

ADMINISTRATIVE PANEL DECISION

Sanofi, and Chattem Inc. v. Stacey McGrath
Case No. D2022-3392

1. The Parties

The Complainants are Sanofi, France, and Chattem Inc., United States of America (“US”), jointly referred to as the “Complainant”, represented by Selarl Marchais & Associés, France.

The Respondent is Stacey McGrath, US, self-represented.

2. The Domain Name and Registrar

The disputed domain name <buyzantac.xyz> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 12, 2022. On September 12, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 13, 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 September 14, 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 September 15, 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 16, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 6, 2022. The Center received email communications from the Respondent on October 9, 2022.

The Center appointed Johan Sjöbeck as the sole panelist in this matter on October 29, 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 has submitted evidence that it is the owner of a number of trademark registrations, including the following:

ZANTAC, US registration No. 1220525, filed on December 9, 1980, and registered on December 21, 1982, in class 5 notably concerning pharmaceutical preparations.

ZANTAC (fig), US registration No. 1685021, filed on October 4, 1990, and registered on May 5, 1992, in class 42 notably concerning pharmaceutical services.

ZANTAC 75, US registration No. 2016139, filed on August 9, 1994, and registered on November 12, 1996, in class 5 notably concerning pharmaceutical preparations.

ZANTAC 150, US registration No. 3080635, filed on June 1, 2004, and registered on April 11, 2006, in class 5 notably concerning pharmaceutical preparations.

CAPTAIN ZANTAC, US registration No. 5407835, filed on October 16, 2014, and registered on February 20, 2018, in classes 35 and 44 notably concerning promoting public awareness of ulcers and gastrointestinal disorders and providing information about ulcers and gastrointestinal disorders.

Z ZANTAC (fig), US registration No. 5484192, filed on July 20, 2017, and registered on June 5, 2018, in class 44 notably concerning medical information on the treatment of gastrointestinal disorders.

ZANTAC 360° (fig)m US registration No. 6584735, filed on September 14, 2020, and registered on December 7, 2021, in class 5 for pharmaceutical preparations.

ZANTAC 360° (fig), US registration No. 6584646, filed on August 31, 2020, and registered on December 7, 2021, in class 5 for pharmaceutical preparations.

ZANTAC 360°, US registration No. 6761355, filed on August 31, 2020, and registered on June 14, 2022, in class 5 for pharmaceutical preparations.

The disputed domain name <buyzantac.xyz> was registered by the Respondent on August 20, 2022. The disputed domain name resolves to a website displaying pay-per-click links.

5. Parties' Contentions

A. Complainant

With consolidated net sales of 37.7 billion Euros in 2021, 36.04 billion Euros in 2020, 34.46 billion Euros in 2018, 35.05 billion Euros in 2017, 33.82 billion Euros in 2016, 34.06 billion Euros in 2015 and 31.38 billion Euros in 2014, the Complainant, Sanofi, is a French multinational pharmaceutical company headquartered in Paris, ranking fourth world's largest multinational pharmaceutical company by prescription sales. The Complainant is present in more than 100 countries on all five continents employing 100,000 people. The Complainant engages in research and development, manufacturing and marketing of pharmaceutical products for sale, principally in the prescription market, but the firm also develops over-the-counter medication. The Complainant is a full member of the European Federation of Pharmaceutical Industries and

Associations (EFPIA). Historically, the company was formed as Sanofi-Aventis in 2004 by the merger of Aventis and Sanofi-Synthelabo, and changed its name to Sanofi in May 2011. With an R&D investment of 5.9 billion Euros in 2018, the Complainant's Research and Development portfolio includes 83 projects in clinical development, 35 of which are at advanced stages. The Complainant offers a wide range of patented prescription drugs to treat patients with serious diseases and has leading positions in seven major therapeutic areas, namely cardiovascular, thrombosis, metabolic disorders, oncology, central nervous system, internal medicine, and vaccines.

