

ADMINISTRATIVE PANEL DECISION

Sanofi v. Iker CESAT
Case No. D2024-2536

1. The Parties

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

The Respondent is Iker CESAT, France.

2. The Domain Name and Registrar

The disputed domain name <paris-sanofi.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 June 21, 2024. On June 21, 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 June 25, 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 June 28, 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 July 8, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 28, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 31, 2024.

The Center appointed Marie-Emmanuelle Haas as the sole panelist in this matter on August 7, 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, France, ranking 4th world's largest multinational pharmaceutical company by prescription sales.

It 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.

The Complainant is a full member of the European Federation of Pharmaceutical Industries and Associations (EFPIA). Historically, the company was formed as Sanofi-Aventis in 2004 by the merger of Aventis and Sanofi-Synthélabo, and changed its name to Sanofi in May 2011.

The Complainant is a multinational company settled in more than 100 countries on all 5 continents employing around 100,000 people.

The Complainant is a major player in the worldwide pharmaceutical market.

The Complainant is the owner of the following trademarks:

- French trademark SANOFI number 96655339, registered on December 11, 1996 in classes 1; 3; 5; 9; 10; 35; 40; 42 notably concerning pharmaceutical products;
- French trademark SANOFI number 1482708, registered on August 11, 1988 in classes 1; 3; 4; 5; 10; 16; 25; 28; 31 notably concerning pharmaceutical products;
- European Union trademark SANOFI number 000596023, registered on February 1, 1999 in classes 3; 5 notably concerning pharmaceutical products;
- International trademark SANOFI number 674936, registered on June 11, 1997 in classes 3; 5 notably concerning pharmaceutical products and designating among others Switzerland, Cuba, Romania, Russian Federation, Ukraine.

The Complainant relies as well on domain names consisting of the SANOFI trademark, for example, <sanofi.com>.

The disputed domain name was registered on May 29, 2024 using a privacy service. The disclosed data provided by the Registrar shows that it was registered in the name of an individual domiciled in France.

This disputed domain name resolves to an inactive website. The available page provides the following information: "Hum, nous ne parvenons pas à trouver ce site" (we can't find this site).

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.

Notably, the Complainant contends that the reproduction of the Complainant's trademarks as the dominant part of the disputed domain name <paris-sanofi.com> is confusingly similar to the well-known SANOFI trademarks.

The adjunction of the generic and geographical term “paris” does not eliminate the likelihood of confusion with the well-known SANOFI trademark.

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 or, in this case, of descriptive terms.

On the absence of rights or legitimate interests, the Complainant contends that:

The Respondent does not have any legitimate interest on the word SANOFI which 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 above-mentioned trademarks.

The Respondent has no prior rights and/or legitimate interests to justify the use of SANOFI trademarks and domain names.

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, so as to confer a right or legitimate interest in it in accordance with paragraph 4(c)(i) of the Policy given that the disputed domain name website is not used legitimately by the Respondent. Indeed, the disputed domain name website simply resolves to an inactive page.

On the bad faith registration and use:

The Complainant contends that panel decisions regularly recognize opportunistic bad faith in cases in which the contested domain name appears confusingly similar to a Complainant’s well-known trademarks.

It relies on prior UDRP cases concerning the SANOFI trademark and deciding on bad faith.

The registration using a privacy service of the disputed domain name that incorporates a well-known trademark, without any right or legitimate interest is a behavior that should undeniably be deemed sufficient to characterize bad faith registration.

It should be considered that, given the famous and distinctive nature of the mark SANOFI, Respondent is likely to have had, at least, constructive, if not actual notice, as to the existence of Complainant’s marks at the time he registered the disputed domain name. This suggests that the Respondent acted with opportunistic bad faith in registering the domain name in order to make an illegitimate use of it.

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.

It relies on the leading case in this regard, which is *Telstra Corporative Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), in which the panelist found that in order to establish that the respondent was using a domain name in bad faith it was not necessary to find that he had undertaken any positive action in relation to the domain name.

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 Complainant is not on the Internet or worse, that 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

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

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.

Although the addition of other terms here, "paris", 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

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights or legitimate interests in the disputed domain name by demonstrating any of the following:

- (i) before any notice to it of the dispute, the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to 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, even if it has acquired no trademark or service mark rights; 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 or service mark at issue.

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 Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out examples of circumstances that will be considered by a Panel to be evidence of bad faith registration and use of the disputed domain name.

It provides that:

For the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent has registered, or the respondent has 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 the 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, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's 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 the respondent's website or location or of a product or service on the respondent's website or location.

In the present case, the Panel is of the opinion that the Respondent, who is an individual domiciled in France, was well-aware of the Complainant's rights on the well-known SANOFI trademark when it decided to register the disputed domain name, which amounts to registration in bad faith. [WIPO Overview 3.0](#), section 3.2.2.

It chose to add the geographical term "paris" where the Complainant has its headquarters, what shows that it directly targeted the Complainant.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

The current non-use of the disputed domain name does not prevent a finding of bad faith use.

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. [WIPO Overview 3.0](#), section 3.3. 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). In this case, the Panel notes the distinctiveness and the reputation of the Complainant's trademark, and the

composition of the disputed domain name, 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.

Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes 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 <paris-sanofi.com> be cancelled.

/Marie-Emmanuelle Haas/

Marie-Emmanuelle Haas

Sole Panelist

Date: August 16, 2024