Decision for dispute CAC-UDRP-106449

Case number	CAC-UDRP-106449
Time of filing	2024-04-16 16:03:44
Domain names	saintgobainpakistan.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	Techsili

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 submitted evidence that it is the registered owner of the following trademark registrations:

- European Union trademark for the word “SAINT-GOBAIN” No. 001552843 registered since 9 March 2000;
- International registration for the logo “SAINT-GOBAIN” No. 740184 registered on 26 July 2000;
- International registration for the word “SAINT-GOBAIN” No. 740183 registered on 26 July 2000;
- International registration for the logo “SAINT-GOBAIN” No. 596735 registered on 2 November 1992;
- International registration for the logo “SAINT-GOBAIN” No. 551682 registered on 21 July 1989.

In addition to its trademarks, the Complainant owns a portfolio of domain names comprising its trademark “SAINT-GOBAIN”, such as the domain name <saint-gobain.com> registered since 29 December 1995. SAINT-GOBAIN is also commonly used to designate the company name of the Complainant.

FACTUAL BACKGROUND

The Complainant 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 4 April 2024 and resolves to an index page. MX servers are configured in respect of the disputed domain name.

The Registrar confirmed that the Respondent is the current registrant of the disputed domain name, and that the language of the registration agreement is English.

The Respondent has not filed a Response.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Complainant made the following contentions:

A. 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 term “pakistan” is not sufficient to escape the finding that the domain name is confusingly similar.

B. The Complainant suggests it has made a prima facie case that the Respondent has no rights or legitimate interests with respect to the disputed domain name. The Complainant further asserts that the Respondent: (i) is not identified in the Whois database as the disputed domain name; (ii) is not related in any way with the Complainant; (iii) has no business with the Complainant; and (iv) has not been granted any license or authorization to the Complainant's trademark. Besides, the disputed domain name resolves to an index page. The Complainant contends that the Respondent has not used the disputed domain name since its registration, and it confirms that the Respondent has no demonstrable plan to use it, which further demonstrates the Respondent’s lack of legitimate interest in the disputed domain name.

C. The Complainant believes that the disputed domain name was registered and is being used in bad faith because it was created recently. In contrast, the Complainant had already extensively used its trademark “SAINT-GOBAIN” worldwide well before that date. The Complainant submits that its trademark has a well-known character worldwide and that it has a long-standing worldwide operating website under the <saint-gobain.com> domain name. 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. Furthermore, the disputed domain name resolves to an error page with MX records being set up, and the Respondent has not demonstrated any activity in respect of the disputed domain name. It is impossible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate or unlawful.

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

This is a proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") and the CAC Supplemental Rules.

Paragraph 15 of the Rules provides that the Panel shall decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

According to Paragraph 4(a) of the Policy, a complainant must prove each of the following: (A) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; (B) the respondent has no rights or legitimate interests in respect of the domain name; (C) the domain name has been registered and is being used in bad faith.

1. **Identical or confusingly similar domain name**

The Complainant demonstrated that it owns the asserted trademark registrations for the “SAINT-GOBAIN” trademark, which were registered long before the Respondent registered the disputed domain name. It is well established that a nationally or regionally registered trademark confers on its owner sufficient rights to satisfy the requirement of having trademark rights for the purposes of standing to file a UDRP case. Therefore, the Panel finds that the Complainant has established such rights.

It is also well established that the generic top-level suffix may be disregarded when considering whether a disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights, as it is a necessary technical requirement of a domain name.

The disputed domain name contains the Complainant's trademark “SAINT-GOBAIN” in its entirety, except that the hyphen is missing in the disputed domain name. The addition of the word “pakistan” to “saintgobain” is not sufficient to avoid the likelihood of confusion. It clearly refers to Pakistan, the Respondent’s country of origin. As a geographical term, it only has a descriptive character, likely leading Internet users to believe that the disputed domain name refers to the Complainant’s activities or operations in Pakistan.

The Panel, therefore, finds that the disputed domain name is confusingly similar to the trademark to which the Complainant has rights.

2. **Lack of rights or legitimate interests**

The Respondent has not filed a Response and has neither provided any other information that would oppose the Complainant's allegations. Therefore, the Panel holds that the Complainant successfully presented its prima facie case that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

In particular, the Respondent is not in any way connected with the Complainant, nor is it authorized to use the Complainant’s trademark for its commercial activities. In addition, the Respondent is not commonly known by the disputed domain name pursuant to Paragraph 4(c)(ii) of the Policy.

Furthermore, the evidence submitted by the Complainant demonstrated that the disputed domain name had not been used for a bona fide offering of goods or services or a legitimate non-commercial or fair use because it resolves to an index page.

The Panel finds that the Respondent has no rights or legitimate interest in the disputed domain name.

3. **Registration and use of the disputed domain name in bad faith**

Concerning the bad faith argument, the Complainant states, in summary: (a) that the disputed domain is confusingly similar to the Complainant's well-known trademark; (b) that the Respondent must have had actual knowledge of the Complainant's rights in its trademarks; (c) that the disputed domain name resolves to an index page rather than being actively used; and (d) that the disputed domain name was set up with MX records.

The Panel has already found that the disputed domain name is confusingly similar to the Complainant's trademark “SAINT-GOBAIN”. It is well established that the mere registration of a domain name that is confusingly similar to a trademark by an unaffiliated entity can lead to the presumption of bad faith. In this case, the Panel concurs that the Complainant’s trademark is widely recognized in business and can be considered well-known. The Respondent must have and should have been aware of the Complainant and its trademarked name before it registered the disputed domain name.

Given the facts of this matter and the lack of proper use of the disputed domain name, as described above, the Panel believes that the Respondent must have registered and used the disputed domain name in bad faith, most probably for fraudulent purposes. It is difficult to imagine any good-faith reason for the registration or use of the disputed domain name by the Respondent, and the Respondent failed to suggest any in these proceedings.

Furthermore, the Complainant submitted evidence that the disputed domain name was set up with MX (mail exchange) records. Configuration of MX records for e-mail purposes is indicative of potential fraudulent use of the disputed domain name, such as spam and phishing, and can lead to the finding of bad faith, as established by previous panels (CAC Case No. 102827 and CAC Case No. 102380).

Consequently, the Panel finds that the disputed domain name was registered and has been used by the Respondent in bad faith.

In conclusion, the Panel finds that all three elements required by Paragraph 4(a) of the Policy were met and makes the following

decision.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **saintgobainpakistan.com**: Transferred

PANELLISTS

Name	**Vojtěch Chloupek**

DATE OF PANEL DECISION 2024-05-28

Publish the Decision