

ADMINISTRATIVE PANEL DECISION

Sanofi v. Laurent PETERS

Case No. D2023-3199

1. The Parties

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

The Respondent is Laurent PETERS, Belgium.

2. The Domain Name and Registrar

The disputed domain name <sanofi-be.com> is registered with Hostinger, UAB (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 25, 2023. On July 25, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 26, 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 (Domain Admin, Privacy Protect, LLC (PrivacyProtect.org)) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 26, 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 amended Complaint on July 26, 2023.

The Center verified that the Complaint together with the amended 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 August 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 22, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 24, 2023.

The Center appointed Rodrigo Azevedo as the sole panelist in this matter on August 30, 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 one of the world's largest pharmaceutical companies, developing, manufacturing, distributing and selling a wide variety of pharmaceutical products under the trademark and trade name SANOFI.

The Complainant registered the SANOFI trademark in multiple jurisdictions throughout the world, since at least 1988, such as SANOFI French trademark number 1482708, registered on August 11, 1988.

The Complainant also owns and operates several domain names incorporating its SANOFI mark, such as <sanofi.com> (registered in 1995) and <sanofi.eu> (registered in 2006).

The disputed domain name was registered by the Respondent on June 19, 2023.

The disputed domain name does not resolve to any active website.¹

5. Parties' Contentions

A. Complainant

The Complainant makes the following contentions:

- The disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The disputed domain name reproduces the SANOFI trademark, which does not have any particular meaning and is therefore highly distinctive. The disputed domain name comprises: (a) an exact reproduction of the Complainant's trademark; (b) combined with a geographic term; and (c) followed by the generic Top-Level ("gTLD") domain ".com". It is well established that the gTLD designation used as part of a domain name should be disregarded as it does not serve to distinguish it. It is also well established that where a domain name wholly incorporates a Complainant's distinctive trademarks in its entirety, it is confusingly similar to that mark despite the addition of a word. It can only be found that the Respondent selected the disputed domain name in a specific attempt of free-riding on the coat tails of the fame of the Complainant's SANOFI trademark, regardless of the adding of the word "be". It must be taken into account that the likelihood of confusion is ascertained by the reputation of the Complainant's trade name, trademarks, domain names and more generally speaking goodwill.

- The Respondent has no rights or legitimate interests in respect of the disputed domain name. The word "sanofi" has no particular meaning and is therefore highly distinctive. The Complainant has never licensed or otherwise authorized the Respondent to use its trademarks or to register any domain name including the SANOFI trademark. There is no relationship whatsoever between the parties and the Respondent has clearly modified the Complainant's trademarks for its own use and incorporated them into the disputed domain name without the Complainant's authorization. The Respondent 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, given that the disputed domain simply refers to an inactive webpage.

¹ Further to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.8, "[n]oting in particular the general powers of a panel articulated inter alia in paragraphs 10 and 12 of the UDRP Rules, it has been accepted that a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision...This may include visiting the website linked to the disputed domain name in order to obtain more information about the respondent or its use of the disputed domain name...".

- The disputed domain name was registered and is being used in bad faith. Panel decisions regularly recognize opportunistic bad faith in cases in which the disputed domain name appears confusingly similar to a complainant's well-known trademark. Given the famous and distinctive nature of the mark SANOFI, the Respondent is likely to have had, at least, constructive, if not actual notice, as to the existence of the Complainant's mark at the time he registered the disputed domain name. The disputed domain name has obviously been registered for the purpose of creating a likelihood of confusion – or at least an impression of association – with the Complainant's trademark. It has been established in many UDRP cases that passive holding under the appropriate circumstances falls within the concept of the domain name being used in bad faith. The lack of use of the disputed domain name particularly close to those used by the Complainant is likely to cause irreparable prejudice to their general goodwill because Internet users could be led to believe that the Complainant is not on the Internet or worse that the Complainant is out of business.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of the disputed domain name, a complainant shall prove the following three elements:

- (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.

A. Identical or Confusingly Similar

The Panel has no doubt that "sanofi" is a term directly connected with the Complainant's trademarks and pharmaceutical products.

