Decision for dispute CAC-UDRP-106093

Case number	CAC-UDRP-106093
Time of filing	2023-12-21 09:17:10
Domain names	saint-gobain-autover.shop

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	Milen Radumilo

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 a registered owner of following trademarks containing a word element "SAINT-GOBAIN":

1. SAINT-GOBAIN (word), EU trademark, filing date 9 March 2000, registration date 18 December 2001, trademark no. 001552843, registered for goods and services in the international classes 1, 2, 3, 6, 7, 8, 9, 10, 11, 12, 17, 19, 20, 21, 22, 23, 24, 37, 38, 40, and 42;
2. SAINT-GOBAIN (word), International (WIPO) trademark, registration date 26 July 2000, trademark registration no. 740183, registered for goods and services in the international classes 1, 2, 3, 6, 7, 8, 9, 10, 11, 12, 17, 19, 20, 21, 22, 23, 24, 37, 38, 40, and 42;

besides other international trademarks consisting of the "SAINT-GOBAIN" denomination (collectively referred to as "**Complainant's Trademarks**").

The SAINT-GOBAIN phrase is also commonly used to designate the company name of the Complainant and its affiliates.

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. For 350 years, the Complainant has consistently demonstrated its ability to invent products that improve quality of 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 disputed domain name was registered on 6 September 2021 and is held by the Respondent.

The domain name website (i.e. website available under internet address containing the disputed domain name) includes random, likely automatically generated, links to third party websites not in any way related to the Complainant.

The Complainant seeks transfer of the disputed domain name to the Complainant.

PARTIES CONTENTIONS

COMPLAINANT:

- CONFUSING SIMILARITY

The Complainant states that:

1. The disputed domain name is confusingly similar to Complainant's Trademarks as they both incorporate the “SAINT-GOBAIN” word element of the Complainant’s trademarks in its entirety.
2. The addition of the term "AUTOVER” is not sufficient to escape the finding that the disputed domain name is confusingly similar to Complainant's trademarks, as it does not change the overall impression of the designation as being connected to the Complainant’s trademark SAINT-GOBAIN
3. On the contrary, use of “AUTOVER”it worsens the likelihood of confusion with the Complainant, as it directly refers to its subsidiary SAINT-GOBAIN AUTOVER and its trademark AUTOVER.

The Complainant refers to previous domain names decisions in this regard.

Thus, according to the Complainant the confusing similarity between Complainant’s trademarks and the disputed domain name is clearly established.

- NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant states that:

1. The Respondent has not been commonly known by the disputed domain name.
2. The Complainant has not authorized, permitted or licensed the Respondent to use Complainant’s trademarks in any manner. The Respondent has no connection or affiliation with the Complainant. whatsoever. On this record, Respondent has not been commonly known by the disputed domain name.
3. Furthermore, the disputed domain name resolves to a parking page with commercial links. Such use is not a bona fide offering of goods or services or legitimate non-commercial or fair use.

The Complainant refers to previous domain names decisions in this regard.

- BAD FAITH REGISTRATION AND USE

The Complainant states that:

1. Seniority of the Complainant's Trademarks predates the registration of the disputed domain name.
2. Furthermore, the Complainant's Trademarks are well-known and have received widespread recognition. Therefore, the Respondent must have been aware of such trademarks and their reputation. This clearly indicates bad faith registration of disputed domain name by the Respondent.
3. Moreover, the addition of the term “AUTOVER” to the SAINT-GOBAIN denomination cannot be coincidental, as it directly refers to the Complainant’s subsidiary SAINT-GOBAIN AUTOVER and its trademark AUTOVER.
4. The disputed domain name website resolves to a parking page with commercial links. The Complainant contends the

Respondent has attempt to attract Internet users for commercial gain to his own website thanks to the Complainant's trademarks for its own commercial gain, which is an evidence of bad faith.

5. Finally, the Respondent, Milen Radumilo, has been involved in numerous UDRP proceedings, as the registrant of the domain names comprising third party trademarks. This indicates that the Respondent has been regularly involved in cybersquatting activities.

The Complainant refers to previous domain names decisions in this regard.

RESPONDENT:

The Respondent has not provided any response to the Complaint.

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

RIGHTS

Since the disputed domain name and the Complainants' trademarks are not identical, the key element investigated and considered by the Panel is whether the disputed domain name is confusingly similar to the Complainants' trademarks.

The threshold test for confusing similarity under the UDRP involves a comparison between the trademark and the disputed domain name itself to determine likelihood of Internet user´s confusion. In order to satisfy this test, the relevant trademark would generally need to be recognizable as such within the disputed domain name. An addition of common, dictionary, generic, or other descriptive terms is typically insufficient to prevent threshold Internet user confusion. Confusing similarity test under the UDRP typically involves a straightforward visual and aural comparison of the trademark with the domain name in question.

Applying the principles described above, the Panel contends that incorporation of the "SAINT-GOBAIN" element of Complainant's trademarks (which standalone enjoys high level of distinctiveness) into the disputed domain name constitutes confusing similarity between Complainant's trademark and the disputed domain name.

The addition of the term "AUTOVER" is not sufficient to escape the finding that the disputed domain name is confusingly similar to Complainant's trademarks, as it does not change the overall impression of the designation as being connected to the Complainant. Moreover, the AUTOVER denomination forms a trademark registered for Complainant's subsidiary SAINT-GOBAIN AUTOVER and thus such use within the dispute domain name reinforces the risk of confusion with the Complainant, its affiliates and their business.

For sake of completeness, the Panel asserts that the top-level suffix in the disputed domain name (i.e. the ".shop") must be

disregarded under the identity and confusing similarity tests as it is a necessary technical requirement of registration.

Therefore, the Panel has decided that there is confusing similarity in this case, it also concludes that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainants' assertions that the Respondent is not commonly known by the disputed domain name and is not affiliated with nor authorised by the Complainant are sufficient to constitute prima facie showing of absence of rights or legitimate interest in the disputed domain name on the part of the Respondent.

Consequently, the evidentiary burden shifts to the Respondent to show by concrete evidence that it does have rights or legitimate interests in that name. However, the Respondent failed to provide any information and evidence that it has relevant rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a) (ii) of Policy).

Use of the disputed domain name for purposes of providing links to third party content, which seems to be automatically generated, does not constitute any rights to the disputed domain name or legitimate interest in it.

BAD FAITH

The Panel finds it grounded that the Respondent registered and used the disputed domain name in bad faith.

The Complainant's Trademarks are well-known and have received widespread recognition and predates registration of the disputed domain name. In addition, the Respondent has incorporated into the disputed domain name the term “AUTOVER” which correspondents to a registered trademark of Complainant’s subsidiary SAINT-GOBAIN AUTOVER. This also indicates that the Respondent must have been aware of Complainant and its business.

Therefore, the Respondent must have been aware of Complainant’s trademarks and their reputation. This clearly indicates bad faith registration of disputed domain name by the Respondent.

As described above, the Complainant has proven that the Respondent has used (at least for some time) the disputed domain name for promotion and offering goods and services (i) likely with intention to free-ride on reputation and goodwill of Complainant's trademarks and business and, even more importantly, (ii) in a manner that was detrimental both to the customers as well the Complainant and its business.

Such unfair use of the disputed domain name for promotion of Respondent’s website cannot be considered as use thereof in good faith and in compliance with fair business practices.

Thus, also having in mind the proven history of the Respondent as a cybersquatter, the Panel has taken a view that 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).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **saint-gobain-autover.shop**: Transferred

PANELLISTS

Name	**Jiří Čermák**

DATE OF PANEL DECISION 2024-01-17

Publish the Decision