

ADMINISTRATIVE PANEL DECISION

Sanofi and Sanofi-Aventis Deutschland GmbH v. Melvin S. Dunn
Case No. D2022-3428

1. The Parties

The Complainants are Sanofi, France and Sanofi-Aventis Deutschland GmbH, Germany (collectively referred to as the “Complainant”), represented by Selarl Marchais & Associés, France.

The Respondent is Melvin S. Dunn, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <dulcolaxonline.top> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 15, 2022. On September 15, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 15, 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 (See PrivacyGuardian.org, United States) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 16, 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 on September 19, 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 the Respondent of the Complaint, and the proceedings commenced on September 22, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 12, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 13, 2022.

The Center appointed Tobias Malte Müller as the sole panelist in this matter on October 28, 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

It results from the Complainant's undisputed allegations that the Complainant SANOFI is a French multinational pharmaceutical company headquartered in Paris, France, with consolidated net sales of 37.7 billion Euros in 2021. SANOFI engages in research and development, manufacturing and marketing of pharmaceutical products for sale, principally in the prescription market, but the firm also develops over-the-counter medication. The second Complainant, Sanofi-Aventis Deutschland GmbH, belongs to the SANOFI group and employs more than 9,000 employees at three sites in Germany.

The Complainants have been manufacturing the product DULCOLAX, a laxative that stimulates bowel movements, which is used to treat constipation or to empty the bowels, for many decades.

Furthermore, it results from the undisputed evidence provided by the Complainant that the second Complainant Sanofi-Aventis Deutschland GmbH is the registered owner of several trademarks consisting of the verbal elements DULCOLAX, such as:

- International trademark DULCOLAX no. 165781, registered on December 10, 1952 for products in classes 1 and 5;
- European Union Trade Mark registration for DULCOLAX no. 002382059, filed on November 29, 2002 for goods in class 5 and duly renewed.

According to the Whois extract provided by the Complainant, the disputed domain name was created on August 13, 2022. The language of the registration agreement used by the Registrant for the disputed domain name is English.

The disputed domain name resolves to a commercial parking website presented by the Registrar ("this domain is parked free of charge with [...]") where users can e.g. submit an offer to purchase the domain name ("Please use the form below to submit an offer to purchase dulcolaxonline.top").

5. Parties' Contentions

A. Complainant

Firstly, the Complainants contend that the disputed domain name is confusingly similar to its earlier trademark. In fact, it reproduces the DULCOLAX trademark identically and combines it with the descriptive term "online". The addition of the generic and common English term "online" refers to an online sales platform and is insufficient to avoid confusing similarity, and on the contrary will merely suggest to Internet users that the disputed domain name offers for sale Complainant's products.

Secondly, the Complainant contends that the Respondent lacks prior rights or legitimate interests in the disputed domain name. In particular, the Complainant has never licensed or otherwise authorized the Respondent to use its trademarks or to register any domain name including the DULCOLAX trademark. Furthermore, 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 since the disputed domain name is leading to a parking website.

Thirdly, the Respondent's registration and use of the disputed domain name constitutes – in the Complainant's view – bad faith. In particular, the Respondent has neither prior right nor legitimate interest to justify the use of the Complainant's trademark. Furthermore, the absence of legitimate interest somewhat induces bad faith. Furthermore, the Respondent must have been aware of the risk of deception and confusion that would arise from the registration of the disputed domain name since it could lead Internet users searching for official DULCOLAX websites to the Respondent's website. In the Complainant's view the Respondent is undeniably trying to take advantage of the Complainant's reputation, characterizing all the more a bad faith usage.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to “decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.

Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements in order to obtain an order that the disputed domain name should be transferred or cancelled:

- (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 Panel is satisfied that the registrant of record for the disputed domain name is the Respondent and will, therefore, proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

It results from the evidence provided that the second Complainant is the registered owner of various trademarks for DULCOLAX as explained above. The Complainant's trademark registrations well predate the creation date of the disputed domain name.

