

Decision for dispute CAC-UDRP-105146

Case number	CAC-UDRP-105146
Time of filing	2023-01-20 09:15:32
Domain names	saint-gobaingyproc.com

Case administrator

Name	Olga Dvořáková (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	Cement
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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 adduced evidence that it is the owner of the following trademarks:

- EU trademark SAINT-GOBAIN No. 001552843 registered on 18 December 2001 in Nice Classification List classes 1, 2, 3, 6, 7, 11, 12, 17, 19, 20, 21, 22, 23, 24, 37, 38, 40 and 42;
- International trademark SAINT-GOBAIN No. 740184 registered on 26 July 2000 in Nice Classification List classes 1, 2, 3, 6, 7, 8, 9, 10, 11, 12, 17, 19, 20, 21, 22, 23, 24, 37, 38, 40 and 42;
- International trademark SAINT-GOBAIN No. 740183 registered on 26 July 2000 in Nice Classification List classes 1, 2, 3, 6, 7, 8, 9, 10, 11, 12, 17, 19, 20, 21, 22, 23, 24, 37, 38, 40 and 42;
- International trademark SAINT-GOBAIN No. 596735 registered on 2 November 1992 in Nice Classification List classes 1, 6, 9, 11, 12, 16, 17, 19, 20, 21, 22, 23 and 24;
- International trademark SAINT-GOBAIN No. 551682 registered on 21 July 1989 in Nice Classification List classes 1, 6, 7, 9, 11, 12, 16, 17, 19, 20, 21, 22, 23, 24, 37, 39 and 41;
- International trademark GYPROC No. 1121411 registered on 19 January 2012 in Nice Classification List classes 6, 7 and 19.

The above trademark registrations include ones for figurative marks alongside word marks.

The Complainant has further adduced evidence that it has been the registrant of the domain name <saint-gobain.com> since 1995.

The Registrar Verification data confirm that the Respondent registered the disputed domain name <saint-gobaingyproc.com> on 10

January 2023.

FACTUAL BACKGROUND

The Complainant, Compagnie de Saint-Gobain, is a large French company specialized in the production, processing and distribution of materials, products and solutions for the construction, industry and mobility markets. It has a presence in 76 countries, 166,000 employees worldwide and a turnover of over €44 billion in 2021. The Saint-Gobain corporate group's product range includes its trademark-protected GYPROC line that is used in solutions for interior insulation and wall and ceiling finishing. Saint-Gobain operates facilities in the Greater Mumbai region alongside its many other locations.

The disputed domain name resolves to an inactive web page and e-mail (MX) servers are configured for its use.

A brief online check by the Panel of the Respondent's name together with that of the Complainant revealed that a person corresponding to the name of the Respondent appears to be employed as a manager by the Complainant in the Greater Mumbai region.

PARTIES CONTENTIONS

COMPLAINANT:

A. The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights

While the Respondent's addition of the term "GYPROC" to the Complainant's trademark-protected name does not change the overall impression of the disputed domain name being connected to the Complainant's other trademarks, such addition increases the likelihood of confusion with the Complainant's GYPROC product. Thus, given that one can ignore the technical gTLD <.com> component, the disputed domain name is confusingly similar to the Complainant's trademark SAINT-GOBAIN.

B. The Respondent has no rights or legitimate interests in respect of the domain name

According to the WIPO Case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd., the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such a prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. The Complainant asserts that the Respondent is not identified in the Whois database as the disputed domain name, nor is the Respondent known by or affiliated to, or authorized by the Complainant in any way. The Complainant hence contends that Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. The domain name was registered and is being used in bad faith

The disputed domain name was created recently, in January 2023, yet the Complainant was already extensively using its trademarks that have been wrongly incorporated in the disputed domain name well before that date and across the world. The Complainant's trademarks are furthermore well known worldwide and the Complainant has a long-standing web presence under its <saint-gobain.com> domain name.

Given the distinctiveness of the Complainant's trademarks and reputation, it is reasonable to infer that the Respondent registered the domain name with full knowledge of the Complainant's trademark

Moreover, the disputed 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 for passing off, for infringing consumer protection legislation, or for infringing the Complainant's rights. 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.

Finally, MX servers are configured, which suggests that the disputed domain name may be actively used for email purposes.

RESPONDENT: NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain name is identical or confusingly similar to trademarks 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 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).

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.

The Panel notes that, in its résumé of the Parties' contentions, references to views of some previous Panels as contained in the Amended Complaint have not been repeated.

PRINCIPAL REASONS FOR THE DECISION

The Panel finds for the purposes of the UDRP three-part cumulative test that:

(1) the Complainant has both established its own rights through the evidence it has adduced (see Identification of Rights) and shown the disputed domain name to engender confusing similarity with them, namely through the combination of two trademarks owned by the Complainant in the stem of the disputed domain name. The addition of a hyphen together with the TLD technical suffix <.com> repeat elements in the Complainant's own domain name, and thus in no way reduce such similarity;

(2) there is no indication in this case that the Respondent has any right or legitimate interest in the disputed domain name whereas, to the contrary, it is plain that the Respondent has been seeking to use the Complainant's rights and reputation illegitimately in what appears from the facts to be a subterfuge;

(3) bad faith registration can easily be inferred from the Respondent's combination in the domain name stem of two distinct trademarks that belong to the Complainant -- the first being that protecting the company's trading name, the second that protecting one of its products prominent in many countries -- while bad faith use can be inferred, in the circumstances of this case, from the Respondent's having equipped itself technically with the means to send e-mails in conjunction with the Respondent's illegitimate and apparently surreptitious registration of the disputed domain name.

In respect of (3), the Panel notes that, viewed purely in isolation, a Respondent merely equipping itself with the means to send e-mails or having an inactive website would not alone have sufficed to ground a finding of bad faith use of a disputed domain name. Yet the other circumstances in this case referred to in (3) compel those technical operations to be seen as serving pursuit of an overall illegitimate purpose. A clear risk exists in this case that unsuspecting recipients of e-mails sent using the disputed domain name could be tricked by it into believing that they emanate from the Complainant in relation to the Complainant's product and will act accordingly, to both their and the Complainant's disadvantage. This is exactly the kind of misuse that the UDRP seeks to combat.

Further, on the question of surreptitious registration, the Panel notes that this was a factual aspect that the Complainant did not consider in its contentions, which were largely based on rehearsal of Decisions from previous Panels. This aspect was, however, raised by the details of the Respondent in the Case File in this proceeding, which prompted the Panel to conduct its own preliminary check pursuant to its general powers under the Rules, with the result stated under Factual Background. The Panel attributes no responsibility to the person whose name was used by the actual Respondent upon registration of the disputed domain name by it.

Lastly, the Panel observes that, in this case, the Complainant sought procedurally to invoke a prima facie standard of proof before then advancing its contentions as to why the Respondent had no right or legitimate interest in the disputed domain name. The Panel points out that application of such a threshold standard -- which is not laid down in the UDRP or the Rules -- makes no sense in this uncontested case, in which the Complainant's contentions based on the circumstances and supported by its own undertakings in bringing the Complaint necessarily conform to a different and higher standard of proof. Nor can a prima facie standard of proof in any event excuse a Complainant's case from a Panel's scrutiny; the Panel's duties of impartiality and fairness under the Rules exclude such an outcome.

Notwithstanding these remarks, the Panel finds for the Complainant and orders the transfer of the disputed domain name to it.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	Kevin Madders
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DATE OF PANEL DECISION	2023-02-20
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Publish the Decision
