Decision for dispute CAC-UDRP-106245

Case number	CAC-UDRP-106245
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Domain names	saint-gcbain.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	COMPAGNIE DE SAINT-GOBAIN

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Organization	sterling homes vt

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

EU TM Registration No. 001552843 SAINT-GOBAIN for numerous goods and services in classes 1, 2, 3, 6, 7, 8, 9, 10, 11, 12, 17, 19, 20, 21, 22, 23, 24, 37, 38, 40 and 42 registered from 9 March 2000.

FACTUAL BACKGROUND

The Complainant is a French company specialising in the production, processing and distribution of materials. It claims to be one of the world's top industrial businesses with around 51.2 billion euros in turnover in 2022. It employs approximately 168,000 employees.

The Complainant owns several trademarks containing or consisting of the words SAINT-GOBAIN in numerous jurisdictions, including the European Union trademark registration referred to above.

The Complainant also owns a number of domain names that include the words SAINT-GOBAIN, including <saint-gobain.com> which was registered on 29 December 1995.

The disputed domain name <saint-gcbain.com> was registered on 5 February 2024. It redirects web users to a parking page. Further, MX servers have been configured for the disputed domain name.

The Respondent registered the disputed domain name using a privacy service. On 12 February 2024 the Registrar of the disputed domain name confirmed the registrant´s name recorded for the disputed domain name was "Elizabeth Simak" with an address in the United States of America.

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

Paragraph (4)(a) of the Policy lists three elements that the Complainant must prove to merit a finding that the disputed domain name registered by the Respondent be transferred to the Complainant:

1) the disputed domain name is identical or confusingly similar to a trademark or service mark ("mark") in which the Complainant has rights; and
2) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
3) the disputed domain name has been registered and is being used in bad faith.

The Panel is satisfied that the Complainant has satisfied all three elements for the principal reasons set out below.

RIGHTS IN AN IDENTICAL OR CONFUSINGLY SIMILAR TRADEMARK

As mentioned above the Complainant asserts it has trademark registrations consisting of the words “SAINT-GOBAIN”. At least one of these registrations predates the registration date of the disputed domain name by over two decades.

To satisfy paragraph 4(a)(i) of the Policy it is enough that the Panel is satisfied that the Complainant has registered rights in a trademark that predates the registration of the disputed domain name in a single jurisdiction (even if that single jurisdiction is not one in which the Respondent resides or operates) (Koninklijke KPN N.V. v. Telepathy, Inc D2001-0217 (WIPO 7 May 2001); see also WIPO Case Nos. D2012-0141 and D2011-1436). The Complainant has clearly satisfied such in relation to the trademark “SAINT-GOBAIN”.

The next question is whether the disputed domain name is confusingly similar to the “SAINT-GOBAIN” trademark.

The Panel disregards the gTLD suffix ".com" for the purpose of this comparison. It is of no brand significance and it is likely to be

totally ignored by web users. Such web users are likely to focus entirely on the only distinctive element in the disputed domain name, being the SAINT-GCBAIN element.

This SAINT-GCBAIN element is strikingly similar to the “SAINT-GOBAIN” trademark. When one visually observes SAINT-GCBAIN the position of a "C" next to a "B" has the effect that, regardless of whether uppercase or lower case letters are used, there is a visual resemblance to a letter "O". This is due to the fact that the open-ended right-hand portion of the "C" appears to be significantly filled by the right-hand vertical line portion of the "B". Visual consumer confusion is highly likely to occur.

The disputed domain name is therefore confusingly similar to the “SAINT-GOBAIN” trademark.

NO RIGHTS OR LEGITIMATE INTERESTS

The Respondent's name is "Elizabeth Simak". This name bears no resemblance to "SAINT-GCBAIN". Further, redirecting web users to a parking page does not indicate any right or legitimate interest in the disputed domain name on the part of the Respondent.

The Respondent has no rights or interests in the disputed domain name.

BAD FAITH

As can be observed from the above facts, SAINT-GOBAIN is a well-known trade mark. It is entirely unforeseeable that a reasonable person residing in United States of America could register the strikingly similar disputed domain name without knowledge of the Complainant's rights. To the contrary, it is put beyond doubt that the Respondent knew of such rights by the fact they chose to register a misspelling of "SAINT-GOBAIN" that is visually deceptive to the eye of consumers in the manner described above. That Panel finds it is highly unlikely that the adoption of a visually deceptive effect in substituting an "O" for a "C" prior to the appearance of a "B" was done innocently. The Respondent had an intention for the disputed domain name to appear like "SAINT-GOBAIN".

The Panel is further concerned by the configuration of MX servers, showing an intention to use the disputed domain name for the purposes of email. The Panel finds that there is no explanation for the Respondent's conduct that is consistent with it acting in good faith. Given the Respondent's knowledge of the Complainant's rights at the time of registering the disputed domain name, and the subsequent configuration of MX servers, the purpose of registering and using this domain name was to opportunistically profit from confusing similarity. Such opportunism could occur, for example, through using the dispute domain name for phishing emails in circumstances where the recipient of such emails could be misled by the fact the disputed domain name is so strikingly similar in appearance to "SAINT-GOBAIN".

Therefore, in consideration of all the circumstances the disputed domain name has been registered and is being used 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-gcbain.com**: Transferred

PANELLISTS

Name	**Andrew Sykes**

DATE OF PANEL DECISION 2024-03-13

Publish the Decision