

ADMINISTRATIVE PANEL DECISION

Sanofi v. Justin Gaines, Sanofi-Aventis

Case No. D2022-3391

1. The Parties

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

The Respondent is Justin Gaines, Sanofi-Aventis, United States of America (the “United States” or “US”).

2. The Domain Name and Registrar

The disputed domain name <sanofiaventis-usa.com> is registered with Google LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 12, 2022. On September 12, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 13, 2022, 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 (Contact Privacy Inc. Customer 7151571251) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 14, 2022, 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 providing elements of identification of the Respondent on October 4, 2022.

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”).

The Complainant submitted a request for suspension and the proceedings were suspended on September 20, 2022. The proceedings were reinstated on October 6, 2022.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on October 6, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 26, 2022. The Respondent sent informal communications to the Center on October 4, 2022, October 6, 2022, and on October 28, 2022. The

Respondent did not submit any formal response. Accordingly, the Center notified the parties that it would proceed to panel appointment on October 28, 2022.

The Center appointed Ganna Prokhorova as the sole panelist in this matter on November 8, 2022. 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 the owner of multiple trademark registrations for the word mark SANOFI AVENTIS in multiple jurisdictions worldwide including:

- International Trademark Registration No. 849323 for SANOFI AVENTIS & fig. registered on February 17, 2005, in classes 1, 3, 5, 10, 38, and 42 and designating several countries including the United States;
- International Trademark Registration No. 839358 for SANOFI-AVENTIS registered on October 1, 2004, in classes 1, 3, 5, 9, 10, 16, 38, 41, 42, and 44 and designating several countries including the United States.

The Complainant also owns multiple domain names incorporating the Complainant's trademark including <sanofi-aventis.com>, <sanofi-aventis.eu>, <sanofi-aventis.fr>, <sanofi-aventis.us>, <sanofi-aventis.ca>, <sanofi-aventis.biz>, <sanofi-aventis.info>, <sanofi-aventis.org>, to name a few. Most of these domain names are registered and used by the Complainant in connection with its activity.

The disputed domain name was registered on July 15, 2022, and does not resolve to an active page.

5. Parties' Contentions

A. Complainant

The Complainant states that it was founded in 2004, as Sanofi-Aventis after the merger of two pharmaceutical companies, Aventis and Sanofi, and then changed its name to Sanofi in May 2011. The Complainant also states that it engages in the research, development, manufacturing, and marketing of pharmaceutical products principally in the prescription market. The Complainant further maintains that it offers a wide range of patented prescription drugs to treat patients with serious diseases, including cardiovascular, thrombosis, metabolic disorders, oncology, central nervous system, internal medicine, and vaccines. The Complainant states that it employs 100,000 people in more than 100 countries around the world and it is the fourth largest multinational pharmaceutical company in the world by prescription sales.

The Complainant further contends as follows:

- (1) The Complainant and its trademark SANOFI AVENTIS enjoy a worldwide reputation. The Complainant owns numerous trademarks and domain names, registered all over the world and containing the distinctive word "sanofi aventis" prior to the registration of the disputed domain name. The reproduction of the Complainant's trademarks as the attack and dominant part of the disputed domain name is confusingly similar to the Complainant's trademarks, regardless of the adjunction of the term "USA" which remains descriptive of the geographic location of the provided goods and services and the generic Top Level Domain ("gTLD") extension ".com". For these reasons, there is no doubt that the disputed domain name is confusingly similar to the trademarks in which the Complainant has rights.
- (2) The Respondent does not have any legitimate interest in using the disputed domain name since the Respondent does not work at Sanofi. The Respondent uses the Company name Sanofi-Aventis, but its email address is not an email address of the Complainant. The Complainant has never licensed or

otherwise authorized the Respondent to use its trademarks or to register any domain name including the Complainant's trademarks. The Respondent illegally impersonates the Complainant's employees. There is no relationship between the parties and the Respondent has clearly modified the Complainant's trademarks for its own use and incorporated them into the disputed domain name without the Complainant's authorization. The Respondent is not making a legitimate noncommercial or fair use of the disputed domain name nor is it 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 is not used legitimately by Respondent.

(3) The Respondent has registered the disputed domain name primarily for the purpose of trying to gain unfair benefit of the Complainant's goodwill and reputation by using the disputed domain name, which suggests an effort to create a likelihood of confusion with the Complainant's trademarks and domain name as to the source, sponsorship, affiliation. Passive holding does not preclude a finding of bad faith in the circumstances of the case.

The Complainant requests the cancellation of the disputed domain name.

B. Respondent

The Respondent sent informal email communication to the Center on October 4, October 6, and October 28, 2022, which did not contain any substantive arguments. The Respondent did not submit a formal Response.

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all the elements listed in paragraph 4(a) of the Policy have been satisfied, as following:

- (i) the disputed domain name is 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 name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Complainant bears the burden of proving that all these requirements are fulfilled, even if the Respondent has not replied to the Complaint.

