

## **ADMINISTRATIVE PANEL DECISION**

Sanofi v. Alexander Shevchenko

Case No. D2022-3427

### **1. The Parties**

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

The Respondent is Alexander Shevchenko, Ukraine.

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

The disputed domain name <plavixgenerico.com> is registered with Gransy, s.r.o. d/b/a subreg.cz (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 15, 2022. On September 15, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 16, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant (Domain Admin, Whois protection) 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 October 18, 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 19, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 8, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 14, 2022.

The Center appointed Togo, Federica as the sole panelist in this matter on November 21, 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. Further Procedural Considerations**

Under paragraph 10 of the Rules, the Panel is required to ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case, and also that the administrative proceeding takes place with due expedition.

Since the Respondent's mailing address is stated to be in Ukraine, which is subject to an international conflict at the date of this Decision that may impact case notification, it is appropriate for the Panel to consider, in accordance with its discretion under paragraph 10 of the Rules, whether the proceeding should continue.

Having considered all the circumstances of the case, the Panel is of the view that it should. The Panel has reached this conclusion in part because the Panel does believe that the Respondent was made aware of the existence of the proceedings, since the Center employed reasonably available means calculated to achieve actual notice to the Respondent.

This Panel notes that, as specified by the Rules at para 2 (a) "Communications", the Center sent the Written Notice of the Complaint to both the named Privacy Service/Whois protection located in Czech Republic and the Respondent located in Ukraine, as per the information disclosed by the Registrar. While the Written Notice was not delivered to the Respondent, because of the Recipient absence, the Written Notice was indeed successfully delivered to the named Privacy Service - Domain Admin, Whois protection. In addition, the Center did successfully send the Written Notice of Complaint to the facsimile address shown in the disputed domain name's registration data in Registrar's Whois database for the registered disputed domain name holder, the technical and the administrative contact. Furthermore, as specified by the Rules, the Center also sent the Written Notice by email to the Respondent at: 1) its email address, as per the information disclosed by the Registrar; 2) at the email address shown in the disputed domain name's registration data in Registrar's Whois database for the registered disputed domain name holder, the technical and the administrative contact and 3) to a postmaster email address. There is no evidence that the case notification email to the Respondent's email address (No. 1) was not successfully delivered, while the notifications emails at the email address available in the Whois database (No. 2) and to a postmaster email address (No. 3) were undeliverable. Finally, the Center sent a Notice of this proceeding to the web form available at the webpage to which the disputed domain name resolves.

The Panel notes that, at the time of this decision, the disputed domain name no longer resolves to an active website, which suggests the Respondent's apparent awareness of this proceeding and control over the disputed domain name.

The Panel also notes that the Complainant has specified in the Complainant that any challenge made by the Respondent to any decision to transfer or cancel the disputed domain name shall be referred to the jurisdiction of the Courts of the location of the principal office of the concerned registrar. In this case, the principal office of the Registrar, Gransy, s.r.o., is in Prague, Czech Republic.

It is moreover noted that, for the reasons which are set out later in this Decision, the Panel has no serious doubt (albeit in the absence of any Response) that the Respondent registered and has used the disputed domain name in bad faith and with the intention of unfairly targeting the Complainant's goodwill in its trademark.

The Panel concludes that the Parties have been given a fair opportunity to present their case, and so that the administrative proceeding takes place with due expedition the Panel will proceed to a Decision accordingly.

## **5. Factual Background**

The Complainant is the registered owner of trademarks in several jurisdictions for the term “PLAVIX”, e.g. International registration No. 613041 PLAVIX (word) registered on December 27, 1993, for “Pharmaceutical products” in class 5 and designating several countries worldwide, amongst others Ukraine, where the Respondent is located. This trademark has been duly renewed and is in force; European Union Trade Mark No. 002236578 PLAVIX (word) registered on April 18, 2002 for “Pharmaceutical preparations” in class 5. This trademark has been duly renewed and is in force.

It results from the evidence provided by the Complainant that the disputed domain name, registered on September 7, 2022, resolved to an online shop allegedly selling and offering the Complainant’s Plavix goods, where the Complainant’s trademark was prominently featured. Currently, the disputed domain name resolves to an inactive website.

