

Decision for dispute CAC-UDRP-105143

Case number **CAC-UDRP-105143**

Time of filing **2023-01-20 09:15:17**

Domain names **saint-gobains.net**

Case administrator

Name **Olga Dvořáková (Case admin)**

Complainant

Organization **COMPAGNIE DE SAINT-GOBAIN**

Complainant representative

Organization **NAMESHIELD S.A.S.**

Respondent

Name **Fernando Chavira**

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 the following registered trademarks:

- EU word trademark SAINT-GOBAIN No. 001552843, registered on December 18, 2001;
- International figurative trademark SAINT-GOBAIN No. 740184, registered on July 26, 2000;
- International figurative trademark SAINT-GOBAIN No. 740183, registered on July 26, 2000;
- International figurative trademark SAINT-GOBAIN No. 596735, registered on November 2, 1992;
- International figurative trademark SAINT-GOBAIN No. 551682, registered on July 21, 1989.

The Complainant proved its ownership of listed trademark registrations by the submitted extracts from the Register.

FACTUAL BACKGROUND

The Complainant is a French company specializing in the production, processing and distribution of materials for the construction and industrial markets. It is now one of the top 100 industrial groups in the world and one of the 100 most innovative companies with 350 years of tradition.

Moreover, the Complainant is also the owner of several domain names including trademark SAINT-GOBAIN, such as the domain name

<saint-gobain.com>, registered and used since December 29, 1995.

The disputed domain name <saint-gobains.net> (hereinafter “disputed domain name”) was registered on September 26, 2022 and resolves to an inactive page. Moreover, MX servers are configured. These facts were proven by pertinent documents.

According to the Registrar verification, the Respondent is Fernando Chavira. The Respondent’s provided address as being at Texas, United States.

PARTIES CONTENTIONS

COMPLAINANT:

1. The Complainant contends that the disputed domain name is confusingly similar to the Complainant’s trademarks.

The Complainant contends that the disputed domain name is confusingly similar to its well-known and distinctive trademark SAINT-GOBAIN. The addition of the letter “s” to the Complainant’s trademark is not sufficient to escape the finding that the domain name is confusingly similar to the trademark and branded goods SAINT-GOBAIN.

According to the Complainant, it is a clear case of typosquatting (when the disputed domain name contains an obvious misspelling of the Complainant’s trademark).

Furthermore, the Complainant contends that the addition of the gTLD “.net” does not change the overall impression of the designation as being connected to the Complainant’s trademark. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and its domain names associated.

The Complainant adds that past Panels have held the Complainant rights over the term “SAINT-GOBAIN”.

- WIPO Case No.D2022-2422, Compagnie de Saint-Gobain v. Contact Privacy Inc. Customer 7151571251 / Finizza, Heidi J., saint gobain <saint-gobaih.com>;
- CAC Case No. 104500, COMPAGNIE DE SAINT-GOBAIN v. Jackson Williams <saint-goibain.com>;
- WIPO Case No. D2021-3664, Compagnie de Saint-Gobain v. Contact Privacy Inc. Customer 1249589662 / Latonya Peterson <saint-gobbain.com>.

1. The Complainant states that the Respondent has 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 (See Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group).

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 to the Complainant. The Complainant does not carry out any activity for, nor has any business with the Respondent. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant’s trademarks or apply for registration of the disputed domain name by the Complainant.

Besides, the Complainant claims that the disputed domain name is typosquatting version of its trademark. Typosquatting is the practice of registering a domain name in an attempt to take advantage of Internet users’ typographical errors and can be evidence that a respondent lacks rights and legitimate interests in the domain name (See Forum Case No. 1597465, The Hackett Group, Inc. v. Brian HERN / The Hackett Group).

The Complainant adds that the disputed domain name resolves to an inactive page. The Complainant contends that the Respondent did not make any use of the disputed domain name since its registration, and it confirms that the 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 (See WIPO Case No. D2000-1164, Boeing Co. v. Bressi).

1. The Complainant contends that the domain name has been registered and is being used in bad faith.

The Complainant asserts that at the time of the disputed domain name registration, it was already extensively using its trademarks worldwide having a well-known character and reputation. The Complainant adds that all the results for a Google search of the terms “SAINT-GOBAINS” refer to the Complainant.

The Complainant contends that the Respondent must have been aware of the Complainant’s prior rights and worldwide use of its trademarks being the only reason why the Respondent registered the litigious domain name.

Furthermore, the Complainant states the misspelling of the trademark SAINT-GOBAIN was intentionally designed to be confusingly similar with the Complainant’s trademark. According to the Complainant, it is evidence of an act of bad faith (See Forum Case No. FA 877979, Microsoft Corporation v. Domain Registration Philippines).

