

ADMINISTRATIVE PANEL DECISION

Sanofi v. Chri Jdn

Case No. D2023-3800

1. The Parties

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

The Respondent is Chri Jdn, Nigeria.

2. The Domain Name and Registrar

The disputed domain name <sanofipharma.net> is registered with Wild West Domains, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 12, 2023. On September 12, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 13, 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 (Registration Private, Domains By Proxy, LLC DomainsByProxy.com) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 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 amendment to the Complaint on September 26, 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 September 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 18, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 20, 2023.

The Center appointed William A. Van Caenegem as the sole panelist in this matter on November 1, 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 headquartered in Paris. It had consolidated net sales of 37,7 billion euros in 2021 and 36.04 billion euros in 2020. The Complainant is active in more than 100 countries and employs 100,000 people.

The Complainant is the registered owner *inter alia* of French trademark SANOFI No. 96655339, registered on December 11, 1996 in classes 01; 03; 05; 09; 10; 35; 40; 42 notably concerning pharmaceutical products; French trademark No 92412574, registered on March 26, 1992 in class 05 concerning pharmaceutical products; French trademark SANOFI No. 1482708, registered on August 11, 1988 in classes 01; 03; 04; 05; 10; 16; 25; 28; 31 notably concerning pharmaceutical products; European Union trademark SANOFI No. 010167351, filed on August 02, 2011 and registered on January 7, 2012 in classes 03; 05 notably concerning pharmaceutical products; European Union trademark SANOFI No. 004182325, filed on December 08, 2004 and registered on February 9, 2006 in classes 01; 09; 10; 16; 38; 41; 42; 44 notably concerning products in pharmaceutical and medical spheres; European Union trademark SANOFI No. 000596023, filed on July 15, 1997 and registered on February 1, 1999 in classes 03; 05 notably concerning pharmaceutical products; International trademark SANOFI No. 1092811, registered on August 11, 2011 in classes 01; 09; 10; 16; 38; 41; 42; 44 notably concerning products in pharmaceutical and medical spheres, and designating among others Australia, Georgia, Japan, Republic of Korea, Cuba, the Russian Federation, and Ukraine; and International trademark SANOFI No. 1094854, registered on August 11, 2011 in classes 03; 05 notably concerning pharmaceutical products, and designating among others Australia, Georgia, Japan, Republic of Korea, Cuba, the Russian Federation, Ukraine and Iceland; International trademark SANOFI No 674936, registered on June 11, 1997 in classes 03; 05 notably concerning pharmaceutical products and designating among others Switzerland, Cuba, Romania, the Russian Federation, and Ukraine; United States of America trademark SANOFI No. 85396658, filed on August 12, 2011 and registered on July 24, 2012 in class 05 notably concerning pharmaceutical products; and United Kingdom trademark SANOFI No. UK00001483425, filed on November 21, 1991 and registered on January 15, 1993 in class 05 notably concerning pharmaceutical preparations.

The Complainant also operates websites resolving to domain names including <sanofi.com> and numerous country specific domain names.

The disputed domain name was registered on August 21, 2023 and resolves to a parking page.

5. Parties' Contentions

A. Complainant

The Complainant notes that all of the above-mentioned trademarks and domain names, registered around the world and containing the distinctive word "Sanofi" have registration dates prior to the registration of the disputed domain name here.

The Complainant further notes that the disputed domain name reproduces its distinctive mark SANOFI, which has no inherent meaning, in its entirety. The Complainant points to the fact that it has used its trade name for over 40 years and invested substantial financial resources over the years to advertise and promote the company and its SANOFI trademarks in countries all over the world, including the United States.

The Complainant says that the reproduction of its trademarks as the dominant part of the disputed domain name makes the latter confusingly similar to the prior registered abovementioned trademarks, and this is irrespective of the additions 'pharma' and '.net'. The additions are to be disregarded as it is, according to the Complainant, well established that where it wholly incorporates the Complainant's distinctive trademark in its entirety, the disputed domain name is confusingly similar to that mark despite the addition of a word.

The Complainant maintains that the Respondent must have selected the disputed domain name so as to free ride on the Complainant's reputation vested in the SANOFI mark. It says the likelihood of confusion is further enhanced by the fact that its SANOFI mark is well-known, something that has been recognised as such by previous UDRP panels, it says.

