

ADMINISTRATIVE PANEL DECISION

Sanofi v. Contact Privacy Inc. Customer 0164679700 / Sanofi smith
Case No. D2022-2389

1. The Parties

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

Respondent is Contact Privacy Inc. Customer 0164679700, Canada / Sanofi smith, United States of America ("United States").¹

2. The Domain Name and Registrar

The disputed domain name <sanofi.work> is registered with Tucows Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on June 30, 2022. On June 30, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 30, 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 and contact information in the Complaint. The Center sent an email communication to Complainant on July 1, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on July 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").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on July 13, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 2, 2022. Respondent sent an email communication to the Center on July 13, 2022.

¹ It is evident from the case file that "Contact Privacy Inc. Customer 0164679700", Canada, is a privacy protection service and that "Sanofi smith", United States, is the underlying registrant of the disputed domain name. Therefore, unless otherwise indicated, the term "Respondent" is used by the Panel in the case at hand to refer to the latter underlying registrant only.

The Center appointed Stephanie G. Hartung as the sole panelist in this matter on August 22, 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

Complainant is a company organized under the laws of France which ranks among the world's largest multinational pharmaceutical companies offering a wide range of prescription products in more than 100 countries on all five continents, thereby employing around 100,000 people.

Complainant has provided evidence that it is the registered owner of numerous trademarks relating to its company name and brand SANOFI, *inter alia*, but not limited to, the following:

- Word mark SANOFI, United States Patent and Trademark Office (USPTO), registration number: 4178199, registration date: July 24, 2012, status: active.

Moreover, Complainant has evidenced to be the owner of numerous domain names relating to its SANOFI trademark, *inter alia*, since 1995 the domain name <sanofi.com>, which resolves to Complainant's official website at "www.sanofi.com", where Complainant promotes its pharmaceutical products and related services worldwide.

Respondent, according to the disclosed Whois information for the disputed domain name, is a resident of the United States who registered the disputed domain name on June 27, 2022. By the time of the rendering of this decision, the disputed domain name does not resolve to any content on the Internet. Complainant, however, has demonstrated that at some point before the filing of the Complaint, the disputed domain name resolved to a website at "www.ssmithpressurewashing.com", selling clothing items and offering cleaning services.

Complainant requests that the disputed domain name be transferred to Complainant.

5. Parties' Contentions

A. Complainant

Complainant contends to rank as the fourth world's largest multinational pharmaceutical company by prescription sales and that its SANOFI trademark is well-known and enjoys recognition worldwide.

Complainant submits that the disputed domain name is confusingly similar to its SANOFI trademark, as it comprises an exact reproduction of said trademark, followed by the Top Level Domain ("TLD") ".work". Moreover, Complainant asserts that Respondent has no rights or legitimate interests in respect of the disputed domain name since (1) Complainant has never licensed or otherwise authorized Respondent to use its SANOFI trademark or to register any domain name including the very same, (2) given Respondent's email address in the Whois information for the disputed domain name, it is very unlikely that Respondent's real name is "Sanofi", and (3) Respondent obviously has neither prior rights nor any legitimate interests to justify the use of the already worldwide well-known SANOFI trademark, but rather is impersonating Complainant within the contact email address that is/was displayed on the website under the disputed domain name. Finally, Complainant argues that Respondent has registered and is using the disputed domain name in bad faith since (1) given the famous and distinctive nature of Complainant's SANOFI trademark, it is likely that Respondent had notice of said trademark when registering the disputed domain name, and (2) Respondent uses the disputed domain name to divert Internet users looking for Complainant's official website to Respondent's own website, where it sells clothing items and offers cleaning services, thereby riding on the worldwide reputation of Complainant's SANOFI trademark.

B. Respondent

Respondent did not file a formal Response, but sent an email communication to the Center on July 13, 2022, claiming that its name was “Sanofi Smith” and that it was trying to start a pressure washing business under the disputed domain name, using the latter also in connection with a work email address.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, Complainant carries the burden of proving:

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) that Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel concludes that the disputed domain name <sanofi.work> is identical with the SANOFI trademark in which Complainant has rights.

The disputed domain name incorporates the SANOFI trademark in its entirety, with no alterations or additions whatsoever. Numerous UDRP panels have recognized that incorporating a trademark in its entirety is normally sufficient to establish that the disputed domain name is at least confusingly similar, if not identical with a registered trademark (see WIPO Overview on WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.7). Moreover, given that the applicable TLD as such is usually disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#), section 1.11.1), the inclusion of the TLD “.work” in the disputed domain name does not alter the finding of identity in the case at hand.

Therefore, Complainant has established the first element under the Policy set forth by paragraph 4(a)(i).

