

## **ADMINISTRATIVE PANEL DECISION**

Compagnie de Saint-Gobain v. Privacy service provided by Withheld for Privacy ehf / Ivy Walker

Case No. D2022-2458

### **1. The Parties**

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

The Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / Ivy Walker, Afghanistan.

### **2. The Domain Name and Registrar**

The disputed domain name <compagnie-st-gobain.com> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 6, 2022. On July 6, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 6, 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 12, 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 July 12, 2022.

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 of the Complaint, and the proceedings commenced on July 15, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 4, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 5, 2022.

The Center appointed Kateryna Oliinyk as the sole panelist in this matter on August 10, 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.

#### **4. Factual Background**

The Complainant is a French multinational corporation founded in 1665 and it specialized in the production, processing and distribution of materials for the construction and industrial markets. According to a corporate presentation, the Complainant is present in 75 countries with turnover EUR 44.2 billion in 2021, and it has 166 000 employees worldwide.

The Complainant is one of the top 100 industrial groups in the world and one of the 100 most innovative companies according to the Clarivate Top 100 Global Innovator™ 2021 ranking.

The Complainant is the owner of registrations of the SAINT-GOBAIN trademark, including the following international registrations:

- International Trademark registration No. 740184 for SAINT-GOBAIN registered on July 26, 2000;
- International Trademark registration No. 740183 for SAINT-GOBAIN registered on July 26, 2000;
- International Trademark registration No. 596735 for SAINT-GOBAIN registered on November 2, 1992;
- International Trademark registration No. 551682 for SAINT-GOBAIN registered on July 21, 1989.

In addition, the name “Saint-Gobain” is part of the registered company name of the Complainant. The Complainant operates the official website under the domain name <saint-gobain.com> created on December 29, 1995.

The disputed domain name <compagnie-st-gobain.com> was created on June 20, 2022 and does not resolve to an active website.

#### **5. Parties' Contentions**

##### **A. Complainant**

###### *Identical or Confusingly Similar*

The Complainant contends that the disputed domain name and the SAINT-GOBAIN trademark are confusingly similar.

According to the Complainant's contentions, the substitution of the term “saint” by its common abbreviation “st” in the disputed domain name and addition of the non-distinctive element “compagnie” does not prevent a finding of confusing similarity between the disputed domain name and the SAINT-GOBAIN trademark.

###### *No rights or legitimate Interests*

The Respondent has no connection with the Complainant or any of its affiliates and has never sought or obtained any trademark registration for the SAINT-GOBAIN trademark. The Complainant does not carry out any activity for, nor have any business with, the Respondent.

The Complainant further contends that the Respondent is not commonly known by the disputed domain name.

As the disputed domain name is inactive, the Complainant contends that the Respondent did not make any use of the disputed domain name since its registration, and it confirms that Respondent has no demonstrable plan to use it. The Respondent, therefore, has no rights or legitimate interests in the disputed domain name.

*Registered and used in bad faith*

The Complainants submit that the Respondent has registered the disputed domain name with full knowledge of the Complainant's well-known SAINT-GOBAIN trademark.

The Complainant contends that the 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 disputed domain name by the Respondent that would not be illegitimate.

**B. Respondent**

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

**6. Discussion and Findings**

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

Considering that the Respondent did not reply to the Complainant's contentions, in order to determine whether the Complainant has met its burden as stated in paragraph 4(a) of the Policy, the Panel bases its Decision on the statements and documents submitted and in accordance with the Policy and the Rules. Under paragraph 14(b) of the Rules, where a Party does not comply with any provision of the Rules, the Panel "shall draw such inferences therefrom as it considers appropriate".

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following: (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and (iii) that the disputed domain name has been registered and is being used in bad faith.

**A. Identical or Confusingly Similar**

Ownership of a nationally or regionally registered trademark serves as a *prima facie* evidence that the Complainant has trademark rights for the purposes of standing to file this Complaint. See section 1.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). The Complainant submitted evidence that the SAINT-GOBAIN trademark enjoys protection under international trademark registrations. Thus, the Panel finds that the Complainant's rights in the SAINT-GOBAIN trademark have been established pursuant to the first element of the Policy.

The textual elements of the disputed domain name include the term "compagnie" and the elements "st" and "gobain". The element "st" is the commonly known abbreviation of the term "saint" which constitutes a part of the Complainant's trademark, and the element "gobain" has been readily appropriated from the Complainant's SAINT-GOBAIN trademark.

As provided in section 1.8 of the [WIPO Overview 3.0](#), the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.

Under section 1.7 of the [WIPO Overview 3.0](#), while each case is judged on its own merits, in 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.

Finally, for the purpose of assessing under paragraph 4(a)(i) of the Policy, the Panel may ignore the generic Top Level Domains (“gTLDs”), see section 1.11.1 of the [WIPO Overview 3.0](#).

Respectively, albeit the disputed domain name is not identical to the Complainant’s SAINT-GOBAIN trademark, it is readily apparent that the Complainant’s trademark remains recognizable in the disputed domain name.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the SAINT-GOBAIN trademark in which the Complainant has rights.

