

Decision for dispute CAC-UDRP-105959

Case number CAC-UDRP-105959

Time of filing 2023-11-13 09:37:43

Domain names salnt-gobain.com

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 Dorothy Kiely

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 proprietor of the following word and figurative trademark registrations consisting of or containing the word element "SAINT-GOBAIN" alone or in a combination with the figurative element of a bridge, namely

- International figurative trademark SAINT-GOBAIN No. 740184 registered on July 26, 2000, in several classes designating inter alia China, Turkey, Ukraine, Vietnam and the Russian Federation;
- International word trademark SAINT-GOBAIN No. 740183 registered on July 26, 2000 in several classes designating inter alia China, Turkey, Ukraine, Vietnam, Russian Federation, USA and Switzerland;
- International figurative trademark SAINT-GOBAIN No. 596735 registered on November 2, 1992 in several classes designating China;
- International figurative trademark SAINT-GOBAIN No. 551682 registered on July 21, 1989 in multiple classes designating inter alia Austria, Italy and Spain (collectively referred to as "SAINT-GOBAIN trademarks").

FACTUAL BACKGROUND

The complainant is a French company specialising in the production, processing and distribution of building materials.

The complainant is the owner of the domain name <saint-gobain.com>, registered since 29 December 1995.

The designation "SAINT-GOBAIN" is part of the Complainant's company name.

The disputed domain name <salnt-gobain.com> was registered on 11 January 2023 and resolves to an inactive page. Mail Exchange ("MX") servers are configured and activated for the disputed domain name.

PARTIES CONTENTIONS

1. Complainant

The Complainant argues that the disputed domain name is confusingly similar to its SAINT-GOBAIN trademarks, pointing out that the substitution of the letter "l" for the letter "L" in the disputed domain name is the obvious misspelling of the Complainant's SAINT-GOBAIN trademarks. The Complainant submits that this is characteristic of a typosquatting practice aimed at creating a confusing similarity between the Complainant's trademark and the disputed domain name.

The Complainant further submits that the Respondent has no rights or legitimate interests in the disputed domain name.

In particular, the Complainant notes that the Respondent is not related to the Complainant in any way and does not carry out any activity for the Respondent or have any business relationship with the Respondent. The Complainant asserts that the Respondent has not been granted any licence or authorisation to use the Complainant's trademark SAINT-GOBAIN or to apply for registration of the disputed domain name by the Complainant.

The Complainant alleges that the disputed domain name is a typosquatted version of the trademark SAINT-GOBAIN and that the disputed domain name points to an inactive page. The Complainant claims that the Respondent has not used the disputed domain name and confirms that the Respondent has no demonstrable intention to use the disputed domain name.

The Complainant alleges that the Respondent has registered and is using the disputed domain name in bad faith.

With respect to the bad faith registration, the Complainant alleges, inter alia, that (i) the disputed domain name is a recent creation, whereas the Complainant has been using its SAINT-GOBAIN trademark extensively throughout the world long before the disputed domain name was registered, and (ii) the Complainant's SAINT-GOBAIN trademark is well known throughout the world and the Complainant has a long-established website operating worldwide under its domain name <saint-gobain.com>, (iii) the disputed domain name is a misspelling of the trademark SAINT-GOBAIN and is intentionally designed to be confusingly similar to the Complainant's trademark.

On the basis of the foregoing, it is reasonable to conclude that the Respondent registered the domain name with full knowledge of the Complainant's trademark.

With respect to bad faith use, the Complainant contends that the Respondent has not demonstrated any activity with respect to the disputed domain name and that 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 unlawful, such as passing off, violation of consumer protection laws, or infringement of the Complainant's trademark rights.

The Complainant further alleges that the inclusion of a famous mark in a domain name, coupled with an inactive website, may be evidence of bad faith registration and use. Furthermore, the configuration of the MX servers suggests that the disputed domain name may be actively used for e-mail purposes.

2. Respondent

No administratively compliant response has been submitted by the Respondent. Ms. Dorothy Kiely, Managing Director of Avery Retail Ireland in response to written notice on the Commencement of Administrative Proceedings under the UDRP sent email dated November 21, 2023 to the Czech Arbitration Court stating that the disputed domain name has nothing to do with Avery Retail Ireland.

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).

The Complainant has demonstrated that it is the rightful owner of several word and figurative marks which include the word "SAINT-GOBAIN" as their dominant and distinctive element and which enjoy legal protection in several countries around the world. The Panel acknowledges that the disputed domain name <salnt-gobain.com> consists of an obvious misspelling of the Complainant's trademark. The substitution of the similar characters "l" for "L" is not sufficient to avoid a likelihood of confusion with the Complainant's trademark SAINT-GOBAIN (see also Article 1.9 of the WIPO Jurisprudential Overview 3.0).

