

ADMINISTRATIVE PANEL DECISION

Sanofi v. Mayank Sharma

Case No. D2023-2262

1. The Parties

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

The Respondent is Mayank Sharma, India.

2. The Domain Name and Registrar

The disputed domain name <ambienstow.com> is registered with Internet Domain Service BS Corp (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 24, 2023. On May 25, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 27, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on June 1, 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 June 5, 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 June 8, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 28, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 29, 2023.

The Center appointed Anna Carabelli 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 multinational pharmaceutical company that engages in research and development, manufacturing and marketing of pharmaceutical products for sale, both in the prescription and over the counter markets. Settled in more than 100 countries, the Complainant benefits from a large portfolio of drugs, including a drug for the treatment of insomnia marketed under the trademark AMBIEN.

The Complainant holds registrations for the trademark AMBIEN in various jurisdictions, including:

- French trademark registration N° 93 456 039, registered on February 19, 1993 and duly renewed;
- European Union Trade Mark registration N° 003 991 999, filed on August 17, 2004 and registered on November 28, 2005;
- International trademark registration N° 605 762, registered on August 10, 1993 and duly renewed;
- United States trademark registration N° 74345754 applied on January 5, 1993 and registered on December 7, 1993, and duly renewed)

All of the above trademarks are registered in connection with class 5 of the international classification (*i.e.*, pharmaceutical products.)

The Complainant also owns numerous domain names that comprise of, or contain, the trademark AMBIEN, including the domain names <ambien.com> (registered on April 12, 2000), <ambien.net> (registered on April 12, 2000), <ambien.info> (registered on August 24, 2001), and <ambien.org> (registered on April 12, 2000).

The disputed domain name <ambienstow.com> was registered on May 5, 2023. As shown by the uncontested evidence in the Complaint, it resolves to a website where purported AMBIEN branded medication is offered for sale, along with products from competitors of the Complainant.

5. Parties' Contentions

A. Complainant

The Complainant submits and contends that:

- The disputed domain name is confusingly similar to the Complainant's registered and well-known AMBIEN mark because it consists of its trademark in its entirety together with the word "stow" and the generic Top-Level Domain ("gTLD") ".com".
- The Respondent has no rights or legitimate interests in the disputed domain name. The Complainant has not licensed or otherwise permitted the Respondent to use its trademark and has not permitted the Respondent to apply for or use any domain name incorporating the AMBIEN mark. The Respondent is not making a legitimate noncommercial or fair use of the domain name nor is he using the litigious 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. On the contrary, the disputed domain name resolves to an online platform from which consumers can purchase medications. The web page never cites the name of actual pharmaceutical manufacturer of genuine AMBIEN drugs, Sanofi. Consequently, besides using the name "ambien" which is protected, and photographs of AMBIEN products, there is nothing to prevent the proposed drugs from being counterfeit products. Additionally, the Respondent's website appears to offer competing products for sale, associating the image of these products with that of AMBIEN drugs.

When registering the disputed domain name, the Respondent had failed to indicate his identity, and this is a further indicator of an absence of legitimate interest as it does for bad faith registration and use.

- The disputed domain name was registered in bad faith. Given the famous and distinctive nature of the trademark “AMBIEN”, consistently recognized by numerous UDRP panel decisions, the Respondent is likely to have had, at least, constructive, if not actual notice, as to the existence of Complainant’s mark at the time he registered the disputed domain name.
- The disputed domain name is being used in bad faith. The disputed domain name resolves to a website which is not the official website of Complainant’s products, which fact suggests an intent to gain unfair benefit of the Complainant’s goodwill and reputation and to create a likelihood of confusion with the Complainant’s trademark AMBIEN as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website and the products displayed/advertised for sale on it. Furthermore, the Respondent has registered and used the disputed domain name for the purpose of disrupting the Complainant’s business, by offering for sale presumably counterfeit products and competing products, which constitutes further evidence of its bad faith.

Based on the above, 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

Paragraph 15(a) of the Rules instructs the panel to decide the complaint based on the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Under 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 respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

Paragraph 4(b) of the Policy sets out four illustrative circumstances, which for the purposes of paragraph 4(a)(iii) of the Policy, shall be evidence of registration and use of a domain name in bad faith.

Paragraph 4(c) of the Policy sets out three illustrative circumstances any one of which, if proved by the respondent, shall be evidence of the respondent’s rights to or legitimate interests in a disputed domain name for the purpose of paragraph 4(a)(ii) of the Policy above.

A. Identical or Confusingly Similar

The Panel finds that the Complainant has established rights over the trademark AMBIEN based on the evidence submitted in the Complaint.

The disputed domain name consists of the Complainant’s trademark AMBIEN with addition of the word “stow”, followed by the “gTLD “.com”.

