Decision for dispute CAC-UDRP-106439

Case number	CAC-UDRP-106439
Time of filing	2024-04-11 14:00:35
Domain names	infosaintgobain.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	COMPAGNIE DE SAINT-GOBAIN

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Name	Yousuf Ahmed

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

In this proceeding the Complainant relies on the following trademark registrations:

- European Union trademark registration No. 001552843 “SAINT-GOBAIN” (word), registration date is December 18, 2001;
- International trademark registration under the Madrid system “SAINT-GOBAIN” (word + device) No. 740184, registration date is July 26, 2000, protected inter alia in Algeria, China, Kazakhstan, Russia, Kenya, Turkey and Ukraine;
- International trademark registration under the Madrid system “SAINT-GOBAIN” (word) No. 740183, registration date is July 26, 2000, protected inter alia in Albania, Armenia, Australia, Belarus, China, Indonesia, Georgia, Serbia and Switzerland;
- International trademark registration under the Madrid system “SAINT-GOBAIN” (word + device) No.596735, registration date is November 02, 1992, protected in China; and
- International trademark registration under the Madrid system “SAINT-GOBAIN” (word + device) No. 551682, registration date is July 21, 1989, protected inter alia in Algeria, Armenia, Benelux, Egypt, Croatia, Italy, Switzerland and Uzbekistan.

The Complainant also refers to various domain names that incorporate the “SAINT-GOBAIN” trademark, including <saint-gobain.com> registered since December 29, 1995.

FACTUAL BACKGROUND

THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

The Complainant states that it is a French company specialized in the production, processing and distribution of materials for the construction and industrial markets.

The disputed domain name was registered on March 21, 2024 and resolves to an inactive website. The Complainant claims that MX servers are configured.

The Complainant refers to its trademark registrations provided above.

The Complainant contends the disputed domain name is confusingly similar to its “SAINT-GOBAIN” trademark since the addition of the generic term “info” is not sufficient to escape the confusing similarity.

The Complainant states that the addition of the gTLD “.COM” does not change the overall impression of the designation as being connected to the Complainant’s trademark.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Complainant asserts that the Respondent is not known as the disputed domain name in the “Whois” database, and is not related in any way to 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 trademark or apply for registration of the disputed domain name by the Complainant.

The Complainant contends that the Respondent did not use the disputed domain name, and non-use confirms that the Respondent has no demonstrable plan to use the disputed domain name and does not have any legitimate interest in respect of the disputed domain name.

THE DISPUTED DOMAIN NAME WAS REGISTERED AND BEING USED IN BAD FAITH

The Complainant’s submissions on the bad faith element of the UDRP can be summarized as follows:

1. The Complainant claims that its “SAINT-GOBAIN” trademark has a well-known character worldwide and it has a long-standing worldwide operating website under the <saint-gobain.com> domain name. Past UDRP panels have confirmed that Complainant’s “SAINT-GOBAIN” mark is well-known.
2. Given the distinctiveness of the Complainant's trademark and its reputation, it is reasonable to infer that the Respondent has registered the domain name with full knowledge of the Complainant's trademark.
3. The Complainant relies on the passive holding doctrine and the “Telstra” decision (**WIPO Case No. D2000-0003, “Telstra Corporation Limited v. Nuclear Marshmallows**”). The Complainant contends that the Respondent has not demonstrated any activity in respect of the disputed domain name, and it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate.
4. The Complainant claims that the disputed domain name has been set up with MX records which suggests that it may be actively used for email purposes. This is also indicative of bad faith registration and use because any email emanating from the disputed domain name could not be used for any good faith purpose.

Therefore, the Complainant claims the disputed domain name was registered and being used in bad faith.

PARTIES CONTENTIONS

The Complainant's contentions are summarized in the Factual Background section above.

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

A. Identical or confusingly similar

The Complainant provides evidence of its trademark registrations "SAINT-GOBAIN" protected in various jurisdictions.

As confirmed by the "WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition" ("WIPO Overview 3.0"): "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" (see sec. 1.2.1).

The disputed domain name fully incorporates the Complainant's mark with the addition of a descriptive term "info".

As stated in WIPO Overview 3.0: "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" (see sec. 1.8).

The Complainant's word trademark "SAINT-GOBAIN" (word elements "SAINT-GOBAIN") is fully included in the disputed domain name and is clearly recognizable within the disputed domain name. The addition of "info" does not affect confusing similarity as this term can be seen as descriptive of Complainant's activities.

The gTLD ".com" is to be disregarded under the confusing similarity test as it does nothing to eliminate confusion. The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark.

Therefore, the Panel finds that the first requirement of the Policy has been satisfied.

B. Rights or Legitimate Interests

The general rule is the following:

(i) a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests; and

(ii) once such prima facie case is made, the burden shifts to the respondent who has to demonstrate his rights or legitimate interests in respect of the domain name under paragraph 4 (c) of the Policy.

If the respondent fails to do so, the second element of the Policy is satisfied, see **"Julian Barnes v. Old Barn Studios", WIPO Case No. D2001-0121; "Belupo d.d. v. WACHEM d.o.o.", WIPO Case No. D2004-0110**.

The disputed domain name was registered on March 21, 2024. It does not resolve to any active page according to the evidence provided by the Complainant.

On the date of this decision the disputed domain name resolved to Registrar's parking page with PPC links.

