

ADMINISTRATIVE PANEL DECISION

Sanofi v. Millan Eskimo
Case No. D2024-1466

1. The Parties

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

The Respondent is Millan Eskimo, United States of America.

2. The Domain Name and Registrar

The disputed domain name <sanofir.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 April 8, 2024. On April 8, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 April 9, 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 April 10, 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 April 15, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 5, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 6, 2024.

The Center appointed Alexander Duisberg as the sole panelist in this matter on May 8, 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 one of the largest pharmaceutical companies in the world with operations in more than 100 countries.

The Complainant has rights to the following non exhaustive list of trademarks containing the word “Sanofi” (“SANOFI Trademarks”):

French trademark SANOFI number 1482708, registered on August 11, 1988;
European Union trademark SANOFI number 004182325, registered on February 9, 2006; and
International trademark SANOFI number 1092811, registered on August 11, 2011.

Furthermore, the complainant has registered the following non-exhaustive list of domain names:

<sanofi.com> registered on October 13, 1995;
<sanofi.eu> registered on March 12, 2006 (Annex 9.2); and
<sanofi.us> registered on May 16, 2002.

The disputed domain name <sanofir.com> was registered on March 21, 2024. All trademark registrations as well as the domain name registrations containing the word “sanofi” took place before the registration of the disputed domain name.

The disputed domain name leads to an inactive website.

The Respondent did not reply to the Complaint.

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 disputed domain name <sanofir.com> is confusingly similar to the SANOFI Trademarks. The disputed domain name reproduces the SANOFI Trademarks and adds the letter “r”. The addition of this letter is insufficient to distinguish the disputed domain name from the SANOFI Trademarks. The generic Top-Level Domain (“gTLD”) “.com” is disregarded since the relevant comparison is made with the second-level domain “sanofir”. In addition, the word “Sanofi” has no particular meaning and is therefore highly distinctive.

Furthermore, the Complainant asserts that the Respondent has no legitimate interest regarding the disputed domain name. The Respondent is not affiliated with the Complainant nor authorized by the Complainant in any way to use the SANOFI Trademark. The Respondent is not commonly known by the disputed domain name. Moreover, according to the Complainant, the disputed domain name is inactive, which also indicates a lack of legitimate interests in respect of the disputed domain name.

According to the Complainant, the disputed domain name is also registered and used in bad faith. The Respondent is likely to have had actual knowledge or at least should have had knowledge of the existence of the SANOFI Trademarks. The incorporation of the Complainant’s distinctive and well-known SANOFI Trademarks in combination with the misspelling of these trademarks could only be deemed as an act of bad faith.

Against this background, the Complainant requests that the Panel order the disputed domain name to be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, the Complainant must prove each of the following:

- (i) the disputed domain names are 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 names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

The Panel acknowledges the consensus view – as set forth in paragraph 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the “[WIPO Overview 3.0](#)”) – that the Respondent's default to respond to the Complaint does not automatically result in a decision in favor of the Complainant. The Complainant must establish each of the three elements required by paragraph 4(a) of the Policy. Although the Panel may draw appropriate inferences from the Respondent's default (e.g., to regard factual allegations which are not inherently implausible as being true), paragraph 4 of the Policy requires the Complainant to support its assertions with actual evidence in order to succeed in the UDRP proceeding. In view of the Panel, the Complainant has established sufficient evidence in its favor in the case at hand.

In line with previous UDRP decisions, it is sufficient for the Complainant to make a prima facie showing that the Respondent has no rights or legitimate interests in the disputed domain name in order to shift the burden of production of evidence to the Respondent (see *OSRAM GmbH. v. Mohammed Rafi/Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org*, WIPO Case No. [D2015-1149](#); *B-Boy TV Ltd v. bboytv.com c/o Whois Privacy Service / Chief Rocka LTD, formerly named BreakStation LTD.*, WIPO Case No. [D2012-2006](#); *Wal-Mart Stores, Inc. v. WalMart Careers, Inc.*, WIPO Case No. [D2012-0285](#); *Skipton Building Society v. skiptonassetmanagement.com, Private Registration*, WIPO Case No. [D2011-0222](#); *Evolution AB v. tom scholes*, WIPO Case No. [D2023-2030](#); *Canva Pty Ltd v. JOSE VALDIR DE LIMA*, WIPO Case No. [D2023-1736](#); *Streamotion Pty Ltd v. Ovi Khan*, WIPO Case No. [D2022-3784](#)).

