Decision for dispute CAC-UDRP-106276

Case number	CAC-UDRP-106276
Time of filing	2024-02-20 10:00:48
Domain names	saintgobainpfoalawyer.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	COMPAGNIE DE SAINT-GOBAIN

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Name	Eric Chaffin

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 various trademark registrations for “SAINT-GOBAIN”, including the following:-

- European Union Trademark no. 001552843 for SAINT-GOBAIN, registered on 18 December 2001;
- International Trademark no. 740184 for SAINT-GOBAIN, registered on 26 July 2000;
- International Trademark no. 740183 for SAINT-GOBAIN, registered on 26 July 2000;
- International Trademark no. 596735 for SAINT-GOBAIN, registered on 2 November 1992;
- International Trademark no. 551682 for SAINT-GOBAIN, registered on 21 July 1989;

The Complainant registered the domain name <saint-gobain.com> on 29 December 1995. The Respondent registered the disputed domain name on 11 November 2014. Currently, the disputed domain name resolves to a parked webpage containing commercial links. its MX servers are also configured.

FACTUAL BACKGROUND

The Complainant is a French company which specialises in the production, processing and distribution of materials for the construction and industrial markets.

The Respondent is an attorney from New York, United States.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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

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 Respondent contacted the CAC after the lapse of time period to provide a response with request to provide access to the online case file. The CAC replied to this email and provided the Respondent with access and instructions on how to log in to the online case file. No further communication was received by the Respondent. The Respondent did not access the online case file.

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

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a complainant to show that a domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. The Complainant has provided evidence that it owns the trademark registration of the SAINT-GOBAIN mark.

In this case, the disputed domain name contains the entirety of the Complainant's SAINT-GOBAIN trademark with the addition of the suffix "pfoalawyer", and the omission of a hyphen. It is well-established that 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. Similarly, the omission of a hyphen would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements. (see WIPO Overview 3.0, section 1.8).

In addition, the disputed domain name comprises the Complainant's SAINT-GOBAIN trademark and the generic Top-Level Domain ("gTLD") ".com". It is well established that the addition of a gTLD ".com" does not avoid confusing similarity between the Complainant's trademark and the disputed domain name (see WIPO Overview 3.0, section 1.11.1).

Consequently, the Panel finds that the Complainant has shown that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

Once the complainant establishes a prima facie case that the respondent lacks rights or legitimate interests in the disputed domain name, the burden of production shifts to the respondent to show that it has rights or legitimate interests in respect to the disputed domain name (see WIPO Overview 3.0, section 2.1).

In the present case, the Complainant has demonstrated prima facie that the Respondent lacks rights or legitimate interests in respect of the disputed domain name and the Respondent has failed to assert any such rights or legitimate interests.

The Complainant has provided evidence that it owns trademark registrations of the SAINT-GOBAIN mark long before the date that the disputed domain name was registered and that it is not licensed or otherwise authorised the Respondent to use the Complainant's trademark.

The Complainant also provided evidence that the Respondent is not commonly known by the disputed domain name. See WIPO Overview 3.0, section 2.3. The Complainant has not consented to the use of its SAINT-GOBAIN trademark, or part thereof, in the disputed domain name.

It is noted that the disputed domain name resolves to a parked webpage containing what appear to be pay-per-click ("PPC") links that advertise goods and/or services some of which appear to be competing with the offerings of the Complainant.

Further, the Respondent did not submit a Response in the present case and did not provide any explanation or evidence to show rights or legitimate interests in the disputed domain name which would be sufficient to rebut the Complainant's prima facie case.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. Registered and Used in Bad Faith

The Complainant must also show that the respondent registered and is using the disputed domain name in bad faith (see Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy provides circumstances that may evidence bad faith under paragraph 4(a)(iii) of the Policy.

The Complainant provided evidence that the disputed domain name resolves to a parked webpage containing PPC links. Past panels have held that parking a domain name with a webpage showing PPC links that compete with the goods or services of the Complainant can serve as indication of bad faith.

The disputed domain name contains the terms (1) "pfoa", which is submitted by the Complainant to refer to perfluorooctanoic acid, a chemical used in several industrial applications, including carpeting, upholstery, apparel, floor wax, textiles, firefighting foam and sealants, and the descriptive word (2) "lawyer".

The Panel finds that the suffix "pfoa" may lead Internet users to associate the disputed domain name with the Complainant's own goods and/or services, considering the applications of perfluorooctanoic acid. Given the particular circumstances of this case, the use of the word "lawyer" in the disputed domain name is neutral at best because the Respondent is an attorney. It is possible that the Respondent wished to attract clients in connection with the Complainant and/or its PFOA-related product(s). This however does not fit with the fact that the domain name resolves to a parked webpage containing PPCs, some of which appear to offer competing goods/services to those offered by the Complainant.

Further, the Complainant has submitted evidence which shows that the Respondent registered the disputed domain name long after the Complainant registered the SAINT-GOBAIN trademark. Given that the SAINT-GOBAIN mark is highly distinctive, it is unlikely that the Respondent was not aware of the Complainant prior to the registration of the disputed domain name. In view of the evidence presented to the Panel, the Panel finds that it is highly likely that the Respondent was aware of the Complainant and its SAINT-GOBAIN trademark at the time of registering the disputed domain name and specifically targeted the Complainant for an unknown reason.

The Respondent failed to submit a response and did not provide any explanation for registering the disputed domain name nor evidence of good-faith use.

Accordingly, given the particular circumstances of this case, the reputation of the Complainant's trademark, and based on the evidence presented to the Panel, including (1) the registration of the disputed domain name long after the registration of the Complainant's trademark, (2) the incorporation of the Complainant's trademark with the addition of a suggestive suffix , (3) the reputation of the Complainant in the SAINT-GOBAIN trademark, (4) the failure of the Respondent to submit a response,, the Panel draws the inference that the disputed domain name was registered and is being used in bad faith.

Accordingly, having regard to the circumstances of this particular case, the Panel finds that the Complainant has met its burden under 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. **saintgobainpfoalawyer.com**: Transferred

PANELLISTS

Name	**Jonathan Agmon**

DATE OF PANEL DECISION 2024-03-27

Publish the Decision