In addition to that, the domain name resolves to an inactive page. 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. According to the Complainant, this may constitute evidence of a bad faith act too (See WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows; WIPO Case No. D2000-0400, CBS Broadcasting, Inc. v. Dennis Toepfen).

Finally, the Complainant contends that MX servers are configured which suggests that it may be actively used for email purposes (See CAC Case No. 102827, JCDECAUX SA v. Handi Hariyono).

RESPONDENT:

No administratively Complaint 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 UDRP).

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 UDRP).

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 UDRP).

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 the present case, the Respondent has not submitted any Response and consequently has not contested any of the contentions made by the Complainant. The Panel proceeds therefore to decide only on the basis of the Complainant's factual statements and the documentary evidence provided in support of them (Paragraph 5(f) of The Rules).

1. CONFUSING SIMILARITY

The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (hereinafter referred to as "The WIPO Overview 3.0") in Paragraph 1.2.1 states: "Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case".

The WIPO Overview 3.0 in Paragraph 1.7 states: "[...] in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing."

The WIPO Overview 3.0 in Paragraph 1.9 states: "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."

Using of the generic Top-Level Domain ".net" is generally disregarded in the similarity test "as it does not add anything to the distinctiveness of the disputed domain name" (see CAC case No. 102399; WIPO Overview 3.0 in Paragraph 1.11.1).

The typosquatting is "the case where the disputed domain name is a slight misspelling of a registered trademark to divert internet traffic" (see e. g. WIPO Case No. D2006-1043).

The Complainant has established that owns registered trademarks for the term “SAINT-GOBAIN” designated for services in connection with, among others, industrial constructions (evidenced by excerpt from the trademark registers).

The Complainant’s trademark is incorporated in its entirety and clearly recognizable in <saint-gobains.net> disputed domain name. The addition of the letter “s” does not change the overall impression of the disputed domain name. From the point of view of this Panel, the addition of the letter “s” to the Complainant’s well-known trademark may be considered typosquatting.

The addition of the gTLD <.net> does not change the overall impression of the disputed domain name either.

As stated in the WIPO Overview 3.0 in Paragraphs 1.7 and 1.8 where a domain name incorporates the entirety of a trademark, the domain will normally be considered confusingly similar.

Therefore, <saint-gobains.net> disputed domain name as it reproduces the SAINT-GOBAIN trademark in its entirety, with the addition of the letter “s” is considered to be confusingly similar to the relevant trademark.

As a result, the Panel finds that the Complainant has satisfied Paragraph 4(a)(i) of the UDRP.

1. THE RESPONDENT’S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DOMAIN NAME

The Panel finds that the Respondent lacks rights or legitimate interests in the disputed domain name.

According to Paragraph 4(a)(ii) of the UDRP, the Complainant shall make case that the Respondent lacks rights and legitimate interests in the disputed domain name. If the Complainant fulfills this demand the burden of proof shifts to the Respondent and so the Respondent shall demonstrate rights or legitimate interests in the disputed domain name. If the Respondent fails to prove its rights or legitimate interests, it is assumed that the Complainant satisfied the element of Paragraph 4(a)(ii) of the UDRP (see CAC Case No. 102430, Lesaffre et Compagnie v. Tims Dozman).

Moreover, past Panels were of the view that it is difficult or sometimes impossible to prove negative facts, i.e., absence of rights or legitimate interest on the part of the Respondent. In this respect, past Panels referred to the WIPO Case No. D2000-1769, Neusiedler Aktiengesellschaft v. Vinayak Kulkarni. Within the meaning of Paragraph 4(a)(ii) of the UDRP, once the complainant has made something credible (*prima facie* evidence), the burden of proof shifts to the Respondent to show that he has rights or legitimate interests in the domain name at issue by providing particular evidence.

In the WIPO No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd., the Panel stated: “Complainant must make at least a *prima facie* showing that Respondent has no rights or legitimate interests in the mark. After Complainant has met its initial burden of proof, if Respondent fails to submit a response Complainant will be deemed to have satisfied Paragraph 4 (a) ii of the Policy.”

In the CAC Case No. 102279, FileHippo s.r.o. v. whois agent, the Panel stated that “[i]n 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.”

In the Forum Case No. FA 1781783, Skechers U.S.A. Inc. v. Chad Moston / Elite Media Group, the Panel stated that: “where a response is lacking, WHOIS information can support a finding that the respondent is not commonly known by the disputed domain name”.