The Complainant further alleges that the Respondent has no legitimate interests or rights in the disputed domain name as the Respondent's name has no resemblance to SANOFI which itself is highly distinctive and devoid of inherent meaning. It says the Respondent has no prior rights that justify its adoption of a well-known trademark belonging to a third party. The Respondent was never authorised by the Complainant to use its trademark SANOFI or incorporate it in a domain name for registration. The disputed domain name also resolves to a parking site and therefore, the Complainant asserts, the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name nor is he using it 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. Using a domain name to lead Internet users to a parking page is not legitimate noncommercial use, as Panels have previously held, the Complainant maintains.

Then the Complainant points to multiple past UDRP decisions that recognized opportunistic bad faith in cases in which the disputed domain name appears confusingly similar to a Complainant's well-known trademark, and hence the disputed domain name was registered and used in bad faith. The Complainant says that the inclusion of SANOFI in the particular domain name by the Respondent cannot be coincidental. The Respondent's name has no connection with the terms incorporated in the disputed domain name,. Further the latter maintains that 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 marks at the time he registered the domain name. This suggests that the Respondent acted with opportunistic bad faith in registering the disputed domain name, in order to make an illegitimate use of it. The disputed domain name is said to have been created for the purpose of generating if not confusion then at least a misleading impression of association with Sanofi, one of the largest pharmaceutical companies in the world. What the Complainant refers to as the well-known character of the SANOFI mark itself points to bad faith in the registration and use of the disputed domain name which incorporates that mark.

The Complainant concludes that it can only be held that the Respondent was undoubtedly aware of the risk of deception and confusion that would inevitably arise from the registration of the disputed domain name since it would lead Internet users searching for official information on SANOFI products to pages unconnected with the Complainant. This knowledge confirms the Respondent's bad faith in registering the disputed domain name.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The disputed domain name is not identical to the SANOFI registered trademark of the Complainant, but that mark is recognizable within it. This is sufficient to satisfy the first element, as has been consistently held by previous panels.

Therefore, the Panel holds that the disputed domain name is confusingly similar to the SANOFI registered mark of the Complainant.

B. Rights or Legitimate Interests

The Respondent has not replied to the contentions of the Complainant and has not made a case for the recognition of rights or legitimate interests in its name. The Respondent has also not been authorized to use the SANOFI trademark in any way, nor to incorporate it in any domain name. There is nothing before the Panel to indicate that the Respondent has ever used the SANOFI mark in a legitimate commercial manner or endeavor, and the name of the Respondent does not in any way resemble the term SANOFI. The disputed domain name does not resolve to an active website, nor is there any evidence of preparations for such a use. There is thus nothing that would support the legitimacy of its acquisition and actual or potential use and in the circumstances the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests, which is sufficient for present purposes. The SANOFI trademark of the Complainant is highly distinctive and very widely known with a legally protected reputation in many countries, and it is thus in any case very difficult to imagine any legitimate use and a fortiori a use that would result in the recognition of rights or legitimate interests in a party in no manner connected to the Complainant.

Therefore, the Panel holds that the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

The registered trademark SANOFI has for many years been used in commerce by one of the very largest pharmaceutical companies in the world, and that in many jurisdictions. When the Respondent registered the disputed domain name it is fanciful to imagine that he was not aware of SANOFI as a trademark or that the Complainant had exclusive rights in it. In any case a quick Internet or register check would have revealed the Complainant's proprietary rights. The deliberate inclusion of the term 'pharma' in the disputed domain name further implies that the Respondent was perfectly aware of the SANOFI mark and what it stands for in commerce. It can be inferred that the Respondent knew full well that there was a connection between SANOFI and the pharmaceuticals sector, and that he would have been aware of his own total lack of rights in that mark. Nonetheless he registered the disputed domain name. In terms of use in bad faith, it is almost impossible to conceive of any use of this particular domain name that would not deceive and mislead consumers into thinking it was properly connected with the Complainant. The inclusion of the trademark is suggestive enough, and the addition of the term "pharma" further reinforces that false impression.

Therefore, the Panel holds that the disputed domain name was registered and used in bad faith.

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 <sanofipharma.net> be cancelled.

/William A. Van Caenegem/

William A. Van Caenegem

Sole Panelist

Date: November 15, 2023