Decision for dispute CAC-UDRP-106396

Case number	**CAC-UDRP-106396**
Time of filing	**2024-03-27 09:44:46**
Domain names	**saint-gobein.com, saintgoban.com**

Case administrator

Name	**Olga Dvořáková (Case admin)**

Complainant

Organization	**COMPAGNIE DE SAINT-GOBAIN**

Complainant representative

Organization	**NAMESHIELD S.A.S.**

Respondents

Organization	**Saint Gobein**
Organization	**Saint Gobein**

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 names.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of several trademarks SAINT-GOBAIN, registered worldwide, such as:

- International registration n°740184 of July 26, 2000 for trademark SAINT-GOBAIN;
- International registration n°740183 of July 26, 2000 for trademark SAINT-GOBAIN;
- International registration n°596735 of November 2, 1992 for trademark SAINT-GOBAIN; and
- International registration n°551682 of July 21, 1989 for trademark SAINT-GOBAIN.
- The Complainant also owns many domain names including its trademark SAINT-GOBAIN, such as the domain name <saint-gobain.com> registered on December 29, 1995.

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FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant, which operates its website under www.saint-gobain.com, 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. It takes a long-term view in order 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.

For 350 years, the Complainant has consistently demonstrated its ability to invent products that improve the quality of life. It is now one of the top 100 industrial groups in the world and one of the 100 most innovative companies.

The Complainant is the owner of several trademarks SAINT-GOBAIN, registered worldwide, and also owns many domain names including its trademark SAINT-GOBAIN.

SAINT-GOBAIN is also commonly used to designate the company name of the Complainant.

The disputed domain names <saint-gobein.com> and <saintgoban.com> were registered on March 23, 2024 and redirect to the Complainant’s website. It also mentions that the MX servers are configured.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domains names should be transferred to it. The Complainant makes a number of legal arguments and also supplies a set of annexes providing evidence of its activities and of the Respondent's use of the disputed domain name.

No administratively compliant Response has been filed. It ought to be indicated that the Centre could not send a written notice to the Respondent´s address of seat because the address was insufficient and non-existent. The notice of the Commencement of the administrative proceeding was therefore only sent by email. Yet, the e-mail notice sent to <postmaster@saint-gobein.com> and to <postmaster@saintgoban.com> was returned back undelivered as the e-mail address had permanent fatal errors. The Respondent did not seem to have set the compulsory email address "postmaster". Furthermore the registration e-mail addresses <saintgoban@hotmail.com> and to <saintgobein@outlook.com> indicated on the Whois (and confirmed by the Registrar) were used, but the Center never received any proof of delivery or notification of undelivery.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 have been registered and are 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

The Complainant has requested that the proceedings concerning both disputed domain names are consolidated into single proceedings

in accordance with paragraph 4(f) of the UDRP and paragraphs 3(c) and 10(e) of the UDRP Rules. The Complainant asserts that all disputed domain names are owned or under the effective control of a single person or entity, or a group of individuals acting in concert. In support of this assertion, the Complainant contend that the domain names:

- are both registered under the name "SAINT GOBEIN";
- use email addresses based on the model "<disputed domain name>@hotmail/outlook.com";
- have been registered with the same Registrar during the same day;
- resolve to the Complainant's website.

Section 4.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0") provides as follows:

> "*Paragraph 10(e) of the UDRP Rules grants a panel the power to consolidate multiple domain name disputes. At the same time, paragraph 3(c) of the UDRP Rules provides that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder.*"

For the above reasons put forward by the Complainant, the Panel concludes that there are sufficient grounds to support the conclusion that the disputed domain names are subject to common control and that consolidation would be fair and equitable to all Parties

According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that the disputed domain name should be transferred or cancelled:

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

The Panel has examined the evidence available to it and has come to the following conclusion concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

