

ADMINISTRATIVE PANEL DECISION

Sanofi, Winthrop Products Inc. v. Jayesh Patel
Case No. D2023-1488

1. The Parties

The Complainants are Sanofi, France, and Winthrop Products Inc., United States of America, represented by Selarl Marchais & Associés, France.

The Respondent is Jayesh Patel, India.

2. The Domain Name and Registrar

The disputed domain name <plaquenilkart.com> is registered with Wix.com Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 5, 2023. On April 5, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 10, 2023, 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 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 3, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 4, 2023.

The Center appointed Delia-Mihaela Belciu as the sole panelist in this matter on May 19, 2023. 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 Sanofi is a French multinational pharmaceutical company headquartered in Paris, France, being one of the world's largest multinational pharmaceutical companies by prescription sales, with a presence in more than 100 countries and industrial sites in more than 40 countries (Annex 6 to the Complaint).

The Complainant Winthrop Products Inc. is a Sanofi company, dedicated to delivering authorized generics equal to the Sanofi brand products.

Plaquenil is a medicinal product with hydroxychloroquine used for the treatment of different diseases, developed, manufactured, distributed and sold by the Sanofi group.

The Complainant Sanofi owns the following trademarks:

- French trademark for PLAQUENIL No. 3043298, filed and registered on July 26, 2000, for goods in class 5;
- European Union Trade Mark for PLAQUENIL No. 000041962, filed on April 1, 1996 and registered on November 27, 1998, for goods and services in class 5;
- Chinese trademark PLAQUENIL No. 3973694, filed on March 23, 2004 and registered on September 21, 2006, for goods in class 5.

The Complainant Winthrop Products Inc. owns the following trademark:

- Indian trademark PLAQUENIL No. 452271, filed and registered on April 8, 1986, for goods in class 5.

The Complainant Sanofi is also the owner of the following domain names:

- <plaquenil.com> registered on October 28, 1998;
- <plaquenil.org> registered on March 19, 2020.

The disputed domain name was registered on February 20, 2021, and it resolves to an active website where pharmaceutical products are offered at discounted prices.

5. Parties' Contentions

A. Complainant

The Complainants contend that the disputed domain name is confusingly similar to their PLAQUENIL trademark.

To this end, the Complainants underline that the disputed domain name reproduces their PLAQUENIL trademark which correspond to one of the pharmaceutical products developed, manufactured, distributed and sold by the Complainant Sanofi.

In the Complainants' view, Plaquenil, which is an exact reproduction of the Complainants' trademark, is the dominant and distinctive part of the disputed domain name and the addition of the misspelled descriptive word "kart" (misspelling of "cart") and of the generic Top-Level Domain ("gTLD") ".com" does not affect the confusing similarity of the disputed domain name with the Complainants' prior PLAQUENIL trademarks.

For these reasons, the Complainants conclude that the disputed domain names is confusingly similar to the Complainants' prior PLAQUENIL trademarks.

The Complainants further contend that the Respondent does not have any rights or legitimate interests in the disputed domain name for a number of reasons.

First, the Complainants assert that the name "Jayesh Patel" (the Respondent's name) does not bear any resemblance with the word "Plaquenil" which has no meaning and is thus highly distinctive.

In the Complainants' view, the Respondent has neither prior right nor legitimate interest to justify the use of the already well-known and worldwide trademarks and domain names of the Complainants.

Secondly, the Complainants contend that they have never licensed or otherwise authorized the Respondent to use their trademarks or to register any domain name including the PLAQUENIL trademarks.

The Complainants further assert that there is no relationship between them and the Respondent and that the Respondent has used the Complainants' trademarks for its own use and incorporated them into the disputed domain name without the Complainants' authorisation.

Thirdly, the Complainants contend that the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services, so as to confer a right or legitimate interest in it in accordance with paragraph 4(c)(i) of the Policy given that the website corresponding to the disputed domain name is used as a bait and switch.

