasons:
 - a. The Domain Name includes in its entirety the Complainant's registered trade mark REGENERON. The inclusion of "bio" in conjunction with this invented word confirms beyond dispute that the Respondent was clearly aware of the Complainant and its business and made a conscious decision to infringe the Complainant's rights in the REGENERON name and trademark.
 - b. The Domain Name will be seen as a reference to the Complainant's commercial field of interest in biotechnology and serves to compound the potential for confusion.

- c. Given that REGENERON is a highly distinctive and invented word, it is difficult to see how its inclusion within the Domain Name can be anything other than abusive.
3. In the hands of the Respondent, there is the potential for the Domain Name to be sold, rented or otherwise transferred either to the Complainant or one of its competitors, for excessive valuable consideration. It furthermore acts as a blocking registration and could be used to unfairly disrupt the Complainant's business. The Domain Name is thus abusive in accordance with Section 5.1.1.1, 5.1.1.2 and 5.1.1.3 of Nominet's Policy.
4. Due to the extensive nature of the Complainant's rights in the name REGENERON, the Domain Name is abusive because it could be used in a way that is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.
5. The Domain Name is abusive in accordance with Section 5.1.3 of Nominet's Policy because the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names corresponding to trademarks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern. A partial reverse WHOIS search on the Respondent reveals 1,177 domain names of which details of the first 500 are freely available. A random selection of these show registrations for domains corresponding with company names, trade mark and/or trading names owned by apparently unrelated parties and in which the Respondent has no apparent rights. For example:
 - a. gparmigianifiglio.co.uk was registered by the Respondent on 12 July 2016. This was the name of an historic Italian delicatessen on Old Compton Street in Soho, London and is also the name of Company No. 237258 incorporated in 1929.
 - b. gaskinproperties.co.uk was registered by the Respondent on 10 August 2016 and corresponds with the name of Company No. 1232043 incorporated on 3 November 1975.
 - c. gangofvirtue.co.uk was registered by the Respondent on 1 July 2016 and corresponds with the name of Company No. 8840422 incorporated on 10 January 2014.
 - d. fricoholdinguk.co.uk was registered by the Respondent on 11 July 2016 and corresponds with the name of Company No. 2334731 incorporated on 12 January 1989. FRICO is a registered trade mark of Swedish company Frico AB who owns EUTMs 8301202 and 375188.
 - e. bluedooradventuresltd.co.uk was registered by the Respondent on 19 June 2016 and corresponds with the name of Company No. 5066721 incorporated on 8 March 2004.
 - f. bobomalleyconstruction.co.uk was registered by the Respondent on 28 June 2016 and corresponds with a previous name of Company No. 1229755 (now Bob O'Malley Holdings Limited). It was incorporated on 14 October 1975.

- g. dawleystatesltd.co.uk was registered by the Respondent on 28 June 2016 and corresponds with the name of Company No. 2886407 incorporated on 11 January 1994.
- h. fowlersblinds.co.uk was registered by the Respondent on 24 April 2017 (the same date as the Domain Name) and corresponds with the name of Company No. 9983956 incorporated on 3 February 2016.
- i. eddiewalewicz.co.uk was registered by the Respondent on 24 April 2017 (the same date as the Domain Name) and corresponds with the name of Company No. 9974936 incorporated on 28 January 2016.
- j. everwellsuffolk.co.uk was registered by the Respondent on 19 July 2016 and corresponds with the name of Company No. 6996802 incorporated on 20 August 2009.
- k. gentiantameside.co.uk and gentiantamesideuk.co.uk were both registered by the Respondent in July 2016 and correspond with the name of Company No. 3266007 incorporated on 21 October 1996.
- l. fanniemae.co.uk was registered by the Respondent on 24 April 2017 (the same date as the Domain Name). FANNIE MAE is a registered trade mark of Federal National Mortgage Association d/b/a Fannie Mae (EUTM 97634 dating from 1996; and UKTMs 1435197 and 2110636 dating from 1990 and 1996). There is also a Fannie Mae Limited, UK Company No. 9976111 incorporated on 28 January 2016.
- m. billyguyatts.co.uk was registered by the Respondent on 24 April 2017 (the same date as the Domain Name). BILLY GUYATTS is the subject of numerous Australian trade mark registrations, including No. 1290380, dating from 2009.
- n. bathhursretravision.co.uk was registered by the Respondent on 24 April 2017 (the same date as the Domain Name). RETRAVISION is an Australian electrical and home appliance store with a store in Bathurst. RETRAVISION is the subject of numerous Australian trade mark registrations, including No. 385633 dating from 1982.
- o. bauerag.co.uk was registered by the Respondent on 24 April 2017 (the same date as the Domain Name). Bauer AG is a well-established Germany company who own a number of trade marks in the name BAUER, including EUTM 810333 dating from 1998.
- p. beauforthousesurveyors.co.uk was registered by the Respondent on 21 June 2016. There is a US company Beaufort Surveying, Inc.
- q. antonyjayproductions.co.uk was registered by the Respondent on 31 July 2016. Sir Antony Rupert Jay was a well-known English writer, broadcaster and director. Antony Jay Productions Limited, No. 2305131, was incorporated on 13 October 1988.
- r. festivalcarehomes.co.uk was registered by the Respondent on 13 July 2016. Festival Care Homes Ltd is the name of Company No. 4685922 registered to Abbey Healthcare.