Chattem Inc. is an American manufacturer of over-the-counter healthcare products, toiletries, dietary supplements, topical analgesics, and medicated skin care products founded in 1879 and owned by Sanofi since 2010. Chattem Inc.'s business has historically been concentrated in the US, Canada, Latin America, the United Kingdom, and Ireland. Chattem Inc. has developed its business in Europe through Chattem Global Consumer Products Limited, a newly established Irish subsidiary, located in Limerick, Ireland and Chattem, a wholly-owned subsidiary located in Basingstoke, Hampshire, England. Sanofi, the parent company of Chattem Inc., has invested substantial financial resources over the years to advertise and promote the company and its ZANTAC-trademarks in countries all over the world, including the US. Given the above, Sanofi and Chattem Inc. are referred to as the "Complainant" in this proceeding.

The disputed domain name reproduces the ZANTAC trademarks which, as themselves, do not have any particular meaning and are therefore highly distinctive, and which is sufficient to create confusing similarity between the disputed domain name and the Complainant's aforementioned trademarks. The reproduction of the ZANTAC trademarks as the dominant part of the disputed domain name is confusingly similar to the Complainant's trademarks, regardless of the adjunction of the generic and descriptive term "buy" and the Top-Level Domain ("TLD") ".xyz". Indeed, TLDs constantly remain, as such, insufficient to avoid confusing similarity, and will, on the contrary, merely suggest to Internet users that the disputed domain name is related to the Complainant, as the Complainant's marks remain the distinctive and dominant component of the disputed domain name.

Also, the addition of the widespread generic word "buy", which obviously refers to buying and constitutes as such common English word, remains insufficient to avoid confusing similarity. On the contrary, it must be considered that the adjunction of this generic term increases the inherent risk of confusion. In fact, the consumer will be deceived into believing that this domain name refers to a website offering ZANTAC products for sale. Hence, the contested domain name comprises: (a) an exact reproduction of the Complainant's trademark; (b) combined with a generic word; and (c) followed by the TLD ".xyz". There exists an inevitable risk that the disputed domain name will cause confusion, as it could lead average consumers to mistakenly believe that the disputed domain name is related to the official ZANTAC websites. It could also lead average consumers to mistakenly believe that the disputed domain name is one of the official ZANTAC websites dedicated to an international and intergenerational public. Indeed, the disputed domain name can be perceived as the Complainant's special website designed to provide information on ZANTAC goods particularly for people from Generations X, Y, and Z and to cover anything from A to Z, which is bound to create a likelihood of confusion between the disputed domain name and the Complainant's trademarks. In this regard, previous panels have already considered that the Complainant's trademarks are well-known in many jurisdictions.

The Respondent does not have any legitimate interest in using the disputed domain name since its name does not bear any resemblance with the word ZANTAC which has no meaning and is therefore highly distinctive. The Respondent has neither prior right nor legitimate interest to justify the use of the already well-known and worldwide trademarks and domain names of the Complainant. Consequently, the Respondent has no prior rights and/or legitimate interest to justify the use of the ZANTAC trademarks in the disputed domain name.

The Complainant has never licensed or otherwise authorized the Respondent to use its trademarks or to register any domain name including the trademarks. Consequently, there is no relationship whatsoever between the parties and the Respondent has clearly modified the Complainant's trademarks for its own use and incorporated them into the disputed domain name without the Complainant's authorization.

