

ADMINISTRATIVE PANEL DECISION

Compagnie de Saint-Gobain v. 王忠文 (Wang Zhong Wen), 临沂商城王忠文汽车用品商行 (lin yi shang cheng wang zhong wen qi che yong pin shang hang)

Case No. D2022-2390

1. The Parties

The Complainant is Compagnie de Saint-Gobain, France, represented by Nameshield, France.

The Respondent is 王忠文 (Wang Zhong Wen), 临沂商城王忠文汽车用品商行 (lin yi shang cheng wang zhong wen qi che yong pin shang hang), China.

2. The Domain Name and Registrar

The disputed domain name <sgbfilms.com> is registered with Alibaba Cloud Computing (Beijing) Co., Ltd. (the “Registrar”).

3. Procedural History

The Complaint in English was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 30, 2022. On July 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 4, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on July 5, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint in English on July 5, 2022.

On July 5, 2022, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On July 5, 2022, the Complainant submitted its request that English be the language of the proceeding. On July 6, 2022, the Respondent submitted its request that Chinese be the language of the proceeding.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent in English and Chinese of the Complaint, and the proceedings commenced on July 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 31, 2022. The Respondent's informal communications were received on July 4, 11, and 15, 2022, respectively. The Center notified the Commencement of Panel Appointment Process to the Parties on August 1, 2022.

The Center appointed Deanna Wong Wai Man as the sole panelist in this matter on August 11, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

On August 16, 2022, the Panel issued the Procedural Order No.1 ("Procedural Order") in Chinese and English to the Parties, inviting the Parties to file additional submissions regarding the following issues: (i) for the Respondent, any evidence regarding potential ownership/use of the term "sgb" as a trademark or otherwise; (ii) for the Complainant, further supporting evidence regarding any ownership/use of the term "sgb" as a trademark or otherwise; and (iii) for the Complainant, its comment on the Respondent's claims regarding ownership/use of the trademark 圣戈班, if such is disputed by the Complainant, and the impact of such on this proceeding. The deadline for these submissions was set at August 23, 2022, and the Complainant's submissions were received by the Center on August 22, 2022, and the Respondent's submissions were received by the Center on August 23, 2022.

4. Factual Background

The Complainant is a company incorporated in France and specializes in the production, processing, and distribution of materials for the construction industry and for industrial markets. The Complainant claimed it was ranked as one of the top 100 most innovative companies around the world in 2021.

The Complainant provides evidence that it or its affiliated company owns a trademark portfolio for SG, including, but not limited to, Chinese trademark registration number 3740574 for SG, registered on February 28, 2006; and French trademark registration number 3806970 for SG, registered on February 16, 2011.

The Respondent is located in Linyi city in Shandong Province, China. The Respondent did not provide specific information about its business operations, but from the website linked to the disputed domain name (before it was taken down), it appears that the Respondent provides products and services for industries including the automotive and construction film and laminate industry. The Respondent provides evidence of ownership of a number of Chinese trademark registrations for 圣戈班, including Chinese trademark registration number 24068101 for 圣戈班, registered on May 7, 2018; Chinese trademark registration number 24067855 for 圣戈班, registered on May 28, 2018; and Chinese trademark registration number 48806753 for 圣戈班, registered on March 21, 2021. The Complainant has filed applications for invalidation of the above-mentioned trademarks registered by the Respondent before the China National Intellectual Property Administration (CNIPA) and the decisions from CNIPA are currently pending.

The disputed domain name was registered on July 6, 2015 and is therefore of a later date than the Complainant's registered trademarks and of an earlier date than the Respondent's registered trademarks. On the date of the Complaint, the disputed domain name directed to an active webpage hosted by the Respondent, where the Respondent apparently provided information regarding its products and services for industries including the automotive and construction film and laminate industry. However, the Panel notes that on the date of this Decision, the disputed domain name directs to an inactive website.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is confusingly similar to its trademark for SG, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered, and is being used in bad faith.