Annex 8 to the Complaint shows trademark registrations for SANOFI that date as early as 1988.

The disputed domain name contains the mark SANOFI in its entirety.

The disputed domain name differs from the Complainant's trademark SANOFI merely by the addition of a hyphen ("-") and of the suffix "be", as well as of the gTLD extension ".com".

Previous UDRP decisions have found that the mere addition of symbols (such as a hyphen) or geographical terms (such as the acronym "be", which is a common acronym for Belgium or Benelux) to a trademark in a domain name does not avoid a finding of confusing similarity (see, e.g., *BHP Billiton Innovation Pty Ltd v. Oloyi*, WIPO Case No. [D2017-0284](#); and *Allianz SE v. IP Legal, Allianz Bank Limited*, WIPO Case No. [D2017-0287](#)).

Finally, it is also already well established that the addition of a gTLD such as ".com" is typically irrelevant when determining whether a domain name is confusingly similar to a complainant's trademark.

As a result, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademarks, and that the Complainant has satisfied the first element of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides some examples without limitation of how a respondent can demonstrate rights or legitimate interests in a domain name:

- (i) before receiving any notice of the dispute, the respondent used or made demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the disputed domain name; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark at issue.

Based on the Respondent's default and on the *prima facie* evidence in the Complaint, the Panel finds that the above circumstances are not present in this particular case and that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has not licensed or authorized the usage of its trademarks to the Respondent, and it does not appear from the present record that the Respondent is commonly known by the disputed domain name.

The Panel notes that the present record provides no evidence to demonstrate the Respondent's intent to use or to make preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services. Indeed, the Respondent has not provided any justification for adopting in the disputed domain name the peculiar expression "sanofi-be", which reproduces the Complainant's famous SANOFI trademark.

Consequently, the Panel is satisfied that the Respondent has no rights or legitimate interests in the disputed domain name, and the Complainant has proven the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states that the following circumstances in particular, but without limitation, shall be evidence of registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) the respondent registered the disputed domain name in order to prevent the owner of the trademark 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 disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the disputed 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 its website or location or of a product or service on its website or location.

When the disputed domain name was registered by the Respondent (in 2023) the trademark SANOFI was already well-known worldwide and directly connected to the Complainant's financial services.

According to the [WIPO Overview 3.0](#), section 3.1.4, UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith. This is even more evident when the brand in question is a coined term, with no dictionary meaning.

Therefore, the Panel concludes that it would not be feasible to consider that the Respondent - at the time of the registration of the disputed domain name - could not have been aware of the Complainant's famous SANOFI trademark, as well as that the adoption of the expression "sanofi-be" together with the gTLD ".com" could not be a mere coincidence.

Actually, the Panel considers that in the present case the addition to the Complainant's trademark of the term "-be" may even enhance the risk of confusion, suggesting that it is the Complainant's official website in Belgium or Benelux.

UDRP panels have frequently found that the apparent lack of so-called active use of the disputed domain name (passive holding) does not prevent a finding of bad faith. See [WIPO Overview 3.0](#), section 3.3; *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); and *Polaroid Corporation v. Jay Strommen*, WIPO Case No. [D2005-1005](#).

The non-collaborative posture of the Respondent, *i.e.*, (a) not presently using the disputed domain name, (b) not indicating any intention to use it, and (c) not at least submitting a Response to this procedure or providing justifications for the use of a famous third party well-known trademark, certainly cannot be used in benefit of the Respondent in this Panel's opinion. Such circumstances, together with (d) the lack of any plausible interpretation for the adoption of the term "sanofi-be" by the Respondent, are enough in this Panel's view to characterize bad faith registration and use in the present case.

Accordingly, the Panel finds that the disputed domain name was registered and used in bad faith, and the Complainant has also satisfied the third element 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 <sanofi-be.com> be transferred to the Complainant.

/Rodrigo Azevedo/

Rodrigo Azevedo

Sole Panelist

Date: September 13, 2023.