

ADMINISTRATIVE PANEL DECISION

Sanofi v. Domain Manager, eWeb Development Group / ProxyTech Privacy Services Inc. / Privacy Manager
Case No. D2014-1185

1. The Parties

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

Respondent is Domain Manager, eWeb Development Group, Vancouver, British Columbia, Canada
ProxyTech Privacy Services Inc. / Privacy Manager, Moncton, Richmond, British Colombia, Canada,
represented by Muscovitch & Associates, Canada.

2. The Domain Name and Registrar

The disputed domain name <sanof.com> (the “Domain Name”) is registered with Alpine Domains Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 8, 2014. On July 8, 2014, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On July 9, 2014, 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 and contact information in the Complaint. The Center sent an e-mail communication to Complainant on July 11, 2014 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint the same day.

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(a) and 4(a), the Center formally notified Respondent of the Complaint, and the proceedings commenced July 15, 2014. In accordance with the Rules, paragraph 5(a), the due date for Response August 4, 2014. Following a request from the Respondent for an extension and

comments from the Complainant the Response due date was extended to August 9, 2014. The Response was filed with the Center August 8, 2014.

The Center appointed Robert A. Badgley, Christophe Caron and Diane Cabell as panelists in this matter on September 1, 2014. The Panel finds that it was properly constituted. Each member of 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

Complainant, based in Paris, is one of the largest pharmaceutical firms in the world. Complainant holds numerous registrations of the trademark SANOFI, including international registrations and registrations in France, the European Union, and Canada (the latter being Respondent's country). Complainant also maintains a significant Internet presence as part of its business, and toward that end owns numerous domain names, including <sanofi.com>.

Respondent, based in Vancouver, describes itself as being "in the website development, website hosting, and branding business." According to Respondent, it "lawfully registers domain names and develops websites," and "registers domain names that are surnames, descriptive, geographic, unique and brand-able, acronyms, or are otherwise non-trademark infringing."

Respondent further states in its Response that it "offers a service wherein a customer can either purchase a domain name by itself from the Respondent, or the customer can alternatively, purchase a website development package along with a domain name."

Respondent registered the Domain Name on November 10, 2012. According to an affidavit submitted by Respondent's General Manager, "The sole reason for the Respondent registering the Domain Name was that it appeared to correspond to a first and last name and was capable of being lawfully used by the Respondent or one of its customers". The General Manager further testified in the affidavit that she had never heard of Complainant or the SANOFI mark.

Respondent also provided evidence in the record of its registration of various other domain names closely or remotely resembling the Domain Name, purportedly as "compelling independent evidence" that Respondent's plan and motivation were to register domain names purportedly reflective of first names or surnames, as opposed to other parties' trademarks. Examples put into the record by Respondent include: <sanov.com>, <hanoff.com>, <zanoff.com>, <sannon.com>, <sannow.com>, and <ivanof.com>.

The Domain Name resolves to a parking page, the top of which states: "FOR SALE & DEVELOPMENT." Below that text is the following message: "Interested in sanof.com? Contact us below. Contact us below to check options for domain ownership, web development and hosting." Near the bottom of the page is a boxed advertisement from ESCROW.COM, advertised as "100% Safe and Secure". The Escrow.com service purports to allow for secure domain name transactions.

Respondent's General Manager avers in her affidavit that Respondent derives no revenue from this Escrow.com advertisement. In its Response, Respondent describes the Escrow.com ad as an "information box" for customers' edification, and is not a source of pay-per-click revenues, as Complainant had asserted in the Complaint.

There were no communications between the parties prior to the initiation of this proceeding by Complainant.

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied all three elements required under the Policy for a transfer of the Domain Name. According to Complainant, Respondent is engaged in classic “typosquatting” and seeks to profit from its illegitimate and opportunistic activities to derive pecuniary gain either through a sale of the Domain Name at a profit or from pay-per-click advertising revenues (presumably from the Escrow.com content at the website).

B. Respondent

Respondent maintains that it is engaged in a legitimate business activity and denies any knowledge of Complainant or its SANOFI mark at the time the Domain Name was registered. Respondent also asserts, through an affidavit from its General Manager, that Respondent never solicited Complainant to purchase the Domain Name. In aid of Respondent’s position that its motives here were pure, Respondent notes several other domain names it registered which are not dissimilar to the Domain Name, and Respondent provides evidence of several individuals whose first or last names are “Sanof”.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

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

For the reasons set forth below, a majority of the Panel concludes that this Complaint should be denied.

