Decision for dispute CAC-UDRP-106282

Case number	CAC-UDRP-106282
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Domain names	proveedoressaint-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	Above.com Domain Privacy

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 the following trademark registrations:

- EU “SAINT-GOBAIN” word trademark No. 001552843, registered on December 18, 2001;
- International “SAINT-GOBAIN” figurative trademark No. 740184, registered on July 26, 2000;
- International “SAINT-GOBAIN” figurative trademark No. 740183, registered on July 26, 2000;
- International “SAINT-GOBAIN” figurative trademark No. 596735, registered on November 2, 1992;
- International “SAINT-GOBAIN” figurative trademark No. 551682, registered on July 21, 1989.

The Complainant proved its ownership of the listed trademark registrations by the submitted extract from the WIPO Brand Database Search.

FACTUAL BACKGROUND

The Complainant is a French company specializing 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 long-term view 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 (referred to the copy of the Complainant’s webpage).

The Complainant also owns an important domain name portfolio comprising its trademark “SAINT-GOBAIN”, such as the domain name <saint-gobain.com> registered since December 29, 1995 (proved by WHOIS information for <saint-gobain.com>).

The disputed domain name <proveedoressaint-gobain.com> (hereinafter “disputed domain name”) was registered on February 12, 2024 (WHOIS information for the disputed domain name) and resolves to a parking page with commercial links (the copy of the webpage linked to the disputed domain name). Besides, MX servers are configured (the copy of the DNS query webpage).

According to the Registrar, the Respondent´s name is protected by Domain Privacy. The Respondent’s provided address as being at Melbourne, Australia.

PARTIES CONTENTIONS

COMPLAINANT:

A. The Complainant contends that the disputed domain name is confusingly similar to the Complainant’s trademarks.

The Complainant states that the disputed domain name is confusingly similar to its trademark “SAINT-GOBAIN” and its domain names associated.

The Complainant asserts that the addition of the generic term “PROVEEDORES” (“SUPPLIERS” in Spanish), is not sufficient to escape the finding that the disputed domain name is confusingly similar to the “SAINT-GOBAIN” trademark. It does not change the overall impression of the designation as being connected to the Complainant’s “SAINT-GOBAIN” trademark. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark, and the domain name associated.

Furthermore, the Complainant contends that the addition of the gTLD “.COM” does not change the overall impression of the designation as being connected to the Complainant’s trademark. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark, and its domain names associated.

Therefore, the Complainant concludes that the disputed domain name is confusingly similar to the Complainant’s “SAINT-GOBAIN” trademark.

B. The Complainant states that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant asserts that the Respondent is not identified in the WHOIS database as the disputed domain name. Past panels have held that a Respondent was not commonly known by a disputed domain name if the WHOIS information was not similar to the disputed domain name.

On the contrary, the Respondent's identity is protected by Domain Privacy. Thus, the Respondent is not known as the disputed domain name.

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 Complainant does not carry out any activity for, nor has any business with the Respondent.

Neither license nor authorization has been granted to the Respondent to make any use of the Complainant’s “SAINT-GOBAIN” trademark or to apply for registration of the disputed domain name by the Respondent.

Furthermore, the disputed domain name resolves to a parking page with commercial links (demonstrated by the copy of the webpage linked to the disputed domain name). Past panels have found it is not a bona fide offering of goods or services or legitimate non-commercial or fair use.

Accordingly, the Complainant contends that the Respondent has no right or legitimate interest in respect of the <proveedoressaint-gobain.com> disputed domain name.

C. The Complainant contends that the disputed domain name has been registered and is being used in bad faith.

The Complainant claims that the disputed domain name was created recently (referred to WHOIS information for the disputed domain name). The Complainant was already extensively using its “SAINT-GOBAIN” trademark worldwide well before that date. It is also recalled that the Complainant’s trademark has a well-known character worldwide and has a long-standing worldwide operating website under the <saint-gobain.com> domain name. The Complainant’s “SAINT-GOBAIN” trademark is widely known. Past panels have confirmed the notoriety of the “SAINT-GOBAIN” trademark.

The Complainant assumes that given the distinctiveness of the Complainant's trademark and reputation, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark.

The Complainant adds that the disputed domain name resolves to a parking page with commercial links (the copy of the webpage linked to the disputed domain name). The Complainant contends the Respondent has attempted to attract Internet users for commercial gain to his website thanks to the Complainant’s trademarks for its commercial gain, which is evidence of bad faith.

Finally, the disputed domain name has been set up with MX records (the copy of the DNS query webpage) which suggests that it may be actively used for e-mail purposes. This is also indicative of bad faith registration and use because any e-mail emanating from the disputed domain name could not be used for any good faith purpose.

On those facts, the Complainant concludes that the Respondent has registered the disputed domain name and is using it in bad faith.

RESPONDENT:

No administrative Complaint 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 UDRP).

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 UDRP).

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 UDRP).