In the Complainants' view, the disputed domain name was registered only for the purpose of unfairly attracting the Complainants' consumers.

The Complainants' further contend that the disputed domain name was registered for the sole purpose of misleadingly diverting consumers into thinking that the Respondent is, in some way or another, linked, connected to, sponsored by or affiliated with the Complainants and their business or that the Respondent's activities are approved or endorsed by the Complainants.

The Complainants allege that the disputed domain name leads to an online commercial website selling presumably fake Plaquenil goods and other medicines at a discounted price.

For these reasons, the Complainants consider that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Complainants further contend that the disputed domain name was registered and is being used in bad faith.

To this end, the Complainants argue that the disputed domain name was registered and is used in bad faith as such appears confusingly similar to the Complainants well-known trademarks.

The Complainants further argue that the disputed domain name was registered in bad faith as the name "Jayesh Patel" does not bear any resemblance with the word "Plaquenil" which has no meaning and is therefore highly distinctive.

The Complainants also contend that the Respondent has no prior rights or legitimate interest to justify the use of the well-known and worldwide trademarks and domain names of the Complainants.

In the Complainants' view, given the famous and distinctive nature of the mark "Plaquenil", the Respondent is likely to have had, at least, constructive, if not actual notice, as to the existence of the Complainants' marks at the time he registered the disputed domain name. The Complainants further allege that this

suggests that the Respondent acted with opportunistic bad faith in registering the disputed domain name in order to make an illegitimate use of it.

The Complainants further contend that the disputed domain name has been registered for the purpose of attracting Internet users to the Respondent's website by creating a likelihood of confusion – or at least an impression of association – between PLAQUENIL trademarks and the disputed domain name.

The Complainants underline that they are the owners of PLAQUENIL trademarks which are worldwide well-known and that the disputed domain name reproduce the distinctive term Plaquenil and that the disputed domain name was registered in bad faith by the Respondent for the primary purpose of gaining unfair benefit of the Complainants' reputation.

The Complainants also argue that since the disputed domain name directs Internet users to a website which is not the official website of the Complainants' goods, it is evident that the circumstances indicate that the Respondent has registered the disputed domain name primarily for the purpose of trying to gain unfair benefit of Sanofi's goodwill and reputation by using the disputed domain name, which suggests an effort to create a likelihood of confusion with the Complainant's trademarks and domain names as to the source, sponsorship, affiliation, or endorsement of the Respondent's website and the products displayed/advertised for sale on it.

In the Complainants' view, the Respondent has clearly registered and used the disputed domain name for the purpose of disrupting the Complainant's business, by offering presumably fake pharmaceutical goods to sale, which constitutes further evidence of its bad faith.

For all these reasons, the Complainants consider that the disputed domain name was registered and is being used in bad faith.

B. Respondent

The Respondent did not reply to the Complainants contentions.

6. Discussion and Findings

In order for the Complainants to succeed, they must prove, according to paragraph 4(a) of the Policy, that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainants have rights; and
- (ii) the Respondent has no rights or legitimate interests with respect to the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

In case all three elements above have been fulfilled, the Panel is able to grant the remedy requested by the Complainants. Thus, the Panel will deal with each of the requirements in turn.

A. Identical or Confusingly Similar

According to paragraph 4(a)(i) of the Policy, the Complainants have to show that the disputed domain name is (i) identical or confusingly similar to a trademark or service mark, (ii) in which the Complainants have rights.

With respect to the requirement of having rights pursuant to paragraph 4(a)(i) of the Policy, the Complainants

own several PLAQUENIL registered trademarks, in several jurisdictions. Consequently, the Panel finds that this requirement is fulfilled.

With regard to the assessment of identity or confusing similarity of the disputed domain name with the PLAQUENIL trademarks, it is generally accepted that this involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. In cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”)).

The Panel finds that the disputed domain name is confusingly similar to the PLAQUENIL trademarks as it incorporates the PLAQUENIL mark in its entirety and the addition of the word “kart” (which could be a misspelling of the English word “cart”) does not avoid a finding of confusing similarity. The PLAQUENIL mark remains clearly recognizable within the disputed domain name (see section 1.8 of the [WIPO Overview 3.0](#)).

