

ADMINISTRATIVE PANEL DECISION

Sanofi v. Wo Off

Case No. D2024-0761

1. The Parties

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

The Respondent is Wo Off, United States of America ("United States").

2. The Domain Name and Registrar

The disputed domain name <ambiennox.com> is registered with NameSilo, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on February 19, 2024. On February 20, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 20, 2024, 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 (REDACTED FOR PRIVACY, PrivacyGuardian.org llc) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 21, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on the same day.

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 the Respondent of the Complaint, and the proceedings commenced on February 23, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 14, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 15, 2024.

The Center appointed Meera Chature Sankhari as the sole panelist in this matter on March 25, 2024. 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), ranking 4th world's largest multinational pharmaceutical company by prescription sales. The Complainant engages in research, development, manufacturing and marketing of pharmaceutical products for sale, principally in the prescription market, but the firm also develops over-the-counter medication. Historically, the Complainant's company was formed as Sanofi-Aventis in 2004 by the merger of Aventis and Sanofi-Synthelabo, and changed its name to Sanofi in May 2011.

The Complainant has a leading position in seven major therapeutic areas, namely cardiovascular, thrombosis, metabolic disorders, oncology, central nervous system, internal medicine and vaccines. The Complainant's efforts were recognized by including it in the annual "L2 Digital IQ Index: Pharmabrand & Healthcare Providers" worldwide brand survey issued April 18, 2011 in which it appeared in the "Flash of Genius" in reference to its promoting patient resources. The Complainant is a full member of the European Federation of Pharmaceutical Industries and Associations (EFPIA).

The Complainant had a consolidated net sales of EUR 37,7 billion in 2021, EUR 36.04 billion in 2020, EUR 34.46 billion in 2018, EUR 35.05 billion in 2017, EUR 33.82 billion in 2016, EUR 34.06 billion in 2015 and EUR 31.38 billion in 2014. The Complainant is a multinational company settled in more than 100 countries on all five continents employing 100,000 people and offers a wide range of patented prescription drugs to treat patients with serious diseases.

The Complainant developed and sells, throughout the world, a drug with demonstrated utilities for the treatment of insomnia under the trademark AMBIEN.

The Complainant is the owner of the trademark AMBIEN, inter alia, in the following jurisdictions:

Trademark	Class	Registration no.	Country	Registered since
AMBIEN	5	003991999	European Union	November 28, 2005
AMBIEN	5	74345754	United States	December 7, 1993
AMBIEN CR	5	78317645	United States	August 7, 2007
	5	78360253	United States	July 17, 2007

The Complainant is the owner of several domain names, with "ambien" in them. Details of such registrations are mentioned below:

S.No.	Domain Name	Date of Registration
1	<ambien.info>	August 24, 2001
2	<ambien.com>	April 12, 2000
3	<ambien.net>	April 12, 2000
4	<ambien.org>	April 12, 2000

The disputed domain name <ambiennorx.com> was registered by the Respondent on December 12, 2023. The disputed domain name is active and sells, inter alia, "ambien" drugs, which according to the Complainant are fake.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for the transfer of the disputed domain name.

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's trademark as it includes the Complainant's trademark AMBIEN in adjunction by the term "norx", which is an abbreviation for "no prescription" and hence is descriptive in nature. The Complainant contends that by creating this disputed domain name, the Respondent is creating confusion as the users may believe that this disputed domain name refers to the Complainant and that the disputed domain name is related to the Complainant.

The Complainant further contends that the Respondent does not have any rights or legitimate interests in using the disputed domain name since the name "REDACTED FOR PRIVACY" does not bear any resemblance with the word "ambien" which has no meaning and is therefore highly distinctive. The Complainant asserts that it has neither licensed nor otherwise authorized the Respondent to use its trademark or to register any domain name including the trademark AMBIEN.

