

ADMINISTRATIVE PANEL DECISION

Sanofi and Sanofi-Aventis Deutschland GmbH v. Brenda Moore Case No. D2022-3995

1. The Parties

The Complainant is Sanofi, France and Sanofi-Aventis Deutschland GmbH, Germany, represented by Selarl Marchais & Associés, France.

The Respondent is Brenda Moore, United States of America.

2. The Domain Name and Registrar

The disputed domain name <buydulcolax.xyz> is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 25, 2022. On October 26, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name(s). On October 27, 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 October 27, 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 27, 2022.

The Center verified that the Complaint together with the amended 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 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 28, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 29, 2022.

The Center appointed Rodrigo Azevedo as the sole panelist in this matter on December 7, 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 Complainants are a French multinational pharmaceutical company headquartered in Paris and its German subsidiary. The Second Complainant is the owner of the trademark DULCOLAX, which refers to a laxative that stimulates bowel movements and is manufactured by the first Complainant.

The Second Complainant owns numerous trademark registrations for DULCOLAX in different regions of the world, such as the European Union trademark No. 002382059, (registered on November 29, 2002); and the International trademark No. 165781 (registered on December 10, 1952) and 937960A (registered on August 16, 2007).

The Complainant is also the owner of other domain names comprising of the DULCOLAX trademark, such as <dulcolax.com> (registered on December 2, 1997); and <dulcolax.info> (registered on July 7, 2001).

The Respondent registered the disputed domain name <buydulcolax.xyz> on October 13, 2022.

The Panel accessed the disputed domain name on December 17, 2022, and it resolved to a pay-per-click (“PPC”) parking page.

5. Parties’ Contentions

A. Complainant

The Complainant makes the following contentions:

- The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights. The disputed domain name reproduces identically the DULCOLAX trademarks and domain names which, as themselves, do not have any particular meaning and are therefore highly distinctive, and what is sufficient to create a likelihood of confusion between the disputed domain name and the Complainant’s trademarks. The Complainant has used its DULCOLAX trademark for over 40 years and invested substantial financial resources over the years to advertise and promote it in countries all over the world. The reproduction of the Complainant’s trademarks and domain names as the central and dominant part of the disputed domain name makes it confusingly similar to prior trademark rights, regardless of the adjunction of the generic term “buy” and the new gTLD extension “.xyz”. 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 and will, on the contrary, merely suggests to Internet users that the litigious domain leads to a website giving possibility to buy DULCOLAX products. The ccTLD suffix “.xyz” in the disputed domain name is also undoubtedly insufficient to alleviate the likelihood of confusion between the Complainant’s trademarks and the disputed domain name. There is 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 DULCOLAX websites. The likelihood of confusion is ascertained by the reputation of the Complainant’s trade name, trademarks, domain names and more generally speaking goodwill.

- The Respondent has no rights or legitimate interests in respect of the disputed domain name. 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. 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. 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. The disputed domain name is leading to a parking website and has been registered only for the purpose of obtaining commercial gain by selling it to interested and malicious people.

- The disputed domain name was registered and is being used in bad faith. Panel decisions regularly recognize opportunistic bad faith in cases in which the disputed domain name appears confusingly similar to a complainant's well-known trademark. 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. The absence of legitimate interest somewhat induces the absence of good faith. 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 DULCOLAX trademarks and the disputed domain name. 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 DULCOLAX websites to the litigious page. The Respondent is trying to ride off the Complainant's worldwide reputation. The lack of use of the disputed domain name particularly close to those used by the Complainant is likely to cause irreparable prejudice to their general goodwill 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

Paragraph 4(a) of the Policy provides that in order to be entitled to a transfer of the disputed domain name, a complainant shall prove the following three elements:

- (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.

A. Identical or Confusingly Similar

The Panel has no doubt that "dulcolax" is a term directly connected with the Complainant's trademarks. Annex 8 to the Complaint shows numerous trademark registrations for DULCOLAX.

