

ADMINISTRATIVE PANEL DECISION

Sanofi and Sanofi-Aventis Deutschland GmbH v. Jake S. Aichele
Case No. D2022-3496

1. The Parties

The Complainant is Sanofi, France, and Sanofi-Aventis Deutschland GmbH, Germany, represented by Selarl Marchais & Associés, France.

The Respondent is Jake S. Aichele, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <buydulcolax.top> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 21, 2022. On September 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 21, 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 (See PrivacyGuardian.org) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 23, 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 on September 26, 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 the Respondent of the Complaint, and the proceedings commenced on September 27, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 17, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 26, 2022.

The Center appointed Johan Sjöbeck as the sole panelist in this matter on November 1, 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

The Complainant is a multinational pharmaceutical company.

The Complainant has submitted evidence that it is the owner of a number of trademark registrations, including the following:

European Union trademark DULCOLAX No. 002382059, filed on September 19, 2001, and registered on November 29, 2002, and in class 5 notably concerning pharmaceutical products.

International trademark DULCOLAX No. 165781, filed and registered on December 10, 1952, in classes 1 and 5 notably concerning pharmaceutical products and designating amongst others Albania, Australia, Croatia, Egypt, Iceland, Israel, Morocco, Switzerland, Ukraine and Vietnam.

International trademark DULCOLAX (fig) No. 937960A, filed and registered on August 16, 2007, in class 5 notably concerning pharmaceutical products and designating amongst others, Australia, European Union, Japan, Republic of Korea, Norway, Russia Federation, Singapore, Switzerland, and United States.

The disputed domain name <buydulcolax.top> was registered by the Respondent on September 5, 2022. The disputed domain name resolves to a parking website where offers for the disputed domain name can be submitted (the website displays the message “buydulcolax.top may be for sale!”).

5. Parties' Contentions

A. Complainant

With 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, Sanofi, is a French multinational pharmaceutical company headquartered in Paris, ranking 4th world's largest multinational pharmaceutical company by prescription sales. The Complainant is present in more than 100 countries on all five continents employing 100,000 people. The Complainant engages in research and development, manufacturing and marketing of pharmaceutical products for sale, principally in the prescription market, but the firm also develops over-the-counter medication. The Complainant is a full member of the European Federation of Pharmaceutical Industries and Associations (“EFPIA”). Historically, the company was formed as Sanofi-Aventis in 2004 by the merger of Aventis and Sanofi-Synthélabo, and changed its name to Sanofi in May 2011.

With an R&D investment of EUR 5,9 billion in 2018, the Complainant's Research and Development portfolio includes 83 projects in clinical development, 35 of which are at advanced stages. The Complainant offers a wide range of patented prescription drugs to treat patients with serious diseases and has leading positions in seven major therapeutic areas, namely cardiovascular, thrombosis, metabolic disorders, oncology, central nervous system, internal medicine and vaccines.

The German subsidiary, Sanofi-Aventis Deutschland GmbH, maintains its largest site in Frankfurt am Main and is the owner of the DULCOLAX trademarks. DULCOLAX is a laxative that stimulates bowel movements and is manufactured by Sanofi. It is used to treat constipation or to empty the bowels. In total, more than 9,000 employees work for Sanofi at three sites in Germany. Given the above, Sanofi and Sanofi-Aventis Deutschland GmbH are referred to as the Complainant in this proceeding.

The disputed domain name reproduces the DULCOLAX trademarks which, as themselves, do not have any particular meaning and are therefore highly distinctive, and what is sufficient to create a likelihood of confusion between the disputed domain name and the Complainant's aforementioned trademarks. The reproduction of the Complainant's trademarks as the central and dominant part of the disputed domain name is confusingly similar to prior above cited trademarks, regardless of the adjunction of the generic term "buy" and the new generic top-level domains ("gTLD") extension ".top".

The addition of the widespread generic word "buy", which obviously refers to buying and constitutes as such common English word, remains insufficient to avoid confusing similarity and will, on the contrary, merely suggests to Internet users that the disputed domain name leads to a website giving possibility to buy DULCOLAX products. Consequently, it must be considered that the adjunction of this generic expression increases the inherent risk of confusion. The likelihood of confusion is ascertained by the reputation of the Complainant's trade name, trademarks, domain names and more generally speaking goodwill. In this regard, several Panels have already considered that the Complainant's trademarks are "well-known" in many jurisdictions.