RIGHTS

The Complainant has established rights in the name SAINT-GOBAIN. The disputed domain names <saint-gobein.com> and <saintgoban.com> are found to be confusingly similar to the Complainant's Trademark(s), company name and domain. This finding is based on the settled practice in evaluating the existence of a likelihood of confusion of:

a) disregarding the top-level suffix in the domain name (i.e. ".com");

b) finding that the mere typo of a modified letter i.e. "E" instead of "A" of GOBAIN or the suppressed "I" of GOBAIN would not be considered sufficient to distinguish a domain name from a trademark being read and pronounced if not strictly identically almost identically. This being a misspelling of the trademark SAINT-GOBAIN, intentionally designed to be confusingly similar with the trademark, i.e. a case of typosquatting;

The disputed domain names are therefore confusingly similar to the earlier right "SAINT-GOBAIN", and the Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The onus to make out a prima facie case that the Respondent lacks rights or legitimate interests is placed on the Complainant. However, once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (see e.g. WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

The Complainant has put forward th"t th' Respondent is not commonly known by the disputed domain names. The Respondent is not identified in the Whois under the disputed domain names. Past panels have held that a Respondent was not commonly known by a disputed domain names if the Whois information was not similar to the disputed domain names. The Respondent is in no way related to the Complainant. Nor has the Respondent been granted an authorization or license to use the disputed domain names by the Complainant. This has not been contested by the Respondent. Instead, the Respondent failed to provide any information and evidence whatsoever that could have shown that it has relevant rights or legitimate interests in respect of the disputed domain names (within the meaning of paragraph 4(a) (ii) of the Policy). The disputed domain names redirect to the official website of the Complainant.

In summary, the Panel concludes that the Respondent did not establish any right or legitimate interest to the disputed domain names (within the meaning of paragraph 4(a)(ii) of the Policy). The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Panel finds that the Complainant has established that the disputed domain names were registered by the Respondent and are being used by the Respondent in bad faith. For this purpose, the Complainant has successfully put forward prima facie evidence that the Respondent has not made use, or demonstrable preparations to use, of either the disputed domain names in connection with a bona fide offering of goods or services, or of making a legitimate non-commercial or fair use of the disputed domain names. This prima facie evidence was not challenged by the Respondent.

The disputed domain names were created quite recently, on March 23, 2024. The Complainant was already using its trademark “SAINT-GOBAIN” extensively well before that date. The Complainant has established that its trademark has a well-known character and that it operates a long-standing globally accessible website under the <saintgobain.com> domain name.

In WIPO Case No. D2020-3549, Compagnie de Saint-Gobain v. On behalf of saint-gobain-recherche.net owner, Whois Privacy Service / Grigore PODAC, the Panel was “satisfied that the Complainant is a well-established company which operates since decades worldwide under the trademark SAINT-GOBAIN. The Panel in these proceedings has no reason to question this finding. It is also satisfied of the worldwide operation of a well-established company under the name SAINT-GOBAIN.

The disputed domain names redirect to the official website of the Complainant. Furthermore, the MX servers are configurated. Such making use of the disputed domain names, obviously in a potential fraudulent manner, neither qualifies as a bona fide nor as a legitimate noncommercial or fair use under the UDRP and may not of itself confer rights or legitimate interests in the disputed domain names. The potential collection of personal data or passwords via phishing process being one possible fraudulent act.

The Respondent has failed to demonstrate any activity in respect of the disputed domain names, and it is not possible to conceive of any plausible actual or contemplated active use of the domain names by the Respondent that would not be illegitimate, by passing off, infringement of consumer protection legislation, or infringement of the Complainant’s rights under trademark law.

In the absence of a Response and given the reputation of the Complainant and its trademark(s), company name and domain as supported by the Complainant’s evidence, the Panel must conclude that the Respondent was fully aware of the Complainant's trademark(s), domain and company name "SAINT-GOBAIN" at the time of registering the disputed domain names <saint-gobein.com> and <saintgoban.com>.

Therefore, it has been established to the satisfaction of the Panel that the disputed domain names were registered and are being used in bad faith, in order to prevent the Complainant from making proper use of the mark in the disputed domain names.

The Panel concludes that the Respondent has registered and is using the disputed domain names in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy). The Complainant has therefore also satisfied the requirement 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. **saint-gobein.com**: Transferred
2. **saintgoban.com**: Transferred

PANELLISTS

Name	**David-Irving Tayer**

DATE OF PANEL DECISION 2024-04-28

Publish the Decision