The Complainant particularly contends that the disputed domain name is confusingly similar to the Complainant's trademarks as it incorporates the Complainant's SG trademark in its entirety, and specifies that the term "sgb" referring to the Complainant's line of "SGB abrasive" products, with the generic term "films" referring to the Complainant's line of business. The Complainant also contends that the Respondent has no rights or legitimate interests in the disputed domain name as the Respondent is identified as "Linyi Hongda Film Industry" ("临沂宏达膜业"), is not affiliated with, licensed by, nor authorized by the Complainant in any way and is using the disputed domain name to redirect consumers to the Respondent's website by pretending to be affiliated with the Complainant. Furthermore, the Complainant contends that the disputed domain name is obviously connected to its well-known name, and that its use by the Respondent, who has no connection to the name, products, or services of the Complainant indicates opportunistic bad faith. Finally, the Complainant also argues that the Respondent has registered and is using the disputed domain name primarily for the purpose of disrupting the business of the Complainant, who is a competitor, and that it has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's marks as to the source of the Respondent's website and of the services promoted on that website. The Complainant contends that such actions constitute registration and use of the disputed domain name in bad faith by the Respondent. With its email communication of July 15, 2022, the Complainant also added that the fact that the Respondent offered to sell the disputed domain name to it for CNY 50,000 during the possible settlement between the Parties is additional evidence of its absence of legitimate interests.

Following the Procedural Order, the Complainant added in its additional submissions of August 22, 2022 that the term "sgb" is a contraction of the SG trademark and the letter "b" for Building. The Complainant added that it has products under this name and provided a hyperlink to a website containing limited information about such product. The Complainant also added that the Respondent is known by the Complainant from other cases, especially for infringing its alleged SAINT GOBAIN trademarks. The Panel notes that the Complainant added references to, and full copies of its opposition and invalidation requests filed with the CNIPA against the Respondent's 圣戈班 marks.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

The Respondent did not reply formally to the Complainant's contentions, but did reply informally via multiple communications received by the Center on July 4, 11, and 15, 2022. Essentially, in these informal communications, a potential settlement was first explored but not reached, and, subsequently, with its informal communication of July 15, 2022, the Respondent also provided a trademark registration certificate for its 圣戈班 mark and a domain name registration certificate for the disputed domain name, and contended that it has been using the disputed domain name in good faith for a long time, and explained why it had offered to sell the disputed domain name during the possible settlement between the Parties (not due to its bad faith).

The Respondent also filed additional submissions following the Procedural Order in this case, which were received by the Center on August 23, 2022. In its additional submissions, the Respondent essentially contends that it owns several trademark registrations for 圣戈班, that “sgb” is a valid acronym in Latin letters for this mark in accordance with the Hanyu Pinyin transliteration method, and that the Respondent has been vigorously defending the trademark opposition and invalidation procedures filed by the Complainant against the Respondent’s Chinese trademark registrations, and the Complainant constantly attempts to apply for trademark registrations for 圣戈班 in China.

6. Discussion and Findings

6.1. Preliminary Issue: Language of the Proceeding

Pursuant to paragraph 11(a) of the Rules, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

According to the Registrar’s verification response, the language of the Registration Agreement for the disputed domain name is Chinese. Nevertheless, the Complainant filed its Complaint and its amended Complaint in English, and requests that English be the language of the proceeding. The Panel notes that the Respondent requests that Chinese be the language of the proceeding.

In considering the Parties’ comments on the language of the proceeding, the Panel has carefully considered all elements of this case, in particular, the Complainant’s request that the language of the proceeding be English; the Respondent’s comments on the language of the proceeding and its informal submissions in Chinese; the fact that the disputed domain name itself is written in Latin characters and contains a word in English, namely “films”; the fact that the website linked to the disputed domain name (before it was taken offline) contained a number of English words and sentences; and that in its informal communications and additional submissions, the Respondent appears to be responding to the arguments made by the Complainant in English; and, finally, the fact that Chinese as the language of the proceeding could lead to unwarranted costs for the Complainant and delays for the proceeding. In view of all these elements, the Panel decides that the language of the proceeding shall be English. However, in accordance with the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.5.1, the Panel has reviewed and accepts all communications, submissions, and documents in Chinese as well submitted by both Parties, and does not require a translation thereof.

6.2. Discussion and Findings on the Merits

The Policy requires the Complainant to prove three elements:

- (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.