B. Rights or Legitimate Interests

The Panel is further convinced on the basis of Complainant’s undisputed contentions, that Respondent has not made use of the disputed domain name in connection with a *bona fide* offering of goods or services, nor has Respondent been commonly known by the disputed domain name, nor can it be found that Respondent has made a legitimate noncommercial or fair use thereof without intent for commercial gain.

Firstly, Respondent has neither been granted a license nor has it been otherwise authorized by Complainant to use its SANOFI trademark, either as a domain name or in any other way.

Secondly, the Panel is not convinced that Respondent’s name somehow corresponds with the disputed domain name and Respondent does not appear to have any trademark rights associated with the fanciful term “Sanofi” on its own. On the one hand, Respondent sent an email communication to the Center on July 13, 2022, claiming that its (personal) name was “Sanofi Smith” and that it was trying to start a pressure washing business under the disputed domain name, using the latter also in connection with a work email address; moreover, the URL of the website to which the disputed domain name temporarily resolved read “www.ssmithpressurewashing.com” with the possibility being that “ssmith” was meant to stand for “Sanofi Smith”. On the other hand, the case file includes a number of indications which point into a different direction, e.g. the email address in the disclosed Whois information for the disputed domain name (according to which Respondent’s name should be “Kevin Roman Smith”, not “Sanofi Smith”), the absence of any supportive documents or the like that Respondent’s real name indeed is “Sanofi”, as well as the website under the disputed domain name which repeatedly referred to “Smith’s Pressure Washing”, but not a single time to the term/name “Sanofi” as it is exclusively reflected in the disputed domain name, except for within

the contact email address. On top, an independent Google research in relation to the term “Sanofi” undertaken by this Panel within its general powers set forth by paragraph 11 of the Rules exclusively points to Complainant (who argues that “Sanofi” has no particular meaning and is, therefore, highly distinctive) and so does not support at all the assumption that “Sanofi” also was a name, in particular one, under which Respondent was at least known, if not commonly known within the meaning of paragraph 4 (c)(ii) of the Policy.

Thirdly, the Panel recognizes that Complainant’s SANOFI trademark undisputedly enjoys considerable reputation around the world, which is why it is more likely than not that Respondent was aware of the SANOFI trademark and connected reputation when registering the disputed domain name and that the latter is directly targeting said trademark. In turn, the website that was temporarily set up under the disputed domain name did not refer at all to the term “sanofi” and the Panel sees no indications in the case file as to why Respondent needed to rely on this term to be included in the disputed name in order to set up a pressure washing business if not to ride on the worldwide reputation which is undisputedly connected to Complainant’s SANOFI trademark. Such use of the disputed domain name, however, neither qualifies as *bona fide* nor as legitimate non-commercial or fair within the meaning of paragraph 4(c) of the Policy.

Against this background, the Panel concludes that Complainant has established a *prima facie* case that Respondent has no rights or legitimate interests in respect of the disputed domain name. Having done so, the burden of production shifts to Respondent to come forward with appropriate evidence demonstrating such rights or legitimate interests (see [WIPO Overview 3.0](#), section 2.1). Given, however, that Respondent has nothing brought forward but the mere assertion that its name was “Sanofi”, Respondent has not met that burden.

The Panel, therefore, finds on balance that Respondent has no rights or legitimate interests in respect of the disputed domain name and that Complainant has also satisfied paragraph 4(a)(ii) and, thus, the second element of the Policy.

C. Registered and Used in Bad Faith

The Panel finally holds that the disputed domain name was registered and is being used by Respondent in bad faith.

On the basis of the circumstances to this case, it is more likely than not that Respondent was well aware of Complainant’s rights in the well-known SANOFI trademark when registering the disputed domain name and that the latter clearly is directed to such trademark. The term “sanofi” – as it is exclusively reflected in the disputed domain name – is on the one hand identical with Complainant’s SANOFI trademark and on the other hand lacks any direct or indirect connection to the commercial content (e.g. the selling of clothing items and the offering of cleaning services) as it had been temporarily put in place by Respondent under the disputed domain name, because (1) such website under the disputed domain name made no reference whatsoever to the term “sanofi”, except for within the contact email address, and (2) on the basis of the case file – as has been laid out under Section B. above – it is more likely than not that Respondent’s name is “Sanofi”. Such circumstances are a clear enough indication that Respondent intentionally attempted to attract, for commercial gain, Internet users to its own website by creating a likelihood of confusion with Complainant’s well-known SANOFI trademark as to the source, sponsorship, affiliation or endorsement of Respondent’s website, and so serve as evidence of registration and use of the disputed domain name in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

Therefore, the Panel finds that Complainant has also satisfied the third element under the Policy as set forth by paragraph 4(a)(iii).

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.work> be transferred to Complainant.

/Stephanie G. Hartung/

Stephanie G. Hartung

Sole Panelist

Date: August 31, 2022