- s. airwiseuk.co.uk was registered by the Respondent on 19 June 2016. It is an EUTM registered in the name of Fluke Corporation, No. 2877785 dating from 2002.
6. None of the above listed domain names are in use. The Complainant notes that Richard Gere is not listed among the officers of the companies named above and that none has the same address as that listed for the Respondent in the Domain Name registration. The Complainant provides company names, trade mark details and domain name registration dates for several hundred domain names registered in the name of the Respondent.
7. There appears to be an overwhelming pattern of the Respondent registering as a domain, a name which is either the Company Name of an unrelated third party and/or its registered trade mark and/or the name under which it trades from its own website.
8. The Complainant also asserts that the Domain Name is abusive in accordance with section 5.1.4 of Nominet's Policy in that the Respondent has given false contact details. The Respondent's name is in itself suspicious, being the name of a very well-known Hollywood actor.
9. The Complainant attempted to make the Respondent aware of its concerns in a letter sent via Royal Mail Special Delivery dated 1 August 2017. The letter was returned as refused with a name "Mrs P A Wood" written on the front and dated 2 August 2017. Paragraph 3.6 on page 11 of Version 2 of Nominet's DRS – Experts' Overview states that delivery service or post office certification will suffice, in terms of proof required for independent verification that a Respondent has given false contact details.
10. The Complainant wrote again on 20 November 2017 to Mrs P A Wood or "The Occupier" at the Domain Name registered address to clarify whether Richard Gere is resident at that address. Mrs Wood telephoned the Complainant's representatives on 23 November 2017 and then sent an email dated 27 November 2017 (copy provided) to confirm that Richard Gere does not and has never lived at that address. Mrs Wood advised during the telephone call that she had been resident at the address for over 20 years.

The Response

The Respondent did not reply to the Complaint.

6. Discussions and Findings

General

To succeed in this Complaint, the Complainant has to prove to the Expert on the balance of probabilities, pursuant to §2.1 and 2.2 of the Policy, both limbs of the test that:

- 2.1.1 *The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*
- 2.1.2 *The Domain Name, in the hands of the Respondent, is an Abusive Registration.*

Complainant's Rights

Rights is defined in §1 of the Policy as “rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning”.

The wholly generic suffix “.co.uk” may be discounted for the purposes of establishing whether a complainant has Rights in a name or mark which is identical or similar to a domain name.

The Complainant has evidenced extensive registered and unregistered rights in the name REGENERON.

The Domain Name comprises the name REGENERON, which is an invented name, with the term “bio” added as a prefix. The addition of the word “bio” adds a descriptive element to the name REGENERON which reinforces the connection with the Complainant’s business and does not detract in any degree from the similarity of the Domain Name to the name REGENERON.

