

## **ADMINISTRATIVE PANEL DECISION**

Sanofi v. Domain Admin, DomainNameNexus  
Case No. D2023-1684

### **1. The Parties**

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

The Respondent is Domain Admin, DomainNameNexus, United States of America.

### **2. The Domain Name and Registrar**

The disputed domain name <sanofiwinthrop.com> is registered with Sav.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 17, 2023. On April 17, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 18, 2023, 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 (Privacyprotection.com, llc) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 25, 2023, 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 April 28, 2023.

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 May 3, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 23, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 15, 2023. The Respondent sent an informal communication to the Center on June 15, 2023. The Center sent a possible settlement communication to the parties and the Complainant requested a suspension of proceedings on the same date. The Complainant requested a reinstatement of proceedings on July 17, 2023. The Center reinstated the proceedings on July 19, 2023, and proceeded to panel appointment.

The Center appointed Nayiri Boghossian as the sole panelist in this matter on July 21, 2023. 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 pharmaceutical company that is ranked the fourth largest multinational pharmaceutical company in the world. The Complainant owns the following trademark registrations for SANOFI:

- French registration No. 96655339 registered on December 11, 1996;
- French registration No 1482708 registered on August 11, 1988;
- European Union Trade Mark registration No. 000596023 registered on February 1, 1999.

The Complainant owns European Union Trade Mark registrations for WINTHROP registered under No. 000041954 registered on November 27, 1998.

The Respondent registered the disputed domain name on November 29, 2022. The disputed domain name resolves to a website hosting Pay-Per-Click (“PPC”) links and is offered for sale.

#### **5. Parties’ Contentions**

##### **A. Complainant**

The Complainant contends that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The disputed domain name incorporates the Complainant’s trademarks. The trademarks of the Complainant have no dictionary meaning and are highly distinctive. The Complainant has used its trademark and trade name SANOFI for over forty years all over the world. The Complainant’s trademarks are the dominant part of the disputed domain name. The generic Top-LevelDomain (“gTLD”) “.com” should be ignored. The goodwill and notoriety of the Complainant’s trademarks should be considered when assessing the likelihood of confusion.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. The trademark SANOFI is distinctive and the Respondent’s name bears no resemblance to the Complainant’s trademark SANOFI. The true identity of the Respondent is kept secret. The Respondent is not authorized by the Complainant to use its trademarks nor is it licensed by the Complainant. The Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods as it resolves to a website used for bait and switch as it is a parking website. The Respondent is using the Complainant’s trademark in order to divert the Complainant’s consumers into believing the Respondent is linked to the Complainant. The Respondent must be generating click-through revenue from the links and hence there’s no noncommercial or fair use of the disputed domain name.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. This is a case of opportunistic bad faith as the Complainant’s trademarks are well-known. The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent must have known of the Complainant’s trademark as it is famous and distinctive. The disputed domain name was registered and is being used to attract Internet traffic by creating a likelihood of confusion with the Complainant’s trademarks which are well-known. The disputed domain name has been registered solely for the purpose of diverting consumers into thinking that the Respondent is connected or sponsored or affiliated with the Complainant or endorsed by it as it resolves to a parking website. Passive holding is considered bad faith use. The Respondent must be generating revenue from the links. There is no genuine use of the disputed domain name, which is likely to cause prejudice to its goodwill.

## **B. Respondent**

The Respondent sent an informal communication to the Center on June 15, 2023 requesting an opportunity to resolve this matter amicably. The Panel notes that the Respondent did not follow up on this offer, and the Parties did not reach a settlement in the matter.

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

The Complainant owns trademark registrations for the trademark SANOFI and a trademark registration for WINTHROP. The Panel is satisfied that the Complainant has established its ownership of the trademarks. The disputed domain name incorporates the Complainant's trademarks SANOFI and WINTHROP in their entirety. The gTLD ".com" should generally be ignored when assessing confusing similarity as established by prior UDRP decisions.

Consequently, the Panel finds that the disputed domain name is confusingly similar to the trademarks of the Complainant and that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

### **B. Rights or Legitimate Interests**

Under paragraph 4(a)(ii) of the Policy, a complainant must make at least a *prima facie* showing that a respondent does not have any rights or legitimate interests in the disputed domain name. Once such showing is made, the burden of production shifts to the respondent. In the instant case, the Complainant asserts, amongst other things, that the Respondent is not authorized by the Complainant to use its trademark. Therefore, the Complainant has established a *prima facie* case and the burden of production shifts to the Respondent to show that it has rights or legitimate interests.

Panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a *bona fide* offering where such links capitalize on the reputation and goodwill of the complainant's mark. The PPC links show the words "pharma" and "pharmaceutical", which relate to the Complainant's field of activity. Accordingly, the Panel is of the view that the Respondent is trying to capitalize on the reputation and goodwill of the Complainant's mark. In *Legacy Health System v. Nijat Hassanov*, WIPO Case No. [D2008-1708](#), it was found that the respondent had no rights or legitimate interests as "the sole purpose of the disputed domain name is to resolve to pay-per-click advertising websites and collect click-through revenue from advertising links. Such use demonstrates that the Respondent has used the disputed domain name to derive a commercial benefit. There is no indication on the website that the Respondent has made a *bona fide* use of the disputed domain name".

Consequently, the Panel finds that the Complainant has met the requirement under the Policy of showing that the Respondent does not have any rights or legitimate interests in the disputed domain name. Accordingly, the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

### **C. Registered and Used in Bad Faith**

The Respondent must have known about the Complainant's business and trademark for the following reasons: 1. The Complainant's trademark SANOFI is considered well-known by prior UDRP decisions (See *e.g. Sanofi-Aventis v. Davie Kearney*, WIPO Case No. [D2006-0861](#)). 2. The disputed domain name resolves to a website with PPC links relating to the Complainant's industry, the pharmaceutical. 3. The disputed domain name was created three decades after the registration of the Complainant's trademarks.

Given that the disputed domain name resolves to a page with PPC links, there is bad faith use in the current circumstances. In *Mpire Corporation v. Michael Frey*, WIPO Case No. [D2009-0258](#), the Panel found that "While the intention to earn click-through-revenue is not in itself illegitimate, the use of a domain name that is deceptively similar to a trademark to obtain click-through-revenue is found to be bad faith use."

Such conduct of using a domain name, to attract Internet users for commercial gain, would fall squarely within the meaning of paragraph 4(b)(iv) of the Policy. Given the above, the Panel believes that the Respondent has registered the disputed domain name in order to trade off the reputation of the Complainant's trademark.

Accordingly, the Panel finds that the Complainant has satisfied 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 disputed domain name, <sanofiwinthrop.com> be cancelled.

*/Nayiri Boghossian/*

**Nayiri Boghossian**

Sole Panelist

Date: July 26, 2023