Previous UDRP panels have held that such additions do not avoid confusing similarity (see *Inter-IKEA Systems B. V. v. Evezon Co. Ltd.*, WIPO Case No. [D2000-0437](#); *The British Broadcasting Corporation v. Jaime Renteria*, WIPO Case No. [D2000-0050](#); *Volvo Trademark Holding AB v. SC-RAD Inc.*, WIPO Case No. [D2003-0601](#)).

In what concerns the addition of the generic Top-Level Domain “.com”, this is not to be taken into consideration when examining the confusing similarity between the Complainants’ trademarks and the disputed domain name, as such is viewed as a standard registration requirement and is disregarded under the first element confusing similarity test (see section 1.11 of the [WIPO Overview 3.0](#)).

The Panel therefore finds that the Complainants have satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainants are required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. Once such *prima facie* case is made out, the burden of production 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 (see section 2.1 of the [WIPO Overview 3.0](#)).

In this case, the Complainants have put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, which has not been rebutted by the Respondent, as the Respondent has not submitted any response.

Thus, based on the available evidence in the file, the Respondent does not appear to be commonly known by the disputed domain name. The Complainants have never licensed or permitted the Respondent to use its PLAQUENIL marks or any domain names incorporating the PLAQUENIL marks, and also, between the Respondent and the Complainants there is no relationship, based on the evidence available in this file.

Moreover, based on the evidence filed by the Complainants, the disputed domain name resolves to a website where pharmaceutical products are offered at discounted prices, among which, also Plaquenil, without any authorisation from the Complainants.

Furthermore, the disputed domain name comprises the Complainants’ PLAQUENIL mark in its entirety

together with the addition of the word “kart” (which could be a misspelling of the English descriptive word “cart”), which might lead to confusion amongst Internet users and the Complainants’ customers.

The above does not amount to a *bona fide* offering of goods or services, or to a legitimate noncommercial or fair use of the disputed domain name.

The Panel therefore finds that the Complainants have satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under paragraph 4(a)(iii) of the Policy, a complainant must show that the domain name has been registered and is being used in bad faith.

In this case, the Complainants’ rights to the PLAQUENIL trademarks predate the registration date of the disputed domain name.

The PLAQUENIL trademark is registered in several jurisdictions, including in India, being a trademark that enjoys of a high distinctive character, considering also that, the term Plaquenil does not have any meaning as such in English.

In light of the above, the Panel agrees with the Complainants that it is not conceivable that the Respondent chose the disputed domain name without knowledge of the Complainants’ PLAQUENIL mark, which supports a finding of bad faith registration (see sections 3.2.2 of the [WIPO Overview 3.0](#)).

The Respondent’s incorporation into the disputed domain name of the Complainants’ highly distinctive PLAQUENIL mark in its entirety, with the addition of the word “kart” (which could be a misspelling of the English word “cart”), the failure of the Respondent to submit a response in this file, as well the fact that the website corresponding to the disputed domain name redirects Internet users to a website where pharmaceutical products are offered at discounted prices, among which, also Plaquenil, without any authorisation from the Complainants, is clear evidence of bad faith use and registration of a domain name, lead to a finding of bad faith registration and use. The Panel finds that by using the disputed domain name, the Respondent has intentionally attempted to attract Internet users to his website by creating a likelihood of confusion with the Complainant’s PLAQUENIL mark as to the source, sponsorship, affiliation, or endorsement of the website.

For all these reasons, the Panel finds that the disputed domain name has been registered and is being used in bad faith and that the third element of paragraph 4(a)(iii) of the Policy is fulfilled.

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, <plaquenilkart.com>, be transferred to the Complainants.

/Delia-Mihaela Belciu/

Delia-Mihaela Belciu

Sole Panelist

Date: June 2, 2023