

ADMINISTRATIVE PANEL DECISION

Sanofi v. Whois Privacy Protection Service by onamae.com / xiansheng chen,
chenxiansheng
Case No. D2022-1761

1. The Parties

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

The Respondent is Whois Privacy Protection Service by onamae.com, Japan / xiansheng chen,
chenxiansheng, Singapore.

2. The Domain Name and Registrar

The disputed domain name <sanoficareers.com> is registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on May 16, 2022. On May 16, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 17, 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 the Complainant on May 24, 2022 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 in English on May 24, 2022.

On May 24, 2022, the Center transmitted an email communication to the Parties in English and Japanese regarding the language of the proceeding. On May 27, 2022, the Complainant submitted a request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 in English and Japanese of the Complaint, and the proceedings commenced on May 30, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 19, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 20, 2022.

The Center appointed Teruo Kato as the sole panelist in this matter on July 6, 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

According to the Complainant, the Complainant is a French multinational pharmaceutical company headquartered in Paris, France, ranking 4th world's largest multinational pharmaceutical company by prescription sales, and it engages in research and development, manufacturing and marketing of pharmaceutical products for sale, principally in the prescription market, but it also develops over-the-counter medication.

The Complainant owns, among others, the International Trademark SANOFI No. 1092811, registered on August 11, 2011, covering goods and services in classes 1, 9, 10, 16, 38, 41, 42 and 44, with multiple designations including Japan and Singapore (in which the Respondent is said to reside).

The disputed domain name was registered on March 4, 2022.

The Respondent is Whois Privacy Protection Service by onamae.com, Japan / xiansheng chen, chenxiansheng, Singapore.

According to the Complainant, the Respondent is not using the disputed domain name in connection with an active website.

The Complainant requests that the disputed domain name be transferred to the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant contends that it is the owner of the SANOFI trademark.

The Complainant also contends that the disputed domain name is confusingly similar to the Complainant's SANOFI trademark.

The Complainant further contends that the Respondent is not a licensee, an authorized agent of the Complainant, or in any other way authorized to use the Complainant's trademark SANOFI, and that the Respondent is not commonly known by the disputed domain name as an individual, business, or other organization, and that the Respondent does not make any *bona fide* use or trade under the disputed domain name.

The Complainant also contends that the Respondent has registered and is using the disputed domain name in bad faith.

B. Respondent

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

6. Discussion and Findings

6.1 Preliminary Issue: Language of the Proceeding

Pursuant to paragraph 11(a) of the Rules, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to authority of the Panel to determine otherwise having regard to the circumstances of the administrative proceeding. The Panel notes that in the present case the Registrar has confirmed that the language of the Registration Agreement is Japanese.

The Complainant has filed the Complaint in English and requests that the language of the proceeding be English and contends, among others, that the Respondent is said to be located in Singapore in which English is one of the four official languages and that, if Japanese were chosen, “the administrative proceeding would be unduly delayed and the Complainant would have to incur substantial expenses for translation”.

On May 24, 2022, the Respondent was invited by the Center, in both Japanese and English, to indicate any objection to the proceeding being conducted in English by May 29, 2022. The Respondent did not respond to this by this deadline nor later.

On May 30, 2022, the Center informed the Respondent, in both Japanese and English, that the Center has decided, under the circumstances of this case, to: “1) accept the Complaint as filed in English; 2) accept a Response in either English or Japanese; 3) appoint a Panel familiar with both languages mentioned above, if available.” Accordingly, the Panel would have accepted a response in Japanese, but no reply was submitted by the Respondent.

The Panel notes that the disputed domain name includes a term “careers”, which is an English word and that English is widely spoken in Singapore where the Respondent is said to reside (also noting that Japanese is not a common language in Singapore).

In the circumstances, in accordance with paragraph 11(a) of the Rules, the Panel decides that English be the language of the proceeding. The Panel further finds that such determination would not cause any prejudice to either Party and would ensure that the proceeding takes place with due expedition.

6.2 Substantive Issues

A. Identical or Confusingly Similar

The Panel must determine whether (a) the Complainant has a trademark or service mark; and (b) whether the disputed domain name is identical or confusingly similar to that trademark or service mark.

