

ADMINISTRATIVE PANEL DECISION

Sanofi v. Anderson marcus, Ambien
Case No. D2022-3996

1. The Parties

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

The Respondent is Anderson marcus, Ambien, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <allambienonline.com> (“Domain Name”) is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 25, 2022. On October 26, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On October 26, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 27, 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 October 27, 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 November 4, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 24, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 25, 2022.

The Center appointed Nicholas Smith as the sole panelist in this matter on December 2, 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 French multinational pharmaceutical company that, ranked by prescription sales, is the 4th largest pharmaceutical company in the world. The Complainant trades in over 100 countries and employs over 100,000 people. One of its medicinal products is a treatment for insomnia which it has offered for over 25 years under a trade mark consisting of the word "Ambien" (the "AMBIEN Mark"). The Complainant is also the owner of the domain names <ambien.com>, <ambien.net>, <ambien.info> and <ambien.org>.

The Complainant holds a number of registered trade marks in various jurisdictions for the AMBIEN Mark including French trade mark registration number 93456039 registered on February 19, 1993 for pharmaceutical products in class 5.

The Domain Name <allambienonline.com> was registered on May 24, 2022. The Domain Name redirects to a website (the "Respondent's Website") that purports to offer the Complainant's Ambien products for sale (and other competing products). The Complainant submits that in the absence of any reference to the Complainant or its packaging it is highly likely that the Ambien products offered by the Respondent through its website are counterfeit.

5. Parties' Contentions

A. Complainant

The Complainant makes the following contentions:

- (i) the Domain Name is identical or confusingly similar to the Complainant's AMBIEN Mark;
- (ii) the Respondent has no rights nor any legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

The Complainant is the owner of the AMBIEN Mark having registered the AMBIEN Mark in the European Union, France and the United States. The Domain Name wholly incorporates the AMBIEN Mark along with the descriptive words "all" and "online" and the ".com" Top-Level Domain.

There are no rights or legitimate interests held by the Respondent in respect of the Domain Name. The Complainant has not granted any license or authorization for the Respondent to use the AMBIEN Mark. The Respondent does not use the Domain Name for a *bona fide* purpose or legitimate noncommercial purpose. Rather the Domain Name resolves to the Respondent's Website where the Respondent is likely selling counterfeit goods in direct competition with the Complainant that will likely endanger consumers; which does not provide the Respondent with rights or legitimate interests.

The Domain Name was registered and is being used in bad faith. Given the reputation of the AMBIEN Mark, which is well-known mark, the registration of the Domain Name can only be taken as an attempt by the Respondent to gain an unfair benefit from the Complainant's reputation. By using the Domain Name to resolve to a website that offers competing and potentially counterfeit goods, the Respondent is using the Domain Name to divert Internet users searching for the Complainant to its own website for commercial gain. Such conduct amounts to registration and use of the Domain Name in bad faith.

B. Respondent

The Respondent did not formally reply to the Complainant's contentions. The Panel notes that the Respondent has sent three e-mail communications to the Center but that the communications were blank.

6. Discussion and Findings

A. Identical or Confusingly Similar

To prove this element, the Complainant must have trade or service mark rights and the Domain Name must be identical or confusingly similar to the Complainant's trade or service mark.

The Complainant is the owner of the AMBIEN Mark, having a registration for the AMBIEN Mark as a trade mark in the European Union, France and the United States.

The Domain Name incorporates the AMBIEN Mark in its entirety with the addition of the terms "all" and "online" and the ".com" Top-Level Domain. Other UDRP panels have repeatedly held that where the relevant trade mark is recognizable within the disputed domain name, the addition of other terms does not prevent a finding of confusing similarity under the first element; see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Panel finds that the Domain Name is confusingly similar to the Complainant's AMBIEN Mark. Consequently, the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

To succeed on this element, a complainant may make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. If such a *prima facie* case is made out, the respondent then has the burden of demonstrating rights or legitimate interests in the domain name.

Paragraph 4(c) of the Policy enumerates several ways in which a respondent may demonstrate rights or legitimate interests in a disputed domain name:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

(i) before any notice to you of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trade mark or service mark rights; or

(iii) you are making legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue."

