

Decision for dispute CAC-UDRP-105850

Case number	CAC-UDRP-105850
-------------	------------------------

Time of filing	2023-10-09 09:33:11
----------------	----------------------------

Domain names	saint-gboain.com
--------------	-------------------------

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)
--------------	--

Complainant

Organization	COMPAGNIE DE SAINT-GOBAIN
--------------	----------------------------------

Complainant representative

Organization	NAMESHIELD S.A.S.
--------------	--------------------------

Respondent

Name	dave more
------	------------------

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is a recognized French company specialized in the production, processing and distribution of materials for the construction and industrial markets.

The Complainant owns the following Trademarks:

- International Trademark SAINT-GOBAIN AND DESIGN, Reg. No. 740184 registered on July 26, 2000 and in force until July 26, 2030;
- International Trademark SAINT-GOBAIN, Reg. No. 740183 registered on July 26, 2000 and in force until July 26, 2030;
- International Trademark SAINT-GOBAIN AND DESIGN, Reg. 596735 registered on November 2, 1992 and in force until November 2, 2032;
- International Trademark SAINT-GOBAIN AND DESIGN, Reg. 551682 registered on July 21, 1989 and in force until July 21, 2029.

FACTUAL BACKGROUND

The Complainant is a recognized French company specialized in the production, processing and distribution of materials for the

construction and industrial markets. The Complainant is a worldwide reference in sustainable habitat and construction markets. The Complainant under a long-term view, develops products and services to facilitate sustainable construction, designs innovative, high-performance solutions, which improves habitat and everyday life for its customers.

According with its Integrated Annual Report of 2022-2023, the Complainant has industrial presence in 75 countries, over 450 filed patents, 51.2 billion euros in turnover in 2022, 168,000 employees across the world; ranked among the 16 companies certified worldwide by the Top Employers Institute and it is committed to achieving Carbon Neutrality by 2050.

The Complainant also owns its domain names portfolio comprising its Trademark SAINT-GOBAIN, such as the domain name <saint-gobain.com> registered since December 29, 1995.

SAINT-GOBAIN is also commonly used to designate the Complainant's company name.

The disputed domain name <**saint-gboain.com**> was registered on **September 27, 2023** and by the time of this Decision, resolves to an inactive website.

PARTIES CONTENTIONS

Complainant Contentions:

The Complainant's primary contentions can be summarized as follows:

- The Complainant asserts that the disputed domain name is confusingly similar to its Trademark SAINT-GOBAIN; that the obvious misspelling through the inversion of the letters "O" and "B", is characteristic of a typosquatting practice.
- The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name due to is not known by the disputed domain name since the Whois information was not similar to the disputed domain name; that the Respondent is not related in any way with the Complainant, that does not carry out any activity for, nor has any business with the Respondent; that neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademark SAINT-GOBAIN, or apply for registration of the disputed domain name by the Complainant; that the disputed domain name website's inactivity confirms that the Respondent has no demonstrable plan to use the disputed domain name.
- The Complainant contends that the disputed domain name was registered and is being used in bad faith due to: the Complainant's trademark SAINT-GOBAIN is widely known, confirmed in *Compagnie de Saint-Gobain v. On behalf of saint-gobain-recherche.net* owner, Whois Privacy Service / Grigore PODAC, WIPO Case No. D2020-3549; that given the distinctiveness of the Complainant's Trademark and reputation, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's Trademark; that the misspelling of the trademark SAINT-GOBAIN was intentionally designed to be confusingly similar with the Complainant's trademark, constituting an evidence of bad faith, citing *Microsoft Corporation v. Domain Registration Philippines, Forum Case No. FA 877979*; that the disputed domain name resolves to an inactive website, showing with it, that any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate it is possible such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law; that the incorporation of a famous trademark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use, citing *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003 and *CBS Broadcasting, Inc. v. Dennis Toeppen*, WIPO Case No. D2000-0400. Finally, the Complainant contents that MX servers are configured, suggesting with it that the disputed domain name may be actively used for e-mail purposes, citing *JCDECAUX SA v. Handi Hariyono*, CAC Case No. 102827.

Response

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

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

In accordance with Paragraph 4(a) of the Policy, the onus is on the Complainant to prove:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (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.

The Panel will consider each of these requirements in turn.

1. Identical or Confusingly Similar

The Panel notes that the Trademarks submitted by the Complainant are composed by figurative elements as well, and that there are no disclaimers over the textual elements of the Trademarks, from which this Panel concludes that, in this case, the Complainant has sufficiently proved of having Trademark Rights over the word SAINT-GOBAIN, since 1989, *e.g.*: Reg. 551682 registered on July 21, 1989 and in force until July 21, 2029.

According to the WIPO Overview 3.0, Section 1.10: “Panel assessment of identity or confusing similarity involves comparing the (alpha-numeric) domain name and the textual components of the relevant mark. To the extent that design (or figurative/stylized) elements would be incapable of representation in domain names, these elements are largely disregarded for purposes of assessing identity or confusing similarity under the first element.”

Therefore, this Panel will compare the disputed domain name <saint-gboain.com> v. the textual components of the Trademark SAINT-GOBAIN.

The Panel finds that the disputed domain name <saint-gboain.com> misspelled Complainant’s Trademark, where the letter “O” is inverted by the letter “B” forming “GBOAIN” instead of “GOBAIN”, which falls within the typosquatting practice. As previous UDRP panelists have already stated “A domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element” (see WIPO Overview 3.0, Section 1.9; *Compagnie De Saint-Gobain v. Mohammed Danu*, WIPO Case No. D2021-1937; *Compagnie De Saint-Gobain v. hidorsir King*, CAC-UDRP Case No. 105067).