Based on the evidence and arguments submitted, the Panel’s findings are as follows:

A. Identical or Confusingly Similar

The Panel finds that the Complainant has provided sufficient evidence that it has valid rights in the mark SG based on its registration and use of the same as registered trademarks in various jurisdictions.

As to confusing similarity, the Panel considers that the disputed domain name consists of two main parts namely the acronym “sgb”, fully incorporating the Complainant’s trademark for SG, followed by the term “films”. In assessing the confusing similarity of the disputed domain name to the Complainant’s trademarks, the Panel refers to the [WIPO Overview 3.0](#), section 1.7, which provides: “[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.” The Panel notes that in this case, the disputed domain name incorporates the entirety of the Complainant’s trademark, and concludes that the disputed domain name is therefore confusingly similar to the Complainant’s trademarks.

The Panel finds that the Complainant has satisfied the requirements of the first element under the Policy.

B. Rights or Legitimate Interests and C. Registered and Used in Bad Faith

In reviewing the submissions of the Parties, the Panel finds that the ownership of valid trademark rights by the Respondent is one of the essential issues to assess in order to conclude whether the Respondent has any rights or legitimate interests in the disputed domain name. In this regard, the Panel reminds the Parties that it generally needs to accept the *prima facie* validity of the registered trademarks submitted to it by the Parties, and that the Policy does not give the Panel the competence to decide complex trademark disputes through a “weighing” of respective trademark rights, or to “look behind” a trademark granted by a national authority and to question or re-assess its validity (see in this regard *Air Supplies Holland B.V. v. Huizhou Hicool Climate Equipment Co., Ltd / li fang chen (李芳晨)*, WIPO Case No. [D2020-1586](#) and *Mubadala Trade Marks Holding Company, LLC, Al Yah Satellite Communications Company PrJSC, and Al Maisan Satellite Communications Company, LLC v. Emedia Development Ltd. and Whois Privacy Services Pty Ltd.*, WIPO Case No. [D2013-0570](#)). The Panel notes that the Respondent has provided evidence of ownership of a number of registered trademarks and that, in its additional submissions following the Procedural Order, the Complainant has provided evidence that it has filed a number of invalidation and opposition procedures against the Respondent’s Chinese trademarks and trademark applications.

However, the Panel concludes on the basis of the Complainant’s evidence that most of such procedures were still pending at the time the Complaint was filed, and remain pending on the date of this Decision, so that the Respondent’s trademark registrations remain valid for now. In this regard, the Panel considers that the Policy does not grant the Panel the competence or power to prejudge or anticipate any decision in these procedures, which remain the exclusive competence of CNIPA. Therefore, the Panel concludes that the Respondent currently owns valid trademark registrations for 圣戈班.

The Panel notes that the Respondent contends, in its submissions of August 23, 2022 to the Procedural Order, that it is using merely the Latin letter acronym “sgb” for its registered trademark 圣戈班 in the disputed domain name because the Respondent’s trademark 圣戈班 would be transliterated as “sheng ge ban” in Hanyu Pinyin (汉语拼音).

Furthermore, the Panel refers to the Complainant’s submissions of August 22, 2022, which were filed in response to the Procedural Order in which the Panel explicitly requested the Complainant to submit evidence regarding its ownership/use of the term “sgb” as a trademark or otherwise. In response, the Complainant contended essentially that “sgb” is a contraction of its SG trademark and the letter “b” for Building, and that it offers products using this term. The Complainant also added references to, and full copies of its opposition and invalidation requests filed with the CNIPA against the Respondent’s 圣戈班 marks. The Panel notes from the invalidation document filed by the Complainant regarding the Respondent’s Chinese trademark registration No. 48806753 that the Complainant also owns the Chinese trademark for 圣戈班 under the number 1580697 registered on June 7, 2001, and appears to have been using the trademark 圣戈班 for providing its products and services in China.

Nevertheless, the Panel finds that the present dispute forms part of a larger complex trademark dispute between the Parties which already existed at the time the Complaint was first filed, and that this dispute should be addressed before the competent administrative authorities and courts as it goes beyond the scope of UDRP proceedings.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Deanna Wong Wai Man/

Deanna Wong Wai Man

Sole Panelist

Date: September 13, 2022