The Complainant argues that the Respondent does not own any trademark corresponding to the disputed domain name and that the disputed domain name resolves to a website that is an online platform from which consumers can purchase medications. As such, a tab allows users to specifically obtain counterfeit "ambien" drugs and the web page or the packaging of the AMBIEN tabs never cites the name of actual pharmaceutical manufacturer of genuine AMBIEN drugs i.e, the Complainant. The Complainant alleges that the products sold on the said website are counterfeit which are sold without any medical prescription whereas the genuine AMBIEN drugs manufactured by the Complainant may only be sold with medical prescription. The Complainant further contests that the Respondent has registered the disputed domain name only for the purpose of unfairly attracting Complainant's consumers and for misleadingly diverting consumers probably suffering from insomnia into thinking that the Respondent is, in some way, connected to, sponsored by or affiliated with the Complainant and its business. The Complainant asserts that the Respondent's activities are detrimental and harming the Complainant's brand reputation.

On the third element, the Complainant submits that given the famous and distinctive nature of the mark AMBIEN, the Respondent is likely to have had, at least, constructive, if not actual notice, as to the existence of Complainant's marks while registering the disputed domain name. The Complainant argues that the Respondent acted with opportunistic bad faith in having registered the disputed domain name in order to make illegitimate use of it.

The Complainant further asserts that the disputed domain name was registered for the purpose of attracting Internet users to its website by creating a likelihood of confusion between AMBIEN trademarks and the Complainant's official domain names, constantly used in combination with the mother brand SANOFI, and the disputed domain name. The Complainant claims that it is inconceivable that the Respondent registered the disputed domain name unaware of the Complainant's rights and reputation, making benefit of the Complainant's trademarks' reputation. The Complainant asserts that the Respondent must have been aware of the risk of deception and confusion that would inevitably arise from the registration of the disputed domain name. The Complainant states further that this could lead Internet users searching for official AMBIEN websites to the disputed domain name, which knowledge characterizes the Respondent's bad faith.

Further, the Complainant claims that the disputed domain name directs Internet users to a website, which is not the official website of Complainant's products, which indicates that the Respondent has registered the disputed domain name to try and gain unfair benefit of the Complainant's goodwill and reputation, which could further cause likelihood of confusion, including, as to the source, sponsorship, affiliation, or endorsement of the Respondent's website and the products displayed/advertised for sale on it

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of the term "norx" may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8. Thus, the Complainant's distinctive trademark AMBIEN is readily recognizable within the disputed domain name and, the addition of the word "norx" is insufficient to avert a finding of confusing similarity.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although 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 difficult 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 (although the burden of proof always remains on the Complainant). If the Respondent fails to come forward with such relevant evidence, the Complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Panels have held that the use of a domain name for illegal activity, such as sale of counterfeit goods or illegal pharmaceuticals, phishing, impersonation can never confer rights or legitimate interests on a Respondent. [WIPO Overview 3.0](#), section 2.13.1. As indicated above, there is a high probability of illegal pharmaceuticals being sold through the website under the disputed domain name.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent's registration and use of the disputed domain name demonstrate bad faith, a claim which the Respondent failed to contest. The usage of the Complainant's registered trademark indicates that the Respondent was aware of the Complainant's trademark rights at the time of registering the disputed domain name. By using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's well-known mark AMBIEN. [WIPO Overview 3.0](#), section 3.1.4.

The Respondent's registration and use of the disputed domain name are evidently aimed at disrupting the Complainant's business. They are selling counterfeit products, which are typically only available via prescription, indicating a deliberate attempt to interfere with the Complainant's business.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a Respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1. The Respondent's website that is operational under the disputed domain name is an online platform from which consumers can purchase medications. As such, a tab allows users to specifically purchase "ambien" drugs. Indeed, neither the web page nor the packaging of the AMBIEN tabs cites the name of the pharmaceutical manufacturer, which clearly indicates that the Respondent was targeting the Complainant and certainly had knowledge of the Complainant's trademark and the reputation related to it.

Panels have held that the use of a domain name for illegal activity such as sale of counterfeit goods or illegal pharmaceuticals, phishing, impersonation constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

The Panel finds that the Complainant has established the third element of the Policy.

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 <ambiennorx.com> be cancelled.

/Meera Chature Sankhari/

Meera Chature Sankhari

Sole Panelist

Date: April 9, 2024