

ADMINISTRATIVE PANEL DECISION

Sanofi v. JN MLOTSHWA, COY
Case No. D2024-1159

1. The Parties

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

The Respondent is JN MLOTSHWA, COY, South Africa.

2. The Domain Name and Registrar

The disputed domain name <sanofie.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 18, 2024. On March 18, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 18, 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 (Redacted for Privacy, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 19, 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 20, 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 21, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 10, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 18, 2024.

The Center appointed Gary Saposnik as the sole panelist in this matter on April 23, 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 Complainant is a French multinational pharmaceutical company headquartered in Paris, in France and founded in 1973. It is ranked as the world's 4th 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.

Historically, the Complainant company was formed as Sanofi-Aventis in 2004 by the merger of Aventis and Sanofi-Synthelabo, and changed its name to Sanofi in May 2011. It is located in more than 100 countries and employs 100,000 people, including a presence in South Africa. It had consolidated net sales of EUR 43 billion in 2022, and EUR 37.7 billion in 2021.

The Complainant is the owner of SANOFI trademarks, including the following registered trademarks:

- French trademark SANOFI, number 96655339, registered on December 11, 1996 in classes 01, 03, 05, 09, 10, 35, 40, 42, concerning pharmaceutical products.
- European Union trademark SANOFI, number 004182325, registered on February 9, 2006 in classes 01, 09, 10, 16, 38, 41, 42, 44 concerning products and services in pharmaceutical and medical spheres.
- International trademark SANOFI, number 674936, registered on June 11, 1997 in classes 03, 05, concerning pharmaceutical products, and designating among others Switzerland, Cuba, Romania, Russia, Ukraine.
- United States of America ("United States") trademark SANOFI, number 85396658, registered July 24, 2012 in class 05, concerning pharmaceutical products.

The Complainant is the registrant of the domain name <sanofi.com> registered on October 13, 1995, which resolves to a website promoting its products and services. It is also the registrant of a number of other "Sanofi" domain names in other Top-Level Domains "TLDs", including generic and country code domains.

The disputed domain name was registered on August 3, 2023, and it does not resolve to an active website.

5. Parties' Contentions

A. Complainant

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

Notably, the Complainant contends that it is the owner of the SANOFI trademark, having registered the trademark in the United States, Europe, and Internationally. The disputed domain name is confusingly similar to the SANOFI mark as it reproduces the SANOFI mark in its entirety and adds the mute letter "e" which does not change the phonetics of the trademark. The likelihood of confusion is particularly true when the registered trademark is well known, as is the SANOFI mark. The addition of the vowel "e" is insufficient to alleviate the likelihood of confusion with the Complainant's mark.

The Registrant does not have any rights or legitimate interests in the disputed domain name. The Complainant has not granted any license or authorization for the Respondent to use the SANOFI trademark, and there is no relationship whatsoever between the parties. Furthermore, the Respondent is not commonly known by the SANOFI trademark, nor does it use the disputed domain name for a bona fide purpose or legitimate noncommercial purpose. The subject domain name does not resolve to an active webpage.

The disputed domain name was registered and is being used in bad faith. There is no plausible circumstance under which the Respondent could legitimately use the disputed domain name other than in bad faith. Based on the well-known and famous reputation of the distinctive SANOFI trademark, the

Respondent must have been aware of the Complainant's trademark at the time of registration. The Respondent's passive holding of the disputed domain name amounts to use in opportunistic bad faith. The lack of use of the disputed domain name that is particularly close to those used by the Complainant is likely to cause irreparable prejudice to the general goodwill of the Complainant's mark, as Internet users could be led to believe that the Complainant is not on the Internet, or worst, that the Complainant is out of business.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. The addition of the phonetically muted "e" in the disputed domain name is an intentional misspelling which does not negate the confusing similarity to the Complainant's mark. [WIPO Overview 3.0](#), section 1.9.

Although the addition of other terms, here an "e", may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

- Before any notice to the Respondent of the dispute, the Respondent did not use, nor has it made any demonstrable preparations to use the disputed domain name in connections with a bona fide offering of goods or services. [WIPO Overview 3.0](#), section 2.2.
- The Respondent has not been commonly known by the domain name. [WIPO Overview 3.0](#), section 2.3.
- The Respondent is not 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 or service mark at issue. [WIPO Overview 3.0](#), section 2.4.

Based on the totality of the available record, the Panel finds that the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent has registered the disputed domain name many years after the Complainant registered its SANOFI trademark in many countries around the world. The Complainant has also registered the SANOFI mark in numerous generic and country code extensions prior to the registration of the disputed domain name.

Based on the record, the Panel finds that there is no evidence of any use or demonstrable preparations to use the disputed domain name. This Panel is in concurrence with prior Panels that have found that the SANOFI trademark is well-known and famous. There is no plausible circumstance under which the Respondent could legitimately use the disputed domain name other than in bad faith.

Panels have found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness and the well-known reputation of the Complainant’s trademark, and the composition of the disputed domain name merely adding a mute “e” to the Complainant’s SANOFI trademark, the Respondent’s lack of response to the Complaint and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

The Panel finds that the Complainant has established 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 <sanofie.com> be cancelled.

/Gary Saposnik/

Gary Saposnik

Sole Panelist

Date: May 7, 2024