

ADMINISTRATIVE PANEL DECISION

Compagnie de Saint-Gobain v. Bruna Oliveira, Saint-Gobain Distribuição Brasil

Case No. D2023-4753

1. The Parties

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

The Respondent is Bruna Oliveira, Saint-Gobain Distribuição Brasil, Brazil.

2. The Domain Name and Registrar

The disputed domain name <saint-gobaindistribuiçãoobrasil.com> is registered with Squarespace Domains II LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 15, 2023. On November 15, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 15, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

On November 16, 2023, the Center informed the parties in Portuguese and English, that the language of the registration agreement for the disputed domain name is Portuguese. On November 16, 2023, the Complainant requested English to be the language of the proceeding. The Respondent did not submit any comment on the Complainant’s submission.

The Center verified that the 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 November 24, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 14, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 15, 2023.

The Center appointed Gonalo M. C. Da Cunha Ferreira as the sole panelist in this matter on December 19, 2023. 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 company, specialized in the production, processing and distribution of materials for the construction and industrial markets, doing business worldwide with more than 168,000 employees. Being the owner of a portfolio of trademarks, notably SAINT-GOBAIN with registered rights in a number of jurisdictions. As such:

European Union trademark SAINT-GOBAIN word mark n°001552843 registered on December 18, 2001;
International trademark SAINT-GOBAIN device mark n°596735 registered on November 2, 1992;
International trademark SAINT-GOBAIN device mark n°551682 registered on July 21, 1989.

The disputed domain name was registered on January 31, 2023, and resolves to an inactive page and MX servers are configured.

The disputed domain name was registered in the name of Complainant's Brazilian subsidiary ("Saint-Gobain Distribuicao Brasil Ltda"). However, the Registrant's email address is not affiliated with SAINT-GOBAIN DISTRIBUICAO BRASIL LTDA and the address used by the Respondent does not correspond to the Complainant's subsidiary's address.

The Complainant registered and uses the <saint-gobain.com> domain name since December 29, 1995.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that:

1. the disputed domain name is confusingly similar to its well-known and distinctive trademark SAINT-GOBAIN as it is identically contained.
2. the addition of the generic terms "distribuio" (meaning "distribution" in Portuguese) and "Brasil" are not sufficient to prevent the finding that the domain name is confusingly similar to the trademark SAINT-GOBAIN
3. the addition of the generic Top-Level Domain ("gTLD") ".COM" does not change the overall impression that the disputed domain name is connected to the Complainant's trademark
4. that the Respondent is not affiliated with nor authorized by the Complainant in any way.
5. that the Respondent has no rights or legitimate interests in respect of the disputed domain name.
6. The disputed domain name was registered in the name of the Complainant's Brazilian subsidiary ("Saint-Gobain Distribuicao Brasil Ltda") but the Registrant's email address is not affiliated with Saint-Gobain Distribuicao Brasil Ltda and the address used by the Respondent does not correspond to the Complainant's subsidiary's address.
7. that the Registrant uses the identity of the Complainant's subsidiary in order to increase the likelihood of confusion with the Complainant.
8. the Respondent is using the name "Saint-Gobain Distribuico Brasil" in the Whois of the disputed domain name to pass off as the Complainant.

9. despite being inactive, MX servers are configured to the disputed domain name, which suggests that it may be actively used for email purposes.
10. the disputed domain name was registered and is being used in bad faith.

B. Respondent

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

6. Discussion and Findings

Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Portuguese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that the choice of language is related to the combined fact that the English language is the language most widely used in international relations and is one of the working languages of the Center and in order to proceed in Portuguese, the Complainant would have had to retain specialized translation services at a cost very likely to be higher than the overall cost of these proceedings. The use of Portuguese in this case would therefore impose a burden on the Complainant which must be deemed significant in view of the low cost of these proceedings.

The Respondent did not make any specific submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 4.5.1).

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms "distribuição" and "Brasil", may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Moreover, the composition of the disputed domain name including the Complainant’s trademark along the term “distribuição” and the geographical term “Brasil” creates a risk of implied affiliation with the Complainant ([WIPO Overview 3.0](#), section 2.5.1). The Respondent’s intention in creating such implied affiliation is further supported by the use of the name of the Complainant’s subsidiary for the registration of the disputed domain name.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent has registered the disputed domain name in the name of Complainant’s Brazilian subsidiary (“Saint-Gobain Distribuicao Brasil Ltda”). However, the Registrant’s email address is not affiliated with Saint-Gobain Distribuicao Brasil Ltda and the address used by the Respondent does not correspond to the Complainant’s subsidiary’s address. This indicates not only that the Respondent was aware of the Complainant, its Brazilian subsidiary, and their activities at the time of the registration of the disputed domain name, which by itself indicates bad faith registration ([WIPO Overview 3.0](#), section 3.2.2), but also that the Respondent had the likely intention or may be using the disputed domain name to pass off as the Complainant.

The fact that the disputed domain name does not resolve to any active websites does not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3.

In addition, while the configuration of MX servers does not, *per se*, indicate bad faith, in the circumstances of this case, and in particular the registrant’s name provided for the registration of the disputed domain name, the Panel considers it supports the Panel’s finding on registration and use in bad faith.

Based on the available record, the Panel finds that the Complainant has established the third element 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 < saint-gobaindistribuiçãoobrasil.com > be transferred to the Complainant.

/Gonçalo M. C. Da Cunha Ferreira/

Gonçalo M. C. Da Cunha Ferreira

Sole Panelist

Date: January 2, 2024