Decision for dispute CAC-UDRP-107047

Case number	CAC-UDRP-107047
Time of filing	2024-11-08 09:09:03
Domain names	seint-gobain.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

Name	Omo Jason

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that are pending or decided and that relate to the Disputed Domain Name.

IDENTIFICATION OF RIGHTS

Complainant states, and provides documentation in support thereof, that it "is the owner of several trademarks SAINT-GOBAIN, registered worldwide," including Int'l Reg. No. 551682 for SAINT-GOBAIN (registered July 21, 1989); Int'l Reg. No. 596735 for SAINT-GOBAIN (registered November 2, 1992); and Int'l Reg. No. 740183 for SAINT-GOBAIN (registered July 26, 2000). These registrations are referred to herein as the "SAINT-GOBAIN Trademark."

FACTUAL BACKGROUND

Complainant states that it is "a French company specialized in the production, processing and distribution of materials for the construction and industrial markets"; and that "[i]t 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 was created on November 5, 2024, and is not being used in connection with an active website. MX records have been created for the Disputed Domain Name.

PARTIES CONTENTIONS

Complainant contends, in relevant part, as follows:

Paragraph 4(a)(i): Complainant states that it has rights in the SAINT-GOBAIN Trademark based on the registrations cited above; and that the Disputed Domain Name is confusingly similar to the SAINT-GOBAIN because "[t]his is a clear case of typosquatting, i.e. the disputed domain name contains an obvious misspelling of the Complainant's trademark" and "[i]t is well-established that the slight spelling variations does not prevent a disputed domain name from being confusing[ly] similar to the Complainant's trademark."

Paragraph 4(a)(ii): Complainant states that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because, inter alia, "Respondent is not identified in the Whois as the disputed domain name"; Respondent "is not related in any way with the Complainant" and "Complainant does not carry out any activity for, nor has any business with the Respondent"; "[n]either 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"; "[t]yposquatting is the practice of registering a domain name in an attempt to take advantage of Internet users' typographical errors and can be evidence that a respondent lacks rights and legitimate interests in the domain name"; and because "the disputed domain name resolves to a parking page… [t] he Complainant contends that Respondent did not make any use of disputed domain name, and it confirms that Respondent has no demonstrable plan to use the disputed domain name" and "[i]t proves a lack of legitimate interests in respect of the disputed domain name except in order to create a likelihood of confusion with the Complainant and its trademark."

Paragraph 4(a)(iii): Complainant states that the Disputed Domain Name was registered and is being used in bad faith because, inter alia, given Complainant's longstanding rights in the Disputed Domain Name as well as Complainant's own registration of the domain name <saint-gobain.com> (created December 29, 1995), "the Respondent obviously knew the prior rights and wide use of SAINT-GOBAIN by the Complainant" and "[t]hat is the sole and only reason why he registered the litigious domain name"; "the misspelling of the trademark SAINT-GOBAIN was intentionally designed to be confusingly similar with the Complainant's trademark"; although "the disputed domain name resolves to a parking page… 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"; and the creation of MX records "suggests that [the Disputed Domain Name] may be actively used for email purposes."

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 UDRP).

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 UDRP).

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 UDRP).

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

Identical or Confusingly Similar: Paragraph 4(a)(i):

The trademark citations and documentation provided by Complainant are sufficient to establish that Complainant has rights in the SAINT-GOBAIN Trademark.

As to whether the Disputed Domain Name is identical or confusingly similar to the SAINT-GOBAIN Trademark, the relevant comparison to be made is with the second-level portion of the Disputed Domain Name only (i.e., "seint-gobain") because "[t]he applicable Top Level Domain ('TLD') in a domain name (e.g., '.com', '.club', '.nyc') is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test." WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 1.11.1.

Here, the Disputed Domain Name contains the SAINT-GOBAIN Trademark in its entirety other than replacing the letter "a" with the letter "e." As set forth in section 1.7 of WIPO Overview 3.0: "[I]n cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing." Further, as set forth in section 1.9 of WIPO Overview 3.0: "A domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element."

In light of the above, the Panel finds that the Disputed Domain Name incorporates a dominant feature of the SAINT-GOBAIN Trademark; that the SAINT-GOBAIN Trademark is recognizable within the Disputed Domain Name; and that replacement of the letter "a" with the letter "e" is a common, obvious, or intentional misspelling of the SAINT-GOBAIN Trademark.

Accordingly, the Panel finds that Complainant has proven the first element of the Policy.

Rights or Legitimate Interests: Paragraph 4(a)(ii)

Complainant states that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because, inter alia, "Respondent is not identified in the Whois as the disputed domain name"; Respondent "is not related in any way with the Complainant" and "Complainant does not carry out any activity for, nor has any business with the Respondent"; "[n]either 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"; "[t]yposquatting is the practice of registering a domain name in an attempt to take advantage of Internet users' typographical errors and can be evidence that a respondent lacks rights and legitimate interests in the domain name"; and because "the disputed domain name resolves to a parking page… [t] he Complainant contends that Respondent did not make any use of disputed domain name, and it confirms that Respondent has no demonstrable plan to use the disputed domain name" and "[i]t proves a lack of legitimate interests in respect of the disputed domain name except in order to create a likelihood of confusion with the Complainant and its trademark."

WIPO Overview 3.0, section 2.1, states: "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 Panel finds that Complainant has established its prima facie case and, without any evidence from Respondent to the contrary, the Panel is satisfied that Complainant has satisfied the second element of the UDRP.

Registered and Used in Bad Faith: Paragraph 4(a)(iii)

Whether a domain name is registered and used in bad faith for purposes of the UDRP may be determined by evaluating four (non-exhaustive) factors set forth in paragraph 4(b) of the UDRP: (i) circumstances indicating that the registrant has registered or the registrant has 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 the registrant's documented out-of-pocket costs directly related to the domain name; or (ii) the registrant has 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 the registrant has engaged in a pattern of such conduct; or (iii) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant's 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 the registrant's website or location or of a product or service on the registrant's website or location.

As set forth in section 3.1.4 of WIPO Overview 3.0: "Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith." That is applicable here.

Further, WIPO Overview 3.0, section 3.3, states:

"From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or 'coming soon' page) would not prevent a finding of bad faith under the doctrine of passive holding.

"While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility

of any good faith use to which the domain name may be put."

Here, the SAINT-GOBAIN Trademark appears to be distinctive and to have a high degree of reputation given that it is protected by international registrations that are at least 35years old and used by a company that Complainant describes as "one of the top industrial groups in the world with around 47.9 billion euros in turnover in 2023 and 160,000 employees." Further, Respondent did not submit a response or provide any evidence of actual or contemplated good-faith use. And it is implausible to conceive of any good faith use to which the Disputed Domain Name may be put.

Further, the Panel finds applicable here WIPO Overview 3.0, section 3.1.4: "Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith."

Accordingly, the Panel finds that Complainant has proven the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **seint-gobain.com**: Transferred

PANELLISTS

Name	**Douglas Isenberg**

DATE OF PANEL DECISION 2024-12-17

Publish the Decision