



## DECISION

Sanofi-Aventis v. Russ Johnson c/o NetWeb, Inc.  
Claim Number: FA0603000660859

### PARTIES

Complainant is **Sanofi-Aventis**, (“Complainant”) represented by **Baila H. Celedonia**, of **Cowan, Liebowitz & Latman, P.C.**, 1133 Avenue of the Americas, New York, NY 10036. Respondent is **Russ Johnson c/o NetWeb, Inc.** (“Respondent”), 206 S. Port Bass, Fair Play, SC 29643.

### REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**buyambien.us**>, registered with **Go Daddy Software, Inc.**

### PANEL

The undersigned certifies that he or she has acted independently and impartially and to the best of his or her knowledge has no known conflict in serving as Panelist in this proceeding.

Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

### PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on March 15, 2006; the National Arbitration Forum received a hard copy of the Complaint on March 20, 2006.

On March 16, 2006, Go Daddy Software, Inc. confirmed by e-mail to the National Arbitration Forum that the <**buyambien.us**> domain name is registered with Go Daddy Software, Inc. and that Respondent is the current registrant of the name. Go Daddy Software, Inc. has verified that Respondent is bound by the Go Daddy Software, Inc. registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with the U. S. Department of Commerce’s usTLD Dispute Resolution Policy (the “Policy”).

On March 22, 2006, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of April 11, 2002 by which Respondent could file a Response to the Complaint, was transmitted to Respondent in compliance with Paragraph 2(a) of the Rules for usTLD Dispute Resolution Policy (the “Rules”).

Having received no Response from Respondent, the National Arbitration Forum transmitted to the parties a Notification of Respondent Default.

On April 18, 2006, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the Forum appointed Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the National Arbitration Forum has discharged its responsibility under Paragraph 2(a) of the Rules. Therefore, the Panel may issue its decision based on the documents submitted and in accordance with the Policy, the Rules, the National Arbitration Forum's Supplemental Rules and any rules and principles of law that the Panel deems applicable, without the benefit of any Response from Respondent.

### **RELIEF SOUGHT**

Complainant requests that the domain name be transferred from Respondent to Complainant.

### **PARTIES' CONTENTIONS**

#### **A. Complainant**

This Complaint is based on the following factual and legal grounds: usTLD Rule 3(c)(ix).

[a.] *The Complained of Domain Name Is Confusingly Similar to Complainant's Trademark.* usTLD Rule 3(c)(ix)(1); usTLD Policy ¶4(a)(i).

Complainant Sanofi-Aventis is the third largest pharmaceutical company in the world, with a business presence in more than 50 countries. AMBIEN is one of Complainant's three flagship products and is used for the short-term treatment of insomnia. It was first launched in the United States in 1993. Virtually since its introduction, AMBIEN has enjoyed a leading market position.

Complainant is the owner of an incontestable United States registration for the mark AMBIEN, Reg. No. 1808770, registered on December 7, 1993 and renewed on December 7, 2003.

Complainant, either itself or through its related and controlled companies, is the owner of the domain name ambien.com, as well as other key domains, including ambien.us and ambien.fr. Complainant markets its AMBIEN products in the United States through its local affiliate, Sanofi-Synthelabo, Inc., and through a number of other alliances and licensees.

Additional information about the drug AMBIEN can be found at Complainant's website [www.ambien.com](http://www.ambien.com). As stated in Complainant's website, AMBIEN is a prescription drug which is intended for the short-term treatment of insomnia.

The complained of domain name is virtually identical or confusingly similar to Complainant's AMBIEN mark. Respondent merely adds the generic word "buy" to Complainant's registered trademark AMBIEN and its domain name ambien.us. Respondent's domain name merely alleges that one can "buy Ambien" at the website.

The mere addition of a generic term or terms to a domain name does not avoid a finding that a domain name is confusingly similar to a complainant's mark. *See Sanofi-Aventis v. Netweb, Inc.*, WIPO Case No. D2005-1265, ("Sanofi-Aventis") which found that the domain belonging to Respondent, *orderambien.net*, was confusingly similar to Complainant's AMBIEN trademark. *See also, Sanofi-Aventis v. CheckoutCo. LLC*, NAF Case No. 606471 (buy-acomplia.us confusingly similar to ACOMPLIA). It is also well-established that the domain suffix is disregarded for the purposes of making this comparison. *Id.*

[b.] ***Respondent Has No Rights or Legitimate Interests in Respect of the Domain Name that Is the Subject of this Complaint.*** usTLD Rule 3(c)(ix)(2); usTLD Policy ¶4(a)(ii).