The name "REDACTED FOR PRIVACY" indicated in the Whois Database as registrant of the disputed domain name is the result of a service provided by the registrar in order to keep the true identity of the registrant secret. "Jake S. Aichele" is the registrant and it is apparent that the Respondent does not have any legitimate interest in using the disputed domain name since the name in the Whois database does not bear any resemblance with the word "DULCOLAX" which has no meaning and is therefore highly distinctive. The Respondent has no prior rights and/or legitimate interest to justify the use of the DULCOLAX trademarks. The Complainant has never licensed or otherwise authorized the Respondent to use its trademarks or to register any domain name including the above-mentioned trademarks. Consequently, there is no relationship whatsoever between the parties and the Respondent has clearly used the Complainant's trademarks for its own use and incorporated them into the disputed domain name without the Complainant's authorization.

The Respondent is not making a legitimate non-commercial or fair use of the disputed domain name nor is he 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 disputed domain name website is not used legitimately by the Respondent. Indeed, the disputed domain name is leading to a parking website and has been registered only for the purpose of attracting internet users into buying the disputed domain name.

The disputed domain name has been registered only to unfairly attract the Complainant's consumers or competitors, as it is clearly revealed on the Respondent's webpages. In other words, someone wanting to commit unfair behavior by acquiring a domain name that infringes the Complainant's rights could do so by purchasing the disputed domain name. Thus, the Respondent is obviously using the disputed domain name to obtain commercial gain by selling the disputed domain name to interested and malicious people. Consequently, the Respondent is not making legitimate non-commercial or fair use of the disputed domain name, by taking unfair advantage of the reputation of the Complainant's trademarks. Under these circumstances, the absence of any authorization by the Complainant and the lack of legitimate reason in the use of the disputed domain name at stake both prove that the Respondent has no rights or legitimate interest in respect of the disputed domain name. Generally speaking, it must be borne in mind that Panel decisions regularly recognize opportunistic bad faith in cases in which the disputed domain name appears confusingly similar to a Complainant's well-known trademarks. See for example *Sanofi v. Whois Agent, Whois Privacy Protection Service, Inc. / Jim Moretta*, WIPO Case No. [D2016-0096](#).

It is obviously clear that the Respondent registered in bad faith the disputed domain name corresponding to the trademarks owned by the Complainant, as this behavior can in no way be the result of a mere coincidence. It is obvious that the Registrant does not have any legitimate interest in using the disputed domain name since the name "Jake S. Aichele" does not bear any resemblance with the word "DULCOLAX" which has no meaning and is therefore highly distinctive.

The Respondent has neither prior rights nor legitimate interest to justify the use of the Complainant's trademarks. Furthermore, the absence of legitimate interest somewhat induces that of good faith. It should be considered that, given the famous and distinctive nature of the Complainant's marks, the Respondent is likely to have had, at least, constructive, if not actual notice, as to the existence of the Complainant's marks at the time he registered the disputed domain name. This suggests that the Respondent acted with opportunistic bad faith when registering the disputed domain name in order to make an illegitimate use of it.

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 the DULCOLAX trademarks and the disputed domain name. The Respondent must have been undoubtedly aware of the risk of deception and confusion that would inevitably arise from the registration of the disputed domain name since it could lead internet users searching for official DULCOLAX websites to the litigious page. This knowledge characterized the Respondent's bad faith usage. For all these reasons, there is no doubt that the disputed domain name has been registered in bad faith by the Respondent, for the primary purpose of gaining unfair benefit of the Complainant's reputation.

This disputed domain name was not only registered in bad faith but is also being used by the Respondent in bad faith. It is clear that, given the famous nature of the Complainant the Respondent is likely to have had, at least, constructive, if not actual notice, as to the Complainant's marks at the time he registered the disputed domain name. This suggests that the Respondent acted with opportunistic bad faith in registering the name "DULCOLAX" in order to make an illegitimate use of it. The disputed domain name leads to a parking website where offers for the disputed domain name can be submitted. Thus, it has been registered only for the purpose of attracting internet users into buying the disputed domain name. The Respondent is undoubtedly trying to ride off the Complainant's worldwide reputation, in particular by selling a domain name highly similar to the DULCOLAX trademark. The Respondent has clearly adopted the Complainant's trademarks for its own use by making profit by using Complainant's well-known trademark and incorporated it into the disputed domain name in order to sell it to the highest bidder, which in any case does not constitute a *bona fide* offering of goods and services. It follows from the above that the Respondent is undeniably trying to take advantage of the Complainant's reputation, characterizing all the more a bad faith usage.

It has been established in many UDRP cases that passive holding under the appropriate circumstances falls within the concept of the domain name being used in bad faith. See *Telstra Corporate Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). The Panelist found that in order to establish that the registrant was using a domain name in bad faith it was not necessary to find that he had undertaken any positive action in relation to the domain name. Indeed, in circumstances of inaction ("passive holding"), this behavior falls within the concept of the domain name "being used in bad faith". The lack of use of the disputed domain name particularly close to those used by the Complainant is likely to cause irreparable prejudice to their general goodwill because Internet users could be led to believe that the Complainant is not on the Internet or worse that Complainant is out of business.