In relation to the gTLD “.com”, it is well established that such element may typically be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark, as it is a technical requirement of registration (see WIPO Overview 3.0, Section 1.11.1).

Therefore, the disputed domain name <**saint-gboain.com**> is confusingly similar to Complainant’s Trademark SAINT-GOBAIN.

2. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires the Complainant to prove that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent may establish rights or legitimate interests in the disputed domain name by demonstrating any of the circumstances, but without limitation, described in paragraph 4(c) of the Policy.

As multiple UDRP panelist have recognized, satisfying the burden of proving a lack of the Respondent’s rights or legitimate interests in respect of the disputed domain name according to paragraph 4(a)(ii) of the Policy “may result in the often-impossible 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element” (see WIPO Overview 3.0, Section 2.1).

The Respondent has not submitted its Response and or any communication rebutting the Complainant’s contentions.

According to the evidence submitted by the Complainant, this Panel finds that:

(1) there is no evidence that the Respondent has become commonly known by the term “saint-gboain.com”;

(2) the Respondent is not associated or affiliated with the Complainant; the Complainant has not granted any rights to the Respondent to use its Trademark SAINT-GOBAIN, or has granted any license to offer any product or service, or any rights to apply for registration of the disputed domain name;

(3) there is no evidence, prior of the present dispute, of the Respondent's use of or demonstrable preparation to use the disputed domain name in connection with a *bona fide* offering of goods or services, in fact the Respondent purposely chose a well-known trademark as SAINT-GOBAIN, intentionally misspelling it, register it as a domain name, point it to an inactive website, confusing the users who seeks or expects to find the Complainant on the Internet;

(4) that the disputed domain name is the result of Respondent's typosquatting practice, who “seeks to capitalize deliberately on a predictable pattern of mistyping of the Complainant's mark by Internet users” (see *Compagnie De Saint-Gobain v. Jackson Williams*, CAC-UDRP Case No. 104500) which constitutes evidence of Respondent's lack of rights or any legitimate interest in respect of the disputed domain name.

Therefore, to the satisfaction of the Panel, the Complainant has made out its *prima facie* case. No Response or any communication from the Respondent has been submitted. In the absence of a Response, this Panel accepts Complainant's undisputed factual assertions as true. Thus, the Panel concludes, that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

3. Registered and Used in Bad Faith

a) Registration in Bad Faith:

The Complainant acquired its Trademark Rights over the word SAINT-GOBAIN at least since 1989. The disputed domain name was registered on September 27, 2023. According to the evidence submitted before this Panel, the Complainant owns a well-known Trademark - confirmed by previous UDRP panelists - with consistent, intense and relevant commercial use/activity, including on the Internet (see *Compagnie de Saint-Gobain v. Ayache Mohammed*, WIPO Case No. D2021-3633; *Compagnie de Saint-Gobain v. Hyder Jane*, WIPO Case No. D2023-1988; *Compagnie De Saint-Gobain v. Jackson Williams*, CAC-UDRP Case No. 104500; *Compagnie De Saint-Gobain v. Elaine Enger*, CAC-UDRP Case No. 105170).

According to the WIPO Overview 3.0, Section 3.1.3:

“Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.”

Panels have moreover found the following types of evidence to support a finding that a respondent has registered a domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's mark: (i) actual confusion, (ii) **seeking to cause confusion (including by technical means beyond the domain name itself) for the respondent's commercial benefit, even if unsuccessful**, (iii) **the lack of a respondent's own rights to or legitimate interests in a domain name**, (iv) redirecting the domain name to a different respondent-owned website, even where such website contains a disclaimer, (v) redirecting the domain name to the complainant's (or a competitor's) website, and (vi) **absence of any conceivable good faith use**.(...)” (emphasis added).

In addition, the WIPO Overview 3.0, Section 3.2.2 has established that:

“Noting the near instantaneous and global reach of the Internet and search engines, and particularly in circumstances where the complainant's mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark (particularly in the case of domainers), panels have been prepared to infer that the respondent knew, or have found that the respondent should have known, that its registration would be identical or confusingly similar to a complainant's mark. (...)” (emphasis added).

Therefore, considering the facts and the submitted evidence, in particular the fact that the disputed domain name is based on the Complainant's Trademark, to this Panel, it is clear that the Respondent knew about Complainant's reputation and SAINT-GOBAIN Trademark's value, at the time of the registration of the disputed domain name. Also, to this Panel, it is clear, that the Respondent has incurred in paragraph 4.b.(iv) of the Policy, which proves that the disputed domain name has been registered in bad faith.

b) Bad Faith Use:

As described along this Decision, the disputed domain name resolved to an inactive website. Also, as the Complainant's has proved, the MX servers are configured.

According to the WIPO Overview 3.0, Section 3.3, this Panel considers the following factors related to the Passive Holding Doctrine, which are evident in this case, being:

(i) the high degree of distinctiveness and strong reputation of the Complainant's Trademark SAINT-GOBAIN;

(ii) the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use;

(iii) the fact that Respondent configured MX-servers, which represents an imminent cascade of online frauds, on detriment of the

Complainant's Trademark SAINT-GOBAIN and the Internet Users; and
(iv) the implausibility of any good faith use to which the domain name may be put.

Therefore, this Panel concludes that, the disputed domain name is being used in faith as well.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

- 1. **saint-gboain.com**: Transferred

PANELLISTS

Name	María Alejandra López García
------	------------------------------

DATE OF PANEL DECISION 2023-11-08

Publish the Decision