

ADMINISTRATIVE PANEL DECISION

Sanofi, Chattem Inc. v. Michael C. Winn

Case No. D2022-4290

1. The Parties

The Complainants are Sanofi, France, and Chattem Inc., United States of America (“United States” or “US”), represented by Selarl Marchais & Associés, France.

The Respondent is Michael C. Winn, United States.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 10, 2022. On November 11, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On November 11, 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 (PrivacyGuardian.org LLC, United States) and contact information in the Complaint. The Center sent an email communication to the Complainants on November 21, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amendment to the Complaint on November 22, 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 23, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 13, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 14, 2022.

The Center appointed Michael D. Cover as the sole panelist in this matter on December 19, 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, Sanofi, is headquartered in France, has consolidated net sales of 37.7 billion euros in 2021, 36.04 billion euros in 2020, 34.46 billion euros in 2018, 35.05 billion euros in 2017, 33.82 billion euros in 2016, 34.06 billion Euros in 2015, and 31.38 billion Euros in 2014 (Annex 5). Sanofi is a French multinational pharmaceutical company headquartered in Paris (France), ranking 4th world's largest by prescription sales. 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 medicines. The Complainant was formed as Sanofi-Aventis in 2004, by the merger of Aventis and Sanofi-Synthélabo and changed its name in May 2011. The Complainant is present in 100 countries on all 5 continents, employing some 100,000 persons.

The Complainant has used the ZANTAC trademark for some 40 years and has invested substantially to advertise the products sold under that trademark throughout the world.

The Complainant's group has a large portfolio of what might be described as high growth drugs, as set out in Annex 6.2 to the Complaint. The Complainant invested some EUR 5.9 billion in 2018 in research and development.

The Complainant Chattem, Inc. is a US manufacturer of over the counter healthcare products and was founded in 1879 and has been owned by the Complainant Sanofi since 2010.

The Complainant Chattem, Inc. is the proprietor of various registered trademarks consisting of or incorporating the name ZANTAC. These are set out in the Complaint and include US registered trademark No. 1220525 ZANTAC in Class 5 for pharmaceutical preparations, which was registered on December 21, 1982. The Complainant's group is also the proprietor of various domain names, which include the name "zantac".

The Complainants are hereinafter referred to as "the Complainant".

The Disputed Domain Name was registered on September 27, 2002, in the name of PrivacyGuardian.org LLC, United States with the registrant later revealed as Michael C Winn, United States, and resolves to a parking website, which *inter alia* invites offers to purchase the Disputed Domain Name, as set out in Annex 11 to the Complaint.

5. Parties' Contentions

A. Complainant

Identical or Confusingly Similar

The Complainant notes that the Disputed Domain Name reproduces the Complainant's registered trademark ZANTAC in full and also notes that this trademark does not have any particular meaning and is therefore highly distinctive and submits that this is sufficient to create a likelihood of confusion between the Disputed Domain Name and the Complainant's trademarks.

The Complainant also submits that the reproduction of the ZANTAC trademark as the dominant part of the Disputed Domain Name is confusingly similar to that trademark and that this is regardless of what the

Complainant calls the adjunction of the generic and descriptive term “buy” and generic Top-Level Domain (“gTLD”) extension “.top”. The Complainant maintains that gTLD suffixes are insufficient to avoid confusing similarity and, on the contrary, merely suggest to Internet users that the Disputed Domain Name is related to the Complainant, as the Complainant’s trademark remains the distinctive and dominant part of the Disputed Domain Name.

Having cited a number of previous panel decisions, the Complainant concludes that the addition of the term “buy” after the trademark ZANTAC is insufficient to alleviate the likelihood of confusion between the Complainant’s trademarks and the Disputed Domain Name and that this, in fact, is likely to increase the likelihood of confusion.

The Complainant makes two further points. First, the Complainant submits that there is an inevitable risk that the Disputed Domain Name could cause confusion by average consumers being led to believe that the Disputed Domain Name is related to the official ZANTAC websites. Second, the Complainant submits that the widespread reputation of the Complainant’s ZANTAC trademark increases the likelihood of confusion.

The Complainant sums up by submitting that the Disputed Domain Name is to be considered as confusingly similar to the ZANTAC trademarks, in which the Complainant has rights.

Rights or Legitimate Interests

The Complainant commences its submissions under this head by stating that, obviously, the Respondent does not have any rights or legitimate interests regarding the Disputed Domain Name. Firstly, notes the Complainant, the name of the registrant of the Disputed Domain Name, initially “Redacted for Privacy”, does not bear any resemblance to the word ZANTAC, which is, in itself, highly distinctive, as it has no meaning.

The Complainant also states that the Complainant has never licensed or otherwise permitted the Respondent to use the ZANTAC trademarks or to register any domain name including those trademarks. The Complainant continues that there is no relationship between the Parties and submits that the Respondent has clearly modified that the Complainant’s trademarks for its own use and incorporated them into the Disputed Domain Name, without the Complainant’s authorization.