Many UDRP panels have found that a disputed domain name is confusingly similar to a complainant's trademark for purposes of the first element where the relevant trademark is recognizable within the disputed domain name. Under such circumstances, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (*cf.* section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). This Panel shares the same view and notes that the disputed domain name contains the Complainant's registered trademark DULCOLAX, which is placed at the beginning of the disputed domain name. In particular, the Panel considers the addition of the dictionary term “online” to the Complainant's trademark in the disputed domain name would not prevent a finding of confusing similarity under the first element of the UDRP. The Panel has no doubts that in a side-by-side comparison of the disputed domain name and the relevant trademark DULCOLAX, the latter mark remains clearly recognizable within the disputed domain name.

Finally, the generic Top-Level Domain (“gTLD”) “.top” of the disputed domain name may be disregarded under the first element confusing similarity test (see section 1.11.1 of the [WIPO Overview 3.0](#)).

In light of the above, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent’s rights or legitimate interests to the disputed domain name. In the Panel’s view, based on the allegations stated above, the Complainant has made a *prima facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

First, no evidence or information has been provided that could lead the Panel to conclude that the Respondent is commonly known by the disputed domain name pursuant to paragraph 4(c)(ii) of the Policy. In addition, the Respondent has no connection or affiliation with the Complainant who has not granted the Respondent any license or consent, express or implied, to use the Complainant’s trademark in domain names or in any other manner.

Second, it results from the evidence provided by the Complainant that the disputed domain name is currently connected to a parking website presented by the Registrar (“this domain is parked free of charge with [...]”) where users can *e.g.* submit an offer to purchase the domain name (“Please use the form below to submit an offer to purchase dulcolaxonline.top”). Such use can, in the Panel’s view, neither be considered a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain name, in the sense of paragraph 4(c)(i) of the Policy.

In addition, the Panel notes that the inherently misleading nature of the disputed domain name, comprising the Complainant’s well-known trademark and a descriptive term with an inherent Internet connotation, carries a risk of implied affiliation with the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

It is acknowledged that once the Panel finds such *prima facie* case is made, the burden of production shifts to the Respondent to come forward with appropriate evidence demonstrating rights or legitimate interests in the disputed domain name. Since the Respondent failed to come forward with any evidence in this regard, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant has therefore satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, “in particular but without limitation”, be evidence of the disputed domain name’s registration and use in bad faith.

In the Panel’s view, the Respondent has intentionally registered the disputed domain name, which contains the Complainant’s trademark DULCOLAX identically, merely adding the term “online”. The Panel considers this trademark to be highly distinctive. Consequently, and in the absence of any evidence to the contrary, the Panel is convinced that the Respondent positively knew the Complainants’ trademark when it registered the disputed domain name.

Finally, the further circumstances surrounding the disputed domain name’s registration and use confirm the findings that the Respondent has registered and is using the disputed domain name in bad faith:

- (i) the inherently misleading nature of the disputed domain name, exactly containing the Complainant's trademark DULCOLAX combining it with a descriptive dictionary term "online";
- (ii) the clear absence of any rights or legitimate interests in the disputed domain name;
- (iii) the Respondent's failure to submit a response with a credible evidence-backed rationale for registering the disputed domain name;
- (iv) the disputed domain name appearing to have been originally registered behind a privacy service, resulting in the Respondent's identity being hidden;
- (v) the website allowing users to submit a purchase offer for the disputed domain name ("Please use the form below to submit an offer to purchase dulcolaxonline.top");
- (vi) the Respondent's failure to provide any evidence of actual or contemplated good-faith use, and
- (vii) the implausibility of any good faith use to which the disputed domain name may be put.

In the light of the above, the Panel finds that the disputed domain name has been registered and is being used in bad faith pursuant to 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 <dulcolaxonline.top> be transferred to the Complainant.

/Tobias Malte Müller/

Tobias Malte Müller

Sole Panelist

Date: November 11, 2022