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

In the present case, the Respondent has not submitted any Response and consequently has not contested any of the contentions made by the Complainant. Therefore, the Panel proceeds to decide only on the basis of the Complainant's factual statements and the documentary evidence provided in support of them [Paragraph 5(f) of The Rules].

1. CONFUSING SIMILARITY

The Panel finds that the disputed domain name is confusingly similar to the Complainant's "SAINT-GOBAIN" trademark.

The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (hereinafter "The WIPO Overview 3.0") in Paragraph 1.2.1 states: "Where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case".

The WIPO Overview 3.0 in Paragraph 1.7 states: "[…] in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing."

The WIPO Overview 3.0 in Paragraph 1.8. states: "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element."

In the WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin, the panel stated that: "In numerous cases, it has been held that a domain name that wholly incorporates a Complainant´s registered mark may be sufficient to establish confusing similarity for purposes of the UDRP."

In the WIPO Case No. D2006-0451, F. Hoffmann-La Roche AG v. Macalve e-dominios S.A., the panel stated that: "It is also well established that the specific top level of a domain name such as ".com", ".org" or ".net" does not affect the domain name for the

purpose of determining whether it is identical or confusingly similar".

In the present case, the Complainant has established that owns numerous trademark registrations, both European and International, consisting of the "SAINT-GOBAIN" verbal element protected for the classes in connection with, among others, industrial constructions (evidenced by the extract from the WIPO Brand Database Search).

The <proveedoressaint-gobain.com> disputed domain name contains the Complainant's "SAINT-GOBAIN" trademark in its entirety and adds the general word "PROVEEDORES" (which means "SUPPLIERS" in Spanish). No further adjustments were made to distinguish it from the Complainant's trademark. The addition of the gTLD <.com> does not change the overall impression of the disputed domain name either.

Past panels have declared that when the trademark is recognizable within the disputed domain name, the addition of a general term – such as "PROVEEDORES" ("SUPPLIERS") in the present case – would not prevent a finding of confusing similarity.

Therefore, the disputed domain name is considered to be confusingly similar to the relevant trademark.

As a result, the Panel finds that the Complainant has satisfied Paragraph 4(a)(i) of the UDRP.

2. THE RESPONDENT´S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAME

The Panel finds that the Respondent lacks rights or legitimate interests in the disputed domain name.

According to Paragraph 4(a)(ii) of the UDRP, the Complainant shall make a case that the Respondent lacks rights and legitimate interests in the disputed domain name. If the Complainant fulfils this demand the burden of proof shifts to the Respondent and so the Respondent shall demonstrate rights or legitimate interests in the disputed domain name. If the Respondent fails to prove its rights or legitimate interests, it is assumed that the Complainant satisfied the element of Paragraph 4(a)(ii) of the UDRP (see CAC Case No. 102430, Lesaffre et Compagnie v. Tims Dozman). Moreover, past panels were of the view that it is difficult or sometimes impossible to prove negative facts, i.e., absence of rights or legitimate interest on the part of the Respondent. In this respect, past panels referred to the WIPO Case No. D2000-1769, Neusiedler Aktiengesellschaft v. Vinayak Kulkarni. Within the meaning of Paragraph 4(a)(ii) of the Policy, once the complainant has made something credible (prima facie evidence), the burden of proof shifts to the Respondent to show that he has rights or legitimate interests in the domain name at issue by providing concrete evidence.

In the CAC Case No. 102279, FileHippo s.r.o. v. WHOIS agent, the panel stated that "[i]n the absence of a response, the Panel accepts the Complainant's allegations as true that the Respondent has no authorization to use the Complainant's trademarks in the disputed domain name. Hence, as the Complainant has made out its prima facie case, and as the Respondent has not demonstrated any rights or legitimate interests as illustrated under Paragraph 4(c) of the Policy, nor has the Panel found any other basis for finding any rights or legitimate interests of the Respondent in the disputed domain name, the Panel concludes that the Complainant has satisfied the requirements of Paragraph 4(a)(ii) of the Policy."

In the Forum Case No. FA 1781783, Skechers U.S.A. Inc. v. Chad Moston / Elite Media Group, the panel stated that: "where a response is lacking, WHOIS information can support a finding that the respondent is not commonly known by the disputed domain name".

In the present case, the Complainant claims that the Respondent is not related in any way to the Complainant and the Complainant has never granted any license nor authorization to the Respondent to use the Complainant's trademark or to apply for registration of the disputed domain name. The Complainant does not carry out any activity for, nor has any business with the Respondent.

The Complainant submitted extracts from the WIPO Brand Database declaring numerous trademark registrations for the word "SAINT-GOBAIN", all predating the date of the disputed domain name registration on February 12, 2024 (proved by the extract from the WIPO Brand Database Search).

There is no evidence that would lead to the conclusion that the Respondent is known by the disputed domain name. The Respondent is not identified in the WHOIS information as it is apparent from WHOIS information. The Respondent's identity is protected by Domain Privacy.

