

ADMINISTRATIVE PANEL DECISION

Sanofi v. Privacy Service Provided by Withheld for Privacy ehf / Matt Gordon,
Monogram Naming
Case No. D2022-1610

1. The Parties

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

The Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / Matt Gordon, Monogram Naming, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <initiv.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 4, 2022. On May 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 4, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on May 11, 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 May 16, 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 May 23, 2022. In accordance with the Rules, paragraph 5, the due date for Response was June 12, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 15, 2022.

The Center appointed Adam Taylor as the sole panelist in this matter on June 30, 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 July 14, 2022, the Panel issued Procedural Order No. 1 requesting information from the Complainant regarding its trading activities under the name "INITIV" by July 19, 2022. The Complainant did not respond.

4. Factual Background

The Complainant is a multinational pharmaceutical company, operating in more than 100 countries and employing some 100,000 people.

The Complainant owns a number of trade marks for INITIV, the earliest of which is French trade mark no. 4608730, filed on December 19, 2019, registered on April 10, 2020, in classes 5 and 10.

The disputed domain name was registered on November 5, 2019.

The disputed domain name was used to resolve to a Registrar parking page with assorted pay-per-click ("PPC") links such as "En Ligne Menu" (online menu), "Commande Course en Ligne" (order shopping online) and "Lancer une Boutique en Ligne" (launch an online store).

5. Parties' Contentions

A. Complainant

The following is a summary of the Complainant's contentions.

The Complainant develops, manufactures, distributes, and sells a wide variety of pharmaceutical products under the trade mark and trade name SANOFI as well as INITIV.

The disputed domain name is identical to the Complainant's trade mark INITIV.

Registration of a domain name before a complainant acquires trade mark rights does not prevent a finding of identity or confusingly similarity as the UDRP makes no specific reference to the date when the trade mark rights were acquired.

There is an inevitable risk that the disputed domain name will confuse consumers into thinking that the disputed domain name is "the official INITIV website".

UDRP panels have found that the Complainant's trade marks are well-known in many jurisdictions.

The Respondent lacks rights or legitimate interests in the disputed domain name.

The name of the Respondent does not resemble the word "initiv".

The Complainant has not authorised the Respondent to register the disputed domain name or to use its trade mark.

The Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services. Nor is it making a legitimate noncommercial or fair use of the disputed domain name. The Respondent is using the disputed domain name for commercial gain by misleadingly diverting consumers. The Respondent's use of a third party trade mark to lead Internet users to its parking page does not amount to a *bona fide* noncommercial use.

The disputed domain name was registered and is being used in bad faith.

Panel decisions regularly recognise opportunistic bad faith in cases in which a disputed domain name is identical or confusingly similar to a Complainant's well-known trade mark.

It is obvious that the Respondent registered the disputed domain name because it corresponded to the Complainant's trade mark as this could not have been a mere coincidence. The Respondent had no prior right or legitimate interest that would justify the use of the already well-known and worldwide trade marks and domain name of the Complainant.

Given the famous and distinctive nature of "the company 'SANOFI'", the Respondent is likely to have had, at least, constructive, if not actual notice, of the existence of the Complainant's marks at the time of registering the disputed domain name. This suggests that the Respondent acted with opportunistic bad faith.

The Respondent registered the disputed domain name to create a likelihood of confusion – or at least impression of association – between the disputed domain name and the Complainant's INITIV trade marks. The Complainant is one of the world's leading pharmaceutical companies and SANOFI is one of the most cyber-squatted trade marks. The Respondent must undoubtedly have been aware the risk of confusion that would arise from registration of the disputed domain name, since it would lead users seeking the official INITIV websites to the website at the disputed domain name.

The Respondent's parking page constitutes use in bad faith as it is undoubtedly attempting to ride off the Complainant's worldwide reputation.

B. Respondent

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

6. Discussion and Findings

Under the Policy, the Complainant is required to prove on the balance of probabilities that:

- the disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- the disputed domain name has been registered and is being used in bad faith.

A. Preliminary Issue – Default

A respondent default is not necessarily an admission that the complainant's claims are true. See section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). In certain cases, *e.g.*, involving wholly unsupported and conclusory allegations advanced by a complainant, panels may find that – despite a respondent's default – a complainant has failed to prove its case.

B. Identical or Confusingly Similar

Disregarding the Top-Level Domain ("TLD") suffix, which is excluded from the comparison, the disputed domain name is identical to the Complainant's registered trade mark INITIV. Accordingly, the Panel finds that the Complainant has established the first element of paragraph 4(a) of the Policy.

