Decision for dispute CAC-UDRP-106779

Case number	CAC-UDRP-106779
Time of filing	2024-08-06 15:17:15
Domain names	saintgobainmercerhrs.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	COMPAGNIE DE SAINT-GOBAIN

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Organization	ICS Inc

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, such as:

- European trademark SAINT-GOBAIN n°001552843 registered since March 9, 2000;
- International trademark SAINT-GOBAIN n°740184 registered on July 26, 2000;
- International trademark SAINT-GOBAIN n°740183 registered on July 26, 2000;
- International trademark SAINT-GOBAIN n°596735 registered on November 2, 1992;
- International trademark SAINT-GOBAIN n°551682 registered on July 21, 1989.

The Complainant also owns many domain names including its trademark SAINT-GOBAIN, such as the domain name <saint-gobain.com> registered on December 29, 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.

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.

For 350 years, the Complainant has consistently demonstrated its ability to invent products that improve quality of life. It is now one of the top industrial groups in the world with around 47.9 billion euros in turnover in 2023 and 160,000 employees.

The disputed domain name <saintgobainmercerhrs.com> was registered on May 12, 2013 and resolves to a parking page with commercial links. Besides, the domain name is offered for sale for 799 USD.

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.

Briefly summarised the Complainant contends the following in support of the complaint.

A. The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The addition of the terms “MERCER” and "HRS” (short for “Hours”) is not sufficient to escape the finding that the domain name is confusingly similar to the trademark SAINT-GOBAIN. It does not change the overall impression of the designation as being connected to the Complainant’s trademark. It is well-established that “a domain name that wholly incorporates a Complainant’s registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP”.

Thus, the disputed domain name is confusingly similar to the Complainant’s trademark SAINT-GOBAIN.

B. The Respondent has no rights or legitimate interests in respect of the disputed domain name.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the domain name and he is not related in any way with the Complainant. The Complainant does not carry out any activity for, nor has any business with the Respondent.

Neither licence 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.

Therefore, the Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. The disputed domain name was registered and is being used in bad faith.

The disputed domain name was created in 2013. The Complainant was already extensively using his trademark SAINT-GOBAIN worldwide well before that date, with a turnover of over 42 billion euros in 2013. It is also recalled that the Complainant trademark has a well-known character worldwide and has a long-standing worldwide operating website under the <saint-gobain.com> domain name.

In view of the above, the Respondent obviously knew the prior rights and wide use of SAINT-GOBAIN by the Complainant. That is the sole and only reason why he registered the litigious domain name.

Furthermore, the disputed domain name points to a parking page with commercial links. The Complainant contends the Respondent attempts to attract Internet users for commercial gain to his own website thanks to the Complainant’s trademarks for its own commercial gain, which is an evidence of bad faith.

In light of the above, the Complainant concludes that the Respondent has registered and is using the disputed domain name <saintgobainmercerhrs.com> in bad faith.

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).

This is a case of adding generic terms - in this case "mercer", meaning "merchant", and "hrs", a well-known abbreviation of "hours", to a well-known trademark and in respect of the well-established practice that the specific top level of a domain name such as “.com” does not affect the disputed domain name for the purpose of determining whether it is identical or confusingly similar, it is found that the disputed domain name is confusingly similar to Complainant´s well-known trademark SAINT-GOBAIN. It is added that the

omission of the hyphen between SAINT and GOBAIN in the disputed domain name doesn't alter this finding of confusing similarity.

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).

Given the circumstances of the case, including the provided information of the use and reputation of the Complainant’s trademark SAINT-GOBAIN and the distinctive nature of this mark, it is inconceivable to the Panel in the current circumstances that the Respondent registered the disputed domain name without prior knowledge of the Complainant and the Complainant’s mark.

The Panel therefore finds that the disputed domain name was registered in bad faith.

The disputed domain name currently resolves to a website with commercial links. The Respondent is using the disputed domain name with the intent to attract Internet users for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, affiliation, or endorsement of the Respondent's website to which the disputed domain name resolves. Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith.

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 three essential issues under the paragraph 4(a) of the Policy are whether:

i. the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

ii. the Respondent has no rights or legitimate interests with respect to the disputed domain name; and

iii. the disputed domain name has been registered and is being used in bad faith.

2. The Panel reviewed carefully all documents provided by the Complainant. The Respondent did not provide the Panel with any documents or statements. The Panel also visited all available websites and public information concerning the disputed domain name, namely the WHOIS databases.

3. The UDRP Rules clearly say in its Article 3 that any person or entity may initiate an administrative proceeding by submitting a complaint in accordance with the Policy and these Rules.

4. The Panel therefore came to the following conclusions:

a) The Complainant states and proves that the disputed domain name is confusingly similar to its trademarks and its domain names. Indeed, the trademark is partially incorporated in the disputed domain name.

The disputed domain name is therefore deemed confusingly similar.

b) The Respondent is not generally known by the disputed domain name and have not acquired any trademark or service mark rights in the name or mark, nor is there any authorization for the Respondent by the Complainant to use or register the disputed domain name. The Panel therefore finds that the Respondent does not have rights or legitimate interest with respect to the disputed domain name.

c) It is clear that the Complainant's trademarks and website(s) were used by the Complainant long time before the disputed domain name was registered.

The disputed domain name resolves to website with commercial links. It is concluded that the mere registration of a domain name that is identical or confusingly similar to a well-known or widely-known trademark by an unaffiliated entity is sufficient to create a presumption of bad faith.

The Panel therefore finds that the disputed domain name has been registered and is being used in bad faith.

For the reasons stated above, it is the decision of this Panel that the Complainant has satisfied all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **saintgobainmercerhrs.com**: Transferred

PANELLISTS

Name	**Lars Karnoe**

DATE OF PANEL DECISION 2024-09-10

Publish the Decision