

## **ADMINISTRATIVE PANEL DECISION**

Sanofi v. Online shopping, online shop  
Case No. D2022-3669

### **1. The Parties**

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

The Respondent is Online shopping, online shop, United States of America (“United States”).

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

The disputed domain name, <ambiensleepingpills.com> (the “Domain Name”), is registered with NameSilo, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 3, 2022. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. Also on October 3, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name, which differed from the named Respondent and contact information in the Complaint.

The Center sent an email communication to the Complainant on October 3, 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 October 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 the Respondent of the Complaint, and the proceedings commenced on October 5, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 25, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 26, 2022.

The Center appointed Tony Willoughby as the sole panelist in this matter on October 31, 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.

The invitation to the Complainant to file an amendment to the Complaint stemmed from the fact that the Domain Name was registered in the name of a privacy service. In response to the Center's registrar verification request, the Registrar disclosed the name and address of the entity in whose name the Domain Name is currently registered. The amendment to the Complaint names the underlying registrant as the Respondent.

#### **4. Factual Background**

The Complainant is a French multi-national pharmaceutical company. One of the Complainant's products is an insomnia treatment which it sells under the name "Ambien", a name protected internationally by numerous trade mark registrations including United States Registration No. 1,808,770 AMBIEN (typed drawing) registered on December 7, 1993 (application filed on January 5, 1993) in class 5 for pharmaceutical preparations for the treatment of sleep disorders.

The Domain Name was registered on August 24, 2022 and is connected to what appears to be an online pharmacy. At the top left of the homepage of the Respondent's website is a logo comprising two red and white capsules, the name "Ambien" and the words "sleepin [*sic*] pills". The website offers for sale a large number of pharmaceuticals, some branded and some generic. Prices are quoted in USD. The Complainant's "Ambien" product is one of the products offered on the website along with a large number of others from different manufacturers. At the foot of the homepage is a copyright notice reading "© 2022 Ambien Sleeping Pills. All Right [*sic*] Reserved".

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that the Domain Name is confusingly similar to the Complainant's AMBIEN registered trade mark; that the Respondent has no rights or legitimate interests in respect of the Domain Name; and that the Domain Name has been registered and is being used in bad faith.

The essence of the Complainant's case is that the Respondent registered the Domain Name for the purpose for which it is using it, namely to attract in traffic to its website on the back of the fame of the reputation and goodwill associated with the Complainant's AMBIEN product.

##### **B. Respondent**

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

#### **6. Discussion and Findings**

##### **A. General**

According to paragraph 4(a) of the Policy, for this Complaint to succeed in relation to the Domain Name, the Complainant must prove each of the following, namely that:

- (i) the 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 Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

### **B. Identical or Confusingly Similar**

The Domain Name comprises the Complainant's AMBIEN registered trade mark followed by the words "sleeping" and "pills" and the ".com" generic Top-Level Domain identifier.

Section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)) explains the test for identity or confusing similarity under the first element of the Policy and includes the following passage:

"While each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing."

The Complainant's AMBIEN trade mark is readily recognizable in its entirety in the Domain Name. The Panel finds that the Domain Name is confusingly similar to a trade mark in which the Complainant has rights.

### **C. Rights or Legitimate Interests**

Section 2.0 of [WIPO Overview 3.0](#) addresses how panels approach this element of the Policy. Significant factors in the context of this case include the following:

