Decision for dispute CAC-UDRP-106593

Case number	CAC-UDRP-106593
Time of filing	2024-06-06 14:40:35
Domain names	saintgobain.digital

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	COMPAGNIE DE SAINT-GOBAIN

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Organization	Autoglass

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 (the "Domain Name").

IDENTIFICATION OF RIGHTS

The Complainant is the owner of numerous registered trade marks around the world that comprise or incorporate the term "SAINT-GOBAIN". They include:

1. European trade mark n° 001552843 filed on 9 March 2000 and registered on 18 December 2001 for SAINT-GOBAIN as a word mark in classes registered1, 2, 3, 6, 7, 8, 9, 10, 11, 12, 17, 19, 20, 21, 22, 23, 24, 37, 38, 40, and 42;
2. International trade mark n° 740183 filed on July 26, 2000 for SAINT-GOBAIN as a word mark in classes registered in classes 1, 2, 3, 6, 7, 8, 9, 10, 11, 12, 17, 19, 20, 21, 22, 23, 24, 37, 38, 40, and 42 and proceedings to registration at least in part in multiple jurisdictions; and
3. Brazilian trade mark n°003704343 for SAINT-GOBAIN as a "Nominativa" mark, registered on 23 April 1978 in national class 11;

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT

The Complainant is a French company specialised in the production, processing and distribution of materials for the construction and industrial markets worldwide. The Complainant has been successful in a number of UDRP cases including Compagnie de Saint-Gobain v. On behalf of saint-gobain-recherche.net owner, Whois Privacy Service / Grigore PODAC WIPO Case No. D2020-3549, where the Panel stated it was "satisfied that the Complainant is a well-established company which operates since decades worldwide under the trademark SAINT-GOBAIN." The territories in which it operates include Brazil, where is began actives prior to 2020.

The Domain Name was registered on 19 December 2020. As at the time of filing of the Complaint, the Domain Name resolved to an inactive page and was set up with MX records.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the 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 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 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 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

The Complainant has demonstrated that it has registered trade mark rights in the term SAINT-GOBAIN and the Domain Name can most sensibly be read as that term combined with the ".digital" new gTLD. Accordingly, the Complainant's trade mark is clearly recognisable in the Domain Name. This is sufficient for a finding of confusing similarity under the Policy (see section 1.7 of the WIPO Overview 3.0). The Complainant has, therefore, satisfied the requirements of paragraph 4(a)(i) of the Policy.

The Panel is also satisfied that the Domain Name inherently impersonates the Complainant and finds on the balance of probabilities that this impersonation is deliberate on the part of the Respondent. In this respect, the Domain Name takes the form<[Complainant's trade mark].[gTLD]> where the gTLD is an ordinary English word that does not signal a lack of association with the Complainant. In the absence of any explanation from the Respondent as to why it has registered a Domain Name that incorporates the term "Saint Gobain" and where the Respondent has not sought to dispute the Complainant claims that its mark is well known worldwide, the Panel concludes that the most likely explanation for the registration is because of its association with the Complainant's business and marks.

Exactly why the Respondent has registered a Domain Name that impersonates the Complainants not clear, although the Panel notes

the Complainant's reference to the configuration of MX records and that its claim that the Domain Name may, therefore, be being used for email purposes. Although not expressly stated, the claim here appears to be that the Domain Name might be being used to send emails purporting to come from the Complainant or its subsidiary, when they do not. However, regardless of the exact reasons why the Domain Name has been registered and is being held, there is no right or legitimate interest in registering and holding a domain name that impersonates a trade mark holder, and such registration and use is in bad faith. (On the issue of legitimate rights and interests where a domain name takes the form <[trade mark].[gTLD]> see also section 2.5.1 of the WIPO Overview 3.0).

The Complainant has, therefore, satisfied the requirements of paragraphs 4(a)(ii) and (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. **saintgobain.digital**: Transferred

PANELLISTS

Name	**Matthew Harris**

DATE OF PANEL DECISION 2024-07-07

Publish the Decision