Consequently, the contested domain name <buydulcolax.top> has been both registered and used intentionally in bad faith without any rights or legitimate interest by the Respondent.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, the Complainant must prove each of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

- (ii) the Respondent has no rights or legitimate interests in the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant is, according to the submitted evidence, the owner of the registered trademark DULCOLAX. The disputed domain name incorporates the DULCOLAX trademark in its entirety with the addition of the English term “buy”. The addition of the term “buy” to the DULCOLAX trademark in the disputed domain name does not prevent a finding of confusing similarity. Furthermore, it is standard practice to disregard the gTLD under the confusingly similar test.

Having the above in mind, the Panel concludes that the disputed domain name is confusingly similar to the Complainant’s trademark and that the Complainant has proven the requirement under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant must show that the Respondent has no rights or legitimate interests with respect to the disputed domain name. The Respondent may establish rights or legitimate interests in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- (i) the Respondent uses or has made preparations to use the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services prior to the dispute; or
- (ii) the Respondent is commonly known by the disputed domain name, even if the Respondent has not acquired any trademark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark.

The Complainant has not licensed, approved or in any way consented to the Respondent’s registration and use of the trademarks in the disputed domain name. There is no evidence in the case file indicating that the Respondent has used or made any preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services prior to the dispute. On the contrary, the Complainant has submitted evidence that the Respondent is offering the disputed domain name for sale via a parking website.

Although given the opportunity, the Respondent has not rebutted the Complainant’s *prima facie* case. The Respondent has not submitted any evidence indicating that it is the owner of any trademark or that it is commonly known by the disputed domain name. Furthermore, there is no evidence indicating that the Respondent intends to make a legitimate, noncommercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark.

The Respondent has failed to invoke any circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy or otherwise, any rights or legitimate interests in respect of the disputed domain name. Thus, there is no evidence in the case that refutes the Complainant’s submissions, and the Panel concludes that the Complainant has also proven the requirement under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under paragraph 4(b) of the Policy, evidence of bad faith registration and use include without limitation:

- (i) circumstances indicating the disputed domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the owner of a

trademark or to a competitor of the trademark owner, for valuable consideration in excess of the documented out-of-pocket costs directly related to the disputed domain name; or

(ii) circumstances indicating that the disputed domain name was registered in order to prevent the owner of a trademark from reflecting the mark in a corresponding disputed domain name, provided there is a pattern of such conduct; or

(iii) circumstances indicating that the disputed domain name was registered primarily for the purpose of disrupting the business of a competitor; or

(iv) circumstances indicating that the disputed domain name has intentionally been used in an attempted to attract, for commercial gain, Internet users to the Respondent's website or other online location, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on that website or location.

The Complainant's trademark registrations predate the registration of the disputed domain name. The nature of the disputed domain name that comprises the Complainant's DULCOLAX trademark in its entirety with the addition of the term "buy" makes it inconceivable that that the Respondent coincidentally selected the disputed domain name without any knowledge of the Complainant and its trademark.

The Complainant has provided evidence that the disputed domain name resolves to a parking website where the disputed domain name is offered for sale. Thus, the evidence and the circumstances in the case indicate that the disputed domain name has been registered or acquired primarily for the purpose of selling or otherwise transferring the disputed domain name registration to the owner of a trademark or to a competitor of the trademark owner, for valuable consideration likely in excess of the documented out-of-pocket costs directly related to the disputed domain name.

Furthermore, given that the disputed domain name incorporates the DULCOLAX trademark in its entirety with the addition of the term "buy" may misled Internet users into believing that the disputed domain name belongs to or is in some way associated with, endorsed by or provided by the Complainant. Consequently, the circumstances in the case also indicate that the disputed domain name has intentionally been used in an attempted to attract, for commercial gain, Internet users to the Respondent's website or other online location.

Based on the facts alleged in the Complaint, which the Respondent has made no effort to rebut, the Panel is persuaded on the balance of probabilities that the Respondent registered and used the disputed domain name with the Complainant's trademark and business in mind. There is no evidence in the case file that refutes the Complainant's submissions and the Panel concludes that the Complainant has proved the requirements under paragraph 4(b) of the Policy and that the disputed domain name has been registered and used in bad faith.

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 <buydulcolax.top> shall be transferred to the Complainant.

/Johan Sjöbeck/

Johan Sjöbeck

Sole Panelist

Date: November 10, 2022