Decision for dispute CAC-UDRP-106037

Case number	CAC-UDRP-106037
Time of filing	2023-12-05 09:26:11
Domain names	sainl-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

Organization	mk electric man

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

In these proceedings, the Complainant relies on the following trademarks:

- SAINT-GOBAIN (device), International Registration No. 551682, filed on July 21, 1989, in the name of COMPAGNIE DE SAINT-GOBAIN (the Complainant), duly renewed;

- SAINT-GOBAIN (device), International Registration No. 596735, filed on November 2, 1992, in the name of COMPAGNIE DE SAINT-GOBAIN (the Complainant), duly renewed;

- SAINT-GOBAIN (word), International Registration No. 740183, filed on July 26, 2000, in the name of COMPAGNIE DE SAINT-GOBAIN (the Complainant), duly renewed; and

- SAINT-GOBAIN (device), International Registration No. 740184, filed on July 26, 2000, in the name of COMPAGNIE DE SAINT-GOBAIN (the Complainant), duly renewed.

It is worth noting that, the Complainant owns many other trademarks in various countries (including the U.S.A., where the Respondent is apparently located), which have not been cited in these proceedings.

Further, the Complainant emphasizes that SAINT-GOBAIN is also commonly used to designate its company name.

FACTUAL BACKGROUND

The Complainant is a French international group of companies, originally founded in 1665, known and active in designing, manufacturing and distributing materials and services for the construction and industrial markets. Ever since, the Complainant has become a very large enterprise with activities all around the world and thousands of employees.

The Complainant owns a large-sized portfolio of trademarks including the wording "SAINT-GOBAIN", among which various registrations dating back to the 1980s. It also owns a multitude of related domain names, like <saint-gobain.com> since December 29, 1995.

The disputed domain name <SAINL-GOBAIN.COM> was registered on November 21, 2023 by the Respondent, as confirmed by the Registrar.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant contends that the disputed domain name is confusingly similar to its SAINT-GOBAIN trademark, as it is a misspelling of this wholly incorporated trademark. This last element is sufficient to support the finding that the disputed domain name is confusingly similar to the Complainant's trademark. Indeed, the mere misspelling of the Complainant's trademark does not change the overall impression of a most likely connection with the trademark SAINT-GOBAIN of the Complainant. As to the gTLD ".com", the Complainant suggests that it should be disregarded, as per the usual practice.

The Complainant maintains that the Respondent lacks rights or legitimate interests in the disputed domain name because the Complainant is not affiliated with nor has it ever authorised the Respondent to register its trademark as a domain name, the Complainant has never licensed its trademark to the Respondent, and because the disputed domain name does not resolve to an active website since its registration.

According to the Complainant, given the distinctiveness and reputation of the SAINT-GOBAIN trademark, the Respondent registered the disputed domain name with full knowledge of the Complainant's trademark in an intentionally designed way with the aim to create a likelihood of confusion with the Complainant's trademarks and domain names, and this is evidence of the fact that the disputed domain name was registered in bad faith.

With respect to use in bad faith, the Complainant points out that the Respondent has not used the domain name at all, which is considered as a clear indication of bad faith. It is, indeed, impossible to conceive any actual or contemplated use that would not be illegitimate. Further, MX servers are configured, which suggests use of e-mails in bad faith.

For all these reasons, the Complainant concludes that the Respondent registered and used the disputed domain name in bad faith.

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).

The disputed domain name consists of the Complainant's whole trademark (SAINT-GOBAIN), written in a misspelled way. The mere exchange of the letter "T" with the letter "L" in the disputed domain name is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark of the Complainant. This is a clear case of typosquatting.

As far as the gTLD ".com" is concerned, it is generally recognized that top level domains do not have any bearing in the assessment of identity or confusing similarity, according to paragraph 4(a)(i) of the Policy.

Hence, the Panel is satisfied that the first requirement under the Policy is met.

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).

Since proving a negative fact is almost impossible, panelists in UDRP proceedings have generally agreed that it is sufficient for the Complainant to establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name to shift the burden of proof to the Respondent.

In the case at issue, the Complainant argued that it had never authorised the Respondent to register the SAINT-GOBAIN trademark in a domain name, and that it had never licensed its trademark to the Respondent.

Furthermore, the disputed domain name resolves to an inactive website with the message “Launching Soon” and therefore the Respondent cannot demonstrate any use of the disputed domain name in connection with a bona fide offering of goods and services or a legitimate non-commercial or fair use of the disputed domain name.

Finally, there is no other evidence in the case file that could demonstrate that the Respondent has been commonly known by the disputed domain name.

In view of the foregoing, the Panel is satisfied that the Complainant has established a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name. In order to rebut the Complainant's arguments, the Respondent had the possibility to make his own defense. However, the Respondent has chosen not to file a Response.

Therefore, the Panel is satisfied that also the second requirement under the Policy is met.

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).

As far as registration in bad faith is concerned, given the reputation of the Complainant's trademark and the fact that the disputed domain name fully incorporates this trademark (even in a misspelled way), it is quite evident that, at the time of the registration of the disputed domain name, the Respondent was well aware of the Complainant's trademark. The registration as domain name of a third party's well-known trademark with full knowledge of the fact that the rights over this trademark belong to a third-party amounts to registration in bad faith.

With respect to use in bad faith, the disputed domain name resolves to an inactive website with the message “Launching Soon”. Such non-use of a domain name can show bad faith under some circumstances, such as when the complainant’s trademark has such a strong reputation that it is widely known, and when it is impossible to conceive any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate. This fact is to be combined with the full incorporation of the Complainant’s reputable trademark in the disputed domain name. These are exactly the circumstances that apply in the case at issue. The trademark SAINT-GOBAIN enjoys wide and extensive reputation. Therefore, it is impossible to conceive any plausible active use of the disputed domain name that would be legitimate. This conclusion is further reinforced by the fraudulent creation of MX servers by the Respondent.

Therefore, the Panel finds it clear that the disputed domain name was used in bad faith.

For all circumstances mentioned above, the Panel is satisfied that also the third requirement under the Policy is satisfied.

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 disputed domain name incorporates the Complainant's trademark, written in a misspelled way. The disputed domain name is therefore confusingly similar to the Complainant's trademark.

The Respondent was not authorised to include the Complainant's trademark in the disputed domain name, and the Complainant never licensed its trademarks to the Respondent. The Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services, or a legitimate non-commercial or fair use.

The Respondent registered the disputed domain name with full knowledge of the Complainant's well-known trademark. His use of

the disputed domain name as a parking website with commercial links is in bad faith, as there is no conceivable use of the disputed domain name that could amount to a legitimate use.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **sainl-gobain.com**: Transferred

PANELLISTS

Name	**Sozos-Christos Theodoulou**

DATE OF PANEL DECISION 2024-01-12

Publish the Decision