

ADMINISTRATIVE PANEL DECISION

Sanofi v. Jitendra Kumar Mishra

Case No. D2024-0888

1. The Parties

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

The Respondent is Jitendra Kumar Mishra, India.

2. The Domain Name and Registrar

The disputed domain name <sanofistore.com> is registered with Dreamscape Networks International Pte Ltd (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on February 29, 2024. On February 29, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 1, 2024, 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 Administrator) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 11, 2024, 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 March 14, 2024.

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 March 15, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 4, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on April 8, 2024.

The Center appointed Debrett G. Lyons as the sole panelist in this matter on April 16, 2024. 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 factual findings pertinent to the decision in this case are that:

1. the Complainant is a French multinational pharmaceutical company providing goods and services under the trademark, SANOFI;
2. the Complainant is the owner of, inter alia, European Union Intellectual Property Office (“EUIPO”) trademark Reg. No. 010167351, filed August 2, 2011, registered January 7, 2012, for SANOFI; and
3. the disputed domain name was registered on December 23, 2023, and is not in use.

5. Parties’ Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a cancellation of the disputed domain name.

In particular, the Complainant asserts trademark rights in SANOFI and submits that the disputed domain name is identical or confusingly similar to its trademark.

The Complainant alleges that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant has not authorized the Respondent to use its trademark or register any domain name incorporating the trademark. The Respondent has no trademark rights of its own. Finally, the disputed domain name is not in use.

The Complainant submits that the notoriety of the trademark and the absence of any reasonable likelihood of good faith use raises the inference that the Respondent registered and passively holds the disputed domain name in bad faith.

The Complainant petitions the Panel to order cancellation of the disputed domain name.

B. Respondent

The Respondent did not reply to the Complainant’s contentions. Whilst the Complaint states that “[t]he Respondent provided an implausible explanation of the intended use of the disputed domain names”, this statement appears to be the vestige of an earlier complaint filed by the Complainant and has been ignored.

6. Discussion and Findings

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a two-fold enquiry – a threshold investigation into whether a complainant has rights in a trademark, followed by an assessment of whether the disputed domain name is identical or confusingly similar to the trademark.

Paragraph 4(a)(i) of the Policy does not distinguish between registered and unregistered trademark rights. The Complainant relies on both common law and statutory trademark rights in SANOFI. For simplicity, the

Panel notes that a trademark registered with a national or pan-national authority is evidence of trademark rights for the purposes of the Policy.¹ The Complainant provides evidence of its EUIPO registration of the trademark and so the Panel finds that the Complainant has trademark rights.

The Complaint observes that the disputed domain name “comprises: (a) an exact reproduction of the Complainant’s trademark; (b) combined with a descriptive term and (c) followed by a top-level domain suffix <.com>.” The Panel finds that the generic Top-Level Domain (“gTLD”) “.com” can be disregarded for the purposes of comparing the disputed domain name with the trademark.² Thereafter, the disputed domain name appends the descriptive/generic word “store” to the trademark. The Panel finds that the added term is wholly non-distinctive within the context of the Complainant’s business and does not differentiate the disputed domain name from the trademark. The Panel finds that the disputed domain name is confusingly similar to the trademark.

The Panel accordingly finds that the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy states that any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate rights or legitimate interests to a domain name for purposes of paragraph 4(a)(ii) of the Policy:

“(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are 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 need only make out a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name, after which the onus shifts to the Respondent to rebut that case by demonstrating those rights or interests.³

The name of the underlying domain name owner as disclosed by the Registrar does not carry any suggestion that the Respondent might be commonly known by the disputed domain name. The Complainant states that it has not authorized use of the trademark and there is no evidence that the Respondent has any trademark rights of its own. Finally, the disputed domain name is not in use.

It follows that a prima facie case has been made that the Respondent has no rights or interests in the disputed domain name (see section 2.1 of the [WIPO Overview 3.0](#)).

The onus shifts to the Respondent. In the absence of a Response, the Panel finds that the Respondent has not discharged the onus and finds the Respondent has no rights or interests.

The Complainant has satisfied the second limb of the Policy.

¹See section 1.2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

²See section 1.11.1 of the [WIPO Overview 3.0](#).

³See, for example, *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#).

C. Registered and Used in Bad Faith

The Complainant must prove on the balance of probabilities both that the disputed domain name was registered in bad faith and used in bad faith.

Further guidance on that requirement is found in paragraph 4(b) of the Policy, which sets out four circumstances, any one of which is taken to be evidence of the registration and use of a domain name in bad faith if established.

The four specified circumstances are:

“(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the 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 the respondent’s documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has registered the 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 Respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, respondent has intentionally attempted to attract, for commercial gain, internet users to respondent’s 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 the respondent’s website or location or of a product or service on the site or location.”

The Panel finds nothing to support the application of any of the paragraph 4(b) scenarios in this case. Accordingly, the Complainant must establish, as separate matters, registration in bad faith and use in bad faith.

The Complainant states that it operates in more than 100 countries, employing 100,000 people. It is the world’s 4th largest pharmaceutical company by prescription sales with consolidated net sales of 43 billion euros in 2022, the year before registration of the disputed domain name. Further, that numerous UDRP panels have recognized that SANOFI is a well-known mark. ⁴

Absent a Response, the Panel shall draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel finds that the Complainant and its trademark are well-known and draws the reasonable inference that the disputed domain name was registered in bad faith. There is nothing to suggest that the Respondent could have a legitimate expectation to use the trademark in a good faith manner. The Panel treats the residual issue of use in bad faith in line with the leading case of *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). The panelist there posed the question: “what circumstances of inaction (passive holding) other than those identified in paragraphs 4(b)(i), (ii) and (iii) can constitute a domain name being used in bad faith?”, concluding that “the question can only be answered in respect of the particular facts of a specific case”, whereafter he paid regard to circumstances showing that (i) the complainant’s trademark was widely known, (ii) the respondent had provided no evidence of any actual or contemplated good faith use by it of the domain name, (iii) the respondent has taken active steps to conceal its identity and had provided false contact details, and (iv) it was not possible to conceive of any plausible use of the domain name by the respondent that would not be illegitimate in the sense of infringing complainant’s rights.

⁴See, for example, *Sanofi v. Domain Admin*, Whoisprotection.cc / Jose Flora, Waeco mart ltd, WIPO Case No. [D2021-1857](#); *Sanofi v. Aamir Hitawala*, WIPO Case No. [D2021-1781](#); and *Sanofi v. Yansheng zhang, GNAME.COM PTE. LTD*, WIPO Case No. [D2021-1751](#).

All of those considerations are satisfied. Following the *Telstra Corporation Limited v. Nuclear Marshmallows* case, the Panel finds passive holding and “use” in bad faith and so finds that the Complainant has satisfied the third and final 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 <sanofistore.com> be cancelled.

/Debrett G. Lyons/

Debrett G. Lyons

Sole Panelist

Date: April 30, 2024