The Respondent did not respond.

While failure to respond does not per se demonstrate that the Respondent does not have rights or legitimate interests, it allows the Panel to draw such inferences as it considers appropriate, see paragraph 14(b) of the Policy and **CAC Case No. 101284**: "A respondent is not obliged to participate in a proceeding under the Policy, but if it fails to do so, reasonable inferences may be drawn from the information provided by the complainant".

The Complainant has made a prima facie case of Respondent's lack of rights or legitimate interests.

The Respondent is not known by the disputed domain name and is identified as an individual from India with no connection to the Complainant's business, the disputed domain name or any name corresponding to the disputed domain name.

The Complainant has not granted any license or authorization to use its trademarks registered many years prior to the registration of the disputed domain name to the Respondent and the Complainant is not doing any business with the Respondent.

Passive holding of the disputed domain name or use for PPC links (see sec. 2.9 of WIPO Overview 3.0) in the circumstances of this case does not create any rights or legitimate interests of the Respondent.

Therefore, the Panel finds that the Complainant has satisfied the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists non-exhaustive circumstances indicating registration and use in bad faith.

These circumstances are non-exhaustive and other factors can also be considered in deciding about the bad faith element.

It is well established that bad faith under the UDRP is broadly understood to occur where a respondent takes an unfair advantage of or otherwise abuses a complainant's mark (see sec. 3.1 of WIPO Overview 3.0).

Targeting with an intent to take unfair advantage is important in establishing bad faith under the UDRP.

The Panel finds that the Complainant provided sufficient evidence that the disputed domain name was registered and is being used in bad faith based on the following:

- The nature of the disputed domain name – confusingly similar to Complainant's trademark (fully incorporates Complainant's mark with the addition of a descriptive term) and the timing of the registration of the disputed domain name – March 21, 2024, many years after the Complainant obtained protection for its trademarks. The nature of the disputed domain name indicates that the Respondent was most likely aware of the Complainant and its trademark when he registered the disputed domain name.

- The strength of the "SAINT-GOBAIN" trademark. The Panel notes that the Complainant provided only limited evidence of well-known character of its trademarks: screenshots of Complainant's own website that contain company's profile, history and some numbers and reference to previous UDRP decisions involving the Complainant and the same trademark. Normally, more evidence is required to establish that a trademark is well-known/ has a strong reputation (e.g. evidence of awards, publications by independent sources, media reports, etc.). However, this is not fatal to the Complainant's case taking into account other evidence available as well as facts of the dispute. Previous UDRP decisions relating to the Complainant's trademarks in Complainant's favor, some of which are referred to in the complaint, could be an additional indication of popularity of the trademarks. While each UDRP case is unique and has its own set of facts, previous decisions in Complainant's favor in similar circumstances can demonstrate that the Complainant's mark was already targeted by cybersquatters and enjoys reputation (see e.g. **CAC Case No. 106245**: "SAINT-GOBAIN is a well-known trade mark…" and **CAC Case No. 105967**: "The Panel assumes that Complainant´s mark is widely known, in view of the long company history and the amount of employees world wide…").

- Passive holding of the disputed domain name in the circumstances of this case indicates both registration and use in bad faith. The WIPO Overview 3.0 states that "from the inception of the UDRP, panelists have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding" and the panelists "will look at the totality of the circumstances in each case" (sec. 3.3). The Panel notes that passive holding per se does not indicate bad faith. However, the totality of the circumstances of this dispute proves bad faith of the Respondent, in particular: i) strength of the Complainant's mark (even taking into account certain shortcomings in Complainant's evidence) and timing of registration of the disputed domain name, ii) the nature of the disputed domain name, iii) failure of the Respondent to respond and take part in this proceeding and iv) the implausibility of any good faith use to which the domain name may be put – the Panel does not find any circumstances under which the Respondent could legitimately use the disputed domain name that is so closely associated with the Complainant and its long-standing business. Any possible explanation of a potential legitimate use is solely within the Respondent's knowledge and the Respondent failed to respond and provide any explanations. The fact that on the date of this decision the disputed domain name resolves to Registrar's parking page does not affect the bad faith analysis above. As noted by another Panel in **CAC Case No. 104710**: "The disputed domain name resolves to a registrar parking page…In the absence of a Response and given the reputation of the Complainant and its trademarks, 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 trademarks, domain and company name "SAINT-GOBAIN" at the time of registering the disputed domain name..."

- The fact that MX servers are configured is an indication of bad faith, taking into account the circumstances of this dispute and all of the above, see e.g. **CAC Case No. 106037**:"The trademark SAINT-GOBAIN enjoys wide and extensive reputation. Therefore, it is impossible to conceive any plausible active use of the disputed domain name that would be legitimate. This conclusion is further reinforced by the fraudulent creation of MX servers by the Respondent."

Based on the above, the Panel finds that Respondent's behavior falls within, at least, par. 4 b (iv) of UDRP and the Respondent by using the disputed domain name has intentionally attempted to attract, for commercial gain, Internet users to his web site, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement and that the Respondent targeted the Complainant with an attempt to take unfair advantage of the Complainant's mark.

The Panel holds that the third requirement of the Policy has been satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **infosaintgobain.com**: Transferred

PANELLISTS

Name	**Igor Motsnyi**

DATE OF PANEL DECISION 2024-05-08

Publish the Decision