

ADMINISTRATIVE PANEL DECISION

Sanofi v. jugs logs

Case No. D2023-2223

1. The Parties

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

The Respondent is jugs logs, United States of America.

2. The Domain Name and Registrar

The Disputed Domain Name <sanofi.cam> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 23, 2023. On May 23, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On May 23, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 24, 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 the same day.

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 June 5, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 25, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 27, 2023.

The Center appointed Edward C. Chiasson K.C. as the sole panelist in this matter on July 3, 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

Historically, the Complainant was formed as Sanofi-Aventis in 2004 by the merger of Aventis and Sanofi-Synthélabo, and changed its company name to Sanofi in May 2011. The Complainant is a French multinational pharmaceutical company headquartered in Paris, France. It is the fourth world's largest multinational pharmaceutical company 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 medication. 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

With an investment of EUR 5.9 billion in 2019, the Complainant's Research and Development portfolio includes 84 projects in clinical development, 28 of which are at advanced stages

The Complainant operates in more than 100 countries on all five continents employing 100,000 people.

The Complainant is a full member of the European Federation of Pharmaceutical Industries and Associations (EFPIA).

The Complainant is the rightful owner of the following trademarks for SANOFI:


- French trademark number 3831592, registered on December 9, 2011, in classes 01, 03, 05, 09, 10, 16, 35, 38, 40, 41, 42, and 44 notably concerning pharmaceutical products;
- French trademark number 96655339, registered on May 23, 1997, in classes 01, 03, 05, 09, 10, 35, 40, and 42 notably concerning pharmaceutical products;
- French trademark number 92412574, registered on July 31, 1992, in class 05 concerning pharmaceutical products;



- French trademark number 1482708, registered on January 27, 1989, in classes 01, 03, 04, 05, 10, 16, 25, 28, and 31 notably concerning pharmaceutical products;
- European Union trademark number 010167351, filed on August 2, 2011, and registered on January 7, 2012, in classes 03; 05 notably concerning pharmaceutical products;
- European Union trademark number 004182325, filed on December 8, 2004, and registered on February 9, 2006, in classes 01, 09, 10, 16, 38, 41, 42, and 44 notably concerning products in pharmaceutical and medical spheres;

- European Union trademark number 000596023, filed on July 15, 1997, and registered on February 1, 1999, in classes 03 and 05 notably concerning pharmaceutical products;



- International trademark **SANOFI** number 1091805, registered on August 18, 2011, in classes 01, 03, 05, 09, 10, 16, 35, 38, 40, 41, 42, and 44 notably concerning pharmaceutical products, and designating among others Georgia, Russia, Ukraine;
- International trademark number 1092811, registered on August 11, 2011, in classes 01, 09, 10, 16, 38, 41, 42, and 44 notably concerning products in 9 among others Australia, pharmaceutical and medical spheres, and designating Georgia, Japan, South Korea, Cuba, Russia, Ukraine;
- International trademark number 1094854, registered on August 11, 2011, in classes 03 and 05 notably concerning pharmaceutical products, and designating among others Australia, Georgia, Japan, South Korea, Cuba, Russia, Ukraine;
- International trademark number 674936, registered on June 11, 1997, in classes 03 and 05 notably concerning pharmaceutical products and designating among others Switzerland, Cuba, Romania, Russia, Ukraine;
- International trademark number 591490, registered on September 25, 1992, in class 05 concerning pharmaceutical products, and designating among others Switzerland, China, Cuba, Romania, Russia;
- Canadian trademark  number 0709174, registered on August 22, 1997 in class 05; and
- Iceland trademark number 838/1997, filed on June 12, 1997, and registered on July 22, 1997, in class 3 and 5 notably concerning pharmaceutical products.

The Complainant is also the owner of the following domain names among others;

- <sanofi.com>, registered on October 13, 1995 (Annex 9.1);
- <sanofi.eu>, registered on March 12, 2006 (Annex 9.2);
- <sanofi.fr>, registered on October 10, 2006 (Annex 9.3);
- <sanofi.us>, registered on May 16, 2002 (Annex 9.4);
- <sanofi.net>, registered on May 16, 2003 (Annex 9.5);
- <sanofi.ca>, registered on January 05, 2004 (Annex 9.6);
- <sanofi.biz>, registered on November 19, 2001 (Annex 9.7);
- <sanofi.info>, registered on August 24, 2001 (Annex 9.8);
- <sanofi.org>, registered on July 12, 2001 (Annex 9.9);
- <sanofi.mobi>, registered on June 20, 2006 (Annex 9.10);
- <sanofi.tel>, registered on March 17, 2011 (Annex 9.11);
- <sanofi.cn>, registered on April 28, 2004 (Annex 9.12); and
- <sanofi.is>, registered on November 21, 2012 (Annex 9.13).

Most of these domain names are registered and used by the Complainant in connection with its activity. All of the above-mentioned trademarks and domain names containing the distinctive word “sanofi” were registered prior to the registration of the Disputed Domain Name.

The Disputed Domain Name was registered on April 28, 2023. It resolves to an inactive webpage.

5. Parties' Contentions

A. Complainant

Based on the following facts and authorities, the Complainant asserts that the Disputed Domain Name is confusingly similar to a trademark in which the Complainant has rights.

The Disputed Domain Name comprises: (a) an exact reproduction of the Complainant's trademark; and (b) followed by the generic Top-Level Domain ("gTLD") suffix ".cam". The Complainant's SANOFI trademark does not have any particular meaning and is highly distinctive. It is well established that the gTLD suffix used as part of a domain name should be disregarded because it does not serve to distinguish domain names.

