Decision for dispute CAC-UDRP-106529

Case number	CAC-UDRP-106529
Time of filing	2024-05-14 10:12:35
Domain names	saint-gobain.cam

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	COMPAGNIE DE SAINT-GOBAIN

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Name	frank buchi

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 several trademarks SAINT-GOBAIN, registered worldwide, including but not limited to the followings:

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

FACTUAL BACKGROUND

The Complainant 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.

The Complainant also owns an important domain names portfolio comprising its trademark SAINT-GOBAIN, such as the domain name <saint-gobain.com> registered since December 29, 1995.

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

The disputed domain name <saint-gobain.cam> was registered on May 9, 2024 and resolves to an index page. Besides, MX servers are configured.

The Respondent appears to be an individual based in Manchester, United Kingdom.

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).

The Complainant claims rights in the SAINT-GOBAIN mark through its international trademark registrations. By virtue of its trademark registrations, the Complainant has proved that it has rights in the mark under paragraph 4(a) of the Policy. See Avast Software s. r. o. v Milen Radumilo, 102384, (CAC 2019-03-12).

The Complainant further contents that the disputed domain name is identical to its trademark SAINT-GOBAIN. The addition of the TLD “.CAM” does not change the overall impression of the designation as being connected to the Complainant’s trademark. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and its domain names associated.

By doing a side-by-side comparison, the Panel agrees that the disputed domain name is confusingly similar to Complainant's trademark, see PATEK PHILIPPE SA GENEVE v. NIE PENG, 106208 (CAC 2024-03-19) ("Having compared the disputed domain name and Complainant's PATEK PHILIPPE mark, it appears to the Panel that the prominent part of the disputed domain name is identical to Complainant's trademark and the .vip new gTLD further confuses Internet users."). The Panel further notes that the .cam new gTLD of the disputed domain name is also confusingly similar to the .com gTLD which makes Internet users almost impossible to distinguish the disputed domain name and Complainant's primary domain name, especially in some forms like URLs and email addresses:

Complainant's primary domain name: <saint-gobain.com>

Disputed domain name: <saint-gobain.cam>

For the foregoing reasons, the Panel finds the Complainant has satisfied 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). More specifically, the Complainant must first make a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name, and the burden of prove then shifts to the Respondent to show it does have rights or legitimate interests. See PepsiCo, Inc. v Smith power production, 102378, (CAC 2019-03-08) ("The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.").

The Complainant submits that the Respondent is not commonly known by the disputed domain name. It is not related to the Respondent in anyway and does not carry out any activities 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 SAINT-GOBAIN, or apply for registration of the disputed domain name by the Complainant.

The Complainant further contends that the Respondent did not make any use of the disputed domain name apart from resolving it to an inded page since its registration, and it confirms that Respondent has no demonstrable plan to use it. It demonstrates a lack of legitimate interests in respect of the disputed domain name.

The Panel finds that the Complainant has established a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name. The burden of proof has been shifted to the Respondent to prove that it has right or legitimate interests to the disputed domain name. However, the Respondent has not submitted any response to rebut the assertions within the required period of time.

For the foregoing reasons, the Panel finds the Complainant has satisfied 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).

The Complainant reiterates that its SAINT-GOBAIN trademark has already been used extensively worldwide well before the registration of the disputed domain name. The Complainant's SAINT-GOBAIN trademark has a well-known character worldwide and 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 domain name with full knowledge of the Complainant's trademark.

The Complainant also 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 domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant’s rights under trademark law.

Further more, the Complainant asserts 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.

Having considered the overall circumstances without receiving an administrative compliant response, the Panel is of the view that more likely than not the Respondent has actual knowledge of Complainant's SAINT-GOBAIN trademark during the registration of the disputed domain name. At the meantime, the Panel also note that it is not merely a coincident for the Respondent to register the disputed domain name that is nearly identical to Complainant's primary domain name and activate the MX records. See SCHNEIDER ELECTRIC SE v. Hilary Maxson (schueider-electric), 106495 (CAC 2024-06-04) ("Furthermore, it seems that the Respondent is using the dispute domain name in bad faith for the sole purpose to attract Internet users for commercial gain, by creating a likelihood of confusion with the Complainant’s trademarks. Indeed, the disputed domain name, likely actively used for email purposes as evidenced by the MX Records, resolves to a parking page displaying a button “get started” to grow a business online, and which is likely to create revenue."). See also BOURSORAMA v. jaqh ehri, 106241 (CAC 2024-03-20) (“The activation of MX records to designate an email server and enable email is an action that goes beyond the mere registration of the disputed domain name and indicates that the Respondent has associated the disputed domain name with email servers, which creates a risk that the Respondent may use the disputed domain name for misrepresentation and/or phishing and spamming activities.”).

For the foregoing reasons, the Panel finds the Complainant has satisfied 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

Having established all three elements required under the UDRP Policy, the Panel concludes that the disputed domain name should be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **saint-gobain.cam**: Transferred

PANELLISTS

Name	**Mr Paddy TAM**

DATE OF PANEL DECISION 2024-06-07

Publish the Decision