Accordingly, for the purposes of the first limb of the test in §2.1.1 of the Policy, I find that the Complainant has Rights in the name REGENERON which is similar to the Domain Name.

Abusive Registration

Abusive Registration is defined in §1 of the Policy as a Domain Name which either:

- i. *was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant’s Rights; or*
- ii. *is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant’s Rights.*

A non-exhaustive list of factors which may be evidence that a domain name is an Abusive Registration is set out in §5.1 of the Policy:

5.1.1 *Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:*

5.1.1.1 *for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the*

Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

5.1.1.2 as a blocking registration against a name or mark in which the Complainant has Rights; or

5.1.1.3 for the purpose of unfairly disrupting the business of the Complainant;

5.1.2 Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;

5.1.3 The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well known names or trademarks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;

5.1.4 It is independently verified that the Respondent has given false contact details to us;

5.1.5 The Domain Name was registered as a result of a relationship between the Complainant and the Respondent, and the Complainant:

5.1.5.1 has been using the Domain Name registration exclusively; and

5.1.5.2 paid for the registration and/or renewal of the Domain Name registration;

5.1.6 The Domain Name is an exact match (within the limitations of the character set permissible in domain names) for the name or mark in which the Complainant has Rights, the Complainant's mark has a reputation and the Respondent has no reasonable justification for having registered the Domain Name.

The Complainant has demonstrated in the papers before me that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names that correspond to trademarks (in which the Respondent has no apparent rights) and that the Domain Name, being registered on the same date in at least 4 cases, is part of that pattern.

Furthermore, there is a pattern of registrations of domain names that correspond exactly with, or are very similar to, the names of companies registered in the UK or elsewhere (at least two of which were also registered on the same date as the Domain Name) where the Respondent seemingly has no connection with, or reason for, registering such domain

names. Many of these names are quite specific, such as G Parmigiani Figlio and Gang of Virtue, where it is difficult to conceive that the Respondent had anything other than the company name in mind when registering the Domain Name. Indeed, given the number of registrations, it appears that a great deal of effort has been invested in finding companies whose names are not registered as domain names.

The registration of a company name on its own does not evidence abusive registration. Indeed, the mere registration of a company name does not of itself give rise to Rights for the purposes of the DRS (see §1.7 of the DRS Experts' Overview). However, the Respondent's registration of a large number of such domain names, and the giving of false contact information to Nominet, leads me to conclude that such registrations are part of a wider pattern of deliberate registration of company names and trademarks and it is likely that the establishment of Rights and Abusive Registration would not merely rest upon the company name in question. Furthermore, the registration of the Domain Name is part of that wider pattern.

In light of the foregoing, I also accept on the balance of probabilities the Complainant's assertion that the inclusion of its registered trade mark, being an invented word, and the term "bio" in the Domain Name, that the Respondent was aware of the Complainant and its business when registering the Domain Name. The Respondent has been given the opportunity to respond to these accusations and has either chosen not to do so or has not responded because he has given false contact details to Nominet. The latter is a factor which may evidence Abusive Registration and on the papers before me I am satisfied that it does do so.

The Complainant asserts that in the hands of the Respondent, there is the potential for the Domain Name to be sold, rented or otherwise transferred either to the Complainant or one of its competitors, for excessive valuable consideration. This may be so but such potential use is not on the face of it sufficient to evidence Abusive Registration. Similarly, the Complainant's assertion that the Domain Name acts as a blocking registration and could be used to unfairly disrupt the Complainant's business is not sufficient to evidence Abusive Registration.

I do, however, accept the Complainant's assertion that due to the extensive nature of the Complainant's rights in the name REGENERON, it is difficult to envisage how the Domain Name could be used in a way that would not confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.

Accordingly, I find that the Respondent's registration of the Domain Name has taken unfair advantage of and has been unfairly detrimental to the Complainant's Rights, and is therefore an Abusive Registration.

7. Decision

In light of the foregoing findings, namely that the Complainant has Rights in a name which is similar to the Domain Name, and that the Domain Name, in the hands of the

Respondent, is an Abusive Registration, I direct that the Domain Name be transferred to the Complainant.

Signed

Dated: 6 February 2018

Steve Ormand