Decision for dispute CAC-UDRP-106955

Case number	CAC-UDRP-106955
Time of filing	2024-10-16 10:05:08
Domain names	saint-gobsain.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	Richard Bartlett

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 a recognized French company specialized in the production, processing, and distribution of materials for the construction and industrial markets.

The Complainant owns the following Trademarks:

- International Trademark SAINT-GOBAIN (and design), Reg. No. 740184 registered on July 26, 2000, and in force until July 26, 2030;

- International Trademark SAINT-GOBAIN (word mark), Reg. No. 740183 registered on July 26, 2000, and in force until July 26, 2030;

- International Trademark SAINT-GOBAIN (and design), Reg. 596735 registered on November 2, 1992, and in force until November 2, 2032; and

- International Trademark SAINT-GOBAIN (and design), Reg. 551682 registered on July 21, 1989, and in force until July 21, 2029.

FACTUAL BACKGROUND

The Complainant is a recognized French company specialized in the production, processing and distribution of materials for the construction and industrial markets. The Complainant is a worldwide reference in sustainable habitat and construction markets. The Complainant under a long-term view, develops products and services to facilitate sustainable construction, designs innovative, high-performance solutions, which improves habitat and everyday life for its customers.

According with its Integrated Annual Report of 2023, the Complainant has industrial presence in 75 countries, over 450 filed patents, 47.9 billion euros in turnover in 2023, around 160,000 employees across the world, representing more than 120 nationalities and it is committed to achieving net zero carbon emissions by 2050.

The Complainant also owns its 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 Complainant's company name.

The disputed domain name **<saint-gobsain.com>** was registered on **October 10, 2024,** and resolves, including by the time of this Decision, to an inactive website, with configured MX serves.

PARTIES CONTENTIONS

Complainant Contentions:

The Complainant's primary contentions can be summarized as follows:

The Complainant asserts that the disputed domain name is **confusingly similar** to its well-known and distinctive trademark SAINT-GOBAIN; that the obvious addition of the letter "s" to the trademark SAINT-GOBAIN, i.e.: SAINT-GOBSAIN, corresponds to a typical act of typosquatting.

The Complainant contends that the Respondent has **no rights or legitimate interests** in respect of the disputed domain name, given that is not commonly known by the disputed domain name, in particular considering the results of the WhoIs; that the Respondent is not related in any way with the Complainant, that does not carry out any activity for, nor has any business with the Respondent; that 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; that the disputed domain name website's inactivity confirms that the Respondent has no demonstrable plan to use it.

The Complainant contends that the disputed domain name was **registered and is being used in bad faith** due to: by the time of the disputed domain name's registration the Complainant's trademark SAINT-GOBAIN has already established its strength and recognition at a worldwide level; that the disputed domain name is confusingly similar to a well-known trademark as SAINT-GOBAIN; that the Respondent knew about the Complainant and its trademark; that the intentional misspelling in this case, constitutes an evidence of bad faith; that the disputed domain name resolves to an inactive website; that the incorporation of a famous trademark in a domain name, coupled with an inactive website, may be evidence of bad faith registration and use. Finally, the Complainant contents that MX servers are configured, suggesting with it that the disputed domain name may be actively used for e-mail purposes.

Response

The Respondent did not reply to any of the Complainant's contentions.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is 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

In accordance with Paragraph 4(a) of the Policy, the onus is on the Complainant to prove:

(i) the disputed 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 disputed domain name; and

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

The Panel will consider each of these requirements in turn.

1. **Identical or Confusingly Similar**

The Panel notes that some of the trademarks submitted by the Complainant are composed by figurative elements as well, and that there are no disclaimers over the textual elements of the trademarks, from which this Panel concludes that, in this case, the Complainant has sufficiently proved of having trademark Rights over the word SAINT-GOBAIN, since 1989, i.e.: Reg. 551682 in force since July 21, 1989.

For the purposes of the present analysis, the Panel will disregard the design elements of the submitted trademarks, comparing the disputed domain name <saint-gobsain.com> v. the textual components of the trademark SAINT-GOBAIN. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("WIPO Overview 3.0"), section 1.10.