Upon information and belief, Respondent does not own any United States registrations for the mark AMBIEN, nor is it its personal or corporate name.

Neither Complainant itself nor any of its companies have authorized Respondent to use the AMBIEN mark in any way, including as part of a domain name. Neither Complainant nor any of its companies have any relationship to Respondent. As reflected in Respondent's website, this website has no connection to Complainant. Rather, this website in the first instance says BUY AMBIEN and then redirects Internet users to another site, <canadianprescriptionsavers.com>, which allegedly offers various pharmaceutical products, including Complainant's AMBIEN and competitive products. Such use is not a *bona fide* use under the Policy. *Sanofi-Aventis, supra.*

Respondent's use of a domain name that is confusingly similar to Complainant's . . . mark to redirect users interested in Complainant's products to a commercial website that offers identical pharmaceutical products is not a use in connection with a bona fide offering of goods or services pursuant to Policy ¶ 4(c)(ii) or a legitimate noncommercial or fair use of the domain name pursuant to Policy ¶ 4(c)(iv).

*Merrell Pharmaceuticals Inc. v. Alex Fisher c/o RxOnline, Inc.*, NAF Case No. 42655.

[c.] ***Respondent Has Both Registered and Used the Complained of Domain Name in Bad Faith.*** usTLD Rule 3(c)(ix)(3); usTLD Policy ¶4(a)(iii).

Complainant has been using the AMBIEN mark in the United States since at least as early as September 16, 1992 and filed its US trademark application on January 5, 1993. Therefore, Respondent should be charged with bad faith because it had actual or constructive knowledge of Complainant's AMBIEN mark at the time the disputed domain name was registered. *See, e.g., J. Crew Int'l, Inc. v. crew.com*, WIPO Case No. D2000-0054 (respondent charged with constructive knowledge of complainant's registered trademark).

Respondent should also be charged with bad faith because it had actual knowledge of Complainant's AMBIEN mark. AMBIEN is one of the leading brands of prescription sleep aids

sold in the US. In fact, Respondent's website, through its link to <canadianprescriptionsavers.com> purports to sell Complainant's AMBIEN products. Therefore, Respondent was well aware of Complainant's rights in the AMBIEN mark at the time it registered its domain name.

From its website, it is also evident that Respondent's purpose in registering the complained of domain name was to trade upon Complainant's goodwill in its AMBIEN mark among consumers who are aware of Complainant's well-known AMBIEN products. Such use is not a use in connection with a bona fide offering of goods or services pursuant to Policy ¶4(c)(ii) or a legitimate noncommercial or fair use pursuant to Policy ¶4(c)(iv). Merrell, supra.

What constitutes a bona fide commercial use of another's mark in its domain name has been defined in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. D2001-0903, which sets out several minimum requirements – none of which Respondent's website meets. To the contrary, in addition to purporting to sell Complainant's AMBIEN products, Respondent's website also purport to sell other pharmaceuticals.

These facts support a finding that the Respondent had knowledge of the AMBIEN mark at the time of registration of the Domain Name, and that the Respondent is using the Domain Name to attract Internet users to a commercial website where products of the Complainant's competitors are offered for sale. The Respondent's primary purpose in registering and using the Domain Name was to attract, for commercial gain, Internet users to this website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the website and the products on this website. This constitutes bad faith registration and use of the disputed domain name under [INCANN UDRP] Policy, Paragraph 4(b)(iv).

Sanofi-Aventis, supra.

B. Respondent failed to submit a Response in this proceeding

## **FINDINGS**

Complainant, Sanofi-Aventis, is the third-largest pharmaceutical company in the world, with a business presence in more than fifty countries. Ambien is one of Complainant's three flagship products and is used for the short-term treatment of insomnia. Complainant has registered the AMBIEN mark with the United States Patent and Trademark Office ("USPTO) (Reg. No. 1,808,770 issued December 7, 1993). Complainant also maintains a website at the <ambien.com>, <ambien.us> and <ambien.fr> domain names.

Respondent registered the <buyambien.us> domain name on June 13, 2005. Internet users who access this domain name are directed to a website with a message informing them that they can purchase "Buyambien" and "Buy Ambien" products through

Respondent's website. The links below the message appear to direct Internet users to products and services unrelated to Complainant.