The addition of the gTLD such as “.com” is viewed as a standard registration requirement and as such is typically disregarded under the first element confusing similarity test (see section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

Therefore, the relevant comparison to be made is with the second-level portion of the disputed domain name, *i.e.*, “ambienstow”. The threshold test for confusing similarity typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark (*i.e.*: “ambienstow”) to assess whether the mark is recognizable within the disputed domain name (see section 1.7 of the [WIPO Overview 3.0](#)). The disputed domain name entirely incorporates the Complainant’s mark AMBIEN and this is a sufficient element to establish confusing similarity, as held by previous UDRP panels (*e.g.*, *Banca Mediolanum S.p.A. v. Domains By Proxy, LLC / Marzia Chiarello*, WIPO Case No. [D2020-1955](#); *Virgin Enterprises Limited v. Domains By Proxy LLC, Domainsbyproxy.com / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2020-1923](#); *Patagonia, Inc. v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2019-1409](#)).

As recorded in section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element. This Panel finds that the addition of the word “stow” does not prevent a finding of confusing similarity.

Accordingly, the Panel finds that disputed domain name is confusingly similar to a mark in which the Complainant has rights. Therefore, the Complainant has established paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, a respondent may demonstrate its rights or legitimate interests in a domain name by showing any of the following circumstances, in particular but without limitation:

- (i) before any notice to it of the dispute, its use of, or demonstrable preparation to use the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods and services;
- (ii) it has been commonly known by the domain name, even if it has acquired no trademark or service mark rights;
- (iii) it is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name, based on the following: (a) the Complainant holds prior rights in the globally registered and well-known AMBIEN mark, (b) the Respondent has not been authorized to use the Complainant’s trademark in any way, and (c) the disputed domain name directs to an online pharmacy offering for sale AMBIEN branded medications (of which photographs are displayed without mentioning the name of the original manufacturer, Sanofi), along with competing products.

According to section 2.1 of the [WIPO Overview 3.0](#), while the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

Here the Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. By not submitting a response, the Respondent has failed to invoke any circumstance, which could have demonstrated any rights or legitimate interests in the disputed domain name under paragraph 4(c) of the Policy.

The disputed domain name is composed of the Complainant's distinctive trademark, along with the addition of "stow". The composition of the disputed domain name carries a risk of implied affiliation to the Complainant, contrary to the fact, which cannot constitute fair use. The Respondent has used the confusingly similar disputed domain name in a manner that increased the risk of implied affiliation found in the composition of the disputed domain name, by associating the website found at the disputed domain name with an offering of AMBIEN branded products and other medications from the Complainant's competitors. While the Complainant has pointed to the fact that the name of the original manufacturer Sanofi is not cited, to reflect the potential counterfeit nature of the AMBIEN branded products offered for sale, the Panel needs not come to a determination on the nature of the products being offered, noting that the website at the disputed domain name displays photographs of AMBIEN branded tablets and reflect no information concerning the websites' relationship (lack thereof) to the Complainant. See sections 2.8 and 2.13.2 of the [WIPO Overview 3.0](#). Further to the so-called "Oki Data test" enshrined in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), even if the goods offered at the website to which the disputed domain name resolves were of a genuine nature, the disputed domain name cannot constitute fair use given its lack of disclaimers.

The Panel concludes that the Respondent deliberately chose to include the Complainant's AMBIEN trademark in the disputed domain name, in order to achieve commercial gain by misleading third parties, and that such use cannot be considered as a legitimate noncommercial or fair use.

Based on the above, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name and the Complainant has satisfied the requirement under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must establish that the disputed domain name has been registered and used in bad faith. Paragraph 4(b) of the Policy provides a non-exhaustive list of circumstances indicating bad faith registration and use on the part of a domain name registrant, which includes: "(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location."

In the present case, both the registration and use of the disputed domain name in bad faith can be found pursuant to the above referenced paragraph 4(b)(iv).

Considering the fact that the AMBIEN mark is well known (as recognized by prior UDRP decisions - see among others, *SANOFI v. Whois Privacy Service / Wyatt Henry* WIPO Case No. [D2019-2826](#), *Sanofi v. Whois Agent, Whois Privacy Protection Service, Inc. / Jim Moretta* WIPO Case No. [D2016-0096](#), *Sanofi-Aventis v. N/A*, WIPO Case No. [D2009-0705](#)), the Panel finds that it would be inconceivable that the Respondent might have registered the disputed domain name without knowing of it. The circumstances of the case indicate that the Respondent has registered and used the disputed domain name primarily for the purpose of selling or advertising AMBIEN products of unknown origin and quality. Such fact suggests that the disputed domain name was registered in bad faith (see [WIPO Overview 3.0](#), section 3.2.2) and that the Respondent targeted the AMBIEN mark with a deliberate intent to create an impression of an association with the Complainant and to attract Internet users for the very purpose of capitalizing on the reputation of the trademark by diverting Internet users for commercial gain. Internet users who encounter the website to which the disputed domain name resolve may believe that they are dealing with the Complainant, or with a website somehow endorsed, authorized, or operated by the Complainant (see section 3.1.4 of the [WIPO Overview 3.0](#)).

Based on the above, the Panel finds that the Complainant has established also 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 <ambienstow.com> be transferred to the Complainant.

/Anna Carabelli/

Anna Carabelli

Sole Panelist

Date: August 4, 2023