

ADMINISTRATIVE PANEL DECISION

Sanofi and Chattem Inc. v. Aurelio M. Gilchrist
Case No. D2022-3530

1. The Parties

The Complainants are Sanofi, France (“The First Complainant”) and Chattem Inc, United States of America (“United States”) (“The Second Complainant”), both represented by Selarl Marchais & Associés, France.

The Respondent is Aurelio M. Gilchrist, United States.

2. The Domain Name and Registrar

The disputed domain name <cheapzantac.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 23, 2022. On September 23, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name <cheapzantac.top>. On September 23, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for this disputed domain name, which differed from the named Respondent and contact information in the Complaint (See PrivacyGuardian.org). The Center sent an email communication to the Complainants on September 26, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amendment to the Complaint on September 26, 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 27, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 17, 2022. On October 10, 2022, the Complainants requested to add the domain names <zantacbuy.top> and <zantaconline.top> to the Complaint. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 18, 2022.

The Center appointed Assen Alexiev as the sole panelist in this matter on October 26, 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.

On November 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the domain names <zantacbuy.top> and <zantaconline.top>. On the same day, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for these domain names. On November 8, 2022, the Panel issued his Procedural Order No.1 whereby he invited the Complainants to submit by November 13, 2022, an amended Complaint with relevant arguments and evidence demonstrating that all named Respondents are, in fact, the same entity and/or that all domain names are under common control, and invited all Respondents named in the amended Complaint to provide comments, if any, on the Complainants' request to add the domain names <zantacbuy.top> and <zantaconline.top> to the current proceeding by November 18, 2022. On November 10, 2022, the Complainants submitted to the Center separate complaints in respect of the domain names <zantacbuy.top> and <zantaconline.top>, and on November 11, 2022, they clarified that they had filed new complaints regarding these domain names as they did not appear to be owned by the same registrant. The Panel regards this statement of the Complainants as a withdrawal of its request for consolidation of the disputes in relation to the domain names <zantacbuy.top> and <zantaconline.top> in the present proceeding, and therefore the subject matter of the present decision concerns only the disputed domain name <cheapzantac.top>.

4. Factual Background

The First Complainant is a French multinational pharmaceutical company active in more than 100 countries and employing 100,000 people. It engages in the research and development, manufacturing, and marketing of pharmaceutical products in the prescription market as well as over-the-counter medications.

The Second Complainant is an American manufacturer of over-the-counter healthcare products, toiletries, dietary supplements, topical analgesics, and medicated skin care products. It was founded in 1879 and is now a subsidiary of the First Complainant. The Second Complainant's business has historically been concentrated in the United States, Canada, Latin America, the United Kingdom, and Ireland.

The Second Complainant is the owner of the following trademark registrations for the sign ZANTAC (the "ZANTAC trademark"):

- the United States trademark ZANTAC with registration No. 1220525, registered on December 21, 1982, for goods in International Class 5; and
- the United States trademark ZANTAC with registration No. 1685021, registered on May 5, 1992, for goods in International Class 5.

The disputed domain name <cheapzantac.top> was registered on September 5, 2022. It resolves to a parking webpage of the Registrar.

5. Parties' Contentions

A. Complainants

The Complainants state that the disputed domain name is confusingly similar to the Second Complainant's ZANTAC trademark, because it represents an exact reproduction of this trademark combined with the dictionary word "cheap". According to the Complainants, the addition of this dictionary word, which refers to the offering of cheap products on the Internet, is insufficient to avoid the confusing similarity and suggests to

Internet users that the disputed domain name leads to a website offering cheap ZANTAC products online.

According to the Complainants, the Respondent has no rights or legitimate interests in respect of the disputed domain name, because they have never licensed or otherwise authorized the Respondent to use the ZANTAC trademark or to register any domain name including it. The Complainants note that the Respondent's name does not resemble the word "zantac", which has no meaning and is highly distinctive. The Complainants maintain that the Respondent has no prior rights or legitimate interests to justify the use of the ZANTAC trademark, which is well-known worldwide. The Complainants state that there is no relationship between the Parties, and the Respondent has registered the disputed domain name without the Complainants' authorization. The Complainants point out that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name and is not using it in connection with a *bona fide* offering of goods or services. The disputed domain name points to a parking webpage, and according to the Complainants, it has been registered only for the purpose of attracting Internet users to buy it or to unfairly attract the Complainants' consumers to the Respondent's webpage.