## DISCUSSION

Paragraph 15(a) of the Rules instructs this Panel to “decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”

In view of Respondent's failure to submit a Response, the Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations pursuant to Paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to Paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. *See Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (Nat. Arb. Forum July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); *see also Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) (“In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.”).

Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (2) the Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered or is being used in bad faith.

Given the similarity between the Uniform Domain Name Dispute Resolution Policy (“UDRP”) and the usTLD Policy, the Panel will draw upon UDRP precedent as applicable in rendering its decision.

### **Identical and/or Confusingly Similar**

Complainant has established that it has rights in the AMBIEN mark through its registration of the mark with the USPTO. *See Janus Int'l Holding Co. v. Rademacher*, D2002-0201 (WIPO Mar. 5, 2002) (“Panel decisions have held that registration of a mark is *prima facie* evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive.”); *see also Vivendi Universal Games v. XBNetVentures Inc.*, FA 198803 (Nat. Arb. Forum Nov. 11, 2003) (“Complainant's federal trademark registrations establish Complainant's rights in the BLIZZARD mark.”).

Respondent's <**buyambien.us**> domain name is confusingly similar to Complainant's AMBIEN mark because it incorporates the mark in its entirety with the additions of the term “buy” and the top-level domain “.us.” The Panel finds “buy” is a generic term, and

that the addition of this term to Complainant's mark does not distinguish Respondent's domain name from the mark. *See Arthur Guinness Son & Co. (Dublin) Ltd. v. Healy/BOSTH*, D2001-0026 (WIPO Mar. 23, 2001) (finding confusing similarity where the domain name in dispute contains the identical mark of the complainant combined with a generic word or term). Moreover, the addition of a top-level domain to Complainant's mark is irrelevant to the analysis of whether Respondent's domain name is confusingly similar to the mark. *See Gardline Surveys Ltd. v. Domain Fin. Ltd.*, FA 153545 (Nat. Arb. Forum May 27, 2003) ("The addition of a top-level domain is irrelevant when establishing whether or not a mark is identical or confusingly similar, because top-level domains are a required element of every domain name.").

The Panel finds Policy ¶4(a)(i) satisfied.

### **Rights or Legitimate Interests**

Complainant alleges Respondent does not have rights or legitimate interests in the <buyambien.us> domain name. Once Complainant makes a *prima facie* case in support of its allegations, the burden shifts to Respondent to prove that he does have rights or legitimate interests pursuant to Policy ¶4(a)(ii). Due to Respondent's failure to respond to the Complaint, Complainant's assertions are unopposed, and the Panel will evaluate the evidence to determine if Respondent has rights or legitimate interests in the disputed domain name. *See Do The Hustle, LLC v. Tropic Web*, D2000-0624 (WIPO Aug. 21, 2000) (once the complainant asserts that the respondent has no rights or legitimate interests with respect to the domain, the burden shifts to the respondent to provide "concrete evidence that it has rights to or legitimate interests in the domain name at issue"); *see also Desotec N.V. v. Jacobi Carbons AB*, D2000-1398 (WIPO Dec. 21, 2000) (finding that failing to respond allows a presumption that the complainant's allegations are true unless clearly contradicted by the evidence).

There is no evidence to show Respondent is the owner or beneficiary of a trade or service mark identical to the <buyambien.us> domain name pursuant to Policy ¶4(c)(i). Respondent's <buyambien.us> domain name directs Internet users to a website featuring a message advertising "Buyambien" and "Buy Ambien" products and services. However, the links below the message appear to direct Internet users to websites offering a wide variety of products and services unrelated to Complainant. Respondent's website contains no information that these websites are associated with any legitimate venture known as "Buyambien" or "Buy Ambien," and Respondent has not responded to the Complaint with any evidence that it has rights in these names or the disputed domain name. The Panel infers Respondent receives click-through fees for diverting Internet traffic to these other websites. Respondent's use of the infringing domain name to direct Internet users to other websites for its own commercial gain cannot be deemed a *bona fide* offering of goods or services pursuant to Policy ¶4(c)(ii) or a legitimate noncommercial or fair use pursuant to Policy ¶4(c)(iv). *See Caterpillar Inc. v. Quin*, D2000-0314 (WIPO June 12, 2000) (finding that Respondent does not have a legitimate interest in using the domain names <caterpillarparts.com> and <caterpillarspares.com> to suggest a connection or relationship, which does not exist, with the Complainant's mark CATERPILLAR); *see also WeddingChannel.com Inc. v. Vasiliev*, FA 156716 (Nat. Arb.