The first element of paragraph 4(a) of the Policy is therefore satisfied.

## **B. Rights or Legitimate Interests**

Under paragraph 4(a)(ii) of the Policy, a complainant must make at least a *prima facie* showing that a respondent possesses no rights or legitimate interests in a disputed domain name. See, e.g., *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#). Once a complainant makes such a *prima facie* showing, the burden of production shifts to the respondent, though the burden of proof always remains on the complainant. If the respondent fails to come forward with evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.

Based on the Complainant’s contentions, the Respondent is not a licensee of, or otherwise affiliated with, the Complainant, and has not been authorized by the Complainant to use its SAINT-GOBAIN trademark.

The Complainant further contends that the Respondent is not commonly known by the disputed domain name and has not made any *bona fide* use - neither commercial nor noncommercial, of the same.

Based on the case records, the Panel finds that there is no evidence that the Respondent has been commonly known by the disputed domain name, and there is no similarity or association between the name of the Respondent and the disputed domain name, which could demonstrate rights or legitimate interests of the Respondent. See, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones TheDotCafe*, WIPO Case No. [D2008-0642](#).

The disputed domain name does not resolve to an active website. Prior UDRP panels have found that the passive holding of a disputed domain name is neither a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use. See, by way of example, *Skyscanner Limited v. WhoisGuard Protected, WhoisGuard, Inc. / petrov petya*, WIPO Case No. [DCC2020-0003](#), *Instagram, LLC v. Zafer Demir, Yok*, WIPO Case No. [D2019-1072](#), “The passive holding of the disputed domain name does not amount to use or preparations to use it in connection with a *bona fide* offering of goods and services. Nor is there any evidence which indicates that the Respondent is commonly known by the disputed domain name. Nor does a passive holding of the disputed domain name comprise a legitimate noncommercial or fair use of it.”).

The Panel agrees and holds the passive holding of the disputed domain name by the Respondent in this case as evidence that the Respondent has not registered the disputed domain name in connection with any *bona fide* offering of goods or services. The Respondent has not made any demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering as well.

In the Panel's view, the use of the disputed domain name by the Respondent does not constitute either a *bona fide* use or a legitimate noncommercial or fair use of the disputed domain name.

By not submitting a Response, the Respondent has failed to invoke any circumstances which could demonstrate any rights or legitimate interests in the disputed domain name. Under such circumstances the Panel draws adverse inferences from this failure, where appropriate, in accordance with the Rules, paragraph 14(b).

The second element of paragraph 4(a) of the Policy is therefore satisfied.

### **C. Registered and Used in Bad Faith**

While paragraph 4(b) of the Policy provides four, non-exclusive, circumstances that shall be evidence of the registration and use of a domain name in bad faith, UDRP panels have been prepared in appropriate cases to draw inferences concerning a respondent's (bad faith) intent from the relevant facts and circumstances. As stated in section 3.1 of [WIPO Overview 3.0](#): "...evidence demonstrating that a respondent seeks to take unfair advantage of, abuse, or otherwise engage in behavior detrimental to the complainant's trademark would also satisfy the complainant's burden".

In the present case, the Complainant asserts that the Respondent was aware of SAINT-GOBAIN and the Complainant's prior rights and use and that the Respondent's aim was to act in bad faith by taking advantage of the voluntary confusion created by its registration of the disputed domain name.

The Complainant's SAINT-GOBAIN trademark is a fanciful name with no meaning aside from referring to the Complainant's goods and services. It has been registered and used for decades and is a renowned trademark worldwide, especially in the construction sector.

In light of that, having in mind the recognition of SAINT-GOBAIN trademark, the registration of the disputed domain name does not seem to be a coincidence, and thus indicates that the Respondent knew of the Complainant's mark and intentionally intended to create an association with the Complainant and its business at the time of the registration of the disputed domain name.

Thus, the Panel cannot find any other reasonable reason for the Respondent to register the disputed domain name other than to disturb or to take advantage of the Complainant or its trademarks. Prior panels have held that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See section 3.1.4 of the [WIPO Overview 3.0](#).

Furthermore, under section 3.3 of the [WIPO Overview 3.0](#), the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Previous UDRP panels have held that the passive holding of a domain name that incorporates a well-known trademark may confirm the bad faith use of a disputed domain name. See, *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

The Panel notes the following factors that have been considered relevant in applying the passive holding doctrine: (i) the reputation of SAINT-GOBAIN (ii) the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the lack of legitimate interests or rights in the disputed domain name and therefore, the implausibility of any good faith use to which the disputed domain name may be put, and (iv) the Respondent's use of a privacy service to mask its identity.

The Panel concludes that the Complainant has established the third element of the Complaint and therefore, the disputed domain name was registered and used in bad faith.

Therefore, the Complainant has satisfied paragraph 4(a)(iii) of the Policy

## **7. Decision**

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <compagnie-st-gobain.com> be transferred to the Complainant.

*/Kateryna Oliinyk/*

**Kateryna Oliinyk**

Sole Panelist

Date: August 24, 2022