The Complainants contend that the disputed domain name was registered and is being used in bad faith. According to them, given the distinctive nature of the ZANTAC trademark, the Respondent is likely to have had notice as to the existence of this trademark at the time it registered the disputed domain name, and has acted with opportunistic bad faith in registering it to illegitimately attract Internet users to the Respondent's website by creating a likelihood of confusion or an impression of association between the ZANTAC trademark and the disputed domain name. In the Complainants' view, the Respondent is also trying to ride off the Complainants' reputation by selling the disputed domain name for financial gain to the highest bidder.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

Pursuant to the Policy, paragraph 4(a), the Complainants must prove each of the following to justify the transfer of the disputed domain name:

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

In this case, the Center has employed the required measures to achieve actual notice of the Complaint to the Respondent, in compliance with the Rules, paragraph 2(a), and the Respondent was given a fair opportunity to present its case.

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: "[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain- name holder) to retain registration and use of the disputed domain name [...]".

The Respondent however did not submit any Response.

A. Identical or Confusingly Similar

The Complainants have provided evidence that the Second Complainant is the owner of the ZANTAC trademark, and submit that the Second Complainant is a subsidiary of the First Complainant. As discussed in section 1.4.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition

(“[WIPO Overview 3.0](#)”), a trademark owner’s affiliate such as a subsidiary of a parent or of a holding company, or an exclusive trademark licensee, is considered to have rights in a trademark under the UDRP for purposes of standing to file a complaint. The Panel’s view is that the same consideration should normally also apply to the parent company of the trademark owner. Therefore, the Panel is satisfied that both Complainants have established that they have rights in the ZANTAC trademark for the purposes of the Policy.

As noted by the Complainants, the disputed domain name incorporates the ZANTAC trademark with the addition of the word “cheap”. As discussed in section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.

In view of the above, the Panel finds that the disputed domain name is confusing similar to the ZANTAC trademark in which the Complainants have rights.

B. Rights or Legitimate Interests

While the overall burden of proof in UDRP proceedings is on the complainant, UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. See section 2.1 of the [WIPO Overview 3.0](#).

The Complainants contend that the Respondent has no rights or legitimate interests in the disputed domain name, because they have not authorized it to use the ZANTAC trademark or to register any domain name including it, and there is no relationship between the Parties. The Complainants point out that the disputed domain name points to a parking webpage, and according to them, was registered only to be resold or to attract the Complainants’ consumers to the Respondent’s webpage. The Complainants have thus established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Respondent has not submitted a Response or disputed the contentions of the Complainants, and has not provided any plausible explanation why it has registered the disputed domain name and how it intends to use it.

The disputed domain name is confusingly similar to the ZANTAC trademark and its composition creates the impression that it is related to the online sales of cheap ZANTAC products, and as shown by the evidence submitted by the Complainants and not disputed by the Respondent, it is currently inactive.

In light of the lack of any evidence or allegation pointing to a conclusion that the disputed domain name has been registered for some kind of legitimate activity, there is nothing to contradict the *prima facie* case made by the Complainants. It appears as more likely than not that the Respondent knew the Complainants’ ZANTAC trademark and targeted it when registering the disputed domain name, and this has been done without the Complainants’ consent.

This is sufficient for the Panel to reach the conclusion that the Respondent does not have rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists four illustrative alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

“(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.”

The disputed domain name incorporates the ZANTAC trademark, which was registered many years earlier, in combination with the additional word “cheap”, so Internet users may regard it as an online location where cheap ZANTAC products of the Complainants are offered for sale. The Complainants state that they have not authorized the registration and use of the disputed domain name, and the Respondent does not maintain the opposite or provide any plausible explanation for the registration and intended use of the disputed domain name.

Taking the above into account, the Panel concludes that it is more likely than not that the Respondent has registered the disputed domain name with knowledge of the Complainant and targeting the ZANTAC trademark to make the disputed domain name attractive for Internet traffic due to its confusing similarity with the same trademark.

In view of the above, the Panel accepts that by registering the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the disputed domain name, by creating a likelihood of confusion with the Complainants and their ZANTAC trademark.

The disputed domain name is inactive. However, as discussed in section 3.3 of the [WIPO Overview 3.0](#), from the inception of the UDRP, panelists 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. 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 several of these factors to be present here. The Complainants have submitted evidence about the popularity of the ZANTAC trademark, the Respondent has not submitted a Response and has provided what appear to be false contact details, and there is no evidence in the case allowing the Panel to conclude that the disputed domain name could be put to a good faith use.

Therefore, the Panel finds that the disputed domain names have been registered and used in bad faith.

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 <cheapzantac.top> be transferred to the Complainants.

/Assen Alexiev/

Assen Alexiev

Sole Panelist

Date: November 22, 2022