

Decision for dispute CAC-UDRP-104504

Case number	CAC-UDRP-104504
Time of filing	2022-04-19 09:34:17
Domain names	saintgobainpartners.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	COMPAGNIE DE SAINT-GOBAIN
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Complainant representative

Organization	NAMESHIELD S.A.S.
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Respondent

Organization	NetCarrots.com Pvt. Ltd.
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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 has submitted evidence, which the Panel accepts, showing that it is the registered owner of the following:

- International trademark n°740184 registered on 26.07.2000;
- International trademark n°740183 registered on 26.07.2000;
- International trademark n°596735 registered on 02.11.1992;
- International trademark n°551682 registered on 21.07.1989.

Moreover, the Complainant is also the owner of the domain name <saint-gobain.com>, bearing the sign "SAINT-GOBAIN®".

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The disputed domain name is confusingly similar to the Complainant's well-known trademark SAINT-GOBAIN®. See WIPO Case No. D2020-3549 Compagnie de Saint-Gobain v. On behalf of saint-gobain-recherche.net owner, Whois Privacy Service / Grigore PODAC ("The Panel is satisfied that the Complainant is a well-established company which operates since decades worldwide under the trademark SAINT-GOBAIN.").

Furthermore, the disputed domain name is inactive. The Complainant contends that the Respondent has not demonstrated

any activity in respect of the disputed domain name, and it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law.

As prior WIPO UDRP panels have held, the incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use. (for instance: WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows; WIPO Case No. D2000-0400, CBS Broadcasting, Inc. v. Dennis Toeppen).

PARTIES CONTENTIONS

1. THE DISPUTED DOMAIN NAME IS CONFUSINGLY SIMILAR

The Complainant contends that the disputed domain name <saintgobainpartners.com> is confusingly similar to its well-known and distinctive trademark SAINT-GOBAIN®. The addition of the generic term "Partners" does not change the overall impression of the designation as being connected to the Complainant's trademark SAINT-GOBAIN®. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and domain names associated. It is well-established that "a domain name that wholly incorporates a Complainant's registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP". The Complainant refers to the earlier WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin.

Furthermore, the addition of the gTLD ".COM" is not sufficient to escape the finding that the domain name is confusingly similar to the Complainant's trademark and it does not change the overall impression of the designation as being connected to the trademark SAINT-GOBAIN®. The Complainant refers to the earlier decision on Forum Case No. FA 153545, Gardline Surveys Ltd v. Domain Finance Ltd. ("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."). Thus, the Complainant claims that the disputed domain name is confusingly similar to the Complainant's trademark SAINT-GOBAIN®.

2. NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Complainant asserts that the Respondent is not identified in the Whois as the disputed domain name. Past panels have held that a Respondent was not commonly known by a disputed domain name if the Whois information was not similar to the disputed domain name. Thus, the Respondent is not known as the disputed domain name. The Complainant refers to the earlier decision on Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com> ("Here, the WHOIS information of record identifies Respondent as "Chad Moston / Elite Media Group." The Panel therefore finds under Policy 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy 4(c)(ii).").

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the domain name <saintgobainpartners.com> and he is not related in any way with the Complainant. The Complainant does not carry out any activity for, nor has any business with the Respondent.

Neither licence 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.

The disputed domain name is not actively used. The Complainant contends that Respondent did not make any use of disputed domain name since its registration, and it confirms that Respondent has no demonstrable plan to use the disputed domain name. It demonstrates a lack of legitimate interests in respect of the disputed domain name except in order to create a likelihood of confusion with the Complainant and its trademark.

Therefore, the Complainant claims that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

3. THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The Complainant claims that the disputed domain name is confusingly similar to the Complainant's well-known trademark SAINT-GOBAIN®. See WIPO Case No. D2020-3549 Compagnie de Saint-Gobain v. On behalf of saint-gobain-recherche.net owner, Whois Privacy Service / Grigore PODAC ("The Panel is satisfied that the Complainant is a well-established company which operates since decades worldwide under the trademark SAINT-GOBAIN."). Given the distinctiveness of the Complainant's trademarks and reputation, it is reasonable to infer that the Respondent has registered the domain name with full knowledge of the Complainant's trademark.