The Panel finds that the intentional misspelled of the disputed domain name, constitutes a typical act of typosquatting, therefore the disputed domain name is confusingly similar to the Complainant's trademark SAINT-GOBAIN. See WIPO Overview 3.0, section 1.9.

Regarding the Generic Top-Level Domain (gTLD) ".com", it is well established that such element may typically be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark, as it is a technical requirement of registration. See WIPO Overview 3.0, section 1.11.1.

Therefore, the disputed domain name <**saint-gobsain.com**> is confusingly similar to Complainant's trademark SAINT-GOBAIN.

2. **Rights or Legitimate Interests**

Paragraph 4(a)(ii) of the Policy requires the Complainant to prove that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent may establish rights or legitimate interests in the disputed domain name by demonstrating any of the circumstances, but without limitation, described in paragraph 4(c) of the Policy.

As previous panelists have stablished, satisfying the burden of proving a lack of the Respondent's rights or legitimate interests in respect of the disputed domain name according to paragraph 4(a)(ii) of the Policy "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". See WIPO Overview 3.0, section 2.1.

The Respondent has not submitted its Response and or any communication rebutting the Complainant's contentions.

According to the evidence submitted by the Complainant, this Panel finds that:

(1) there is no evidence that the Respondent has become commonly known by the term "saint-gobsain.com";

(2) the Respondent is not associated or affiliated with the Complainant; the Complainant has not granted any rights to the Respondent to use its trademark SAINT-GOBAIN, or has granted any license to offer any product or service, or any rights to apply for registration of the disputed domain name;

(3) there is no evidence, prior of the present dispute, of the Respondent's use of or demonstrable preparation to use the disputed domain name in connection with a bona fide offering of goods or services, in fact the Respondent purposely chose a well-known trademark as SAINT-GOBAIN, intentionally misspelling it, register it as a domain name, point it to an inactive website, confusing the users seeks or expects to find the Complainant on the Internet;

(4) that the disputed domain name is the result of Respondent's typosquatting practice. The Panel agrees that it can be further evidence of Respondent's lack of rights or any legitimate interest in respect of the disputed domain name (see Compagnie De Saint-Gobain v. jackson Williams, CAC-UDRP Case No. 104500; Compagnie De Saint-Gobain v. Data Services, CAC-UDRP Case No.106689).

Therefore, to the satisfaction of the Panel, the Complainant has made out its prima facie case. No Response or any communication from the Respondent has been submitted. In the absence of a Response, this Panel accepts Complainant's undisputed factual assertions as true. Thus, the Panel concludes, that the Complainant has satisfied the second element under the Policy.

3. **Registered and Used in Bad Faith**

a) Registration in Bad Faith:

The Complainant acquired its trademark Rights over the word SAINT-GOBAIN at least since 1989. The disputed domain name was registered on **October 10, 2024**. The Panel notes that SAINT-GOBAIN it is a well-known trademark with a worldwide presence, including via Internet, facts that under the present scenario, constitutes a presumption of bad faith. See WIPO Overview 3.0, section 3.1.3.

Additionally, considering the facts and the submitted evidence, in particular that the disputed domain name is fully based on the Complainant's well-known trademark, to this Panel, it is clear that the Respondent knew about Complainant's reputation and SAINT-GOBAIN trademark's value, at the time of the registration of the disputed domain name, and with it, showing that the disputed domain name has been registered in bad faith. See WIPO Overview 3.0, section 3.2.2.

b) Bad Faith Use:

Given the inactive use of the disputed domain name, and according with the section 3.3. of the WIPO Overview 3.0, the following Passive Holding Doctrine's factors, are evident and relevant in this case:

(i) the high degree of distinctiveness and strong reputation of the Complainant's trademark SAINT-GOBAIN;

(ii) the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use; and

(iii) the implausibility of any good faith use, in particular given the existence of the MX records, to which the domain name may be put.

Additionally, and as described, the MX servers of the disputed domain name are configured, which evidences a likelihood of additional bad-faith use of the disputed domain name to engage in fraudulent e-mail or phishing communications. See WIPO Overview 3.0, section 3.4.

Therefore, this Panel concludes that, the disputed domain name is also being used in faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **saint-gobsain.com**: Transferred

PANELLISTS

Name	**María Alejandra López García**

DATE OF PANEL DECISION 2024-11-11

Publish the Decision