The disputed domain name differs from the Complainant's trademark DULCOLAX by the addition of the English dictionary word "buy" – as a prefix – and of the generic Top-Level Domain ("gTLD") extension ".xyz".

Previous UDRP decisions have found that the mere addition of symbols such as a hyphen or terms (such as "buy") to a trademark in a domain name do not avoid a finding of confusing similarity. This has been held in many UDRP cases (see, e.g., *Inter-IKEA Systems B.V. v. Evezon Co. Ltd.*, WIPO Case No. [D2000-0437](#); *The British Broadcasting Corporation v. Jaime Renteria*, WIPO Case No. [D2000-0050](#); *Volvo Trademark Holding AB v. SC-RAD Inc.*, WIPO Case No. [D2003-0601](#); *Wal-Mart Stores, Inc. v. Lars Stork*, WIPO Case No. [D2000-0628](#); *America Online, Inc. v. Dolphin@Heart*, WIPO Case No. [D2000-0713](#); *AltaVista Company v. S. M. A., Inc.*, WIPO Case No. [D2000-0927](#)).

It is also already well established that the addition of a gTLD extension such as ".xyz" is typically irrelevant when determining whether a domain name is confusingly similar to a complainant's trademark.

As a result, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark, and that the Complainant has satisfied the first element of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides some examples without limitation of how a respondent can demonstrate rights or legitimate interests in a domain name:

- (i) before receiving any notice of the dispute, the respondent used or made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the domain name; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark at issue.

Based on the Respondent's default and on the *prima facie* evidence in the Complaint, the Panel finds that the above circumstances are not present in this particular case and that the Respondent has no rights or legitimate interests in the disputed domain name.

The Panel notes that the present record provides no evidence to demonstrate the Respondent's intent to use or to make preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services. Indeed, the disputed domain name is linked to a PPC advertising scheme, potentially generating revenues to the Respondent.

The Complainant has not licensed or authorized the use of its trademarks to the Respondent, and it does not appear from the present record that the Respondent is commonly known by the disputed domain name. Actually, the Respondent has not indicated any reason to justify why it has chosen the specific term "buydulcolax" to compose the disputed domain name.

Consequently, the Panel is satisfied that the Respondent has no rights or legitimate interests in the disputed domain name, and the Complainant has proven the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy states that the following circumstances in particular, but without limitation, shall be evidence of registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent has registered or acquired the 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 trademark or service mark or to a competitor of that the complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent registered the domain name in order to prevent the owner of the trademark 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 its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location.

When the disputed domain name was registered by the Respondent (in 2022), the trademark DULCOLAX was already directly connected to the Complainant's medicine.

The term “dulcolax” has no dictionary meaning in English.

The addition of the prefix “buy” to the Complainant’s trademark DULCOLAX even enhances the confusingly similarity in the present case, as in this Panel’s view it clearly suggests that the disputed domain name refers to an official store where the Complainant’s products could be purchased.

Therefore, the Panel concludes that it would not be feasible to consider that the Respondent – at the time of the registration of the disputed domain name – could not have been aware of the Complainant’s trademark, as well as that the adoption of the expression “buydulcolax” could be a mere coincidence.

Furthermore, the Respondent’s use of the disputed domain name in connection with a PPC scheme may have potentially generated revenues and enhanced the likelihood of confusion with the Complainant’s trademark. Previous UDRP decisions have considered this type of use of a domain name sufficient to demonstrate bad faith. For reference on the subject, see *Serta Inc. v. Charles Dawson*, WIPO Case No. [D2008-1474](#); see also *Asian World of Martial Arts Inc. v. Texas International Property Associates*, WIPO Case No. [D2007-1415](#).

Finally, the passive posture of the Respondent, not at least providing justifications for the use of a famous third party trademark, certainly cannot be used in benefit of the Respondent in the present case.

Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith, and the Complainant has also satisfied the third element of 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 name, <buydulcolax.xyz> be transferred to the Complainant.

/Rodrigo Azevedo/

Rodrigo Azevedo

Sole Panelist

Date: December 21, 2022