The Respondent is not making a legitimate noncommercial or fair use of the disputed domain name nor is he 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) or (iii) of the Policy given that the disputed domain name website is not used legitimately by the Respondent. Indeed, the disputed domain name website leads to a parking website and has been registered only for the purpose of attracting Internet users into clicking on the sponsored links. Thus, the Respondent is obviously using the disputed domain name to obtain commercial gain by misleadingly diverting consumers. Furthermore, previous panels have already held that the use of a third party's trademarks to lead the Internet user to a parking website does not correspond to a *bona fide* noncommercial use. See *Hoffmann-La Roche AG v. Macalve e-dominios S.A.*, WIPO Case No. [D2006-0451](#). Generally speaking, it must be borne in mind that Panel decisions regularly recognize opportunistic bad faith in cases in which the contested domain name appears confusingly similar to a Complainant's well-known trademarks. See for example *Sanofi v. Whois Agent, Whois Privacy Protection Service, Inc. / Jim Moretta*, WIPO Case No. [D2016-0096](#).

It is obvious that the Registrant does not have any legitimate interest in using the disputed domain name since the registrant name does not bear any resemblance with the word ZANTAC which has no meaning and is therefore highly distinctive. This behavior should undeniably be deemed sufficient to characterize bad faith registration. 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. Furthermore, the absence of legitimate interest somewhat induces that of good faith. It should be considered that, given the distinctive nature of the mark ZANTAC, the Respondent is likely to have had, at least, constructive, if not actual notice, as to the existence of the Complainant's marks at the time he registered the domain name. This suggests that the Respondent acted with opportunistic bad faith in registering the domain name in order to make an illegitimate use of it.

In addition, the disputed domain name has been registered for the purpose of attracting Internet users to the Respondent's website by creating a likelihood of confusion, or at least an impression of association, between the ZANTAC trademarks and the contested domain name.

Previous panels have found that the Complainant has a widespread reputation in the ZANTAC trademarks with regard to its products. See for example *Boehringer Ingelheim Pharmaceuticals Inc. v. JimmyX*, WIPO Case No. [D2016-0055](#). In cases in which the well-known status of a complainant's trademarks is well established, numerous panel decisions constantly acknowledge that this consideration is, in itself, indicative of bad faith registration and use. 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 ZANTAC websites to the disputed domain name website. This knowledge characterized the Respondent's bad faith usage.

For all these reasons, there is no doubt that the disputed domain name has been registered in bad faith by the Respondent, for the primary purpose of gaining unfair benefit of the Complainant's reputation. This disputed domain name was not only registered in bad faith but is also being used by the Respondent in bad faith. Firstly, it is clear that, given the distinctive nature and reputation of the trademark ZANTAC, the Respondent is likely to have had, at least, constructive, if not actual notice, as to the Complainant's marks at the time he registered the domain name. This suggests that the Respondent acted with opportunistic bad faith in registering the name in order to make an illegitimate use of it. This is sufficient to characterize a bad faith use under paragraph 4(b)(i) of the Policy. Secondly, the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name nor is he 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 the disputed domain name website is not used legitimately by the Respondent. Indeed, the disputed domain name website is a parking website and has been registered only for the purpose of attracting Internet users into clicking on sponsored links. The Respondent is undoubtedly trying to ride on the Complainant's worldwide reputation. This practice has been described and recognized as being a use of bad faith. See *Classmates Online, Inc v. Mary-Lamb*, WIPO Case No. [D2009-0715](#).

It follows from the above that the Respondent is undeniably trying to take advantage of the Complainant's reputation, characterizing all the more a bad faith usage. Consequently, the disputed domain name has been both registered and used intentionally in bad faith without any rights or legitimate interest by the Respondent.

B. Respondent

The Respondent did not reply to the Complainant's contentions. However, on October 9, 2022, the Respondent sent informal communications to the Center claiming to have recently registered the disputed domain name and that he had not yet used the disputed domain name.

6. Discussion and Findings

According to paragraph 4(a) of the Policy, the Complainant must prove each of the following:

- (i) the disputed 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 the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant is, according to the submitted evidence, the owner of the registered trademark ZANTAC. The disputed domain name incorporates the ZANTAC trademark in its entirety with the addition of the term "buy". The addition of the term "buy" to the ZANTAC trademark in the disputed domain name does not prevent a finding of confusing similarity.

