

## **ADMINISTRATIVE PANEL DECISION**

Sanofi v. Sidney Haitoff, Mishe, Inc  
Case No. D2024-0127

### **1. The Parties**

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

The Respondent is Sidney Haitoff, Mishe, Inc., United States of America.

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

The disputed domain name <sanofidirect.com> is registered with GoDaddy.com, LLC., (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 12, 2024. On January 12, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 12, 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 (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 16, 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 January 17, 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 January 19, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 8, 2024. The Respondent sent an email communication to the Center on January 30, 2024. Based on the Complainant’s request, the Center suspended the proceedings for purposes of settlement discussions on February 1, 2024. On March 5, 2024, the Complainant requested the proceeding to be reinstated. On March 7, 2024, the Center reinstated the proceeding and informed the Parties of the new Response due date being March 14, 2024. The Respondent did not submit further communications.

The Center appointed Meera Chature Sankhari as the sole panelist in this matter on March 26, 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 Sanofi is a French multinational pharmaceutical company headquartered in Paris (France), ranking 4th world's largest multinational pharmaceutical company by prescription sales. The Complainant engages in research, development, manufacturing and marketing of pharmaceutical products for sale, principally in the prescription market, but the firm also develops over-the-counter medication. Historically, the Complainant's 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 offers a wide range of patented prescription drugs to treat patients with serious diseases and has a leading position in seven major therapeutic areas, namely cardiovascular, thrombosis, metabolic disorders, oncology, central nervous system, internal medicine and vaccines. The Complainant's efforts were recognized by including it in the annual "L2 Digital IQ Index: Pharmabrand & Healthcare Providers" worldwide brand survey issued on April 18, 2011, in which it appeared in the "Flash of Genius" in reference to its promoting patient resources. The Complainant is a full member of the European Federation of Pharmaceutical Industries and Associations (EFPIA).

The Complainant had consolidated net sales of 43 billion euros in 2022, 37.7 billion euros in 2021, 36.04 billion euros in 2020 and 34.46 billion Euros in 2018. The Complainant is a multinational company settled in more than 180 countries on all five continents employing 90,000 people.

The Complainant is the owner of trademark SANOFI, some of the trademark registrations secured by the Complainant are mentioned below:

Trademark	Classes	Registration no.	Country	Registered since
SANOFI	1,3,4,5,10,16,25,28,31	1482708	France	August 11, 1988
SANOFI	3,5,9,10, 16, 35,41,42 & 44	4178199	United States of America	July 24, 2012
SANOFI	1,3,5,9,10,35,40,42	96655339	France	December 11, 1996
SANOFI	3,5	000596023	European Union	February 1, 1999

The Complainant is the owner of the following domain names containing the word "sanofi". Details of such registrations are mentioned in the table below:

S.No.	Domain Name	Date of Registration
1.	<sanofi.com>	October 13, 1995
2.	<sanofi.eu>	March 12, 2006
3.	<sanofi.us>	May 16, 2002

The disputed domain name <sanofidirect.com> was registered by the Respondent on January 4, 2024. The disputed domain name leads to a parking website with pay-per-click ("PPC") links.

## **5. Parties' Contentions**

### **A. Complainant**

The Complainant contends that it has satisfied each of the elements required under the Policy for seeking cancellation of the disputed domain name.

The Complainant contends that the disputed domain name <sanofidirect.com> is confusingly similar to Complainant's prior registered trademarks as it reproduces the Complainant's trademark SANOFI, which does not have any particular meaning and is thus, highly distinctive. Reproduction of the Complainant's trademark in conjunction of the term "direct" which is descriptive in nature and does not eliminate the likelihood of confusion with the well-known SANOFI trademark. The disputed domain name also includes the generic Top-Level Domain ("gTLD") extension ".com".

The Complainant further contends that the Respondent does not have any legitimate interest in using the disputed domain name. The Complainant argues that neither does the Respondent own any trademark corresponding to the disputed domain name nor has the Complainant licensed/ authorized the Respondent to use its trademark or any domain name including the trademark SANOFI. The Complainant claims that the disputed domain name is used as a bait and switch. It leads to a parking website and has been registered only for the purpose of unfairly attracting the Complainant's consumers. By creating this disputed domain name the Respondent is creating confusion and for the purpose of misleadingly diverting consumers into thinking that the Respondent is in some way connected to, sponsored by or affiliated with the Complainant or that the Respondent's activities are approved or endorsed by the Complainant.

The Complainant alleges that the Respondent is likely to generate click-through revenue from such links, which does not amount to noncommercial or fair use of the disputed domain name.

The Complainant submits that it should be considered that, given the well-known status and the distinctive nature of the Complainant's trademark SANOFI, the Respondent is likely to have had, at least, constructive, if not actual notice, of the Complainant's mark while registering the disputed domain name. The Complainant argues that the Respondent acted with opportunistic bad faith in having registered the disputed domain name in order to make an illegitimate use of it.

Lastly, the Complainant states that the advertisements and links proposed on the parking websites provide income to the Respondent depending on the number of hits that are generated on the domain name, on a PPC model. The Respondent is trying to ride off the SANOFI's worldwide reputation. The absence of clear genuine utilization of the disputed domain name, especially those closely resembling those of the Complainant, is likely to significantly harm their overall reputation because Internet users might mistakenly think that the Complainant is either not present online or, worse, out of business.

### **B. Respondent**

The Respondent did not formally reply to the Complainant's contentions, however sent an email to the Center stating its willingness to forfeit the disputed domain name. No further communications were received from the Respondent.

## **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 the term here, “direct” 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**

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.

It is apparent that the Respondent lacks any rights or legitimate interests in utilizing the disputed domain name. This is evident because the Respondent’s name, “Sidney Haitoff, Mishe, Inc” bears no resemblance to the Complainant’s SANOFI trademark. It is reiterated that the trademark SANOFI holds significant distinctiveness as it lacks any specific meaning. Moreover, the Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services but instead the disputed domain name leads to a parking site with PPC links.

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 the Complainant’s trademarks are distinctive, and the marks have already been considered as well-known by previous panels. The Complainant’s business also has a substantial presence all over the world. In these circumstances it is most likely that the Respondent was well aware of the Complainant and of its rights in the SANOFI trademarks when it registered the disputed domain name in January 2024.

As already discussed, the disputed domain name directs to a parking page containing PPC links. It is highly probable that the Respondent earns revenue through click-throughs on these links present on the website associated with the disputed domain name.

The Panel finds that the Respondent's utilization of the disputed domain name represents a deliberate effort to draw Internet users to its website for commercial benefit. This is achieved by creating confusion regarding the origin, sponsorship, affiliation, or endorsement of the links displayed on the website associated with the disputed domain name, in relation to the Complainant's SANOFI trademarks. Such actions constitute evidence of registration and use in bad faith under paragraph 4(b)(iv) of the Policy.

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.

Panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the current 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 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 current 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 <sanofidirect.com> be cancelled.

*/Meera Chature Sankhari/*

**Meera Chature Sankhari**

Sole Panelist

Date: April 9, 2024