A. Identical or Confusingly Similar

Complainant clearly holds rights in the trademark SANOFI. The Domain Name is identical to the distinctive mark, except for the omission of the final letter “i”. The Panel concludes that this difference is relatively insignificant in this instance. The Domain Name is confusingly similar to Complainant’s mark.

Accordingly, the Panel concludes that paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in a Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your 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) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] are 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 or service mark at issue.

A majority of the Panel concludes, based on this record, that Respondent has a legitimate interest in respect of the Domain Name, and therefore the Complaint fails. There is enough evidence in the record to conclude that Respondent is indeed engaged in the business of web hosting and website development, and that part of this business includes the offering of domain names which may be perceived as attractive to customers from a branding perspective. Particularly relevant to the Panel majority’s finding in this regard is the fact that

Respondent registered, in addition to the Domain Name, several phonetically similar domain names, including <sanov.com> and <zanoff.com>, and did so many months prior to registering the Domain Name. It would seem to the Panel to be quite a subtle, scheme to have registered these other domain names in 2010 and 2011, all for the purpose of masking the ultimate goal of registering the Domain Name in late 2012. The Panel majority is prepared to accept on the limited record before it as more likely that Respondent in fact registered these domain names (and the Domain Name) over time as part of its web hosting and branding business.

The actual attractiveness of these domain names from a marketing perspective remains to be seen and is beyond the purview of this proceeding, but it would appear that Respondent's activities, which include the bulk acquisition of domain names with a view toward their ultimate resale (either alone or packaged with other services) is under the specific circumstances of this proceeding a legitimate activity within the meaning of the Policy.

Accordingly, a majority of the Panel concludes that Complainant has not established paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, "in particular but without limitation," are evidence of the registration and use of the Domain Name in "bad faith":

- (i) circumstances indicating that [Respondent has] registered or has acquired the [Domain Name] primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to [C]omplainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or
- (ii) that [Respondent has] 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 [Respondent has] engaged in a pattern of such conduct; or
- (iii) that [Respondent] has registered the [Domain Name] primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the [Domain Name], [Respondent has] intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other on line location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of [Respondent's] website or location or of a product or service on [Respondent's] website or location.

For reasons overlapping with those set forth in the immediately preceding discussion, a majority of the Panel concludes that there is insufficient evidence in the record to positively demonstrate that Respondent registered or is using the Domain Name in bad faith within the meaning of the Policy. First, notwithstanding the fact that SANOFI is a fanciful and strong trademark registered in many countries and indicative of several leading pharmaceutical products, there is insufficient evidence to conclude that Respondent actually had Complainant or its SANOFI mark in mind when registering the Domain Name, or that it was willfully blind to such possibility.

Respondent's General Manager specifically denies having such actual knowledge. Further, Respondent's previous registration of other domain names (<sanov.com> and <zanoff.com>, for example) tends to sufficiently corroborate Respondent's account of events. The Panel also observes here that there is no evidence that the website to which the Domain Name resolves has ever made reference to any pharmaceutical products, or to Complainant, or to the SANOFI mark. There are no ads or hyperlinks touching on these subjects. In the Panel majority's view, this is further support for Respondent's account.

Further, the Panel majority does not accept that knowledge of Complainant's mark in this case must be imputed to Respondent for purposes of the Policy merely because that mark is registered in Respondent's country. The concept of bad faith under the Policy is not necessarily coterminous with concepts of

constructive notice or imputed knowledge that may exist under the trademark and competition laws of various jurisdictions (though in some circumstances panels under the Policy have adopted such principles).

A majority of the Panel also concludes that Respondent is not in bad faith under paragraph 4(b)(i) of the Policy simply because Respondent has made the Domain Name available for sale at its website. As noted above, the resale of the Domain Name is part of Respondent's business, and this business has already been found (by a majority of the Panel) to be legitimate in the circumstances of this case. There is no evidence that Respondent sought to sell the Domain Name specifically to Complainant or one of Complainant's competitors. In these circumstances, a majority of the Panel perceives no bad faith under paragraph 4(b)(iv).

Accordingly, a majority of the Panel finds on this record that Complainant has failed to establish bad faith registration and use required by paragraph 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, the Complaint is denied.

Robert A. Badgley
Presiding Panelist

Diane Cabell
Panelist

Christophe Caron
Panelist
Date: September 15, 2014