Previous UDRP panels have held that when a domain name wholly incorporates a complainant's registered trademark that may be sufficient to establish confusing similarity for purposes of the Policy. See *STADA Arzneimittel AG v. Withheld for Privacy ehf / Namecock Cheapli*, WIPO Case No. [D2021-1762](#); and *bioMérieux v. Privacy service provided by Withheld for Privacy ehf / alona jackson*, WIPO Case No. [D2022-2114](#).

Confusion is particularly true when the registered trademark is well-known. The Complainant has used its SANOFI trademark and trade name for over 40 years. The Complaint referred to and relies on a number of previous UDRP cases involving its trademark to illustrate that it is well known.

Based on the following fact and authorities, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Respondent does not have any legitimate interest in using the Disputed Domain Name is illustrated by the fact that its name has no resemblance to the word "sanofi". The Respondent has no prior right to use the word "sanofi". There is no relationship between the Parties. The Complainant has never licensed or otherwise authorized the Respondent to use its trademarks or to register any domain name including the Complainant's trademark.

The Respondent is neither making a legitimate noncommercial or fair use of the Disputed Domain Name nor 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 is not used at all by Respondent.

Based on the following fact and authorities, the Complainant asserts that the Disputed Domain Name was registered and is being used in bad faith.

UDRP panels regularly recognize opportunistic bad faith in cases in which a contested domain name appears confusingly similar to a complainant's well-known trademarks. Given the famous and distinctive nature of the mark SANOFI, the Respondent is likely to have had, at least, constructive notice, if not actual notice, of the existence of the Complainant's marks at the time the Disputed Domain Name was registered. This suggests that the Respondent acted with opportunistic bad faith in registering the Disputed Domain Name in order to make illegitimate use of it. See *Sanofi v. Whois Agent, Whois Privacy Protection Service, Inc. / Jim Moretta*, WIPO Case No. [D2016-0096](#); *Giorgio Armani S.p.A. Milan, Swiss Branch Mendrisio v. Min Zhi*, WIPO Case No. [D2013-0020](#); and *Sanofi v. Bo Li*, WIPO Case No. [D2013-1971](#).

The Complainant contends that the fact that the Complainant's trademark is well known and the Respondent has no legitimate interest in the Disputed Domain Name, supports a conclusion that the Disputed Domain Name was registered in bad faith.

Presently, the Disputed Domain Name resolves to an inactive website that states: "This website is inaccessible. Check if the address sanofi.cam is correct. If there is no error, try to diagnose the Windows network". It has been established in many UDRP cases that passive holding under appropriate circumstances falls within the concept of bad faith use of a domain name.

The leading case in this regard is *Telstra Corporative Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), in which the UDRP panel 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 international fame of a complainant's trademarks has supported a finding that passive holding is bad faith use. See also *Action S.A. v. Robert Gozdowski*, WIPO Case No. [D2008-0028](#); and *Mr. Antonino Amaddeo (Reminiscence Diffusion Internationale) against Gas Bijoux SAS / GAS Olivier*, WIPO Case No. [D2012-1831](#).

The international fame of a complainant's trademarks has supported a finding that passive holding is bad faith use. *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

The non-use of the Disputed Domain Name is likely to cause irreparable prejudice to the Complainant's general goodwill because Internet users could be misled to believe that the Disputed Domain Name is connected with the Complainant is not on the Internet or worse that the Complainant is out of business. See *M. Antonino Amaddeo (Reminiscence Diffusion Internationale) v. Gas Bijoux SAS / GAS Olivier, supra*.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has provided clear evidence that it has rights in the trademark SANOFI.

The Disputed Domain Name consists entirely of the Complainant's SANOFI mark and merely adds the gTLD suffix ".cam". The gTLD is irrelevant for purposes of the first element and does not prevent a finding of confusing similarity. See section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Complainant contends that the disputed domain name is confusingly similar. The Panel finds that the Disputed Domain Name is, in fact, identical to the trademark in which the Complainant has rights. The Panel concludes that the Complainant has established the requirements of Policy paragraph 4(a)(i).

B. Rights or Legitimate Interests

The Complainant did not authorize the Respondent to use its name and mark. "In the absence of any license or permission from the Complainant to use its trademark, no actual or contemplated *bona fide* or legitimate use of the Disputed Domain Name could reasonably be claimed." See *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#).

There is no evidence that the Respondent has been identified and is commonly known by the Disputed Domain Name or the Complainant's name and mark. The Respondent has advanced no explanation for using the Complainant's name and mark or any legitimate interests or rights in the Disputed Domain Name.

The Respondent is not using the Disputed Domain Name for any legitimate commercial purpose. It resolves to an inactive website.

The Panel finds that the Complainant has made a *prima facie* case showing that the Respondent does not have rights to or legitimate interests in the Disputed Domain Name, which has not been rebutted by the Respondent. The Panel concludes that the Complainant has established the requirements of Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The Complainant's trademark SANOFI was registered years before the Disputed Domain Name was registered and was registered in many jurisdictions around the world, the Complainant's trademark SANOFI was well known. That, coupled with the passive holding of the Disputed Domain Name supports a finding of bad faith registration.

The Disputed Domain Name merely added the gTLD suffix ".cam" to the Complainant's trademark. The addition is irrelevant. Prior panels have held that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith registration. Section 3.3 of the [WIPO Overview 3.0](#).

The Panel notes that the passive use of the Disputed Domain Name indicates bad faith use by the Respondent, as it could prevent Internet users from contacting the Complainant and finding information about its business.

The Panel finds that the Respondent has registered and is using the Disputed Domain Name in bad faith. The Panel concludes that the Complainant has established the requirements of Policy, paragraph 4(a)(iii).

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, <sanofi.cam>, be transferred to the Complainant.

/Edward C. Chiasson K.C./

Edward C. Chiasson K.C.

Sole Panelist

Date: July 17, 2023