Having the above in mind, the Panel concludes that the disputed domain name is confusingly similar to the Complainant's trademark and that the Complainant has proven the requirement under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant must show that the Respondent has no rights or legitimate interests with respect to the disputed domain name. The Respondent may establish rights or legitimate interests in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- (i) the Respondent uses or has made preparations to use the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services prior to the dispute; or
- (ii) the Respondent is commonly known by the disputed domain name, even if the Respondent has not acquired any trademark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark.

The Complainant's trademark registrations for ZANTAC predate the Respondent's registration of the disputed domain name. The Complainant has not licensed, approved, or in any way consented to the Respondent's registration and use of the trademark in the disputed domain name. There is no evidence in the case file indicating that the Respondent has used or made any preparations to use the disputed domain

name in connection with a *bona fide* offering of goods or services prior to the dispute. On the contrary, the Complainant has submitted evidence that the Respondent is using the disputed domain name, which is confusingly similar to the Complainant's trademark, to display sponsored commercial pay-per-click links competing with or capitalizing on the Complainant's trademark.

Although given the opportunity, the Respondent has not rebutted the Complainant's *prima facie* case. The Respondent has not submitted any evidence indicating that it is the owner of any trademark or that it is commonly known by the disputed domain name. Furthermore, there is no evidence indicating that the Respondent intends to make a legitimate, noncommercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark.

The Respondent has failed to invoke any circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy or otherwise, any rights or legitimate interests in respect of the disputed domain name. Thus, there is no evidence in the case that refutes the Complainant's submissions, and the Panel concludes that the Complainant has also proven the requirement under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under paragraph 4(b) of the Policy, evidence of bad faith registration and use include without limitation:

- (i) circumstances indicating the disputed domain name was registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the owner of a trademark or to a competitor of the trademark owner, for valuable consideration in excess of the documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) circumstances indicating that the disputed domain name was registered in order to prevent the owner of a trademark from reflecting the mark in a corresponding disputed domain name, provided there is a pattern of such conduct; or
- (iii) circumstances indicating that the disputed domain name was registered primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the disputed domain name has intentionally been used in an attempted to attract, for commercial gain, Internet users to the Respondent's website or other online location, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on that website or location.

As previously mentioned, the Complainant's trademark registrations for ZANTAC predate the registration of the disputed domain name. The Panel notes that the Complainant's trademark is considered distinctive and well known according to previous UDRP decisions cited by the Complainant. This and the fact that the disputed domain name comprises the Complainant's trademark ZANTAC in its entirety with the addition of the term "buy" make it inconceivable that that the Respondent coincidentally selected the disputed domain name without any knowledge of the Complainant and its trademarks.

Furthermore, the Complainant has provided evidence that the disputed domain name resolves to a parking website with sponsored commercial pay-per-click links competing with or capitalizing on the Complainant's trademark. Thus, the circumstances in the case indicate that the disputed domain name has intentionally been used in an attempted to attract, for commercial gain, Internet users to the Respondent's website or other online location, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on that website or location. Moreover, even if the pay-per-click links are automatically generated, such fact by itself would not prevent a finding of bad faith in these circumstances, particularly noting the reputation of the Complainant's trademark and the inherently misleading nature of the disputed domain name clearly incorporating such mark. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 3.5.

In the absence of any evidence to the contrary, the Panel is persuaded on the balance of probabilities that the Respondent registered and used the disputed domain name with the Complainant's trademark and business in mind. Another factor to weigh in the balance is the fact that the Respondent has not responded to the Complainant's contentions.

There is no evidence in the case file that refutes the Complainant's submissions and the Panel concludes that the Complainant has proved the requirements under paragraph 4(a)(iii) of the Policy that the disputed domain name has 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 <buyzantac.xyz> shall be transferred to the Complainant.

/Johan Sjöbeck/

Johan Sjöbeck

Sole Panelist

Date: November 12, 2022