

ADMINISTRATIVE PANEL DECISION

Sanofi v. opep roxxo
Case No. D2022-4852

1. The Parties

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

The Respondent is opep roxxo, France.

2. The Domain Name and Registrar

The disputed domain name <sanofi-aventis-group.com> (the “Domain Name”) is registered with Hostinger, UAB (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 19, 2022. On December 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On December 20, 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 (Domain Admin, Privacy Protect, LLC (PrivacyProtect.org)) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 20, 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 December 20, 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 December 27, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 16, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 19, 2023.

The Center appointed Vincent Denoyelle as the sole panelist in this matter on January 30, 2023. 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 multinational pharmaceutical company headquartered in Paris, France.

The Complainant was formed as “Sanofi-Aventis” upon the merger of Sanofi and Aventis in 2004 and changed its name to “Sanofi” in May 2011.

The Complainant has registered multiple trade marks for SANOFI-AVENTIS including:

- French Trade Mark SANOFI-AVENTIS registration number 3288019, registered on April 26, 2004; and
- European Union Trade Mark SANOFI-AVENTIS registration number 004025318, registered on November 3, 2005.

The Complainant has also registered multiple domain names reflecting its SANOFI-AVENTIS trade marks including <sanofi-aventis.com>, which the Complainant registered on March 14, 2004.

The Domain Name was registered on December 8, 2022. At the time the Complaint was filed, the Domain Name pointed to a parking page of the Registrar. At the time of the Decision, the Domain Name did not point to any active website.

5. Parties' Contentions

A. Complainant

The Complainant contends that the Domain Name is confusingly similar to the SANOFI-AVENTIS trade mark in which the Complainant has rights, as the Domain Name reproduces the entire SANOFI-AVENTIS trade mark of the Complainant with the mere addition of the term “group”. The Complainant considers that such addition does not prevent confusing similarity between the Domain Name and the Complainant’s well-known SANOFI-AVENTIS trade mark.

The Complainant asserts that the Respondent has no prior right or legitimate interest to justify the use of the well-known SANOFI-AVENTIS trade mark in the Domain Name. The Complainant submits that it has no relationship whatsoever with the Respondent and that the Respondent was not given any authorization by the Complainant to use its SANOFI-AVENTIS trade mark. In addition, the Complainant contends that the Respondent is not making a legitimate noncommercial or fair use of the Domain Name or using the Domain Name in connection with a *bona fide* offering of goods or services given that the Domain Name merely points to a Registrar parking page including sponsored links.

The Complainant contends that given the famous and distinctive nature of the trade mark SANOFI-AVENTIS, the Respondent is likely to have had, at least, constructive, if not actual, notice, as to the existence of the Complainant’s SANOFI-AVENTIS trade mark at the time of registration of the Domain Name. The Complainant argues that the Respondent has registered the Domain Name to take unfair advantage of the Complainant and its SANOFI-AVENTIS trade mark. Finally, the Complainant contends that the lack of use of the Domain Name is likely to be detrimental to the Complainant because Internet users could be led to believe that the Complainant is not on the Internet or worse, that the Complainant is out of business.

B. Respondent

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

6. Discussion and Findings

In order to prevail the Complainant must substantiate that the three elements of paragraph 4(a) of the Policy have been met, namely:

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

(ii) the 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.

In the case of default by a party, as is the case here, paragraph 14(b) of the Rules makes it clear that if a party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, the Rules or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate.

In the absence of a Response from the Respondent whereby the Respondent did not object to any of the contentions from the Complainant, the Panel will have to decide on the basis of the Complaint and supporting Annexes.

A. Identical or Confusingly Similar

In light of the evidence provided by the Complainant, the Panel is satisfied that the Complainant has substantiated that it holds valid trade mark rights in SANOFI-AVENTIS, which is reproduced in its entirety in the Domain Name.

The second point that has to be considered is whether the Domain Name is identical or confusingly similar to the trade mark SANOFI-AVENTIS in which the Complainant has rights.

At the second level, the Domain Name incorporates the Complainant's SANOFI-AVENTIS trade mark in its entirety with the mere addition of a hyphen "-" and the term "group". The Panel finds that these additions do not prevent a finding of confusing similarity arising from the incorporation of the Complainant's exact trade mark in the Domain Name.

Then there is the addition of the generic Top-Level Domain ("gTLD") ".com". As is generally accepted, the addition of a gTLD such as ".com" is merely a technical registration requirement and as such is typically disregarded under the first element confusing similarity test.