## **6. Parties’ Contentions**

### **A. Complainant**

It results from the Complainant’s allegations that it is a multinational pharmaceutical company headquartered in Paris (France), settled in more than 100 countries on all five continents employing 100,000 people circa. It is one of the world’s largest multinational pharmaceutical companies by prescription sales. It engages in research and development, manufacturing and marketing of pharmaceutical products for sale, principally in the prescription market, but it also develops over-the-counter medication.

Moreover, it offers a wide range of high-growth drugs, with several pharmaceutical blockbusters, amongst which Plavix, which is one of the two leading drugs in the category of thrombosis medicines. The drug commercialized as Plavix is an anti-platelet agent indicated for a number of atherothrombotic conditions. The Complainant has developed and sold throughout the world under the trademark PLAVIX a drug indicated for the reduction of recurrence after ischemic cerebrovascular disorder. It is one of the world’s ten leading medicines, and to date, over 100 million patients throughout the world have been treated with Plavix. It has been commercialized since 1998, first in the United States of America and then in Germany and in the United Kingdom and is available in over 115 countries.

Furthermore, the Complainant owns and uses several domain names including the term “PLAVIX”, in order to promote its products, e.g. <plavix.com>, created on March 26, 1998.

The Complainant contends that its trademark PLAVIX is highly distinctive and well-known worldwide.

The Complainant further contends that the disputed domain name is confusingly similar to the Complainant’s earlier trademark, since it entirely reproduces the “PLAVIX” trademarks regardless of the adjunction of the descriptive term “generico” (which is the Italian translation of the word “generic”) which refers to a “generic” drug, easily referring in the public mind to the Complainant’s activities in the healthcare field; the generic Top-Level Domain (“gTLD”) extension “.com”. It is also well-established that where a domain name wholly incorporates a complainant’s well-known and distinctive trademarks in its entirety, it is confusingly similar to that mark despite the addition of a word or, in this case, of descriptive terms.

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain name. According to the Complainant, the Complainant has never licensed or otherwise authorized the Respondent to use its trademarks or to register any domain name including the above-mentioned

trademarks. In addition, the Respondent is not using the contested 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 website at the disputed domain name is clearly used as a bait and switch. Indeed, the disputed domain name was registered for the sole purpose of misleadingly diverting consumers into thinking that the Respondent is, in some way or another, 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. In fact, the disputed domain name leads to a commercial website selling presumably fake PLAVIX goods. Indeed, by clicking on "ACQUISTA ORA" ("buy now" in Italian) button, the Internet user is redirected to another website, through which an Internet user can buy pharmaceutical products at a discounted price.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. In fact, given the famous and distinctive nature of the mark PLAVIX, 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 name. This suggests that the Respondent acted with opportunistic bad faith in having registered the disputed domain name in order to make an illegitimate use of it. 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 PLAVIX trademarks and the disputed domain name. In addition, as the disputed domain name direct Internet users to a website which is not the official website of the Complainant's goods, it is evident that the circumstances indicate that the Respondent has registered the disputed domain name primarily for the purpose of trying to gain unfair benefit of the Complainant's goodwill and reputation by using the disputed domain name, which suggests an effort to create a likelihood of confusion with the Complainant's trademarks and domain names as to the source, sponsorship, affiliation, or endorsement of the Respondent's websites and the products displayed/advertised for sale on them.

## **B. Respondent**

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

## **7. Discussion and Findings**

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable". Paragraph 4(a) of the Policy requires a complainant to prove each of the following three elements in order to obtain an order that the disputed domain name be transferred or cancelled:

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

The Panel will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

### **A. Identical or Confusingly Similar**

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

As mentioned in the Section 4 of the Decision, it results from the evidence provided that the Complainant is the registered owner of several trademark registrations for PLAVIX.

Prior UDRP panels have found that a disputed domain name is confusingly similar to a complainant's trademark where the disputed domain name incorporates the complainant's trademark in its entirety (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") at section 1.7.

This Panel shares this view and notes that the Complainant's registered trademark PLAVIX is fully included in the disputed domain name, followed by the term "generico". Furthermore, it is the view of this Panel that the addition of the term "generico" in the disputed domain name cannot prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark since the Complainant's trademark is clearly recognizable in the disputed domain name (see [WIPO Overview 3.0](#) at section 1.8).

