

## **ADMINISTRATIVE PANEL DECISION**

Sanofi v. Sara Ali, Sanofiuae  
Case No. D2023-4475

### **1. The Parties**

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

The Respondent is Sara Ali, Sanofiuae, United States of America (“United States”).

### **2. The Domain Name and Registrar**

The disputed domain name <sanofi-aventisuae.com> (the “Disputed Domain Name”) is registered with Squarespace Domains II LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 27, 2023. On October 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On October 27, 2023, 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 October 30, 2023, 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 amended Complaint on October 30, 2023.

The Center verified that the Complaint together with the amended 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 November 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 22, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 6, 2023.

The Center appointed Mireille Buydens as the sole panelist in this matter on December 18, 2023. 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. The Complainant, formed as Sanofi-Aventis in 2004, changed its name to Sanofi in 2011. The Complainant is settled in more than 100 countries on all 5 continents employing 100,000 people.

The Complainant owns numerous trademark registrations of SANOFI-AVENTIS (“the Trademark”), alone or with a design element, in connection with pharmaceutical products, in many jurisdictions around the world, including, for example:

- European Union trademark (word and design) SANOFI-AVENTIS no. 004054193 registered on November 24, 2005;
- European Union trademark SANOFI-AVENTIS no. 004025318, registered on November 3, 2005;
- International trademark (word and design) SANOFI-AVENTIS no. 849323, registered on February 17, 2005, and designating among others United States, Australia, Japan, South Korea, China, Romania, Russia, Ukraine;
- International trademark SANOFI-AVENTIS no. 839358, registered on October 01, 2004, designating among others United States, Australia, Georgia, Japan, South Korea, China, Romania, Russia.

The Complainant also owns numerous domain names in which the Second-Level Domain is SANOFI-AVENTIS, including <sanofi-aventis.com> (registered on March 14, 2004), <sanofi-aventis.us> (registered on April 26, 2004), and <sanofi-aventis.biz> (registered on April 26, 2004).

The Respondent registered the Disputed Domain Name on October 21, 2023. The Disputed Domain Name is passively held. At the date of this decision, the panel found that the Disputed Domain Name directs to a page mentioning “this site can’t be reached”.

#### **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.

First, the Complainant asserts that it owns registrations for the Trademark. The Complainant contends that the Trademark does not have any particular meaning and is highly distinctive. Numerous UDRP decisions have already considered that Sanofi’s trademarks are “well-known” in many jurisdictions. The Complainant considers that the Disputed Domain Name is confusingly similar to the Complainant’s Trademark as it includes (a) an exact reproduction of the Complainant’s Trademark; (b) combined with a descriptive geographical location (the three letters “uae” which are the abbreviation for United Arab Emirates); and (c) followed by the generic Top-Level Domain (“gTLD”) “.com” (which should be disregarded).

Second, the Complainant asserts that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. The Complainant has never licensed or otherwise authorized the Respondent to use the Trademark or to register any domain name including the Trademark. 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 as it simply refers to an inactive page.

Third, the Complainant asserts that the Disputed Domain Name was registered and is being used in bad faith. The Complainant submits that the Trademark (which predates the registration of the Disputed Domain Name) is so wellknown worldwide that it is inconceivable that the Respondent ignored the Complainant and its earlier rights. In this regard, the Complainant contends that it is one of the largest pharmaceutical companies in the world, detailing considerable proof of same and that even as early as 2011 UDRP decisions recognized SANOFI among the most cybersquatted trademarks. This suggests that the Respondent acted with opportunistic bad faith in registering the Disputed Domain Name to make an illegitimate use of it.

Finally, the Complainant submits that the Disputed Domain Name resolves to an inactive website. The Complainant asserts that the conditions referred to in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 3.3, are met: the passive holding of the Disputed Domain Name amounts to use in bad faith because (i) the Trademark is well-known, and (2) one cannot see any plausible good faith use of the Disputed Domain Name, taking into account the wellknown character of the Trademark.

The Complaint seeks that the Disputed Domain Name be cancelled.

## **B. Respondent**

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

## **6. Discussion and Findings**

Dealing with the Respondent's failure to file a response to the Complaint, paragraph 14(b) of the Rules provides that if a party, in the absence of exceptional circumstances, does not comply with a provision of, or requirement under these Rules, the panel shall be entitled to draw such inferences from this omission, as it considers appropriate.

Paragraph 4(a) of the Policy provides that the Complainant proves each of the following three elements to succeed in its Complaint:

- (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.

### **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. See [WIPO Overview 3.0](#), section 1.7.

The Complainant has shown rights in respect of the Trademark for the purposes of the Policy. See [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the Trademark is reproduced within the Disputed Domain Name. Accordingly, the Disputed Domain Name is confusingly similar to the Trademark for the purposes of the Policy. See [WIPO Overview 3.0](#), section 1.7.

Although the addition of other letters, here the letters "uae" (the common abbreviation for United Arab Emirates), may bear on the assessment of the second and third elements, the Panel finds the addition of such letters does not prevent a finding of confusing similarity between the Disputed Domain Name and the Trademark for the purposes of the Policy ([WIPO Overview 3.0](#), section 1.8.).

The gTLD “.com” is a standard registration requirement and does not prevent the Disputed Domain Name from being confusingly similar to the Trademark ([WIPO Overview 3.0](#), section 1.11.1).

Based on the available record, 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 Respondent is not licensed by or affiliated with the Complainant in any way. There is no evidence that the Respondent would be commonly known under the Disputed Domain Name, nor is there any evidence of use or demonstrable plans to use the Disputed Domain Name for a bona fide offering of goods or services. There is no evidence of legitimate noncommercial or fair use of the Disputed Domain Name, either.

The Panel notes that the composition of the Disputed Domain Name carries a risk of implied affiliation with the Complainant (see [WIPO Overview 3.0](#), section 2.5.1). The composition of the Disputed Domain Name, adding the letters “uae” (the common abbreviation for United Arab Emirates) to the Complainant’s Trademark along with the gTLD “.com”, affirms the Respondent’s intention of taking unfair advantage of the likelihood of confusion between the Disputed Domain Name and the Complainant’s Trademark. This confirms that there is no use, nor preparations to use, of the Disputed Domain Name in connection with a bona fide offering of goods or services.

Based on the available record, 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.

In the present case, the Panel notes that, given that the Disputed Domain Name incorporates the Complainant’s well-known Trademark, which predates the registration of the Disputed Domain Name, with the addition of the letters “uae” (the common abbreviation for United Arab Emirates), the Respondent was more likely than not aware of the Complainant’s Trademark at the time of the registration of the Disputed Domain Name ([WIPO Overview 3.0](#) section 3.1.4). The Panel notes in this regard that the Complainant owns registrations for the Trademark and is carrying business in the United States, where the Respondent is located. When looking for “sanofi-aventisuae” on the Internet, Internet users are referred to pages belonging to the Complainant (and presenting inter alia the Complainant’s campus in the United Arab Emirates).

The Respondent has sought to create a misleading impression of association with the Complainant.

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.

In this respect, the Panel notes the distinctiveness and reputation of the Complainant's Trademark and the composition of the Disputed Domain Name, the failure of the Respondent to submit a response and the Respondent's concealing its identity. 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.

Based on the available record, 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-aventisuae.com> be cancelled.

*/Mireille Buydens/*

**Mireille Buydens**

Sole Panelist

Date: December 28, 2023