C. Rights or Legitimate Interests

It is unnecessary to consider this element in view of the Panel's finding under the third element below.

D. Registered and Used in Bad Faith

Section 3.8.1. of [WIPO Overview 3.0](#) observes that, except for limited circumstances involving registration of a domain name to capitalise on nascent trade mark rights, panels will not normally find bad faith on the part of the respondent where a respondent registers a domain name before the complainant's trade mark rights accrue.

The Panel is treating the disputed domain name registration date of November 5, 2019, as the date when the Respondent acquired the disputed domain name because the Complainant has not contended for a later acquisition date and, indeed, when invoking its registered trade mark rights under the first element, the Complainant specifically asserts that registration of a domain name before the acquisition of trade mark rights does not prevent a finding of identity or confusing similarity. The Complainant therefore apparently acknowledges that its registered trade mark rights post-date the Respondent's acquisition of the disputed domain name.

The difficulty for the Complainant is that, as further discussed in section 6.E. below, it has failed to supply evidence that it acquired any common law rights in the term "INITIV" before registration of the disputed domain name, or indeed since, or of any nascent trade mark rights predating the disputed domain name.

Accordingly, the disputed domain name could not have been registered in bad faith and this is fatal to the Complainant's case, irrespective of the nature of any later use of the disputed domain name, because the Complainant is required to prove both registration and use in bad faith.

E. Reverse Domain Name Hijacking ("RDNH")

Paragraph 15(e) of the Rules provides that, if "after considering the submissions the panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding". RDNH is defined under the Rules as "using the UDRP in bad faith to attempt to deprive a registered domain-name holder of a domain name".

Section 4.16 of the [WIPO Overview 3.0](#) sets out examples of the reasons articulated by panels for finding RDNH. These include: "(i) facts which demonstrate that the complainant knew it could not succeed as to any of the required three elements – such as the complainant's lack of relevant trade mark rights, clear knowledge of respondent rights or legitimate interests, or clear knowledge of a lack of respondent bad faith ... such as registration of the disputed domain name well before the complainant acquired trademark rights, ... (iv) the provision of false evidence, or otherwise attempting to mislead the panel, (v) the provision of intentionally incomplete material evidence – often clarified by the respondent..."

In this case, the Complaint seeks to give the impression (a) that the Complainant supplies pharmaceutical products for sale under the name "INITIV" and (b) that such rights predate registration of the disputed domain name by the Respondent.

For example: the Complaint states at section 12.A.2: "SECONDLY, SANOFI is a multinational company in the pharmaceutical field which develops, manufactures, distributes and sells a wide variety of pharmaceutical products under the trademark and trade name SANOFI as well as INITIV." And at section 12.C1: "The Respondent has neither prior right nor legitimate interest to justify the use of the already well-known and worldwide trademarks and domain name of the Complainant." Also in section 12.C.1: "Therefore, it can only be found that the Respondent must have been undoubtedly aware of the risk of deception and confusion that would inevitably arise from the registration of the disputed domain name since

it could lead internet users searching for official INITIV websites to the litigious page.”

Despite such assertions, the Panel was unable to find any evidence of any actual trading activity by the Complainant under the name “INITIV” within the voluminous annexes to the Complaint, or indeed when searching on Google. To clarify the position, the Panel issued Procedural Order No. 1, requesting the Complainant to provide, amongst other things, evidence of the date when it allegedly started trading under the name “INITIV” and of the extent of its alleged reputation in that name as of the date that the Respondent acquired the disputed domain name. The Panel also invited the Complainant to give reasons as to why the Panel should not make an order of RDNH against the Complainant if the Complainant was unable to provide the requested information. The Complainant did not respond – and its failure to do so is telling.

The Panel is no doubt that the Complainant was well aware of the requirement, and its inability, to establish prior trade mark rights under the third element of the Policy. The Complainant plainly hoped that, by asserting prior unregistered trade mark rights in INITIV, by invoking its later-acquired registered trade mark rights and by exhibiting a great deal of material relating to its extensive trading activities under its other brands, the Panel would somehow miss the fact the Complainant had never actually traded under the name “INITIV” and would simply wave the case through.

In the Panel’s view, the Complainant set out to deliberately mislead the Panel and this is a clear case of RDNH.

The Panel would add that, while it has imputed the actions of the Complainant’s representatives to the Complainant, the Panel acknowledges that the Complainant may well be unaware of the attempted deception undertaken in its name and that the fault may lay entirely with the Complainant’s representatives.

7. Decision

For the foregoing reasons, the Complaint is denied, and the Panel finds that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.

/Adam Taylor/

Adam Taylor

Sole Panelist

Date: July 23, 2022