

Decision for dispute CAC-UDRP-104699

Case number CAC-UDRP-104699

Time of filing 2022-07-08 09:05:52

Domain names saint-gobain.sbs

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 mao tas

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 the owner of following trademarks SAINT-GOBAIN:

- International trademark SAINT-GOBAIN n°740184 registered on July 26, 2000;
- International trademark SAINT-GOBAIN n°740183 registered on July 26, 2000;
- International trademark SAINT-GOBAIN n°596735 registered on November 2, 1992;
- US trademark SAINT-GOBAIN n°73825251 registered on June 25, 1991;
- International trademark SAINT-GOBAIN n°551682 registered on July 21, 1989.

The Complainant also owns domain name <saint-gobain.com> registered on December 29, 1995.

SAINT-GOBAIN is also part of the company name of the Complainant.

The disputed domain name <saint-gobain.sbs> was registered on June 14, 2022.

FACTUAL BACKGROUND

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

The Complainant claims it is a French company specialized in the production, processing and distribution of materials for the construction and industrial markets for 350 years and it is one of the top 100 industrial groups in the world and one of the 100 most innovative companies.

The Complainant is the owner of several trademarks SAINT-GOBAIN, registered worldwide, and also owns many domain names including its trademark SAINT-GOBAIN. SAINT-GOBAIN is also commonly used to designate the company name of the Complainant.

The disputed domain name was registered on June 14, 2022, and resolves to a parking page with commercial links related for some of them to the Complainant building activities.

The Complainant contends that the disputed domain name is identical to its trademark SAINT-GOBAIN. Indeed, the domain name includes in its entirety the above-mentioned trademark without any addition of letter or word. The Complainant contends that the addition of the gTLD ".COM" does not change the overall impression of the designation as being connected to Complainant's trademark. It does not prevent the likelihood of confusion between the disputed domain name and Complainant, its trademark and its domain names associated.

Finally, Panels previously held the Complainant rights over the term "SAINT-GOBAIN" (WIPO Case No. D2020-3555, *Compagnie de Saint-Gobain v. chap jeks <saint-gobain.club>*; WIPO Case No. D2020-3546, *Compagnie de Saint-Gobain v. Andrea Chi, Andrea Chi Chi < saint-gobain.tech>*).

The Complainant contends that the Respondent does not have any rights or legitimate interest in the disputed domain name. The Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the UDRP.

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 contends that the Respondent has no rights or legitimate interests in respect of the domain name 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 or apply for registration of the disputed domain name by the Complainant.

Furthermore, the disputed domain name resolves to a parking page with commercial links. Past panels have found it is not a bona fide offering of goods or services or legitimate non-commercial or fair use; WIPO Case No. D2007-1695, *Mayflower Transit LLC v. Domains by Proxy Inc./Yariv Moshe* ("Respondent's use of a domain name confusingly similar to Complainant's trademark for the purpose of offering sponsored links does not of itself qualify as a bona fide use.").

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

The Complainant finally contends that the disputed domain name has been registered and is being used in bad faith. The disputed domain name was created quite recently, on June 14, 2022. The Complainant was already extensively using his trademark SAINT-GOBAIN worldwide well before that date. It is also recalled that the Complainant trademark has a well-known character worldwide and has a long-standing worldwide operating website under the <saint-gobain.com> domain name.

The disputed domain name is identical to the Complainant's well-known trademark SAINT-GOBAIN; 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.").

Besides, the terms "SAINT-GOBAIN" has no meaning, except in relation with the Complainant.

In view of the above evidences, the Respondent obviously knew the prior rights and wide use of SAINT-GOBAIN by the Complainant. That is the sole and only reason why he registered the litigious domain name.

Furthermore, the disputed domain name resolves to a parking page with commercial links. The Complainant contends the Respondent has attempted to attract Internet users for commercial gain to his own website thanks to the Complainant's trademarks for its own commercial gain, which is an evidence of bad faith; WIPO Case No. D2018-0497, StudioCanal v. Registration Private, Domains By Proxy, LLC / Sudjam Admin, Sudjam LLC ("In that circumstance, whether the commercial gain from misled Internet users is gained by the Respondent or by the Registrar (or by another third party), it remains that the Respondent controls and cannot (absent some special circumstance) disclaim responsibility for, the content appearing on the website to which the disputed domain name resolve [...] so the Panel presumes that the Respondent has allowed the disputed domain name to be used with the intent to attract Internet users for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, affiliation, or endorsement of the Respondent's website to which the disputed domain name resolves. Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith.").

In light of the above, the Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith.

PARTIES CONTENTIONS

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

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

(i) The domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
and

(ii) The 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.

I. Identical or Confusingly Similar

The Complainant has established the fact that it has valid rights for the international trademark SAINT-GOBAIN n°740184 registered on July 26, 2000, n°740183 registered on July 26, 2000, n°596735 registered on November 2, 1992, n°551682 registered on July 21, 1989 and US trademark SAINT-GOBAIN n°73825251 registered on June 25, 1991. The Complainant further established the fact that it owns the domain name including the same distinctive wording SAINT-GOBAIN. The disputed domain name was registered on June 14, 2022, i.e. more than 30 years after the first SAINT-GOBAIN trademark registration, and wholly incorporates the Complainant's trademark SAINT-GOBAIN and is therefore identical to it.

The generic top level domain "SBS" should be disregarded in the assessment under the Policy when comparing disputed domain names and trademarks and does not change the overall impression of the designation as being connected to Complainant's trademark.

The Panel therefore considers the disputed domain name to be identical to the Complainant's trademarks SAINT-GOBAIN which the Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

II. Rights or Legitimate Interests

The Complainant has established a prima facie case (not challenged by the Respondent who did not file any response to the complaint) that the Respondent has no rights or legitimate interests in the disputed domain name, since the Respondent is not related in any way with the Complainant.

The disputed domain name resolves to a parking page with commercial links only and, therefore, does not constitute a bona fide offering of goods and services or a legitimate noncommercial fair use. The Respondent has no rights or legitimate interests in the disputed domain name, since there is no indication that the Respondent is commonly known by the term "SAINT-GOBAIN" or its variations or that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services.

The Panel therefore considers that the Respondent has no rights or legitimate interests in respect of the disputed domain name within the meaning of paragraph 4(a)(ii) of the Policy.

III. Registered and Used in Bad Faith

Given the distinctiveness of the Complainant's trademark and reputation (as confirmed in other UDRP proceeding in the past – WIPO Case No. D2020-3555, *Compagnie de Saint-Gobain v. chap jeks < saint-gobain.club >*; or WIPO Case No. D2020-3546, *Compagnie de Saint-Gobain v. Andrea Chi, Andrea Chi Chi < saint-gobain.tech >*) it is evident that the Respondent had the Complainant and its trademarks in mind when registering the disputed domain name. Furthermore, the disputed domain name is used only for the webpage with the commercial links, some of them being connected to the area of the Complainant's activities. Such use could mean that the Respondent has attempted to attract Internet users for commercial gain to his own website for its own commercial gain, which is evidence of bad faith.

The Panel therefore considers that 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.

The Panel finally considers that the Complainant has shown that the disputed domain name is identical to the trademarks in

which the Complainant has rights, the Respondent has no rights or legitimate interests in respect of the disputed domain name and the disputed domain name has been registered and is being used in bad faith. The Complainant has thus established all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **SAINT-GOBAIN.SBS**: Transferred
-

PANELLISTS

Name	JUDr. Petr Hostaš
------	--------------------------

DATE OF PANEL DECISION **2022-08-04**

Publish the Decision