Furthermore, the disputed domain name resolves to a parking page with commercial links (demonstrated by the copy of the webpage linked to the disputed domain name). Besides, MX servers are configured (proved by the copy of the DNS query webpage) and thus, the disputed domain name may be used for e-mail purposes. This Panel is of the view that such use of the disputed domain name cannot be understood as a legitimate non-commercial fair use of the disputed domain name.

The Respondent did not reply to the Complaint and so failed to demonstrate his rights or legitimate interests in the disputed domain name.

Therefore, the Panel finds that the Complainant has satisfied the requirement under Paragraph 4(a)(ii) of the UDRP.

3. THE REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME IN BAD FAITH

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

The WIPO Overview 3.0 in Paragraph 3.1.1 states: "If on the other hand circumstances indicate that the respondent's intent in registering the disputed domain name was in fact to profit in some fashion from or otherwise exploit the complainant's trademark,

panels will find bad faith on the part of the respondent. While panel assessment remains fact-specific, generally speaking such circumstances, alone or together, include: (i) the respondent's likely knowledge of the complainant's rights, (ii) the distinctiveness of the complainant's mark, […], (vii) failure of a respondent to present a credible evidence-backed rationale for registering the domain name, […]".

The WIPO Overview 3.0 in Paragraph 3.1.4 states: "Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith."

In the WIPO Case No. D2006-1440, National Football League v. Thomas Trainer, the panel stated: "when a registrant, such as the Respondent here, obtains a domain name that is confusingly similar to a famous mark, with no apparent rights or legitimate interests in the name, and then fails to respond to infringement claims and a UDRP Complaint, an inference of bad faith is warranted."

In the WIPO Case No. D2015-1167, Valero Energy Corporation and Valero Marketing and Supply Company v. Sharad Bhat, the panel stated that: "In accordance with previous UDRP decisions, inactive or passive holding of a domain name, under the circumstances does not prevent a finding of bad faith use."

In the WIPO Case No. D2018-0497, StudioCanal v. Registration Private, Domains By Proxy, LLC / Sudjam Admin, Sudjam LLC, the panel stated that: "[…] whether the commercial gain from misled Internet users is gained by the Respondent or by the Registrar (or by another third party), it remains that the Respondent controls and cannot (absent some special circumstance) disclaim responsibility for, the content appearing on the website to which the disputed domain name resolves. […] the Panel presumes that the Respondent has allowed the disputed domain name to be used with the intent to attract Internet users for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, affiliation, or endorsement of the Respondent's website to which the disputed domain name resolves. Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith."

In the present case, the Complainant has established that owns numerous trademark registrations, both European and International, consisting of the "SAINT-GOBAIN" verbal element protected for the classes in connection with, among others, industrial constructions (evidenced by the extract from the WIPO Brand Database Search) with the right of priority since 1989. The disputed domain name contains the Complainant's "SAINT-GOBAIN" trademark in its entirety. The addition of the general term "PROVEEDORES" ("SUPPLIERS") does not change the overall impression. Therefore, the disputed domain name is confusingly similar to a highly distinctive earlier trademark of the Complainant.

Past panels have decided that the Complainant is a well-established company which operates for decades worldwide under the trademark "SAINT-GOBAIN" (cf., e.g., the WIPO Case No. D 2020-3549, Compagnie de Saint-Gobain v. On behalf of saint-gobain-recherche.net owner, WHOIS Privacy Service / Grigore PODAC).

The Complainant also owns domain name comprising its "SAINT-GOBAIN" trademark, such as the <saint-gobain.com> domain name registered since December 29, 1995 (proved by WHOIS information for <saint-gobain.com>).

Therefore, this Panel states that the Respondent must have been aware of the Complainant's trademark and its reputation before the registration of the disputed domain name on February 12, 2024.

The Respondent is not identified in the WHOIS information and so cannot be recognized under the disputed domain name (evidenced by WHOIS information for the disputed domain name). The Respondent's identity is protected by Domain Privacy. Moreover, the Respondent did not reply to the Complaint and so failed to demonstrate her rights or legitimate interests in the disputed domain name.

Therefore, this Panel states that the Respondent is not identified under the disputed domain name and lacks any good faith rights in the disputed domain name.

The Respondent's bad faith is evidenced by his two acts (among registering the confusingly similar disputed domain name).

First, the disputed domain name resolves to a parking page with commercial links (evidenced by the copy of the webpage linked to the disputed domain name). Since the likelihood of confusion between the disputed domain name and the Complainant's trademark is established, it is clear that the Respondent intended to confuse Internet users and to attract them to visit the website with links allegedly leading to products of the Complainant for his own commercial gain.

Second, the disputed domain name has MX servers configured in the background (proved by the copy of the DNS query webpage) which indicates that it can be used for email purposes. It cannot be assumed that any legitimate e-mail activity would be associated with such use of a confusingly similar domain name or that it would be used for good faith purposes.

Following the above-mentioned, the Panel finds that the Complainant has satisfied conditions pursuant to Paragraph 4(a)(iii) of the UDRP.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	**Radim Charvát**

DATE OF PANEL DECISION 2024-03-27

Publish the Decision