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 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 disputed domain name <sanofir.com> only differs from the Complainant's SANOFI Trademarks by the addition of the letter “r” at the end of the disputed domain name. The similarity test under the UDRP involves a straight forward comparison which besides the visual appearance can also involve aural and phonetic aspects (see [WIPO Overview 3.0](#), Section 1.7). The consideration of aural and phonetic aspects is in line with previous UDRP decisions (see *Wikimedia Foundation, Inc. v. Jorge Navarro*, WIPO Case No. [D2017-1914](#); *H & M Hennes & Mauritz AB v. Simon Maufe, Akinsanya Odunayo Emmanuel and Nelson Rivaldo*, WIPO Case No. [D2014-0225](#)).

The addition of the letter “r” constitutes only minimal phonetic and aural differences when spoken or heard in conjunction with the word “Sanofi”. Furthermore, the addition of the letter “r” only creates a minimal visual difference.

The gTLD (in this case “.com”) is viewed as a standard registration requirement. Hence, the gTLD “.com” is generally ignored when comparing the disputed domain name to the Complainant’s trademark (see *O2 Worldwide v. Domains By Proxy, LLC / Martin Ulbrich* Case, WIPO Case No. [D2020-0033](#)).

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.

The Complainant’s SANOFI Trademarks are well-known and have been registered and used for many years preceding the date of the Respondent’s registration of the disputed domain name. The Complainant has neither authorized the Respondent to use the SANOFI Trademarks nor is the Respondent in whatever manner affiliated with the Complainant.

The Respondent cannot be considered to be making a bona fide offering of goods or services within the meaning of paragraph 4(c)(i) of the Policy referred to above, given that the disputed domain name is currently not being used to lead to an active website. Neither can the Respondent be said to be making a legitimate non-commercial or fair use of the disputed domain name within the meaning of paragraph 4(c)(iii), without any active usage of the disputed domain name (see *Arnold Clark Automobiles Limited v. Whois Agent, Whois Privacy Protection Service, Inc. / Arnold Clark*, WIPO Case No. [D2018-0571](#)). It is highly unlikely that the Respondent is commonly known by the name “Sanofir”. In any case, he has not submitted anything in this regard even though the burden of production has shifted to the Respondent.

The Panel finds 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.

The distinctive and well known character of the SANOFI Trademarks has been well established in prior decisions under the UDRP (*Sanofi v. Name Redacted*, WIPO Case No. [D2023-2322](#); *Sanofi v. Laurent PETERS*, WIPO Case No. [D2023-3199](#)). Therefore, the Panel holds that the Respondent must have been

certainly aware of the Complainant's trademark and the registration of the Complainant's trademark prior to the registration of the disputed domain name.

Panels have found that the non-use of a domain name 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, that the SANOFI Trademarks are highly distinctive. Furthermore, the Respondent failed to submit a response or provide evidence regarding good faith use. Finally, the Respondent is using a privacy service in order to hide his identity (see section 3.6, [WIPO Overview 3.0](#); *Marlette Funding, LLC v. Whois Privacy Corp*, WIPO Case No. [D2018-1907](#); *AB Electrolux v. Domain Admin, Whois Privacy Corp*, WIPO Case No. [D2022-0241](#)). Therefore, the Panel 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 <sanofir.com> be transferred to the Complainant.

/Alexander Duisberg/

Alexander Duisberg

Sole Panelist

Date: May 22, 2024