

Decision for dispute CAC-UDRP-105905

Case number **CAC-UDRP-105905**

Time of filing **2023-10-24 09:57:44**

Domain names **saint-gobainco.com**

Case administrator

Name **Olga Dvořáková (Case admin)**

Complainant

Organization **COMPAGNIE DE SAINT-GOBAIN**

Complainant representative

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

Respondent

Name **Ben Baz**

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 several trademark registrations for SAINT-GOBAIN, including the following, as per trademark registration certificates available in the Complaint:

- International trademark registration No. 740183 for SAINT-GOBAIN (word mark), registered on July 26, 2000 in classes 1, 2, 3, 6, 7, 8, 9, 10, 11, 12, 16, 17, 19, 20, 21, 22, 23, 24, 37, 38, 40 and 42;
- International trademark registration No. 551682 for SAINT-GOBAIN (figurative mark), registered on July 21, 1989, in classes 1, 6, 7, 9, 11, 12, 16, 17, 19, 20, 21, 22, 23, 24, 37, 39 and 41;
- International trademark registration No. 596735 for SAINT-GOBAIN (figurative mark), registered on November 2, 1992, in classes 1, 6, 9, 11, 12, 16, 17, 19, 20, 21, 22, 23, 24;
- International trademark registration No. 740184 for SAINT-GOBAIN (figurative mark), registered on July 26, 2000, in classes 1, 2, 3, 6, 7, 8, 9, 11, 12, 17, 19, 20, 21, 22, 23, 24, 37, 38, 40 and 42.

FACTUAL BACKGROUND

The Complainant is a French multinational corporation specialized in the production, processing and distribution of construction materials.

With a turnover of around 51.2 billion Euro in 2022 and 168,000 employees, the Complainant is a worldwide reference in sustainable habitat and construction markets.

The Complainant is the owner, amongst others, of the domain name <saint-gobain.com>, registered on December 29, 1995, and used by the Complainant to promote its products and services under the trademark SAINT-GOBAIN.

The disputed domain name <saint-gobainco.com> was registered on October 16, 2023, and currently resolves to an inactive website. According to the screenshots submitted as annexes to the Complaint, the disputed domain name previously resolved to a registrar parking page and had MX records configured.

PARTIES CONTENTIONS

COMPLAINANT

The Complainant contends that the disputed domain name <saint-gobainco.com> is confusingly similar to the trademark SAINT-GOBAIN in which the Complainant has rights as it reproduces the trademark in its entirety with the mere addition of the descriptive term “co” (abbreviation for “company”) and the generic Top Level Domain (gTLD) “.com”.

The Complainant submits that the Respondent has no rights or legitimate interests in the disputed domain name since: i) the Respondent is not a licensee of the Complainant and has in no way been authorized or allowed by the Complainant to use the trademark SAINT-GOBAIN; ii) the Respondent is in no way related to the Complainant, nor does he carry out any activity or have any business with the Complainant; iii) the Respondent is not commonly known by the disputed domain name; iv) the Respondent does not use, and has not used, the disputed domain name in connection with a *bona fide* offering of goods or services, as the Respondent has not actively used the disputed domain name; v) the Respondent cannot assert to have made a legitimate non-commercial or fair use of the disputed domain name since the disputed domain name falsely suggests an affiliation with the Complainant and, given the distinctiveness and notoriety of the Complainant’s trademark, there cannot be any actual or contemplated good faith use of the disputed domain name as this would result in misleading diversion and taking unfair advantage of the Complainant’s rights.

The Complainant claims that the Respondent registered the disputed domain name in bad faith because: i) the trademark SAINT-GOBAIN is a coined term specifically used in relation to the Complainant’s products services since 1665; ii) that the disputed domain name is confusingly similar to the Complainant’s well-known trademark; iii) the Complainant was already extensively using his trademark SAINT-GOBAIN worldwide well before the date of registration of the disputed domain name; iv) the disputed domain name resolves to an inactive web page, which makes it impossible 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 and v) the disputed domain name has been set up with MX records which suggests that it may be used for email purposes and is further indication of bad faith registration and use, since an email address based on the disputed domain name could not be used for any good faith purpose.

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

1. The Complainant has provided evidence of ownership of trademark registrations for SAINT-GOBAIN.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark SAINT-GOBAIN as it reproduces the trademark in its entirety with the mere addition of the two-letter term "co", which can be interpreted as an abbreviation for "company", and the gTLD ".com" which, as established in a number of prior UDRP cases, is viewed as a standard registration requirement and as such can be disregarded for the purpose of assessing identity or confusing similarity under paragraph 4(a)(i) of the Policy.

2. With reference to the Respondent's rights or legitimate interests in the disputed domain name, the Panel finds that the Complainant has made a *prima facie* case and that the Respondent, by not submitting a Response, has failed to provide any element from which a Respondent's right or legitimate interest in the disputed domain name could be inferred.

The Panel notes that, based on the records, the Complainant has not authorized the Respondent to register and use its trademark SAINT-GOBAIN. Moreover, there is no evidence that the Respondent might be commonly known by the disputed domain name or a name corresponding to the disputed domain name.

As highlighted above, the disputed domain name, confusingly similar to the Complainant's trademark, was previously pointed to a registrar parking page and currently does not resolve to any active website. The Panel finds that the Respondent's passive holding of the disputed domain name does not amount to a *bona fide* offering of goods or services or a legitimate non-commercial or fair use of the disputed domain name without intention to misleadingly divert consumers or to tarnish the Complainant's trademark.

Moreover, considering the Complainant's trademark SAINT-GOBAIN is well-known and is used to identify the goods and services of the Complainant's multinational corporation, the disputed domain name, which clearly incorporates the Complainant's trademark, is inherently misleading as it suggests an affiliation with the Complainant that does not exist.

3. As to bad faith at the time of the registration, the Panel finds that, in light of the Complainant's prior registration and use of the trademark SAINT-GOBAIN and considering the well-known character of the trademark, the Respondent must have been aware of the Complainant's trademark when it registered the disputed domain name in October 2023.

As indicated above, the disputed domain name has not been pointed to an active website. As established in a number of prior cases, the concept of "bad faith use" in paragraph 4(b) of the Policy includes not only positive action but also passive holding. In the present case, considering the well-known character of the Complainant's trademark, the Respondent's failure to file a Response and the implausibility of any good faith use to which the disputed domain name may be put, the Panel finds that the current passive holding of the disputed domain name does not prevent a filing of bad faith use.

Moreover, the fact that MX records were also configured for the disputed domain name suggests that the Respondent may have used, or intends to use, the disputed domain name for email communication purposes. Considering that the recipients of possible email communications coming from addresses based on the disputed domain name would be very likely misled as to the source or approval of such communications, the Panel finds that this circumstance further demonstrates the Respondent's bad faith.

Therefore, the Panel finds that the Respondent registered and is using the disputed domain name 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-gobainco.com**: Transferred

PANELLISTS

Name	Luca Barbero
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DATE OF PANEL DECISION	2023-11-28
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