In the Forum Case No. FA 1597465, The Hackett Group, Inc. v. Brian Herns / The Hackett Group, the Panel stated that: “The Panel agrees that typosquatting is occurring, and finds this is additional evidence that Respondent has no rights or legitimate interests under Policy ¶ 4(a)(ii).” (*Citing the Forum Case No. FA 877979, Microsoft Corp. v. Domain Registration Philippines, where the Panel stated that: „the respondent had ‘engaged in typosquatting, which provides additional evidence that [the] respondent lacks rights and legitimate interests in the disputed domain name under Policy ¶ 4(a)(ii).’”*)

In the present case, the Complainant states that the Respondent is not known by the disputed domain name and is not identified in the Whois. The Complainant also contends that the Respondent is not affiliated with nor authorized by the Complainant in any way and so the Respondent does not have any rights or legitimate interests in respect of the disputed domain name.

This Panel agrees with the Complainant that the Respondent used the Complainant’s trademark in the disputed domain name in typosquatting, which, as previous Panels stated, provides evidence that the Respondent lacks rights and legitimate interests in the disputed domain name.

Furthermore, the disputed domain name resolves to an inactive page (evidenced by Annex). This Panel agrees that the Respondent does not make any use of the disputed domain name and has no demonstrable plan to use it. This finding supports the Complainant’s claim that the Respondent lacks rights and legitimate interests in the disputed domain name.

To the satisfaction of this Panel, the Complainant has shown a *prima facie* case that the Respondent has no rights to the Complainant’s trademarks nor the disputed domain name.

The Respondent did not reply to the Complaint and also failed to demonstrate its rights or legitimate interests in the disputed domain name.

Therefore, the Panel finds that the Complainant has satisfied Paragraph 4(a)(ii) of the UDRP.

1. THE REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME IN BAD FAITH

The Panel finds that the Respondent registered and used the disputed domain in bad faith.

The WIPO Overview 3.0 in Paragraph 3.1.4 states: “Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar [...] to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.”

In the WIPO Case No. D2006-1440, National Football League v. Thomas Trainer, the Panel stated: “when a registrant, such as the Respondent here, obtains a domain name that is confusingly similar to a famous mark, with no apparent rights or legitimate interests in the name, and then fails to respond to infringement claims and a UDRP Complaint, an inference of bad faith is warranted.”

In the WIPO Case No. D2015-1167, Valero Energy Corporation and Valero Marketing and Supply Company v. Sharad Bhat, the Panel stated that: “In accordance with previous UDRP decisions, inactive or passive holding of a domain name, under the circumstances does not prevent a finding of bad faith use.”

In the CAC Case No. 102827, JCDECAUX SA v. Handi Hariyono, past Panel stated that: “There is no present use of the disputed domain name but there are several active MX records connected to the disputed domain name. It is concluded that it is inconceivable that the Respondent will be able to make any good faith use of the disputed domain name as part of an e-mail address.”

In the present case, the Complainant owns various (EU and international) registered trademarks consisting of the term “SAINT-GOBAIN”. Moreover, the Complainant has a certain reputation in the area of materials for industrial construction globally. Past panels declared that the Complainant’s trademark is widely/well-known (see WIPO Case No. D2022-2422, Compagnie de Saint-Gobain v. Contact Privacy Inc. Customer 7151571251 / Finizza, Heidi J., saint gobain; WIPO Case No. D2021-3664, Compagnie de Saint-Gobain v. Contact Privacy Inc. Customer 1249589662 / Latonya Peterson; CAC Case No. 104500, COMPAGNIE DE SAINT-GOBAIN v. Jackson Williams).

It was also proven that a common Google search for the term “SAINT-GOBAINS” refers to the Complainant’s domain name and trademark. Therefore, this Panel assumes that the Respondent must have been aware of the Complainant’s trademarks and its reputation before the registration of the disputed domain on September 26, 2022.

To the satisfaction of this Panel, it is established that the Respondent registered the disputed domain name which incorporates the entirety of the Complainant’s widely-known trademark. The typosquatting was evidenced in the disputed domain name. Both findings designate the bad faith of the Respondent in order to be confusingly similar with the Complainant’s trademark.

Additionally, the Respondent is not recognized as the disputed domain and cannot be identified from the Whois database. Therefore, the domain was registered by an unknown and unaffiliated entity.

Furthermore, the disputed domain name resolves to an inactive page (evidenced by Annex). By that, the Respondent is passively holding the disputed domain name that is considered to be evidence of bad faith too. Finally, the disputed domain has active MX records and so the domain name may be used for e-mail purposes. In connection with the outlined findings from parts I. and II. above, this Panel finds that using the disputed domain name for e-mail purposes would confuse internet users and cannot constitute an act of good faith.

Following the above-mentioned, the Panel finds that the Complainant has satisfied Paragraph 4(a)(iii) of the UDRP.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **saint-gobains.net**: Transferred

PANELLISTS

| | |
|------|----------------------|
| Name | Radim Charvát |
|------|----------------------|

DATE OF PANEL DECISION 2023-02-18

Publish the Decision
