Decision for dispute CAC-UDRP-106781

Case number	CAC-UDRP-106781
Time of filing	2024-08-07 09:10:49
Domain names	saintgobainhr.info

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	COMPAGNIE DE SAINT-GOBAIN

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Name	justin time

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 a number of trademark registrations for “SAINT-GOBAIN” (the “SAINT-GOBAIN trademark”), including the following:

- the International trademark SAINT-GOBAIN with registration No.740183, registered on 26 July 2000 for goods and services in International Classes 1, 2, 3, 6, 7, 8, 9, 10, 11, 12, 17, 19, 20, 21, 22, 23, 24, 37, 38, 40 and 42; and

- the European Union trademark SAINT-GOBAIN with registration No.001552843, registered on 18 December 2001 for goods and services in International 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

The Complainant is a French company specialized in the production, processing and distribution of materials for the construction and industrial markets. It is one of the top industrial groups in the world with annual turnover of EUR 47.9 billion in 2023 and 160 000 employees. The Complainant’s official website is located at the domain name <saint-gobain.com>, registered on 29 December 1995.

The disputed domain name <saintgobainhr.info> was registered on 31 July 2024. It resolves to a parking webpage with pay-per-click

("PPC") links and has mail exchange ("MX") servers configured for it.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant contends that the disputed domain name is confusingly similar to its SAINT-GOBAIN trademark, because it wholly incorporates the same trademark, and the addition of the abbreviation "hr" (short for "human resources") is not sufficient to escape the confusing similarity to the SAINT-GOBAIN trademark.

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name, as it is not commonly known under it and is not affiliated to the Complainant, who has not given any authorization to the Respondent to use the SAINT-GOBAIN trademark. The Complainant adds that the use of the disputed domain name for a parking webpage with PPC links does not represent a bona fide offering of goods or services or a legitimate non-commercial or fair use of the disputed domain name.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. According to it, the SAINT-GOBAIN trademark is distinctive and well-known, and the Respondent must have known it when it registered the disputed domain name, which is confusingly similar to this trademark. The Complainant adds that the Respondent attempts to attract Internet users to its own website for commercial gain by exploiting the goodwill of the Complainant's trademark. Finally, the Complainant points out that the disputed domain name has been set up with MX records, which suggests that it may be used for e-mail purposes. According to the Complainant, the Respondent would not be able to use the disputed domain name in good faith as part of an e-mail address.

RESPONDENT:

The Respondent did not submit a Response in this proceeding.

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

Pursuant to the Policy, paragraph 4(a), a complainant must prove each of the following to justify the transfer of a domain name:

(i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;

(ii) the respondent has no rights or legitimate interests in respect of the domain name; and

(iii) the domain name was registered and is being used in bad faith.

In this case, the Provider has employed the required measures to achieve actual notice of the Complaint to the Respondent, and the Respondent was given a fair opportunity to present its case.

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: "[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name …"

In this proceeding, the Respondent has not used the opportunity provided to it under the Rules and has not submitted a substantive Response addressing the contentions of the Complainant and the evidence submitted by it.

Identical or confusingly similar

The Complainant has provided evidence and has thus established its rights in the SAINT-GOBAIN trademark.

The Panel notes that a common practice has emerged under the Policy to disregard in appropriate circumstances the general Top-Level Domain ("gTLD") section of domain names for the purposes of the comparison under the Policy, paragraph 4(a)(i). The Panel sees no reason not to follow the same approach here, so it will disregard the ".info" gTLD section of the disputed domain name.

The relevant part of the disputed domain name is therefore the sequence "saintgobainhr", which incorporates the SAINT-GOBAIN trademark with the removal of the hyphen between the two words forming the trademark, and the addition of the sequence "hr", which is commonly used as an abbreviation for "human resources". The SAINT-GOBAIN trademark is easily recognizable in the disputed domain name. As discussed in section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (the "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. Taking the above into account, the Panel finds that the disputed domain name is confusingly similar to the SAINT-GOBAIN trademark in which the Complainant has rights.

Rights and legitimate interests

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name, because it was not authorized to use the SAINT-GOBAIN trademark and is not commonly known under the disputed domain name. The Complainant adds that the disputed domain name resolves to a parking webpage containing PPC links. Thus, the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Respondent has not submitted a Response and has not provided an explanation of the reasons why it has registered the disputed domain name and how it intends to use it.

In the Panel's view, the circumstances of this case do not support a finding that the Respondent has rights and legitimate interests in the disputed domain name. It is confusingly similar to the distinctive SAINT-GOBAIN trademark and contains the abbreviation "hr", and this combination may well create an impression in Internet users that it represents an online location of the Human Resources department of the Complainant, especially if the disputed domain name is used for the transmission of e-mail messages, which is likely, given that MX records have been set up for the disputed domain name. In the lack of any arguments or evidence to the contrary, the above leads the Panel to the conclusion that it is more likely than not that the Respondent, being aware of the goodwill of the Complainant's SAINT-GOBAIN trademark, has registered the disputed domain name targeting this trademark in an attempt to exploit its goodwill by confusing Internet users that the disputed domain name and the associated content (such as commercial PPC links on the associated webpage, or e-mail communications from an account at the disputed domain name) originate from or are endorsed by the Complainant. As discussed in section 2.9 of the WIPO Overview 3.0, panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users. In view of the above, the Panel does not regard the Respondent's conduct as giving rise to rights or legitimate interests in the disputed domain name.

Therefore, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain name.

Bad faith

Paragraph 4(b) of the Policy lists four illustrative alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

“(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.”

The registration of the distinctive SAINT-GOBAIN trademark predates by 23 years the registration of the disputed domain name. It is confusingly similar to the same trademark and combines it with the abbreviation for “human resources”, which may lead Internet users to believe that it is connected to the Complainant and its Human Resources department. As further noted by the Complainant, the Respondent has configured MX records for the disputed domain name, so it may be used for e-mail communications. The recipients of such communications may wrongly believe them to be originating from the Complainant. The Respondent has not provided any explanation of its choice of a domain name and its plans how to use it. The Panel is therefore of the view that the Respondent is more likely to have registered the disputed domain name with knowledge of the Complainant’s trademark and with the intention of taking advantage of its goodwill for commercial gain.

This satisfies the Panel that the disputed domain name has been registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **saintgobainhr.info**: Transferred

PANELLISTS

Name	**Assen Alexiev**

DATE OF PANEL DECISION 2024-09-05

Publish the Decision