

ADMINISTRATIVE PANEL DECISION

Sanofi v. 梁照予 (liang zhao yu)

Case No. D2022-4019

1. The Parties

Complainant is Sanofi, France, represented by Selarl Marchais & Associés, France.

Respondent is 梁照予 (liang zhao yu), China.

2. The Domain Name and Registrar

The disputed domain name <sanofibook.top> is registered with Eranet International Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 27, 2022. On October 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 4, 2022, 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 and contact information in the Complaint. The Center sent an email communication to Complainant on November 4, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on November 8, 2022.

The Center verified that the Complaint together with the amendment to 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 Respondent of the Complaint, and the proceedings commenced on November 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 30, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on December 1, 2022.

The Center appointed Gregory N. Albright as the sole panelist in this matter on December 8, 2022. 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

Complainant is a multinational pharmaceutical company headquartered in Paris, France. Complainant manufactures and markets both prescription and over-the-counter medications. It employs 100,000 people in more than 100 countries, on five continents. In 2021, Complainant had consolidated net sales of about EUR 37.7 billion. It invested EUR 5.9 billion in research and development in 2018.

Complainant holds many trademarks registrations for the SANOFI mark, including in the European Union and the United States of America, and International Registrations with effect around the world, including China where Respondent reportedly resides. These include:

- French trademark Registration No. 1482708, registered on August 11, 1988;
- French trademark Registration No. 96655339, registered on December 11, 1996;
- European Union trademark Registration Nos. 000596023, registered on February 1, 1999, and 004182325, registered on February 9, 2006; and
- French trademark Registration No. 3831592, registered on May 16, 2011.

The SANOFI trademark has also been registered in China under International trademark Registration No. 591490, registered on September 25, 1992.

Complainant itself or through related companies also owns domain names that incorporate the SANOFI mark, including <sanofi.com>, registered in 1995; <sanofi.eu>, registered on March 12, 2006; <sanofi.fr>, registered on October 10, 2006; <sanofi.us>, registered on May 16, 2002; and <sanofi.cn>, registered on April 28, 2004.

The disputed domain name was registered on October 17, 2022, and does not resolve to an active website.

5. Parties' Contentions

A. Complainant

Complainant asserts the disputed domain name incorporates the entire SANOFI trademark, which has no meaning apart from Complainant's mark and is highly distinctive. Complainant is a multinational company that develops, manufactures, distributes and sells a wide variety of pharmaceutical products under the SANOFI trademark and trade name. Complainant has used its trade name for over 40 years and invested substantial financial resources to advertise and promote the company and its products, in connection with the SANOFI trademark, all over the world.

Complainant is the owner of multiple trademark registrations effective around the world, including those described in section 4 above. Complainant also owns many domain names that incorporate the SANOFI mark. Each of those trademark registrations and domain names was registered by Complainant before Respondent registered the disputed domain name on October 17, 2022. Respondent was not free to ignore Complainant's trademarks and domain names, which are present worldwide and notably in China, when registering the disputed domain name.

The disputed domain name incorporates the entire SANOFI trademark as the dominant feature of the disputed domain name, combined with a descriptive term “book” and the new top level domain name “.top”. It is well established that the Top-Level Domain name should be disregarded in the similarity analysis. And where a disputed domain name incorporates a distinctive trademark in its entirety, it is confusingly similar to that mark despite the addition of a common word. Here, “book” is a common English word that refers to a form of compilation of Complainant’s activities and is insufficient to avoid confusing similarity. To the contrary, the addition of “book” to the SANOFI trademark in the disputed domain name will suggest to Internet users that the disputed domain name is related to Complainant’s activities.

Confusing similarity is also informed by reference to the reputation of Complainant’s trade name, trademarks, domain names and good will in the marketplace. Many prior panel decisions have found that Complainant’s SANOFI trademark is “well-known” in many jurisdictions.

Complainant also asserts Respondent does not have any rights or legitimate interests in respect of the disputed domain name. First, Respondent’s name has no resemblance to the SANOFI trademark. Second, Complainant has never licensed or otherwise authorized Respondent to use Complainant’s trademark or to register any domain name that incorporates Complainant’s trademark. Third, Respondent’s use of a privacy service – registering as “REDACTED FOR PRIVACY” – is an effort to shield Respondent’s true identity, and undermines any claim of legitimate interests in respect of the disputed domain name. Finally, Respondent is not making any legitimate noncommercial or fair use of the disputed domain name, or making a *bona fide* offering of goods or services; and the disputed domain name instead resolves to an inactive webpage.

