

ADMINISTRATIVE PANEL DECISION

Sanosil AG v. Dev Gupta, Sanosil Biotesh
Case No. D2022-1413

1. The Parties

Complainant is Sanosil AG, Switzerland, represented by Isler & Pedrazzini AG, Switzerland.

Respondent is Dev Gupta, Sanosil Biotesh, India.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 20, 2022. On April 20, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On April 21, 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 to Complainant on April 25, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on the same day.

The Center verified that the Complaint together with the amended 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 May 5, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 25, 2022. The Response was filed with the Center on May 24, 2022.

The Center appointed Robert A. Badgley as the sole panelist in this matter on May 25, 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 June 8, 2022, the Panel issued Procedural Order No. 1, which stated:

“The Panel has reviewed the submissions from the Parties in this case.

In accordance with paragraphs 10 and 12 of the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), the Panel orders that Respondent provide the Center, on or before June 20, 2022, the following information, backed up by documentary evidence wherever possible:

1. Explain why, when it was first formed on or around June 24, 1985, Respondent adopted the name “Sanosil Chemicals (India) Private Limited”. Specifically, why did Respondent include the word “Sanosil” in its company name?
2. At the time of formation on or around June 24, 1985, was Respondent aware of Complainant Sanosil AG and Complainant’s use of SANOSIL as a trademark in certain jurisdictions?
3. Why was the company name changed to Sanosil Biotech Private Limited?
4. Is the reference to “Sanosil Biotesh” in the Whois database for the registration of the Domain name at issue (namely, <sanosilbiotech.com>) an erroneous misspelling of “Sanosil Biotech”?
5. When Respondent applied to register in India the trademark (Reg. No. 989415) SANOSIL PUROSIL, was the contractual relationship between Complainant and Respondent already terminated? If so, why did Respondent include the word SANOSIL in this trademark application?
6. Respond to Complainant’s allegation that Respondent is misleadingly marketing “Swiss quality” for products that “have neither been developed nor produced in Switzerland”.
7. Respond to Complainant’s allegation that Respondent is falsely claiming in its marketing materials that there is an ongoing “technical collaboration” with Complainant.
8. Respond to Complainant’s allegation that Respondent’s “VIROSIL” Brochure (Complaint Annex 20) misleadingly includes, in the upper left corner of each page, a reference to “SANOSIL TM”.

Complainant shall have until June 27, 2022, to reply to Respondent’s response to this Procedural Order No. 1.

The Parties’ further submissions should be limited to the above request.

The Panel reserves the right to raise further questions or make additional requests for information or documentation.”

On June 27, 2022, Respondent submitted to the Center a letter stating that Respondent refused to respond to Procedural Order No. 1 because it objected to the Center’s jurisdiction over this dispute.

On July 6, 2022, the Panel issued Procedural Order No. 2, which stated in relevant part:

“In response to Procedural Order No. 1, Respondent submitted (on June 27, 2022, *i.e.*, one week late) to the WIPO Arbitration and Mediation Center (the “Center”) a response in which Respondent refused to answer the questions raised in the Panel’s Procedural Order No. 1 on the purported basis that Respondent objects to the Center’s jurisdiction over this dispute.

The Panel now orders as follows:

First, the Center (and this Panel) has jurisdiction over this dispute. As was set forth in section V of the Complaint, this dispute is governed by the Uniform Domain Name Dispute Resolution Policy (“UDRP”) by virtue of Respondent having agreed the terms of the domain name registration agreement with the Registrar (GoDaddy). Article 6 of that agreement states, in relevant part:

“You agree to be bound by our current Dispute Resolution Policy. This policy is incorporated herein and made a part of this Agreement. You can view the Uniform Domain Name Dispute Resolution Policy online. You agree that GoDaddy may from time to time modify its Dispute Resolution Policy. GoDaddy will post any changes to its Dispute Resolution Policy at least thirty (30) days before they become effective. You agree that by maintaining your domain name registrations with GoDaddy after the updated policy becomes effective that you agree to the Dispute Resolution policy as amended. You agree to review GoDaddy's website periodically to determine if changes have been made to the Dispute Resolution Policy.”

Second, because the Center (and this Panel) has jurisdiction over this dispute, the Panel now orders Respondent to respond fully to the items set forth in the Panel's Procedural Order No. 1, and do so on or before July 12, 2022. [...]

Complainant shall have until July 19, 2022, to reply to any response Respondent makes to this Procedural Order No. 2.

The Panel reserves the right to raise further questions or make additional requests for information or documentation. The Panel also reserves the right to draw an adverse inference from any failure to respond fully to the items indicated in Procedural Order No. 1.”

On July 11, 2022, the Center responded to Complainant's request for an extension, stating as follows:

“The Panelist grants the Complainant the extension to submit any response the Respondent may make to August 9, 2022. As a result, the Respondent's response due date is also extended to July 26, 2022, and the Decision due date is extended until August 16, 2022.”

Respondent submitted no response to Procedural Order No. 2 (and hence no response to the items contained in Procedural Order No. 1). Complainant did not file a further submission after Procedural Order No. 2 was issued.

4. Factual Background

Founded in Switzerland in 1982, Complainant states that it “is active in the development, production, marketing and sale of disinfectants for various fields of application, such as water industry, public health, facility management and food and beverage industry.”

Complainant holds various trademark registrations for the mark SANOSIL, either in word form or in stylized form, including: Swiss Reg. No. 2P-320087 for the stylized mark SANOSIL, registered in connection with “disinfectants for water (except for mouth and teeth)”, with a priority date of August 16, 1982; and Indian Reg. No. 414349 for the stylized mark SANOSIL, registered in connection with “disinfectants excluding those for the mouth and teeth,” with a priority date of December 13, 1983.

