

ADMINISTRATIVE PANEL DECISION

Sanofi v. Rose Johnson

Case No. D2022-3695

1. The Parties

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

The Respondent is Rose Johnson, India.

2. The Domain Name and Registrar

The disputed domain name <ambien-online.org> (the “Disputed Domain Name”) is registered with Dreamscape Networks International Pte Ltd (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 3, 2022. On October 5, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On October 11, 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 (Private Registry Authority) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 17, 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 18, 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 25, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 14, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 23, 2022.

The Center appointed Michael D. Cover as the sole panelist in this matter on December 13, 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

The Complainant is a French multinational pharmaceutical company, headquartered in Paris, with annual consolidated sales of in excess of EUR 30 billion. The Complainant ranks as the world's 4th largest multinational pharmaceutical company by prescription sales. The Complainant was formed as Sanofi-Aventis in 2004, by the merger of Aventis and Sanofi-Synthélabo, and changed its name to its present style, Sanofi, in May 2011. The Complainant has a presence in more than 100 countries around the world and employs some 100,000 people.

The Complainant engages in research and development, manufacturing and marketing of pharmaceutical products for sale, principally in the prescription pharmaceutical market but the Complainant also develops over-the-counter medication.

The Complainant invested some EUR 5.9 billion in research and development in 2018 and offers a wide range of drugs to treat patients with serious diseases in a range of major therapeutic areas. With reference to the products sold under the Complainant's AMBIEN trademark, this is a drug with demonstrated utilities for the treatment of insomnia.

The Complainant is the proprietor of the following registered trademarks, registered in connection with Class 5, pharmaceutical products, of the International Classification:

French trademark AMBIEN No. 93456039 registered on February 19, 1993 in class 5 and duly renewed (Annex 9.1 to the Complaint);

European Union trademark AMBIEN No. 003991999 filed on August 17, 2004 and registered on November 28, 2005 in class 5 (Annex 9.2);

International trademark AMBIEN No. 605762 registered on August 10, 1993 in class 5, duly renewed and designating Algeria, Belarus, Benelux, Bulgaria, China, Croatia, Czech Republic, Egypt, Germany, Hungary, Italy, Kazakhstan, Liechtenstein, Monaco, Montenegro, Morocco, Poland, Romania, Russian Federation, San Marino, Serbia, Slovakia, Slovenia, Spain, Sudan, Switzerland, Ukraine, Uzbekistan and Viet Nam (Annex 9.3);

United States of America trademark AMBIEN No. 74345754 filed on January 5, 1993 and registered on December 7, 1993 and duly renewed.

The Complainant is also the owner of the following domain names among others (Annex 10 to the Complaint), which are used by the Complainant in connection with AMBIEN pharmaceutical products:

<ambien.com> registered on April 12, 2000 (Annex 10.1 to the Complaint);

<ambien.net> registered on April 12, 2000 (Annex 10.2);

<ambien.info> registered on August 24, 2001 (Annex 10.3); and

<ambien.org> registered on April 12, 2000 (Annex 10.4).

The Disputed Domain Name was registered on December 27, 2019 and resolves to a website offering for sale pharmaceutical products, with offers such as "Buy Ambien Online Overnight Delivery" and "Buy Ambien Online without Prescription" and at least many other (seemingly random) prescription drugs manufactured not by the Complainant but by third parties, such as: Levitra, Viagra, Soma, Xanax, etc.

5. Parties' Contentions

A. Complainant

Identical or Confusingly Similar

The Complainant, having set out details of its business, as referred to above, submits that it is a major player on the worldwide pharmaceutical market. The Complainant notes that all of the registered trademarks and domain names were registered prior to the registration of the Disputed Domain Name. The Complainant states that it should be highlighted that the Respondent should not simply have ignored the Complainant, whose trademarks and domain names are present worldwide.

The Complainant submits that the Disputed Domain Name reproduces the Complainant's AMBIEN trademarks and domain names in their entirety, which trademark has no particular meaning and are therefore highly distinctive.