Complainant also asserts Respondent registered the disputed domain name in bad faith because Respondent is likely to have had constructive notice if not actual notice of the existence of the famous and distinctive SANOFI mark before Respondent registered the disputed domain name. Use of a privacy service to conceal Respondent’s identity is further evidence of bad faith registration. Complainant contends the disputed domain name was obviously registered for the purpose of creating a likelihood of confusion, or at least the false impression of an association, between the SANOFI trademark and the disputed domain name.

The disputed domain name is also being used in bad faith, Complainant asserts. It is well established that passive holding may constitute bad faith use of a disputed domain name. Further, Respondent’s non-use of a disputed domain name may create a false impression among Internet users that Complainant is not active on the Internet or, worse, is out of business, thus causing harm to Complainant’s reputation and goodwill.

B. Respondent

Respondent did not reply to Complainant’s contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy requires Complainant to prove: (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; (ii) Respondent has no rights or legitimate interests in respect of the disputed domain name; and (iii) the disputed domain name has been registered and is being used in bad faith.

Paragraph 4(b) of the Policy elaborates some circumstances that shall be evidence of the registration and use of the disputed domain name in bad faith. Paragraph 4(c) sets out various circumstances which, if found by the Panel to be proved based on the evaluation of all the evidence presented, shall demonstrate that Respondent has rights or legitimate interests in the disputed domain name.

A. Identical or Confusingly Similar

Complainant has rights in the SANOFI trademark, for which it owns many registrations around the world.

The disputed domain name incorporates the entire SANOFI trademark. The addition of “book” to Complainant’s trademark in the disputed domain name does not, in the Panel’s view, dispel confusing similarity between the mark and the disputed domain name. A prior panel has reached the same conclusion regarding the very same issue. See *Sanofi v. wingsknow* (上海天链知识文化传播有限公司), WIPO Case No. [D2020-0642](#) (“The mark, which is fanciful and inherently distinctive and has no other generic or dictionary meaning, is fully incorporated into the Domain Name at the second level, and the addition of the term ‘book’ after the mark does nothing to prevent a finding of confusing similarity.”). The Panel therefore finds that the disputed domain name is confusingly similar to the SANOFI trademark.

The first element of paragraph 4(a) of the Policy is satisfied.

B. Rights or Legitimate Interests

“While 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 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.” WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 2.1.

Here, Complainant has made a *prima facie* case that Respondent does not have any rights or legitimate interests in respect of the disputed domain name. Complainant asserts that it has not given Respondent permission to use the SANOFI trademark in any manner, including in domain names. Nor is there any evidence that “sanofi” is Respondent’s personal name, or that Respondent is known by, or has acquired any trademark rights in the disputed domain name.

Moreover, the nature of the disputed domain name carries a risk of implied affiliation. See section 2.5.1 of [WIPO Overview 3.0](#) (“Even where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner”). Complainant asserts that the addition of “book” to the SANOFI trademark in the disputed domain name suggests that Respondent’s website compiles information about Complainant or its products. Respondent has not responded to the Complaint to dispute this point, or to otherwise assert any rights or legitimate interests in respect of the disputed domain name.

The second element of paragraph 4(a) of the Policy is satisfied.

C. Registered and Used in Bad Faith

The Panel finds sufficient evidence that Respondent registered the disputed domain name in bad faith. It may be inferred that Respondent registered the disputed domain name with knowledge of Complainant’s trademark because: (1) Complainant has numerous registrations for the SANOFI trademark, including in China where Respondent resides; (2) Complainant has many domain names of its own that incorporate the SANOFI trademark; (3) Complainant obtained registrations of its trademark and domain names long before Respondent registered the disputed domain name in October 2022; and (4) the disputed domain name incorporates the entire SANOFI trademark. Knowing adoption of the disputed domain name, with apparent intent to create confusion with Complainant’s trademark, is not good faith.

The Panel also finds that non-use of the disputed domain name does not prevent a finding of bad faith. Respondent is not using the website to which the disputed domain name resolves for any legitimate business purpose; the website to which the disputed domain name resolves is inactive. Complainant asserts that bad faith may be found under the “passive holding doctrine”. “While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.” [WIPO Overview 3.0](#), section 3.3.

Here, Complainant has shown that its registered mark is inherently distinctive, widely known and has long been used in commerce. Respondent did not submit any response to the Complaint in this case. And it is implausible that Respondent might put the disputed domain name to any good faith use. Respondent’s passive holding of the disputed domain name does not prevent a finding of bad faith use.

The third element of paragraph 4(a) of the Policy is satisfied.

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 <sanofibook.top> be transferred to Complainant.

/Gregory N. Albright/

Gregory N. Albright

Sole Panelist

Date: December 20, 2022