

ADMINISTRATIVE PANEL DECISION

Sanofi v. Privacy Department, IceNetworks Ltd.

Case No. D2023-3575

1. The Parties

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

The Respondent is Privacy Department, IceNetworks Ltd., Iceland.

2. The Domain Name and Registrar

The disputed domain name <stilnoxs.com> is registered with Internet Domain Service BS Corp (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 24, 2023. On August 25, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 1, 2023, 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 (Domain Admin, Whois Privacy Corp.) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 12, 2023 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 12, 2023.

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 12, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 2, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 3, 2023.

The Center appointed Nayiri Boghossian as the sole panelist in this matter on October 19, 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.

On October 26 and 28, 2023, the Center received third party communications, which indicated that the Written Notice had been sent to the wrong address and person and that this person has no relationship with the Respondent. The Panel notes that indeed such communications were submitted by a third party and not a Registrar-confirmed registrant and hence the Panel proceeds to render a decision in this matter.

4. Factual Background

The Complainant is a French pharmaceutical company that is ranked the fourth largest multinational pharmaceutical company in the world. The Complainant produces a drug for the treatment of insomnia under the trademark STILNOX. The Complainant owns the following trademark registrations for STILNOX:

- French registration No. 1263152 registered on March 1, 1984;
- International registration No. 485741 registered on May 21, 1984;

The Respondent registered the disputed domain name on October 27, 2022. The disputed domain name does not resolve to an active website.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The Complainant's trademarks are found worldwide. The trademark of the Complainant has no dictionary meaning and is distinctive as a result. The Complainant has invested in its trade name for over 40 years around the world. The reproduction of the Complainant's trademarks is the dominant part of the disputed domain name. The addition of the letter "s" does not distinguish the disputed domain name from the Complainant's trademark. The generic Top-Level Domain ("gTLD") ".com" should generally be ignored when assessing confusing similarity as established by prior UDRP decisions. The disputed domain name incorporates the Complainant's trademark in its entirety. The addition of the letter "s" leads to an assumption that the disputed domain name is the Complainant's official website. The goodwill and notoriety of the Complainant's trademarks should be taken into consideration.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. The trademark STILNOX is distinctive and the Respondent's name bears no resemblance to the Complainant's trademark. The registration of the disputed domain name is done through a privacy service.

The Respondent is not authorized by the Complainant to use its trademark and does not have a relationship with the Complainant. The Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods as it resolves to an inactive website.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. This is a case of opportunistic bad faith as the Complainant's trademarks are well-known. The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent must have known of the Complainant's trademark as it is famous and distinctive. The disputed domain name was registered and is being used to attract Internet traffic by creating a likelihood of confusion with the Complainant's trademark STILNOX and domain names. This is a case of passive holding, which under appropriate circumstances indicates bad faith use.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant owns trademark registrations for the trademark STILNOX. The Panel is satisfied that the Complainant has established its ownership of the trademark STILNOX. The disputed domain name incorporates the Complainant's trademark STILNOX in its entirety. It is established by prior UDRP panels that when a domain name incorporates a complainant's registered trademark, such incorporation is sufficient to establish identity or confusing similarity for the purposes of the Policy even if other terms are added as part of the disputed domain name. *E.g., Oki Data Americas, Inc v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) ("Oki Data"). The addition of the letter "s" does not alter the fact that the disputed domain name is confusingly similar to the Complainant's trademark. The gTLD ".com" should generally be ignored when assessing confusing similarity as established by prior UDRP decisions.

Consequently, the Panel finds that the disputed domain name is confusingly similar to the trademark of the Complainant and that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make at least a *prima facie* showing that a respondent does not have any rights or legitimate interests in the disputed domain name. Once such showing is made, the burden of production shifts to the respondent. In the instant case, the Complainant asserts that the Respondent is not affiliated with nor authorized by the Complainant to use its trademark. Therefore, the Complainant has established a *prima facie* case and the burden of production shifts to the Respondent to show that it has rights or legitimate interests.

The absence of a response by the Respondent allows the Panel to draw inferences, and under the circumstances, the absence of a response leaves the Complainant's *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name un rebutted.

Consequently, the Panel finds that the Complainant has met the requirement under the Policy of showing that the Respondent does not have any rights or legitimate interests in the disputed domain name. Accordingly, the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

At the time of registering the disputed domain name, the Respondent must have been aware of the Complainant's trademark for a number of reasons:

- (i) The Complainant's trademark had been registered for almost 40 years before the disputed domain name was created.
- (ii) A simple Google search on STILNOX reveals the Complainant's trademark.
- (iii) The Complainant is a leader in the pharmaceutical field worldwide.

The disputed domain name resolves to an inactive website. Prior UDRP panels have found that passive holding does not prevent a finding of bad faith if the totality of circumstances supports an inference of bad faith. See section 3.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). Noting the concealment of the Respondent's identity using a privacy service,

the Respondent's failure to provide any good-faith explanation for his registration and use of the inherently misleading disputed domain name and the absence of a plausible use of the disputed domain name that would be legitimate (*Johnson & Johnson v. Daniel Wistbacka*, WIPO Case No. [D2017-0709](#)), the Panel finds that the current passive holding of the disputed domain name does not prevent the Panel's bad faith finding.

The Panel finds that the Complainant has satisfied paragraph 4(a)(iii) 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 <stilnoxs.com> be transferred to the Complainant.

/Nayiri Boghossian/

Nayiri Boghossian

Sole Panelist

Date: November 1, 2023