Thus, the Panel finds that the Domain Name is confusingly similar to the trade mark in which the Complainant has rights.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out relevant circumstances that could demonstrate that a respondent has rights or legitimate interests in a domain name, namely:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate [the respondent's] rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

(i) before any notice to [the respondent] of the dispute, [the respondent's] 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) [the respondent] (as an individual, business, or other organization) ha[s] been commonly known by the domain name, even if [the respondent] ha[s] acquired no trade mark or service mark rights; or

(iii) [the respondent] is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.”

Numerous previous panels have found under the UDRP that once the Complainant makes a *prima facie* showing that the registrant does not have rights or legitimate interests in the domain name, the burden of production shifts to the Respondent to rebut the showing by providing evidence of its rights or legitimate interests in the Domain Name.

Having reviewed the Complainant's assertions and evidence, the Panel is satisfied that the Complainant has made a *prima facie* showing that the Respondent does not have rights or legitimate interests in the Domain Name.

The Complainant has stated that it has not licensed or otherwise authorized the Respondent to make any use of its SANOFI-AVENTIS trade mark. There is no indication that the Respondent is commonly known by the Domain Name.

The previous use of the Domain Name to point to a parking page of the Registrar is not one that would qualify as being *bona fide*, legitimate, or fair under the Policy.

The fact that the Domain Name does not currently seem to direct to an active website suggests that the Domain Name is held passively by the Respondent. Given the overall circumstances of the present case including the renown of the SANOFI-AVENTIS trade mark of the Complainant, the passive holding of the Domain Name cannot be considered *bona fide*, legitimate, or fair.

Furthermore, the nature of the Domain Name, comprising the Complainant's trade mark in its entirety in combination with a hyphen “-“ and the term “group”, carries a risk of implied affiliation. See section 2.5.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)).

Thus, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out a number of relevant non-exhaustive circumstances, which can be deemed to constitute evidence of registration and use of a domain name in bad faith, namely:

(i) circumstances indicating that [the respondent has] registered or acquired [a disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trade mark or service mark or to a competitor of that complainant, for valuable consideration in excess of [the respondent's] documented out-of-pocket costs directly related to the domain name; or

(ii) [the respondent has] registered the domain name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that [the respondent has] engaged in a pattern of such conduct; or

(iii) [the respondent has] registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent's] website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] website or location or of a product or service on [the respondent's] website or location.

Given the circumstances described in the Complaint and the documentary evidence provided by the Complainant, the Panel finds that the Domain Name was registered in bad faith.

The Domain Name reproduces the exact SANOFI-AVENTIS trade mark of the Complainant and this cannot be a coincidence.

The term "sanofi-aventis" is not a descriptive or common term, so the fact that the Respondent decided to register the Domain Name reproducing this term strongly suggests that the Respondent had the Complainant's trade mark in mind and targeted it specifically.

This is even more likely given the overall circumstances including (i) the renown of the Complainant's trade marks, as acknowledged by several previous UDRP panels, (ii) the fact that the Respondent appears to be based in France where the Complainant is headquartered and where its renown is probably higher than anywhere else, (iii) the fact that the Domain Name was registered relatively recently and many years after the registration of the trade mark SANOFI-AVENTIS, and (iv) the choice of term added to the trade mark SANOFI-AVENTIS in the Domain Name.

Thus, the Panel finds that the Domain Name was registered in bad faith.

As for use of the Domain Name in bad faith, given the circumstances described in the Complaint, the documentary evidence provided by the Complainant and the brief verification carried out by the Panel of the website associated with the Domain Name, the Panel is satisfied that the Domain Name is used in bad faith.

The Domain Name's previous use to point to a parking page of the Registrar with sponsored links and the current absence of use of the Domain Name do not offer any indication as to how the Domain Name could be considered as being used in good faith. Indeed, given the substantial goodwill and reputation of the Complainant's SANOFI-AVENTIS trade mark, it is difficult to conceive that there could be any actual or contemplated good faith use of the Domain Name (see *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

The fact that the Respondent chose not to object to the Complainant's assertions can only reinforce the Panel's view that the Domain Name is used in bad faith.

Thus, the Panel finds that the Domain Name was registered and is being 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 Domain Name <sanofi-aventis-group.com> be transferred to the Complainant.

/Vincent Denoyelle/

Vincent Denoyelle

Sole Panelist

Date: February 13, 2023