Forum June 12, 2003) (finding that the respondent's use of the disputed domain name to redirect Internet users to websites unrelated to the complainant's mark, websites where the respondent presumably receives a referral fee for each misdirected Internet user, was not a *bona fide* offering of goods or services as contemplated by the UDRP).

Complainant asserts neither itself nor any of its affiliates have authorized Respondent to use its AMBIEN mark in any way. Respondent has not provided any proof that he is commonly known by the <buyambien.us> domain name, and the WHOIS database entry contains no information implying Respondent is commonly known by the domain name. The Panel finds Respondent has no rights or legitimate interests in the domain name under Policy ¶4(c)(iii). *See Compagnie de Saint Gobain v. Com-Union Corp.*, D2000-0020 (WIPO Mar. 14, 2000) (finding no rights or legitimate interest where the respondent was not commonly known by the mark and never applied for a license or permission from the complainant to use the trademarked name); *see also Wells Fargo & Co. v. Onlyne Corp. Services11, Inc.*, FA 198969 (Nat. Arb. Forum Nov. 17, 2003) ("Given the WHOIS contact information for the disputed domain [name], one can infer that Respondent, Onlyne Corporate Services11, is not commonly known by the name 'wellsfargo' in any derivation.").

The Panel finds Policy ¶4(a)(ii) satisfied.

#### **Registration and Use in Bad Faith**

The evidence indicates Respondent has registered and used the <buyambien.us> domain name in bad faith pursuant to Policy 4 ¶(b)(iv). Respondent registered the <buyambien.us> domain name, which incorporates Complainant's AMBIEN mark, in order to divert Internet traffic to other websites. The fact Respondent's website displays a message including the phrase "Buy Ambien" creates further confusion about the relationship between Complainant and Respondent. The Panel infers Respondent generates click-through fees in return for diverting Internet users to other websites. Therefore, Respondent registered the disputed domain name with the intention of gaining commercially by diverting Internet users, who mistakenly believe Respondent's website is affiliated with Complainant, away from Complainant's website. *See Dr. Karl Albrecht v. Natale*, FA 95465 (Nat. Arb. Forum Sept. 16, 2000) ("There may be circumstances where [the respondent's registration of a domain name that uses the complainant's mark] could be done in good faith, but absent such evidence, the Panel can only conclude that the registration was done in bad faith."); *see also Vapor Blast Mfg. Co. v. R & S Tech., Inc.*, FA 96577 (Nat. Arb. Forum Feb. 27, 2001) (finding that Respondent's commercial use of the domain name to confuse and divert Internet traffic is not a legitimate use of the domain name).

In addition to the demonstration of bad faith by the application of Policy ¶4(b)(iv), there is a legal presumption of bad faith, when Respondent was clearly aware, actually or constructively, of Complainant's famous and distinctive trademark. The Panel finds Respondent had constructive knowledge of Complainant's rights in the AMBIEN mark through Complainant's registration of the mark with the USPTO because both parties are in the U.S. In addition, the Panel finds that Respondent likely had actual knowledge of

Complainant's rights in the AMBIEN mark as evidenced by the fact that Respondent's website features multiple uses of the phrase "Buy Ambien." *See Orange Glo Int'l v. Blume*, FA 118313 (Nat. Arb. Forum Oct. 4, 2002) ("Complainant's OXICLEAN mark is listed on the Principal Register of the USPTO, a status that confers constructive notice on those seeking to register or use the mark or any confusingly similar variation thereof."); *see also Samsonite Corp. v. Colony Holding*, FA 94313 (Nat. Arb. Forum Apr. 17, 2000) (finding that evidence of bad faith includes actual or constructive knowledge of a commonly known mark at the time of registration).

## DECISION

Having established all three elements required under the usTLD Policy, the Panel concludes that relief shall be **GRANTED**

Accordingly, it is Ordered that the <buyambien.us> domain name be **TRANSFERRED** from Respondent to Complainant.



Houston Putnam Lowry, Esq.  
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist  
Dated: May 2, 2006

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