The Complainant continues that the reproduction of the Complainant's trademark as the dominant part of the Disputed Domain Name is confusingly similar to the AMBIEN trademark of the Complainant, regardless of the addition of the term "online" and the generic Top-Level Domain ".org.". The Complainant notes that previous panels have held that the addition of another word to a trademark is not sufficient to escape the finding of similarity and cites in support *Sanofi-Aventis v. Domain Guru*, WIPO Case No. [D2005-1359](#). The Complainant submits that the addition of the term "online" after the trademark AMBIEN in the Disputed Domain Name is not sufficient to alleviate the likelihood of confusion between the Complainant's AMBIEN trademark and the Disputed Domain Name.

The Complainant also submits that the fact that the Complainant's AMBIEN trademark is used in connection with a well-established sleeping aid establishes the likelihood of confusion.

The Complainant concludes that the Disputed Domain Name is confusingly-similar to the trademarks and domain names in which the Complainant has rights.

Rights or Legitimate Interests

The Complainant states that obviously the Respondent does not have any legitimate interests regarding the Disputed Domain Name and that the Respondent has neither the prior rights nor legitimate interests to justify the use of the already well-known and worldwide trademarks and domain names of the Complainant.

The Complainant notes that the registrant of the Disputed Domain Name was initially stated to be "Redacted for Privacy" and states that this is a service that offers its clients to register domain names on their behalf in order to keep the true identity of the registrant secret.

The Complainant also states that the Complainant has never licensed or otherwise authorized the Respondent to use its trademarks or to register any domain name, including its AMBIEN trademark.

The Complainant submits that the Respondent is not making legitimate noncommercial or fair use of the Disputed Domain Name nor is the Respondent using the Disputed Domain Name in connection with a *bona fide* offering of goods or services, so as to confer a right or legitimate interest in it in accordance with paragraph 4(c)(i) of the Policy, given that what the Complainant calls the litigious domain name website is not used legitimately by the Respondent.

On the contrary, the Disputed Domain Name resolves to an online platform, from which consumers can purchase medications, says the Complainant. The Complainant continues that a tab on that website allows users to obtain counterfeit "ambien" drugs in 10mg.

The Complainant submits that the Disputed Domain Name has been registered only for the purpose of unfairly attracting Complainant's consumers, as is revealed, says the Complainant, on the Respondent's webpage. The Complainant submits that the Disputed Domain Name has been registered only for the purpose of unfairly attracting consumers into thinking that the Respondent is, in some way, connected to, sponsored by or affiliated with the Complainant and its business or that the Respondent's activities are approved or endorsed by the Complainant. The Complainant states that this use is detrimental and harming for the Complainant's brand reputation.

The Complainant concludes that the Respondent has no rights or legitimate interests in the Disputed Domain Name, under the Policy, paragraph 4(a)(ii).

Registered and Used in Bad Faith

The Complainant maintains that it is obviously clear that the Respondent has registered the Disputed Domain Name in bad faith, as this behaviour can in no way be the result of a mere coincidence.

The Complainant submits that the fact that the Respondent has no rights or legitimate interests to justify the use of the well-known trademark AMBIEN, which is also highly distinctive, as it has no particular meaning, points towards bad faith. The Complainant adds that, given the famous and distinctive nature of the Complainant's AMBIEN trademark, the Respondent would have had constructive, if not actual notice of the Complainant's AMBIEN trademark.

The Complainant then continues that the Disputed Domain Name has obviously been registered for the purpose of attracting Internet users to the Respondent's website by creating a likelihood of confusion between the Disputed Domain Name and the Complainant's AMBIEN trademark and domain names.

The Complainant notes that numerous previous panel decisions had acknowledged the well-known status of the Complainant's AMBIEN trademark and that this consideration is, in itself, indicative of bad faith. For these reasons, the Complainant concludes, there is no doubt that the Disputed Domain Name has been registered in bad faith.

The Complainant also submits that the Disputed Domain Name is being used in bad faith. First, the Complainant notes that, given the famous and distinctive nature of the AMBIEN trademark of the Complainant, the Respondent is likely to have had at least constructive, if not actual notice of the Complainant's trademark when the Disputed Domain Name was registered.

Second, the Complainant notes that the Disputed Domain Name directs Internet users to a website which is not the official website of the Complainant's products and submits that the Respondent has registered the Disputed Domain Name primarily for the purpose of trying to gain the benefit of the Complainant's reputation, which, says the Complainant, suggests an effort to create confusion with the Complainant's trademarks and domain names as to the source, sponsorship, affiliation or endorsement of the Respondent's website and the products displayed/ advertised for sale on it.

