

ADMINISTRATIVE PANEL DECISION

Sanofi v. Sophia, Sophia
Case No. D2024-4564

1. The Parties

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

The Respondent is Sophia, Sophia, United States of America

2. The Domain Names and Registrar

The disputed domain names <sanofimall.com> and <sanofimall.top> are registered with Dominet (HK) Limited/Dominet (HK) Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 7, 2024. On November 7, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On November 11, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (REDACTED FOR PRIVACY, Sophia) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 11, 2024, 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 November 19, 2024.

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 November 20, 2024. In accordance with the Rules, paragraph 5, the due date for Response was December 10, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 13, 2024.

The Center appointed Nayiri Boghossian as the sole panelist in this matter on December 18, 2024. 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 French pharmaceutical company that is ranked the fourth largest multinational pharmaceutical company in the world. The Complainant owns the following trademark registrations for SANOFI:

- French registration No. 96655339 registered on December 11, 1996;
- French registration No 1482708 registered on August 11, 1988;
- European Union Trade Mark registration No. 000596023 registered on February 1, 1999.

The Respondent registered the disputed domain names on October 27, 2024. The disputed domain name <sanofimall.top> resolves to an active website displaying the Complainant's trademark, the use of which is unclear, and the disputed domain name <sanofimall.com> is inactive. There does not seem to be a specific use.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain names are identical or confusingly similar to a trademark in which the Complainant has rights. The disputed domain names incorporate the Complainant's trademark SANOFI. The trademark of the Complainant has no dictionary meaning and is therefore highly distinctive. The Complainant has used its trademark and trade name SANOFI for over forty years all over the world. The Complainant's trademark is the dominant part of the disputed domain names. The generic term "mall" does not eliminate the likelihood of confusion as it is a descriptive term. On the contrary, it increases risk of confusion. The generic Top-Level-Domains ("gTLD") ".com" and ".top" should be ignored. The disputed domain names can be perceived as being the Complainant's websites. The goodwill and the well-known character of the Complainant's trademarks ascertain the likelihood of confusion.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain names. The trademark SANOFI is distinctive and the Respondent's name bears no resemblance to the Complainant's trademark SANOFI. The true identity of the Respondent is kept secret. The Respondent is not authorized by the Complainant to use its trademark nor is it licensed by the Complainant. The Respondent is not using the disputed domain names in connection with a bona fide offering of goods as one resolves to a website which displays the Complainant's trademark and the other is inactive. The Respondent is using the disputed domain names to obtain indirect commercial gain by misleading the consumer, suggesting a new business line of the Complainant.

The Complainant contends that the disputed domain names were registered and are being used in bad faith. This is a case of opportunistic bad faith as the Complainant's trademark is well-known. The Respondent has no rights or legitimate interests in the disputed domain names. The Respondent must have known of the Complainant's trademark as it is famous and distinctive. The disputed domain names were registered and are being used to create a likelihood of confusion with the Complainant's trademarks. The well-known character of the Complainant's trademark is indicative of bad faith. The disputed domain names have been

registered for the purpose of attracting Internet users. The Respondent is using the disputed domain names to obtain indirect commercial gain by misleading the consumer, suggesting a new business line of the Complainant. Passive holding under the appropriate circumstances falls within bad faith use. The lack of apparent genuine use of the disputed domain names is likely to cause prejudice to the Complainant's goodwill.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, "mall" may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in the disputed domain names.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent was aware of the Complainant's trademark as it is well-known and as one of the disputed domain names resolves to a website which displays the Complainant's trademark.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Panels have found that the non-use of a domain name (including a blank page) would not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's trademark, and the composition of the disputed domain name <sanofimall.com>, and finds that in the circumstances of this case the passive holding of one of the disputed domain names does not prevent a finding of bad faith under the Policy.

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 names <sanofimall.com> and <sanofimall.top> be transferred to the Complainant.

/Nayiri Boghossian/

Nayiri Boghossian

Sole Panelist

Date: December 27, 2024