Moreover, the Panel has taken note of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") and, where appropriate, will decide consistent with the consensus views captured therein.

A. Identical or Confusingly Similar

According to paragraph 4(a)(i) of the Policy it should be established that the disputed domain name is identical or confusingly similar to a mark in which the Complainant has rights.

The Complainant has demonstrated ownership of its SANOFI AVENTIS trademarks. Therefore, the Panel is satisfied that the Complainant has registered trademark rights in the SANOFI AVENTIS marks. See [WIPO Overview 3.0](#), section 1.2.1.

The Panel is also of the view that the disputed domain name is confusingly similar to the Complainant's trademarks because it incorporates the trademark in its entirety, merely deleting space and adding hyphen followed by the term "usa", which remains descriptive of a geographic location and the gTLD ".com".

Adding the hyphen and the term “usa” does not prevent a finding of confusing similarity between the disputed domain name and the mark under the Policy, paragraph 4(a)(i). See [WIPO Overview 3.0](#), sections 1.7 and 1.8. Bearing that in mind, the Panel accordingly holds the disputed domain name is confusingly similar to the Complainant’s trademark SANOFI AVENTIS.

The addition of the gTLD “.com” shall be disregarded for the purposes of assessing confusing similarity, as it is a standard requirement of registration. See [WIPO Overview 3.0](#), section 1.11.1.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademark and that the requirement of paragraph 4(a)(i) of the Policy is met.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

While the burden of proof remains with the Complainant, the Panel recognizes that this would often result in the impossible task of “proving a negative”, in particular as the evidence needed to show the Respondent’s rights or legitimate interests is often primarily within the knowledge of the Respondent. Therefore, the Panel agrees with prior UDRP panels that the Complainant is required to make out a *prima facie* case before the burden of production shifts to the Respondent to show that it has rights or legitimate interests in the disputed domain name to meet the requirements of paragraph 4(a)(ii) of the Policy.

The Complainant made sufficient statements in order to demonstrate that the Respondent would have no rights or legitimate interests in the disputed domain name. The Panel has found out that the Respondent is not a licensee of the Complainant and not affiliated with the Complainant in any way. The Complainant has not granted any authorization for the Respondent to make use of its trademarks in a domain name or otherwise. There is no relationship whatsoever between the parties and the Respondent has clearly modified the Complainant’s trademarks for its own use and incorporated them into the disputed domain name without the Complainant’s authorization.

The disputed domain name resolves to an inactive webpage. According to this Panel, the Complainant also proved that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name nor is it 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 litigious domain website is not used legitimately by the Respondent.

The Respondent has not provided any rebuttal of the Complainant’s *prima facie* case and has therefore not proved rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds that the Complainant has established the second element under paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must prove on the balance of probabilities both that the disputed domain name was registered in bad faith and that it is being used in bad faith.

The Panel finds that the Complainant has demonstrated the Respondent’s bad faith registration and use of the disputed domain name.

The Complainant holds multiple trademark registrations for the trademarks SANOFI AVENTIS including in the United States that predate the registration of the disputed domain name.

Considering the above, the Respondent could not be unaware of the Complainant's trademark when registering the disputed domain name. The Respondent is likely to have had, at least, constructive, if not actual notice, as to the existence of the Complainant's marks at the time it registered the disputed domain name. This clearly suggests that the Respondent acted with opportunistic bad faith in registering the disputed domain name in order to make an illegitimate use of it. Hence, the Panel finds that the Respondent knew or should have known of the Complainant's trademark and deliberately registered the confusingly similar disputed domain name (see section 3.2.2, [WIPO Overview 3.0](#)).

Furthermore, the Panel is also of the view 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 – or at least an impression of association – between SANOFI AVENTIS trademarks and the disputed domain name.

The disputed domain name resolves to an inactive website. It has been established in many UDRP cases that passive holding under the appropriate circumstances falls within the concept of a domain name being used in bad faith. Section 3.3 of the [WIPO Overview 3.0](#) describes the circumstances under which the passive holding of a domain will be considered to be in bad faith: "While 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, (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."

The Panel finds that passive holding of the disputed domain name does not in the circumstances of this case prevent a finding of bad faith. There is no evidence in the record of a legitimate use of the disputed domain name. The trademark of the Complainant is distinctive and widely used in commerce. Previous panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See section 3.1.4 of the [WIPO Overview 3.0](#).

The Respondent has provided no evidence of actual or contemplated good-faith use of the disputed domain name and the Panel does not find any such use plausible.

In light of the above, the Panel finds that the Respondent has registered and used the disputed domain name in bad faith and that the Complainant has established its case under paragraph 4(a)(iii) 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 <sanofiaventis-usa.com> be cancelled.

/Ganna Prokhorova/
Ganna Prokhorova
Sole Panelist
Date: November 14, 2022