

ADMINISTRATIVE PANEL DECISION

Sanofi v. Sanofi SAS
Case No. D2024-3026

1. The Parties

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

The Respondent is Sanofi SAS, France.

2. The Domain Name and Registrar

The disputed domain name <sanofi-it.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 July 25, 2024. On July 25, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 25, 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) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 26, 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 July 29, 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 August 5, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 25, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 27, 2024.

The Center appointed Nathalie Dreyfus as the sole panelist in this matter on September 2, 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 Sanofi, a leading French multinational pharmaceutical company, headquartered in Paris, ranking 4th globally by prescription sales. With consolidated net sales reaching EUR 43 billion in 2022, the company operates in over 100 countries, employing 100,000 people. Sanofi focuses on research, development, manufacturing, and marketing of both prescription and over-the-counter medications. Sanofi holds leading positions in seven key therapeutic areas, including cardiovascular, oncology, and vaccines, and is a full member of the European Federation of Pharmaceutical Industries and Associations.

The Complainant owns several trademarks around the world, namely:

- France trademark SANOFI number 1482708, dated August 11, 1988, in classes 1, 3, 4, 5, 10, 16, 25, 28, and 31
- European Union trademark SANOFI number 004182325, dated February 9, 2006, in classes 1, 9, 10, 16, 38, 41, 42, and 44
- International trademark SANOFI number 1092811, dated August 11, 2011, in classes 1, 9, 10, 16, 38, 41, 42 and 44
- United States of America trademark SANOFI number 4178199, dated July 24, 2012, in class 5

Furthermore, the Complainant is the owner of several domain names, namely:

- <sanofi.com> registered on October 13, 1995
- <sanofi.us> registered on May 16, 2002

The disputed domain name was registered on July 14, 2024, and resolves to an inactive page.

Since the Respondent did not participate in the proceeding, nothing is known other than the Registrar-disclosed details identified above, which are assessed in section 6C below.

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 the disputed domain name is confusingly similar to its trademark SANOFI, as it is incorporated in its entirety. The Complainant also asserts that the geographic acronym "it" and the generic Top-Level Domain ("gTLD") ".com" do not exclude the likelihood of confusion between the SANOFI trademark and the disputed domain name which reproduces it.

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name. In fact, the Respondent is not affiliated or related to the Complainant in any way, or licensed, or otherwise authorized to use the SANOFI mark in connection with a website, a domain name, or for any other purpose. According to the Complainant, the Respondent has failed to make use of the disputed domain name's website and 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.

The Complainant alleges that the disputed domain name has been registered in bad faith and that, given the well-known and distinctive nature of the mark SANOFI, the Respondent is likely to have had constructive, if not actual notice, as to the existence of the Complainant's marks at the time of registration.

Finally, the Complainant asserts that the disputed domain name has been used in bad faith. The disputed domain name resolves to an inactive page, and passively holding a domain name can constitute a factor in finding bad faith registration and use. The Complainant also believes that Internet users can be confused as to the source of the disputed domain name. Indeed, the Complainant contends that the disputed domain name has been registered for the purpose of attracting Internet users to the Respondent's website by creating a likelihood of confusion between SANOFI trademarks and 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

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, "it", 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.

Finally, the extension ".com" is not to be taken into consideration when examining the identity or similarity between the Complainant's trademarks and the disputed domain name (*Accor v. Noldc Inc*, WIPO Case No. [D2005-0016](#)).

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.

Indeed, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name as it does not own any rights to the SANOFI trademarks, and the Complainant has never authorized or permitted the Respondent to use the SANOFI trademark or use it to register any domain name consisting of the SANOFI trademark.

Moreover, the disputed domain name is not actively used, as it simply leads to an inactive page. Therefore, there is no evidence of any use of, or preparations to use, the disputed domain name in connection with a bona fide offering of goods or services, or 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. Furthermore, in previous UDRP decisions, panels found that in the absence of any license or permission from the Complainant to use such widely-known trademarks, no actual or contemplated bona fide or legitimate use of the disputed domain name could reasonably be claimed (*LEGO Juris A/S v. DomainPark Ltd, David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host master*, WIPO Case No. [D2010-0138](#)). Moreover, given that the disputed domain name is composed of the Complainant's distinctive SANOFI trademark and the "it" ISO code for Italy, the composition is likely to carry a risk of implied affiliation, namely that any website to which such disputed domain name resolves is likely affiliated with the Complainant and an Italian distributor, and thus such composition cannot constitute fair use under the present circumstances. [WIPO Overview 3.0](#), section 2.5.1.

Finally, the Respondent had the opportunity to provide its arguments in support of its rights or legitimate interests in the disputed domain name. However, by failing to file a formal response, the Respondent has missed this opportunity, and the Panel is entitled to draw such inferences from the Respondent's failure as it considers appropriate in accordance with paragraph 14 of the Rules.

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 Complainant has established that the registered SANOFI trademarks long predated the registration of the disputed domain name. The Respondent reproduced in its entirety the Complainant's trademark SANOFI in the disputed domain name. The confusing similarity in this choice demonstrates that the Respondent was fully aware of the fact that the disputed domain name incorporated such a well-known trademark. Indeed, the Respondent knew of the Complainant and its trademark rights given the Respondent's impersonation of the Complainant when registering the disputed domain name, as assessed below.

The Panel is of the opinion that the Respondent registered the disputed domain name in bad faith.

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 notes the distinctiveness or 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.

Moreover, 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, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. (*International Olympic Committee (IOC) v. Registration Private, Domains By Proxy, LLC / Thomas Clohessy, Spirited Movie Co*, WIPO Case No. [D2022-2383](#)).

In this case, the Complainant's SANOFI mark is highly distinctive and well-known. The Respondent has failed to submit a response or to provide any evidence of the actual or contemplated good faith use of the disputed domain name.

Also, in the decision *Confédération Nationale du Crédit Mutuel v. Nicola Bazar*, WIPO Case No. [D2013-1572](#), the Panel found that:

"Respondent knew or should have known that the Domain Name included Complainant's CREDIT MUTUEL well-known trademark. [...] However, passive holding of the website does not prevent the Panel from finding registration and use in bad faith. The Panel further notes that Respondent undeveloped use of the website at the Domain Name which incorporates Complainant's trademark in its entirety indicates that Respondent possibly registered the Domain Name with the intention to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the trademark of Complainant as to the source, sponsorship, affiliation, or endorsement of its website or location or of a service on its website or location, as per paragraph 4(b)(iv) of the Policy."

Therefore, the Panel finds that the Respondent could not have registered the disputed domain name without the intention to profit from the likelihood of confusion it created with the Complainant's prior trademark.

Finally, Panel finds that Complainant's identity has been impersonated by the Respondent when registering the disputed domain name, though the Panel notes that the Complainant is a French Société anonyme and not a SAS. This impersonation further proves the use in bad faith of the disputed domain name, which has not been contested by Respondent.

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 <sanofi-it.com> be cancelled.

/Nathalie Dreyfus/

Nathalie Dreyfus

Sole Panelist

Date: September 16, 2024