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).

A complainant is required to establish a prima facie case that the respondent lacks rights or legitimate interests. Once such a case is made, the burden of proof shifts to the respondent to demonstrate their rights or legitimate interests in the disputed domain name. Failure to do so results in the complainant satisfying paragraph 4(a)(ii) of the Policy (as per Article 2.1 of WIPO Jurisprudential Overview 3.0 and WIPO Case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

Based on the contentions of the Complainant, the panel finds that the Complainant has successfully established a prima facie case that the Respondent lacks rights or legitimate interests. As the Respondent has failed to provide relevant evidence demonstrating any such rights or legitimate interests, the Complainant is deemed to have satisfied the second element.

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).

Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark (see Article 3.1. of the WIPO Jurisprudential Overview 3.0).

Registration in bad faith

In determining that the disputed domain name was registered in bad faith, the Panel considered, in particular, the following factors

(a) the longstanding registration of the Complainant's SAINT-GOBAIN trademarks, which the Complainant demonstrated to date back to 1989, and the Complainant's longstanding presence on the market, whereas the disputed domain name was registered only in January 2023; and

(b) the use of obvious misspellings of the Complainant's SAINT-GOBAIN trademarks in the disputed domain name, which the Panel found to be intentional.

On the basis of the foregoing, the Panel concludes that the Respondent must have been aware of the Complainant and its SAINT-GOBAIN trademarks when it registered the disputed domain name.

Therefore, the Panel finds that the Respondent registered the disputed domain name in bad faith.

Bad faith use

Although there are currently no active web pages associated with the disputed domain name, this does not preclude a finding of bad faith use where, as here, (i) the complainant's mark is distinctive, (ii) the respondent failed to respond to the complaint, (iii) the respondent provided false contact information when registering the disputed domain name, and (iv) there is no plausible bona fide use to which the disputed domain name, consisting of the obvious misspelling of the complainant's marks, could be put. (See also Article 3.3 of the WIPO Jurisprudence Overview 3.0).

In the circumstances of this case, the Panel finds that the Complainant's trademark SAINT-GOBAIN, which is also the distinctive and dominant element of the Complainant's company name, has a high degree of inherent distinctiveness. Furthermore, the Panel notes that the Respondent has not provided any response or evidence of actual or intended use in good faith. On the contrary, based on the response received by the Czech Arbitration Court ("CAC") from Avery Retail Ireland on 21 November 2002 that the disputed domain name has nothing to do with Avery Retail Ireland, it appears that the Respondent's contact information may be false. In addition, Mail Exchange ("MX") records have been activated for the disputed domain name, allowing e-mail to be sent and received using the disputed domain name. An MX record is a resource record in the domain name System that specifies which e-mail server is responsible for accepting e-mail on behalf of a domain name. It is not necessary to assign MX records to a domain name if the registrant does not intend to use the domain name to send and receive e-mail. Activating the MX records to designate an e-mail server and enable email is an action that goes beyond the mere registration of the disputed domain name and may constitute bad faith use (see, for example, WIPO Panel decision CKM Holdings Inc. v. Grant Chonko, Genesis Biosciences Case No. D2022-0479).

Therefore, the Panel is satisfied that the totality of the circumstances of this case supports a finding that the Respondent's use of the domain name is in bad faith.

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

The Panel has determined that the disputed domain name is confusingly similar to the Complainant's trademarks.

Based on the contentions presented by the Complainant, the Panel has found that the Complainant has satisfactorily made a prima facie case that the Respondent lacks rights or legitimate interests. As the Respondent has failed to provide relevant evidence demonstrating any such rights or legitimate interests, the Complainant is deemed to have satisfied the second element.

The Panel finds that, based on the Complainant's contentions and evidence, it can be concluded that the Respondent must have been aware of the Complainant's trademarks when it registered the disputed domain name, and as such, the Respondent has registered the disputed domain name in bad faith.

Lastly, the Panel has concluded that the Complainant has successfully proven that the disputed domain name is being used in bad faith.

Therefore, for the aforementioned reasons, the Panel orders that the disputed domain name <salnt-gobain.com> be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. salnt-gobain.com: Transferred
-

PANELLISTS

| Name | Karel Šindelka |
|------|----------------|
|------|----------------|

DATE OF PANEL DECISION 2023-12-18

Publish the Decision
