Decision for dispute CAC-UDRP-106460

Case number	CAC-UDRP-106460
Time of filing	2024-04-18 13:45:40
Domain names	saintgobaindistribuicao.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	Leandro alves da Fonseca

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 registered owner of many trademark registrations for “SAINT-GOBAIN” worldwide, e.g. European Union trademark registration no. 001552843 SAINT-GOBAIN registered on December 18, 2001 for 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.

FACTUAL BACKGROUND

It results from the Complainant’s undisputed allegations that it is a French company specialized in the production, processing and distribution of materials for the construction and industrial markets. The Complainant operates worldwide, especially in Brazil, where the Respondent is located, via several subsidiaries since the end of the 1930s, such as SAINT-GOBAIN DISTRIBUIÇÃO BRASIL LTDA.

The Complainant further contends its trademark SAINT-GOBAIN be distinctive and well-known.

Furthermore, the Complainant owns and uses the domain name <saint-gobain.com> (registered on December 29, 1995) to connect to its official website.

The disputed domain name <saintgobaindistribuicao.com> was registered on April 4, 2024 and resolves to an inactive webpage.

Furthermore, the undisputed evidence provided by the Complainant proves that MX servers are configured.

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

1.

Pursuant to paragraph 4(a)(i) of the Policy, the complainant must establish rights in a trademark or service mark, and that the disputed domain name is identical or confusingly similar to a trademark in which the complainant has rights.

It results from the evidence provided, that the Complainant is the registered owner of various trademarks worldwide for “SAINT-GOBAIN”, e.g. European Union trademark registration no. 001552843 SAINT-GOBAIN registered on 18/12/2001.

The entirety of the mark (but the hyphen) is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”) at section 1.7).

Although the addition of other terms here, “distribuicao”, may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy, WIPO Overview 3.0, section 1.8.

Finally, the generic Top-Level Domain (“gTLD”) “.com” of the disputed domain name is typically disregarded under the first element confusing similarity test (see WIPO Overview 3.0 at section 1.11.1).

In the light of the above, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainants have rights.

2.

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent's rights or legitimate interests to the disputed domain name.

In the Panel's view, the Complainant has made a prima facie case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

According to the Complaint, which has remained unchallenged, the Complainant has no relationship in any way with the Respondent and did, in particular, not authorize the Respondent's use of the Complainant's trademark e.g. by registering the disputed domain name. Furthermore, the Panel notes that there is no evidence showing that the Respondent might be commonly known by the disputed domain name in the sense of paragraph 4(c)(ii) of the Policy.

Moreover, the Panel notes that the disputed domain name contains the Complainant's trademark SAINT-GOBAIN, and that more likely than not, this trademark is not a trademark that one would legitimately adopt as a domain name unless to suggest an affiliation with the Complainant. The Panel finds it most likely that the Respondent registered the disputed domain name with the intention to take advantage of the Complainant's reputation by registering a domain name containing the Complainant's trademark with the intent to mislead Internet users.

It is acknowledged that once the Panel finds a prima facie case is made by a complainant, the burden of production under the second element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name (see WIPO Overview 3.0 at section 2.1). Since the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds, in the circumstances of this case, that the Respondent has no rights or legitimate interests in the disputed domain name.

The Panel finds that the Complainant has therefore satisfied paragraph 4(a)(ii) of the Policy.

3.

According to paragraph 4(a)(iii) of the Policy, the Complainant must, lastly, establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in its paragraph 4(b) may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith.

The Panel shares the view of other UDRP panels and finds that the Complainant's trademark SAINT-GOBAIN is well-known (see e.g. Teva Pharmaceutical Industries Ltd. v. Dale Stehlik, WIPO Case No. D2023-3935). Therefore, this Panel has no doubt that the Respondent positively knew or should have known that the disputed domain name consisted of the Complainant's trademark when registered the disputed domain name. Registration of the disputed domain name in awareness of the reputed SAINT-GOBAIN mark and in the absence of rights or legitimate interests in this case amounts to registration in bad faith, see WIPO Overview 3.0, section 3.1.4.

The disputed domain name does not resolve to active website. In this regard, the Panel notes that the passive holding does not preclude a finding of bad faith (see Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003). In fact, the further circumstances surrounding the disputed domain name's registration and use confirm the findings that the Respondent has registered and is using the disputed domain name in bad faith: (1) the Complainant's trademark SAINT-GOBAIN is well-known; (2) the Respondent failed to submit a formal response or to provide any evidence of actual or contemplated good-faith use; (3) the respondent's concealing its identity and (4) the implausibility of any good faith use to which the disputed domain name may be put (see WIPO Overview 3.0 at section 3.3).

In the light of the above, the Panel finds that the disputed domain name has been registered and is being used in bad faith pursuant to 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. **saintgobaindistribuicao.com**: Transferred

PANELLISTS

Name	**Tobias Malte Müller**

DATE OF PANEL DECISION 2024-05-24

Publish the Decision