- (i) While complainants are required to prove all three elements of paragraph 4(a) of the Policy, this element calls for the complainant to prove a negative in circumstances where it is often the case that all the relevant information is in the hands of the respondent, rendering the task impossible for the complainant. Thus, a protocol has been developed whereby the complainant is required to satisfy the panel that it has a *prima facie* case; it is then for the respondent to come forward with evidence demonstrating rights or legitimate interests;
- (ii) Paragraph 4(c) of the Policy sets out a non-exhaustive list of circumstances any of which if found by the Panel to be present shall demonstrate rights or legitimate interests for the purposes of this element of the Policy, namely (in brief) that the respondent has been using or making preparation to use the domain name in connection with a *bona fide* offering of goods or services; or has been commonly known by the domain name; or "is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."
- (iii) A respondent's use of a domain name will not be considered "fair" if it falsely suggests affiliation with the trademark owner (Section 2.5) and if it is identical to the complainant's trade mark it carries a high risk of implied affiliation. (Section 2.5.1)
- (iv) Where the domain name consists of the complainant's trade mark and an additional term it cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. (Section 2.5.1)

(v) However, there are circumstances where the unauthorized use of a third party's trade mark in a domain name may give rise to the acquisition by a respondent of rights or legitimate interests in respect of that domain name. The issue frequently falls to be considered where, as here, the respondent is using the domain name to connect to a website selling the goods of the complainant. Section 2.8.1 of [Overview 3.0](#) provides:

"Panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the "Oki Data test" [a test derived from the decision in *Oki Data Americas, Inc. v. Asdinc.com*, WIPO Case No. [D2001-0903](#)], the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to "corner the market" in domain names that reflect the trademark."

The Complainant asserts that it has no association with the Respondent and specifically has granted the Respondent no permission to use its AMBIEN trade mark.

The Complainant recites the circumstances set out in paragraph 4(c) of the Policy, and contends that none of them is applicable. The Complainant contends that the Respondent's impersonation of the Complainant cannot constitute a *bona fide* offering of goods or services for the purposes of paragraph 4(c)(i) of the Policy; there is nothing to indicate that the Complainant is commonly known by the Domain Name (paragraph 4(c)(ii) of the Policy); and the use being made of the Domain Name is a commercial use, is not fair and is not covered by paragraph 4(c)(iii) of the Policy.

The Panel accepts the Complainant's assertion that it has not authorized the Respondent's use of the AMBIEN trade mark in this or any other way and is satisfied that that the Complainant has made out a *prima facie* case that the Respondent has intentionally set out to impersonate the Complainant for commercial gain.

While the Domain Name is not identical to the Complainant's trade mark, it features an identical representation of that trade mark along with words describing the Complainant's product and as such, in the view of the Panel, suggests an affiliation with the Complainant. If the website to which the Domain Name is attached had passed the Oki Data test (see above) in only offering for sale the Complainant's "Ambien" sleeping pills and making clear the true nature of the Respondent's relationship with the Complainant, the Panel might have been given cause to pause for thought. However, that is not the case. The website is an online pharmacy offering a large number of branded and generic pharmaceuticals, of which the Complainant's "Ambien" sleeping pills are only one. It is clear to the Panel that the Respondent selected the Domain Name for one reason only, namely to attract traffic to its website on the back of the reputation and goodwill of the Complainant's AMBIEN brand. The positioning and design of the Respondent's homepage logo described in section 4 above makes it clear that not only does the Respondent's website fail to accurately and prominently disclose the Respondent's relationship with the Complainant, it falsely indicates that the website is formally and closely associated with the owner of the AMBIEN brand, namely the Complainant.

The Respondent has not responded to the Complainant's contentions. The Panel is in no doubt that the Respondent has no satisfactory answer to those contentions. The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name.

#### **D. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy sets out a non-exhaustive list of circumstances, which if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The Complainant relies primarily upon sub-paragraph (iv), which provides: "by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location."

As can be seen from C above, the Panel has found that in registering and using the Domain Name as it has, the Respondent has impersonated the Complainant. It was clearly intentional and for commercial gain.

The Panel finds that the Domain Name has been registered and is being used in bad faith within the meaning of paragraph 4(b)(iv) 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 Domain Name, <ambiensleepingpills.com>, be transferred to the Complainant.

*/Tony Willoughby/*

**Tony Willoughby**

Sole Panelist

Date: November 9, 2022