Finally, the gTLD ".com" of the disputed domain name may be disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#) at section 1.11.1).

In the light of the above, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

## **B. Rights or Legitimate Interests**

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent's rights or legitimate interests to the disputed domain name. In the Panel's view, based on the undisputed allegations stated above, the Complainant has made a *prima facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

According to the Complaint, which has remained unchallenged, the Complainant has no relationship in any way with the Respondent and, in particular, did not authorize the Respondent's use of the trademark PLAVIX, e.g. by registering the disputed domain name comprising the said trademark entirely.

Furthermore, the Panel notes that there is no evidence showing that the Respondent might be commonly known by the disputed domain name in the sense of paragraph 4(c)(ii) of the Policy.

Finally, it results from the Complainant's non-contested evidence that the disputed domain name resolves to a website on which the Complainant's PLAVIX goods are allegedly sold and which did not accurately and prominently disclose the lack of the Respondent's relationship with the Complainant. Since this use is clearly commercial, it cannot be considered 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 or service mark at issue pursuant to paragraph 4(c)(iii) of the Policy. Furthermore, such use cannot be qualified a *bona fide* offering of goods or services in accordance with paragraph 4(c)(i) of the Policy and the Oki Data test (e.g. *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#)) as it is misleading and diverting consumers, making them erroneously believe that the Respondent is an authorized dealer, retailer, or reseller of Plavix products, and is authorized to promote sales of Plavix products. This is reinforced by the following facts: (1) the Respondent did not add any note, information or disclaimer pointing out that it actually has no relationship with the Complainant; (2) the website is accessible under a disputed domain name that comprises the Complainant's trademark entirely; and (3) clicking the purchase button redirects to a website selling drugs produced by competitors of the Complainant, along with products claiming to be from the Complainant (at discounted prices, some with a discount of more than 40%), see also [WIPO Overview 3.0](#), section 2.8.1: "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', 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 Oki Data test does not apply where any prior agreement, express or otherwise, between the parties expressly prohibits (or allows) the registration or use of domain names incorporating the complainant's trademark."

It is acknowledged that once the Panel finds such *prima facie* case is made, the burden of production shifts to the Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name. Since the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant is therefore deemed to have satisfied paragraph 4(a)(ii) of the Policy.

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

According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith.

Based on the evidence submitted by the Complainant, the Panel shares the view of other UDRP panels and finds that the Complainant's trademark PLAVIX is widely known (e.g. *Sanofi v. Jiyong Luo*, WIPO Case No. [D2022-0502](#)). In addition, it results from the Complainant's documented allegations that the disputed domain name resolves to a website on which the Complainant's goods are allegedly sold and where the Complainant's trademark is prominently featured. Therefore, this Panel has no doubt that the Respondent positively knew that the disputed domain name consisted of the Complainant's trademark when he registered the disputed domain name. Registration of the disputed domain name in awareness of the reputed PLAVIX mark and in the absence of rights or legitimate interests in this case amounts to registration in bad faith (see, e.g. *Carrefour SA v. Matias Barro Mares*, WIPO Case No. [D2020-3088](#); *Banca Mediolanum S.p.A. v. Domains By Proxy, LLC / Marzia Chiarello*, WIPO Case No. [D2020-1955](#)).

Finally, the further circumstances surrounding the disputed domain name's registration and use confirm the findings that the Respondent has registered and is using the disputed domain name in bad faith, including (1) the nature of the disputed domain name, *i.e.* incorporating the Complainant's well-know mark PLAVIX plus the additional descriptive term "generico" (Italian term corresponding to "generic" in English); (2) a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the disputed domain name; (3) other indicia generally suggesting that the Respondent has targeted the Complainant, e.g. redirecting the disputed domain name to a web page allegedly selling PLAVIX goods (with discounted prices); and (4) the Respondent did not provide any response with a plausible explanation of its behavior or good faith use (see e.g. [WIPO Overview 3.0](#) at section 3.2.1).

In the light of the above, the Panel finds that the disputed domain name has been registered and is being used in bad faith pursuant to paragraph 4(a)(iii) of the Policy.

### **8. 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, <plavixgenerico.com>, be transferred to the Complainant.

/Federica Togo/

**Federica Togo**

Sole Panelist

Date: December 5, 2022