The Complainant submitted evidences of trademark registrations and the Panel is satisfied that the Complainant is the owner of, among others, International Trademark SANOFI No. 1092811, registered on August 11, 2011, covering goods and services in classes 1, 9, 10, 16, 38, 41, 42 and 44, with multiple designations including Japan and Singapore (in which the Respondent is said to reside).

As to the confusingly similar element for the purposes of the Policy, the Panel has proceeded to compare the disputed domain name to the trademark rights which have been proved.

Section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) states that “[t]he applicable Top Level Domain (‘TLD’) in a domain name (e.g., ‘info’, ‘.com’, ‘.club’) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test”, and the Panel finds no reason why this established practice should not be applied to the present case.

Apart from the generic Top-Level Domain (being “.com”), the Complainant contends that the disputed domain name contains its trademark SANOFI in its entirety. The Panel notes that a term “careers” is added immediately after SANOFI.

In this connection, the Panel notes section 1.7 of the [WIPO Overview 3.0](#) which states that “[w]hile each case is judged on its own merits, 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.”

The Panel also notes that, in relation to the addition of the term “careers”, section 1.8 of the [WIPO Overview 3.0](#) states that “[w]here the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.”

In the circumstances, the Panel sees no reason why these established practices should not be applied to the present case and holds that the disputed domain name is confusingly similar to the Complainant’s trademarks. Accordingly, the Panel finds that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, any of the following circumstances, if found by the Panel, may demonstrate a respondent’s rights or legitimate interests in a domain name:

(i) before any notice to it of the dispute, the respondent’s use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

(iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The consensus view of UDRP panels is that the burden of proof in establishing no rights or legitimate interests in respect of a domain name rests with the complainant in making out a *prima facie* case that the respondent lacks rights or legitimate interests. Once such *prima facie* case is made, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (see section 2.1 of the [WIPO Overview 3.0](#)).

In the present case, the disputed domain name does not resolve to an active website, and the Complainant contends with relevant evidence that: (i) the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services; (ii) the Respondent has not been commonly known by the disputed domain name; and (iii) the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name.

The Panel is satisfied that the Complainant has established a *prima facie* case. By not submitting a response, the Respondent has failed to overturn such *prima facie* case and has also failed to invoke any of the defenses as set out in paragraph 4(c) of the Policy.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. Registered and Used in Bad Faith

To fulfill the third requirement, the Complainant must prove that the disputed domain name was registered and is being used in bad faith.

In the present case, the Panel is satisfied with the Complainant's contention that the word SANOFI is not a dictionary word and has no particular meaning. The Panel also notes that the registration of the SANOFI trademark took place many years ago and it had established its reputes internationally long before.

In the circumstances, the Panel holds that the Respondent was most likely to have known of the Complainant, its products, and trademarks prior to registering the disputed domain name on March 4, 2022. (See section 3.2.2 of the [WIPO Overview 3.0](#).)

Further, in connection with the additional term "careers", the Panel notes that the main home page of the Complainant contains a section entitled "Careers", which resolves to a page containing statements such as "Build Your Career with Sanofi", "You'll be surprised what you can achieve at Sanofi," and "Discover your future here."

This suggests the Panel a possibility that the Respondent's registration of the disputed domain name may have been an attempt or desire to give an impression that the disputed domain name (including email addresses generated from the disputed domain name, if any) was officially representing or associated with the Complainant, which the Complainant denies categorically.

In the circumstances, the Panel holds that the Respondent registered the disputed domain name in bad faith.

As to the use in bad faith, the Complainant acknowledges that the disputed domain name does not resolve to an active webpage, and the Complainant invokes the so-called "passive holding" doctrine.

In this connection the Panel takes note that section 3.3 of the [WIPO Overview 3.0](#) states:

"From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or 'coming soon' page) would not prevent a finding of bad faith under the doctrine of passive holding. 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."

Having considered all the evidences in front of the Panel, the Panel is satisfied that the facts of this case satisfy all of the factors (i) to (iv) mentioned above for the doctrine of passive holding, and the Panel finds no evidence to indicate otherwise. The Panel also notes that no counter-argument has been submitted by the Respondent.

Taking all matters into careful consideration, the Panel holds that the Respondent registered and used the disputed domain name in bad faith.

The Panel therefore concludes that the third requirement of the Policy has been met.

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 <sanoficareers.com> be transferred to the Complainant.

/Teruo Kato/

Teruo Kato

Sole Panelist

Date: July 20, 2022