Furthermore, the disputed domain name is inactive. The Complainant contends that the Respondent has not demonstrated any activity in respect of the disputed domain name, and it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law. The Complainant refers to the prior WIPO UDRP panel decisions on the incorporation of a famous mark into a domain name, coupled with an inactive website, which may be evidence of bad faith registration and use. For instance, WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows; WIPO Case No. D2000-0400, CBS Broadcasting, Inc. v. Dennis Toepfen.

On these bases, the Complainant concludes that the Respondent has registered and is using the disputed domain name <saintgobainpartners.com> in bad faith.

RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or 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

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable. In this context, the Panel also notes that the burden of proof is on the Complainant to make out its case and past UDRP panels have consistently said that a Complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

- A. the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- B. the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- C. the disputed domain name has been registered and is being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.

A. IDENTICAL OR CONFUSINGLY SIMILAR

The Policy simply requires the Complainant to demonstrate that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The Panel is satisfied that the Complainant is the owner of registration of "SAINT-GOBAIN" trademarks.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's "SAINT-GOBAIN" trademark and the addition of the non-distinctive word element "PARTNERS" is not sufficient to vanish the similarity, as it can easily refer to

the Complainant, which is a global group company.

Moreover, the addition of the gTLD “.COM” is not enough to abolish the similarity.

The Panel is of the opinion that the Internet users will easily fall into false impression that the disputed domain name is an official domain name of the Complainant. The Panel recognizes the Complainant's rights and concludes that the disputed domain name is confusingly similar with the Complainant's trademark. Therefore, the Panel concludes that the requirements of paragraph 4(a)(i) of the Policy is provided.

B. NO RIGHTS OR LEGITIMATE INTERESTS

Under paragraph 4(a)(ii) of the Policy, the complainant has the burden of establishing that the respondent has no rights or legitimate interests in respect of the domain name.

It is open to a respondent to 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 the respondent of the dispute, the use or making 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) the respondent of the dispute (as an individual, business, or other organization) has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the respondent of the dispute is making a legitimate non-commercial or fair use of the domain name, without an intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Thus, if the respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the disputed domain name, the complainant will have failed to discharge its burden of proof and the complaint will fail. The burden is on the complainant to demonstrate a prima facie case that the respondent does not have rights or legitimate interests in the disputed domain name. Once the complainant has made out a prima facie case, then the respondent may, inter alia, by showing one of the above circumstances, demonstrate rights or legitimate interests in the disputed domain name.

The Complainant contends that the Respondent has nothing to do with the Complainant and any use of the trademarks “SAINT-GOBAIN” has to be authorized by the Complainant and there is no such authorization. Moreover, the disputed domain name has no relation with the Respondent and the Respondent is not commonly known as the disputed domain name.

In the absence of a response, the Panel accepts the Complainant's allegations as true that the Respondent has no authorization to use the Complainant's trademarks in the disputed domain name.

Hence, as the Complainant has made out its prima facie case, and as the Respondent has not demonstrated any rights or legitimate interests as illustrated under paragraph 4(c) of the Policy, nor has the Panel found any other basis for finding any rights or legitimate interests of the Respondent in the disputed domain name, the Panel concludes that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. BAD FAITH

The Panel concludes that the Complainant's “SAINT-GOBAIN” trademark is of distinctive character. Therefore, the Panel is of the opinion that due to the earlier rights of the Complainant in the “SAINT-GOBAIN” trademarks, the Respondent, was aware of the Complainant and its trademarks at the time of registration of the disputed domain name (see e.g., *Ebay Inc. v. Wangming*, WIPO Case No. D2006-1107). Referring to *Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net*, WIPO Case No. D2000-0226, the Panel believes that the awareness of the Complainant's trademark at the time of the registration of the disputed domain name is to be considered an inference of bad faith registration.

Moreover, the link < saintgobainpartners.com > is currently inactive.

Therefore, in light of the above-mentioned circumstances in the present case, the Panel finds that the disputed domain name has been registered and is being used in bad faith and that the Complainant has established the third element under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. SAINTGOBAINPARTNERS.COM: Transferred

PANELLISTS

Name	Mrs Selma Ünlü
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DATE OF PANEL DECISION 2022-05-27

Publish the Decision