The Complainant submits that the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name nor is the Respondent 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. Indeed, continues the Complainant, the Disputed Domain Name resolves to a parking website, as set out in Annex 11 to the Complaint. The Complainant submits that the Disputed Domain Name has been registered only for the purpose of selling the Disputed Domain Name. The Complainant concludes that the Respondent is obviously using the Disputed Domain Name to obtain commercial gain by misleadingly diverting consumers. The Complainant notes that a previous Panel in *F. Hoffman-La Roche AG v Macalve e-dominios S.A.* (WIPO Case No. [D2006-0451](#)) found that: “The use of the domain name as a parking website is not a *bona fide* non-commercial use pursuant to paragraph 4(c)(iii) of the Policy”.

The Complainant sums up submitting that the absence of any authorization by the Complainant and the lack of a legitimate reason in the use of the ZANTAC trademark both prove that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

Registered and Used in Bad Faith

The Complainant commences its submissions on this head by setting out that panels generally recognize opportunistic bad faith in cases in which the disputed domain name appears similar to a complainant’s well known trademarks. The Complainant refers the Panel to a number of earlier decisions, including one which references the case of *Telstrar Corporation Ltd. v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), where it was stated that only passive use by a respondent does not preclude a finding of use in bad faith.

The Complainant then goes on that, in the light of the above, it will be demonstrated that the Disputed Domain Name was registered and is being used in bad faith.

The Claimant continues that the Respondent has neither the prior rights nor legitimate interests to justify the use of the already well known trademarks of the Complainant and the absence of that legitimate interests somewhat induces that of bad faith. The Complainant also submits that, given the distinctive nature of the Complainant's ZANTAC trademark and the reputation of the Complainant, the Disputed Domain Name has obviously been registered in bad faith. On this head, the Complainant concludes that 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.

The Complainant then moves on to the question of the Disputed Domain Name being used in bad faith and submits that the Complainant is not making a legitimate noncommercial 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. The Complainant notes that the Disputed Domain Name resolves to a parking website, as set out at Annex 11 to the Complaint and submits that the Respondent is undeniably trying to take advantage of the Complainant's reputation, characterizing, as the Complainant puts it, all the more a bad faith usage.

The Complainant sums up by submitting consequently that the Disputed Domain Name has been both registered and used intentionally in bad faith.

The Remedy requested by the Complainant

The Complainant requests that the Disputed Domain Name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

The Complainant must establish on the balance of probabilities that the Disputed Domain Name is identical or confusingly similar to a trademark in which the Complainant has rights; that the Respondent has no rights or legitimate interests in the Disputed Domain Name; and that the Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel finds and decides that the Complainant has established registered rights in its ZANTAC trademark, the first registration of which predates the registration of the Disputed Domain Name by some 40 years. The Panel also finds that the Complainant's trademark ZANTAC has become well known through extensive use over the same period by the Complainant.

The Disputed Domain Name incorporates the Complainant's trademark ZANTAC in full and, in assessing the confusing similarity, it is well established that the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise), such as the term "buy", as in this case, does not prevent a finding of confusing similarity. It is also well established that the gTLD is viewed as a standard registration requirement and, accordingly, is to be disregarded under the first element of the Policy.

The Panel therefore finds that the Disputed Domain Name is confusingly similar to the Complainant's trademark ZANTAC, in which the Complainant has rights, and that the provisions of the Policy, paragraph 4(a)(i) have been met.

B. Rights or Legitimate Interests

The Panel accepts and finds that the Respondent has no rights or legitimate interests in the Disputed Domain Name and finds that the provisions of paragraph 4(a)(ii) of the Policy have been met.

The Panel accepts and finds that the Respondent has not been authorized, licensed, or otherwise permitted by the Complainant to register or use the Complainant's ZANTAC registered trademark as part of the Disputed Domain Name or otherwise.

The Complainant has established a *prima facie* case, to which no response has been filed, that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The Respondent has not, before any notice to the Respondent of the dispute, made use or demonstrable preparations to use the Disputed Domain Name or a name corresponding to it in connection with a *bona fide* offering of goods or services nor has the Respondent been commonly-known by the Disputed Domain Name nor has the Respondent made noncommercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. Such use as has in fact taken place of the Disputed Domain Name involves the Disputed Domain Name resolving to a parking website, which invites offers to purchase the Disputed Domain Name which does not constitute a *bona fide* offering of goods or services.

C. Registered and Used in Bad Faith

The Panel accepts and finds that the Disputed Domain Name has been registered and is being used in bad faith. It is a reasonable inference that the Respondent knew of the Complainant and its well known trademark the time when the Respondent registered the Disputed Domain Name. The Panel also finds that the Respondent could have had no reason to register the Disputed Domain Name, if not for the significance of the "Zantac" element, which is the dominant part of the Disputed Domain Name.

With regard to the use of the Disputed Domain Name, this has been to resolve to a parking website, where the Disputed Domain Name invites offers for sale. In addition, the Respondent has failed to avail himself of the opportunity to file a response to the Complaint and, in particular, to file any evidence of good faith use and has sought to conceal his identity.

The Panel accordingly finds that the Respondent has registered and is using the Disputed Domain Name in bad faith and that the provisions of the Policy, paragraph 4(a)(iii) have 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 <zantacbuy.top> be transferred to the Complainant.

/Michael D. Cover/

Michael D. Cover

Sole Panelist

Date: January 2, 2023