Third, the Complainant submits that the Respondent has clearly registered and used the Disputed Domain Name for the purpose of disrupting the Complainant's business, by selling what the Complainant calls the directly counterfeit AMBIEN products and that this constitutes further evidence of the Respondent's bad faith. Last, the Complainant states that what it calls the illegal use of the Disputed Domain Name in this manner is likely to cause irreparable damage to the Complainant's general goodwill, because Internet users could be led to believe that the Complainant is involved in the sale of counterfeit medicines.

The Complainant concludes that the Disputed Domain Name has been both registered and used intentionally in bad faith, without any rights or legitimate interest by the Respondent.

The Remedy Requested by the Complainant

The Complainant requests that the Disputed Domain Name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

The Complainant must establish on the balance of probabilities that the Disputed Domain Name is identical or confusingly similar to a trademark in which the Complainant has rights; that the Respondent has no rights or legitimate interests in the Disputed Domain Name; and that the Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel finds that the Complainant has established registered rights in its trademark AMBIEN and also that the extensive use of this trademark has meant that it has become well known. (The first registration of the Complainant's registered trademark AMBIEN goes back over 25 years before the registration of the Disputed Domain Name.)

The Panel also finds that the Disputed Domain Name is confusingly similar to the Complainant's AMBIEN trademark, in which the Complainant has rights. The Disputed Domain Name incorporates the Complainant's trademark AMBIEN, in which the Complainant has rights, in full. In assessing confusing similarity, it is well established that the addition of other terms, such as "-online", does not prevent a finding of confusing similarity. It is also well established that the addition of the gTLD ".com" is viewed as a standard registration requirement and, as such, is disregarded under the first element of the Policy.

The Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's trademark, AMBIEN, in which the Complainant has rights, and that the provisions of the Policy, paragraph 4(a)(i) have been met.

B. Rights or Legitimate Interests

The Panel accepts and finds that the Respondent has no rights or legitimate interests in the Disputed Domain Name and finds that the provisions of paragraph 4(a)(ii) of the Policy have been met.

The Panel accepts and finds that the Respondent has not been authorized, licensed, or otherwise permitted by the Complainant to register or use the Complainant's AMBIEN registered trademark as part of the Disputed Domain Name or otherwise.

The Complainant has established a case, to which no response has been filed, that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The Respondent has not, before any notice to the Respondent of the dispute, made use or demonstrable preparations to use the Disputed Domain Name or a name corresponding to it in connection with a *bona fide* offering of goods or services nor has the Respondent been commonly known by the Disputed Domain Name nor has the Respondent made noncommercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. Such use as has in fact taken place of the Disputed Domain Name involves the Disputed Domain Name resolving to a website, which offers goods not only which purport to be those offered by the Complainant or purport to be those of the Complainant but of competing third parties, which does not constitute a *bona fide* offering of goods or services and which could tarnish the Complainant's AMBIEN trademark.

C. Registered and Used in Bad Faith

The Panel accepts and finds that the Disputed Domain Name has been registered and is being used in bad faith. It is a reasonable inference that the Respondent knew of the Complainant's AMBIEN trademark, which the Panel has accepted is well known. The Respondent could have had no reason to register the Disputed Domain Name, if not for the significance of the dominant "Ambien" element of the Disputed Domain Name as the trademark of the Complainant. The Panel's finding has been reinforced by the finding that the Disputed Domain Name was being used in connection with the offering of goods described as AMBIEN goods of the Complainant – not to mention the several drugs of third party competitors – and with the likelihood that these would be counterfeit. In addition, the Respondent has failed to avail herself of the opportunity to file any response to the Complaint and, in particular, to file any evidence of any good faith use of the Disputed Domain Name and has sought to conceal her identity.

The Panel accordingly finds that the Respondent has registered and is using the Disputed Domain Name in bad faith and that the provisions of the Policy, paragraph 4(a)(iii) have been met.

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, <ambien-online.org>, be transferred to the Complainant.

/Michael D. Cover/

Michael D. Cover

Sole Panelist

Date: December 27, 2022