

Decision for dispute CAC-UDRP-106008

Case number	CAC-UDRP-106008
Time of filing	2023-11-28 14:11:31
Domain names	contratistas-saintgobain.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

Name	Demian Cleiman
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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 is the owner of several trademarks SAINT-GOBAIN, registered worldwide, such as:

- European trademark word: SAINT-GOBAIN n°001552843 registered on March 9 , 2000 and duly renewed;
- Moreover, the Complainant owns multiple domain names consisting in the wording SAINT-GOBAIN, such as the domain name <saint-gobain.com> registered on December 29, 1995.

The disputed domain name <contratistas-saintgobain.com> was registered on November 30 , 2022.

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 reference in sustainable habitat and construction markets. It takes a longterm view in order to develop products and services for its customers that facilitate sustainable construction. In this way, it designs innovative, high-performance solutions that improve habitat and everyday life. It is now one of the top industrial groups in the world with around 51.2 billion euros in turnover in 2022 and 168,000 employees.

The Complainant's trademark Saint-Gobain is distinctive and well-known and in several countries active, especially in France and in the Netherlands.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name and he is not related in any way with the Complainant.

The disputed domain name resolves to a login page displaying the Complainant's trademark and logo.

The Respondent is based in the Netherlands where he registered the disputed domain name.

The Respondent didn't deny Complainants presentation.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.

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

The UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (UDRP) of the Internet Corporation for Assigned Names and Numbers (ICANN) (the "Policy") provides that complainant must prove each of the following to obtain transfer or cancellation of the domain name:

1. that respondent's domain name is identical or confusingly similar to a trademark in which complainant has rights; and
2. that respondent has no rights or legitimate interests in respect of the domain name; and
3. the domain name has been registered and is being used in bad faith.

The Panel finds that the Respondent registered a disputed domain name which is almost identical to the famous Complainant's trademarks. This is especially true where, as here, the distinctive trademark SAINT-GOBAIN is "the dominant portion of the domain name," CAC UDRP 103970 - BOEHRINGERINGELHEIMONLINE.COM, Case LEGO Juris A/S v. Domain Tech Enterprises, WIPO Case No. D2011-2286, or where the trademark in the domain name represents "the most prominent part of the disputed domain name [] which will attract consumers' attention." Kabushiki Kaisha Toshiba dba Toshiba Corporation v. WUFACAI, WIPO Case No. D2006-0768. See also CAC Case 101202 - US-BOEHRINGER-INGELHEIM.COM. Therefore the generic word part "Contratistas" of the disputed domain name, translated into English "Contractors" is not distinctive. The TLD .com and the missing "-" between "Saint" and "Gobain" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and its domain names associated.

Please see WIPO Case No. D2006-0451, F. Hoffmann-LaRoche AG v. Macalve e-dominios S.A.

Secondly, the Respondent lacks rights or legitimate interests in the disputed domain name (Para. 4(a)(ii) of the Policy).

Under the Policy, a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy (see WIPO Overview 2.0, paragraph 2.1). According to the Complainant, the Respondent has no rights to the disputed domain name, and any use of the trademark SAINT-GOBAIN has to be authorized by the Complainant. The Respondent has not been authorized or licensed by the Complainant to use the disputed domain name. There is, concerning the disputed domain name given evidence with annex to the complaint, no legitimate interest shown by the Respondent. The Panel thus takes the view that the Respondent lacks rights or legitimate interests in the disputed domain name.

Thirdly, the disputed domain name has been registered and is being used in bad faith (Paragraph 4(a)(iii) of the Policy).

The Panel agrees with the Complainant that its trademark SAINT-GOBAIN is distinctive and well known and finds that the disputed domain name is confusingly similar to the Complainant's well-known trademark. It is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark. The Complainant's use and registration of the trademark largely precede the registration date of the disputed domain name. The fact that the Respondent registered the disputed domain name adding as prefix a descriptive term "contratistas" clearly indicates that the Respondent had knowledge of the Complainant's trademark at the time of registration of the disputed domain name. It is reasonable to conclude that this is evidence of registration of the domain name in bad faith.

The fact that a complainant's trademark has a strong reputation and is widely used and the absence of evidence whatsoever of any actual or contemplated good faith use are further circumstances that may evidence bad faith registration and use in the event of passive use of domain names (see section 3.3, WIPO Overview 3.0).

In addition, the Policy defines that one of the actions which constitute bad faith pursuant to paragraph 4(b)(iv) of the Policy is the use of the domain name to intentionally attempt to attract, for commercial gain, Internet users to a website, by creating a likelihood of confusion with the complainant's trademark as to the source, sponsorship, affiliation, or endorsement of respondent's website or location or of a product or service on respondent's website or location.

The Panel believes it is likely that this was at least one of the reasons behind the Respondent's registration and use of the disputed domain name. Accordingly, the Panel finds that the Respondent has engaged in an evident squatting activity to cause confusion with the Complainant's trademark for their own commercial gain, and therefore the disputed domain name was registered and is being used in bad faith within the meaning of Paragraph 4(a)(iii) of the Policy.

For all reasons stated above, the Panel is satisfied that the Complainant has proven the third element of the Policy that is that the Respondent's registration and use of the disputed domain name in bad faith.

Pursuant to Rule 15 of the UDRP Rules, the Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the UDRP Policy, the UDRP Rules, and any rules and principles of law that the Panel deems applicable.

For the foregoing reasons, and noting that the Respondent has not provided a Response to refute any of the allegations and evidence produced by the Complainant in these proceedings, the Panel finds that the Complainant has made a prima facie showing of the Respondent's lack of rights or legitimate interests.

At the same time the Complainant has made a prima facie showing that the Respondent has 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. **contratistas-saintgobain.com**: Transferred

PANELLISTS

Name Harald von Herget

DATE OF PANEL DECISION 2024-01-03

Publish the Decision