

Decision for dispute CAC-UDRP-105872

Case number	CAC-UDRP-105872
Time of filing	2023-10-12 10:00:00
Domain names	saint-gobalin.com, saint-gobain.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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Respondents

Name	Alessandro Nora
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Name	Teresa Mejia
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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 names.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of several registered trademarks as follows.

1. International trademark, no.740184 registered on 26 July 2000 for the logo mark, SAINT-GOBAIN (with a skyline above it), in classes 1,2,3,6,7, 8,9, 10, 11, 12, 17, 19, 20, 21, 22, 23, 24, 37, 38, 40 & 42;

2. International trademark no.740183 registered on 26 July 2000 for the stylised word logo mark, SAINT-GOBAIN, in the same classes;

3. International trademark no.596735 registered on 12 November 1992 for the logo mark, SAINT-GOBAIN (with a bridge above it), in classes 1,6,9,11,12, 16, 17, 19, 20, 21, 22, 23 & 24;

4. International trademark no.551682 registered on 21 July 1989 for the logo mark, SAINT-GOBAIN (with a bridge above it), in classes 1,6,7, 9,11,12, 16, 17, 19, 20, 21, 22, 23, 24, 37, 39 & 41.

The Complainant also owns a domain names portfolio comprising its trademark SAINT-GOBAIN, including <saint-gobain.com> registered since 29 December 1995 and that the group website is at: www.saint-gobain.com.

FACTUAL BACKGROUND

The Complainant is a French company specialized in the production, processing and distribution of materials for the construction and industrial markets. SAINT-GOBAIN is a worldwide name in sustainable construction markets. It designs innovative, high-performance solutions.

The disputed domain names <saint-gobain.com> and <saint-gobalin.com> were registered on 19 September 2023 and resolve to inactive pages, however their MX servers are configured.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant states that the disputed domain names <saint-gobain.com> and < saint-gobalin.com> are both confusingly similar to its trademark SAINT-GOBAIN and are obvious misspellings with the addition of the extra letters "L". This is typosquatting.

The Complainant says the Respondent is not identified in the WHOIS database as known by the disputed domain names. No license or consent has been granted to the Respondent. Finally, the disputed domain names both point to inactive pages and the Respondent did not use the disputed domain names, and the Respondent has not shown a demonstrable plan to use them, so there is a lack of a bona fide offering of goods or services or a legitimate or fair use per Policy paras. 4(c)(i) and (iii)."

Finally, the MX servers are configured which suggests that the disputed domain names may be or intended to be actively used for email purposes. See CAC Case No. 102827, JCDECAUX SA v. Handi Hariyono ("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."). Given the distinctiveness of the Complainant's trademark and reputation, it is reasonable to infer that the Respondent has registered the disputed domain names with full knowledge of the Complainant's trademark.

RESPONDENT:

The Respondent replied out of time and essentially denied that the disputed domain names are typosquatting. She says that they were registered for a proposed and intended legitimate business although that use has not yet commenced. The Respondent denies Bad Faith for the same reasons.

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 but notes that the Respondent filed a Response out of time and without giving any or any good reason. The time periods should be observed and enforced. Without prejudice to that, in light of the fact that the information the Respondent provided does not change the result or the position, the Panel has allowed it into evidence.

PRINCIPAL REASONS FOR THE DECISION

Under paragraph 4(a) of the UDRP, the Policy, a complainant can only succeed in administrative proceedings if the panel finds:

- (i) the disputed 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 disputed domain name has been registered and is being used in bad faith.

A complainant must prove that each of these three elements are present.

In this case, the Complainant has Rights in the distinctive and dominant elements of its registered marks and its trade name, the word element, SAINT-GOBAIN. The trade marks are well known. They come up first on a google search and dominate the entire first page. It does not appear that there is a primary meaning or a place by that name but in any event, due to its long use in trade, it has clearly acquired a distinctive character as a badge of origin for the Complainant's goods and services.

Here, the disputed domain names have only one character different from the mark, an extra L in both domains, as follows: <saint-gobainl.com> and < saint-gobalin.com>.

This is an obvious case of typosquatting. The selection of the .com is relevant insofar as it suggests the domain is official.

As to the second limb, a complainant is only required to make out a prima facie case that a respondent lacks rights or legitimate interests and then the burden shifts to the respondent to show it has rights or legitimate interests in the domain name. If it fails to do so, the complainant is deemed to have satisfied the limb in paragraph 4(a) (ii). See WIPO Case No. D2003-0455, Croatia Airlines d. d. v. Modern Empire Internet Ltd. The Complainant has discharged its burden on this limb.

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. See the 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>.

The Respondent is not known by the names. Here, there is no use on the face of the matter. The Respondent has belatedly come forward but she has failed to explain, adequately or at all, the reason for her selection of the disputed domain names. She disputes that there is typosquatting or bad faith and there is a bare assertion of a future intended legitimate purpose—but no evidence is provided as to that—and no information either. We are not told what kind of goods or services will be offered under or at these disputed domain names or what use will be made of them. Passive holding is fact sensitive and the factors in the other limbs are highly relevant. Here, we have slightly more than mere non-use as the configuration of the MX records suggest that the registration was for a purpose and that purpose was likely at least in part email use. This carries a risk of impersonation and possibly phishing. The Respondent came forward but failed to raise any affirmative defence and a bare denial is not sufficient.

The WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows is apposite. This is sometimes known as the passive Bad Faith test. Where a famous mark is incorporated into a domain name without any legitimate reason or explanation, Bad Faith can often be inferred. Again, here, although the Respondent belatedly came forward, she failed to provide any, or any meaningful, explanations.

The Panel finds that the disputed domain names were registered and are used in Bad Faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **saint-gobalin.com**: Transferred
2. **saint-gobainl.com**: Transferred

PANELLISTS

Name **Victoria McEvedy**

DATE OF PANEL DECISION **2023-11-08**
