

ADMINISTRATIVE PANEL DECISION

Compagnie de Saint-Gobain v. Richard Andre, Bigcountryadventures Pty Ltd
Case No. D2023-5215

1. The Parties

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

The Respondent is Richard Andre, Bigcountryadventures Pty Ltd, United States of America.

2. The Domain Name and Registrar

The disputed domain name <salnt-goban.com> is registered with Gransy, s.r.o. d/b/a subreg.cz (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on December 14, 2023. On December 15, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 19, 2023, the Registrar transmitted by email to the Center its verification response disclosing the registrant and contact information for the disputed domain name which differed from the named Respondent (My Domain Provider) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 20, 2023, 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 on December 20, 2023.

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 December 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 10, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 28, 2024.

The Center appointed Peter Burgstaller as the sole panelist in this matter on February 5, 2024. 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 major designer, manufacturer and distributor of materials and services for the construction and industrial markets with a global market presence (Annex 3 to the Complaint).

The Complainant owns several trademark registrations containing the mark SAINT-GOBAIN, inter alia

- European Union trademark (word), Registration Nr. 1552843, registered December 18, 2001;
- International trademark (figurative), Registration Nr. 740184, registered July 26, 2000, designated for several countries around the world;
- International trademark (figurative), Registration Nr. 740183, registered July 26, 2000, designated for several countries around the world;
- International trademark (figurative), Registration Nr. 596735, registered November 2, 1992, designated for China; and
- International trademark (figurative), Registration Nr. 551682, registered July 21, 1989, designated for several countries around the world (Annex 4 to the Complaint).

Furthermore, the Complainant is the registrant of the domain name <saint-gobain.com>, registered December 29, 1995 (Annex 5 to the Complaint).

The disputed domain name was registered on December 11, 2023 (Annex 1 to the Complaint); it resolves to a parking page provided by "Hostinger" (Annex 6 to the Complaint).

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 the SAINT-GOBAIN trademark is distinctive and well-known; it notes that the disputed domain name contains the SAINT-GOBAIN trademark in its entirety, simply using the letter "l" instead of an "i" in the word "SAINT" and omitting the letter "i" in the word "GOBAIN". Such a typosquatting practice is intended to create confusing similarity between the Complainant's trademark and the disputed domain name.

The Complainant submits that it is therefore inconceivable that the Respondent would not have been aware of the Complainant's trademark when registering the disputed domain name, or that there would be any legitimate use for the disputed domain name. Further, the Complainant has never assigned, granted, licensed, sold, transferred or in any way authorized the Respondent to register or use the SAINT-GOBAIN trademark in any manner.

Further, the Complainant notes that the disputed domain name does not resolve to an active website, and is therefore not used for a bona fide offering of goods or services. Moreover, the passive holding of a domain name may amount to bad faith when it is difficult to imagine any plausible future active use of the disputed domain name by the Respondent that would be legitimate and not infringing the Complainant's well-known mark.

Finally, the Complainant asserts that the Respondent has established MX records for the disputed domain name, which enables it to use it to send and receive email.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, the Complainant must prove that

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests with respect to the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

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. This test typically involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

In the case at issue, the Complainant submitted evidence, which incontestably and conclusively establishes rights in the SAINT-GOBAIN mark.

The disputed domain name is confusingly similar to the SAINT-GOBAIN mark in which the Complainant has rights since the Complainant's SAINT-GOBAIN mark is clearly recognizable in the disputed domain name. It has long been established under UDRP decisions that where the relevant trademark is recognizable within the disputed domain name, the mere addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) will not prevent a finding of confusing similarity under the first element of the Policy. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.8.

Further, 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. This stems from the fact that the domain name contains sufficiently recognizable aspects of the relevant mark. [WIPO Overview 3.0](#), section 1.9.

This is the case at hand: The use of the letter "l" instead of an "i" in the word "SAINT" and the omission of the letter "i" in the word "GOBAIN" in the disputed domain name does not prevent a finding of confusing similarity; in fact, such common and obvious misspellings of the Complainant's trademark rather strengthen the confusing similarity.

Finally, it has also long been held that generic Top-Level Domains are generally disregarded when evaluating the confusing similarity under the first element.

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.

The nature of the disputed domain name, comprising the Complainant’s distinctive mark together with common, obvious and intentional misspellings of the Complainant’s trademark cannot be considered fair as these confuse users seeking or expecting the Complainant.

Furthermore, the Respondent has no trademark with regard to the disputed domain name, is not commonly known under it and there is no connection or affiliation with the Complainant whatsoever nor has it received any license or consent, express or implied, to use the Complainant’s mark in a domain name or in any other manner; and the Respondent is not making a legitimate, non-commercial or fair use of the disputed domain name.

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.

Hence, 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:

(i) In the present case the Complainant has rights and is the owner of the distinctive mark SAINT-GOBAIN, which is registered and used in many jurisdictions around the world long before the registration of the disputed domain name. Moreover, the Complainant registered and is using the domain name <saint-gobain.com> to address its company website.

It is inconceivable for this Panel that the Respondent registered or has used the disputed domain name without knowledge of the Complainant’s rights, which leads to the necessary inference of bad faith. This finding is supported by the fact that the disputed domain name incorporates the Complainant’s distinctive trademark SAINT-GOBAIN together with common, obvious and intentional misspellings of the Complainant’s SAINT-GOBAIN mark.

Further, it is well-settled case law that the practice of typosquatting may in itself be evidence of a bad faith registration of a domain name (see, e.g., *Longs Drug Stores California, Inc. v. Shep Dog*, WIPO Case No.

[D2004-1069](#); *Wal-Mart Stores, Inc. v. Longo*, WIPO Case No. [D2004-0816](#); *Compagnie Générale des Etablissements Michelin v. Super Privacy Service LTD c/o Dynadot / Reed Mueller*, WIPO Case No. [D2021-1771](#); *Philip Morris Products S.A. v. Rohan Mubbashir Khan*, WIPO Case No. [D2022-4582](#); *Sopra Steria Group v. Sopra Steria, soprasteria*, WIPO Case No. [D2023-2397](#)).

Moreover, Panels have consistently found 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 (as it is in the present case) can by itself create a presumption of bad faith.

[WIPO Overview 3.0](#), section 3.1.4.

(ii) The disputed domain name is also being used in bad faith: Although there is no evidence that the disputed domain name is being actively used or resolved to a website with substantive content, Panels have found that the non-use of a domain name (including a blank or “coming soon” or “parking” page) would not prevent a finding of bad faith under the doctrine of passive holding.

Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although 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, and (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3.

The distinctiveness and reputation of the Complainant’s trademark, and the composition of the disputed domain name (including common, obvious and intentional misspellings of the Complainant’s SAINT-GOBAIN mark) support the finding that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

Furthermore, this Panel concludes that the disputed domain name is being used in bad faith, putting emphasis on the following:

- the Complainant’s trademark SAINT-GOBAIN is distinctive and used as domain name to address the Complainant’s website, e.g., <saint-gobain.com>;
- the disputed domain name consists of common, obvious, or intentional misspellings of the Complainant’s trademark SAINT-GOBAIN which is a typical case of typosquatting which in itself constitutes bad faith;
- the Respondent has failed to present any evidence of any good faith use with regard to the disputed domain name;
- there is no conceivable plausible reason for good faith use with regard to the disputed domain name.

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 <salnt-goban.com> be transferred to the Complainant.

/Peter Burgstaller/

Peter Burgstaller

Sole Panelist

Date: February 13, 2024