The Respondent is not affiliated with the Complainant in any way. It has not been authorized by the Complainant to register or use the Domain Name or to seek the registration of any domain name incorporating the AMBIEN Mark or a mark similar to the AMBIEN Mark.

The Whois lists “ambien” as registrant organization of record. However, as discussed below, the Panel is not satisfied that the Respondent is actually commonly known under this name as opposed to simply registering the Domain Name under a pseudonym for the purpose of asserting rights or legitimate interests. The Respondent has provided no evidence that an entity known as “ambien” exists. Even if a respondent’s name appears from the Whois record to correspond to the domain name, without additional affirmative evidence, it can be concluded that such a respondent is not commonly known by the disputed domain name under Policy 4(c)(ii).

There is no evidence that the Respondent has used or made demonstrable preparations to use the Domain Name in connection with a legitimate noncommercial or fair use or a *bona fide* offering of goods or services. The Respondent has used the Domain Name to operate a website purporting to sell the Complainant’s Ambien products as well as other third party medications. It is unclear whether the products purported to be sold on the Respondent’s Website are the Complainant’s products or counterfeit products, though the Complainant makes a strong case, based on the absence of any evidence of official packaging, that they are counterfeit products. If the Ambien products sold on the Respondent’s Website are not genuine products produced by the Complainant, the Respondent’s use of the Domain Name does not grant it rights or legitimate interests since it is using the Complainant’s AMBIEN Mark for a site selling counterfeit or at the minimum unauthorized products.

Even if the Respondent was offering genuine AMBIEN products from the Respondent’s Website, such use does not automatically grant it rights and legitimate interests. The principles that govern whether a reseller of genuine goods has rights or legitimate interests have been set out in a variety of UDRP decisions, starting with the case of *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

The [WIPO Overview 3.0](#), section 2.8 summarizes the consensus views of UDRP panels in assessing claims of nominative (fair) use by resellers or distributors in the following manner:

“... Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant’s trademark to undertake sales or repairs related to the complainant’s goods or services may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the ‘Oki Data test’, the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant’s relationship with the trademark holder; and
- (iv) the respondent must not try to ‘corner the market’ in domain names that reflect the trademark.

The Oki Data test does not apply where any prior agreement, express or otherwise, between the parties expressly prohibits (or allows) the registration or use of domain names incorporating the complainant’s trademark.”

In this case the Respondent’s Website is not limited to selling the trademarked goods and services. Nor does the Respondent’s Website accurately or prominently disclose the Respondent’s relationship with the Complainant, in particular that it is not an authorized dealer or has any particular connection with the Complainant. Even in the event that the Respondent is reselling genuine AMBIEN products, its use of the Domain Name for the Respondent’s Website in the circumstances described above does not grant it rights or legitimate interests in the Domain Name.

The Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name. The Respondent has had the opportunity to put on evidence of its rights or legitimate interests, including submissions as to why its conduct amounts to a right or legitimate interest in the Domain Name under the Policy. In the absence of such a Response, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

For the purposes of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that the respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trade mark or service mark or to a competitor of the complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has registered the domain name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location (Policy, paragraph 4(b)).

The Panel finds that the Respondent was aware of the Complainant and its reputation in the AMBIEN Mark at the time the Domain Name was registered. The Complainant's AMBIEN Mark is a coined and well-known mark. The Respondent's Website purports to offer the Complainant's products for sale. The registration of the Domain Name in awareness of the AMBIEN Mark and in the absence of rights or legitimate interests amounts under these circumstances to registration in bad faith.

The Respondent registered the Domain Name for the purposes of operating a website specifically to sell either the Complainant's products or counterfeit products that compete with the Complainant. The Respondent is using the Domain Name to sell products, be they genuine or otherwise, in competition with the Complainant and without the Complainant's approval and without meeting the "Oki Data" test. Consequently the Panel finds that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant and the Complainant's AMBIEN Mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's Website.

Accordingly, the Panel finds that the Respondent has registered and used the Domain Name in bad faith under paragraph 4(a)(iii) 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 Domain Name <allambienonline.com> be transferred to the Complainant.

/Nicholas Smith/

Nicholas Smith

Sole Panelist

Date: December 12, 2022