Complainant operates a commercial website at the domain name <sanosil.com>.

Complainant states that it has entered into agreements with local distributors in more than 30 countries, including India, to sell its SANOSIL products.

On August 28, 1986, Complainant entered into an agreement with an Indian company called Sanosil Chemicals (India) Private Limited ("SCIPL"). Under this agreement, Complainant granted SCIPL the right to use Complainant's SANOSIL mark "in the business operations of SCIPL covering the manufacture, sale and distribution of chemical products within India." This agreement also granted to SCIPL the right to use the business name Sanosil Chemicals (India) Private Limited, but, in the event the agreement were terminated, SCIPL was required (upon request by Complainant) to take all necessary steps to cancel the registration of that business name. The agreement also states that SCIPL had no right, title, or interest in Complainant's SANOSIL "logo."

On September 12, 1986, Complainant and SCIPL entered into a "Technical Collaboration Agreement," and on February 21, 1987, the Parties entered into a "Supplemental Technical Collaboration Agreement." By the time of the latter agreement, Complainant alleges, SCIPL had changed its name to Sanosil Biotech Private Ltd. ("SBPL"). Complainant alleges that the named Respondent in this proceeding, Sanosil Biotech, is in fact the predecessor of SCIPL and SBPL. Respondent has not denied any of the allegations in this paragraph.

The Domain Name was registered on July 24, 1998. The Domain Name resolves to a website marketing Respondent's VIROSIL disinfectant products. At the top of the page, there is a stylized trademark VIROSIL, under which the following text appears in smaller font: "A PRODUCT OF SANOSIL BIOTECH."

Complainant alleges that, in 2003, it became aware that SBPL was "selling SANOSIL products also outside India which amounted to a material breach" of the distributorship agreements. Complainant asserts that it warned SBPL about this several times, but SBPL continued its sales outside India. By letter dated February 12, 2007, Complainant formally terminated its contract with SBPL, and demanded that SBPL cease any use of the SANOSIL "name and logo" in India or elsewhere. Respondent has not denied any of the allegations in this paragraph.

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied all three elements required under the Policy for a transfer of the Domain Name.

B. Respondent

Respondent disputes the jurisdiction of the Center, and this Panel, to decide this case. That issue was dealt with in Procedural Order No. 2.

Respondent also asserts that, while the name "Sanosil" is part of its company name, it does not market any products called SANOSIL. Rather, according to Respondent, its products are marketed under the trademark VIROSIL.

Respondent makes other arguments that are unsupported or irrelevant to this proceeding, and they will not be addressed herein.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements, which Complainant must satisfy with respect to the Domain Name:

(i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and

- (ii) 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.

A. Identical or Confusingly Similar

The Panel concludes that Complainant has rights in the trademark SANOSIL through registration and use demonstrated in the record. The Panel also concludes that the Domain Name is confusingly similar to that mark. The dominant element of the mark – SANOSIL – is entirely reproduced in the Domain Name.

Complainant has established Policy paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services; or
- (ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] are making a legitimate noncommercial 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.

The Panel concludes that Respondent lacks rights or legitimate interests in respect of the Domain Name. Despite being given the opportunity to respond to several pointed questions by the Panel, and despite the Panel's express reservation of its inherent right to draw adverse inferences from a lack of response to those questions, Respondent offered nothing by way of explanation, much less evidence, to support its purported version of events.

The Panel finds that, while Respondent appears to be operating a legitimate business selling disinfectants under the trademark VIROSIL, Respondent has no legitimate interests vis-à-vis the Domain Name, which features Complainant's distinctive trademark SANOSIL in its entirety. The Panel has little option but to credit Complainant's version of events, namely, that Respondent registered the Domain Name solely because it had a business relationship with Complainant to market Complainant's SANOSIL products in India. There is no basis in the record to conclude that Respondent would have had any legitimate reason to register the Domain Name except for its knowledge of Complainant. In particular, there is no indication in the record that Complainant gave Respondent express permission to use SANOSIL trademark in a domain name. Having registered the Domain Name without express authority to do so, Respondent went on to violate the territorial limits in its contract with Complainant, and Respondent uses the Domain Name to sell its own similar products under the VIROSIL brand. Such use of the Domain Name does not reflect a *bona fide* offering of goods, and does not give rise to any rights or legitimate interests in respect of the Domain Name.

Complainant has established Policy paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, "in particular but without limitation," are evidence of the registration and use of the Domain Name in bad faith:

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or

- (ii) that Respondent has 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 Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

The Panel concludes that Respondent has registered and used the Domain Name in bad faith. The Panel incorporates its discussion above in the "Rights or Legitimate Interests" section, and reiterates that Respondent had ample opportunity to rebut the clear allegations contained in the Complaint, but chose not to do so.

On the record provided, the Panel concludes that Respondent registered the Domain Name with Complainant's SANOSIL trademark in mind. The Panel also concludes that Respondent used the Domain Name in bad faith, within the meaning of the above-quoted Policy paragraph 4(b)(iv). Specifically, Respondent is selling disinfectant products – as Complainant does – through use of a Domain Name which entirely incorporates Complainant's distinctive SANOSIL trademark.

Complainant has established Policy 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 Domain Name <sanosilbiotech.com> be transferred to Complainant.

/Robert A. Badgley/

Robert A. Badgley

Sole Panelist

Date: August 16, 2022