

## **ADMINISTRATIVE PANEL DECISION**

Compagnie de Saint-Gobain v. Fabricio Saraiva Moreira, saintgobainsaint-gobainnet.com

Case No. D2024-3615

### **1. The Parties**

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

The Respondent is Fabricio Saraiva Moreira, saintgobainsaint-gobainnet.com, Brazil.

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

The disputed domain name <saintgobainsaint-gobainnet.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 September 6, 2024. On September 6, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 6, 2024, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 9, 2024, 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 September 9, 2024.

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 September 11, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 1, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 2, 2024.

The Center appointed Stefan Bojovic as the sole panelist in this matter on October 4, 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 French company specialized in the production, processing and distribution of materials for the construction and industrial markets. The Complainant has a revenue of over EUR 47.9 billion in 2023 and approximately 160,000 employees.

The Complainant is the owner of number of registered trademarks for the SAINT-GOBAIN trademark, including the following:

- European Union trademark registration No. 001552843 for SAINT-GOBAIN, registered on December 18, 2001; and
- International trademark registration No. 740183 for SAINT-GOBAIN, registered on July 26, 2000.

The Complainant also owns domain names that include its trademark SAINT-GOBAIN, such as the domain name <saint-gobain.com>, registered on December 29, 1995.

The disputed domain name was registered on September 5, 2024, and at the time of filing of the Complaint, it resolved to an “under construction” webpage. At the time of the Decision, the disputed domain name resolves to an inactive page. Furthermore, at the time of filing of the Complaint, based on the undisputed evidence produced by the Complainant, email exchange (“MX”) records were configured on the disputed domain name.

#### **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 disputed domain name is confusingly similar to its SAINT-GOBAIN trademark, which is recognizable within the disputed domain name and the addition of the words “saint”, “gobain” and “net” and the generic Top-Level-Domain (“gTLD”) “.com” does not prevent a finding of confusing similarity.

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant contends that the Respondent is not a licensee of the Complainant, that it is not affiliated with the Complainant in any way, and that the Complainant has not granted any authorization for the Respondent to make use of its SAINT-GOBAIN trademark. Although the Respondent’s organization has been indicated as “saintgobainsaint-gobainnet.com”, the Complainant asserts that no organization exists under that name and that the Respondent uses a confusingly similar business name to that of the Complainant in order to increase the likelihood of confusion with the Complainant. Furthermore, the disputed domain name resolves to a website under construction and the Complainant contends that the Respondent did not make any use of disputed domain name since its registration, and it confirms that the Respondent has no demonstrable plan to use the disputed domain name. It demonstrates a lack of legitimate interests in respect of the disputed domain name.

With reference to the circumstances evidencing bad faith, the Complainant states that its SAINT-GOBAIN trademark is extensively used throughout the world well before the registration date of the disputed domain name. Furthermore, previous panels have found that the Complainant’s trademark is well-known and the

Complainant therefore holds that the Respondent obviously knew about the prior rights and wide use of SAINT-GOBAIN trademark by the Complainant. The disputed domain name resolves to a website under construction and 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, such as being a passing off, an infringement of consumer protection legislation, an infringement of the Complainant's rights under trademark law, or an attempt to attract, for commercial gain, Internet users to his own website, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of the Respondent's website. Finally, the disputed domain name has been set up with MX records which suggests that it may be actively used for email purposes. This is also indicative of bad faith registration and use because any email emanating from the disputed domain name could not be used for any good faith purpose.

## **B. Respondent**

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

## **6. Discussion and Findings**

According to paragraph 15(a) of the Rules: "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." Paragraph 4(a) of the Policy stipulates that the complainant must prove each of the following:

- (i) that the disputed domain name registered by the respondent 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**

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.

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 structure of the disputed domain name is somewhat unusual, as the same incorporates the Complainant's SAINT-GOBAIN trademark twice (once with and once without hyphen) in combination with the term "net" within the Second-Level Domain ("SLD"). Nonetheless, the entirety of the Complainant's trademark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the Complainant's trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel holds that two versions of the Complainant's SAINT-GOBAIN trademark (with and without the hyphen) should not be perceived as additional terms within the disputed domain name, as the same are merely variations of the Complainant's trademark. Although the addition of other terms (here, "net") may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

In addition, it is well established that “.com”, as a gTLD, can be disregarded in the assessment of the confusing similarity between the disputed domain name and the Complainant’s trademark. [WIPO Overview 3.0](#), section 1.11.1.

The Panel, therefore, finds that 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.

The Panel notes that there seems to be no relationship between the Respondent and the Complainant and that the Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant’s SAINT-GOBAIN trademark. There appears to be no element from which the Panel could infer the Respondent’s rights and legitimate interests in the disputed domain name. Although the Respondent’s organization has been indicated as “saintgobainsaint-gobainnet.com”, this appears to be merely a reference to the disputed domain name and there appears to be no organization under such name. The Panel therefore holds that there is no evidence that the Respondent is known under the disputed domain name.

The Panel also finds that the structure of the disputed domain name, which contains the Complainant’s SAINT-GOBAIN trademark in two versions (with and without hyphen) and in combination with the word “net” carries a risk of implied affiliation. [WIPO Overview 3.0](#), section 2.5.1

Having in mind the above, 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.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In the present case, the Panel notes that the Respondent must have been aware of the Complainant and its SAINT-GOBAIN trademark, especially having in mind the long-standing use of SAINT-GOBAIN trademark throughout the world. It is, therefore, highly unlikely that the Respondent decided to register a domain name

containing this trademark in its entirety (and in two versions – with and without hyphen) without having the Complainant in mind when doing so. It should be also borne in mind that that the registration and use of SAINT-GOBAIN trademark predates the registration of the disputed domain name for decades, making it unlikely that the Respondent was not aware of the Complainant's trademark at the time of registration of the disputed domain name.

Due to the above, the Panel finds that the disputed domain name has been registered in bad faith.

Panels 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. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness of the Complainant's trademark, the composition of the disputed domain name and the fact that it is rather difficult to imagine any good faith use to which the disputed domain name may be put, and finds 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.

The Panel also considers that configuration of MX records on the disputed domain name can also contribute to the Respondent's bad faith. Based on the undisputed evidence provided by the Complainant, MX records were configured at the time of filing of the Complaint. Previous panels have held that mere configuration of such records can represent a risk of phishing or other fraudulent and abusive activities (see, for example, *Carrefour v. WhoisGuard, Inc., WhoisGuard Protected / Robert Jurek, Katrin Kafut, Purchasing clerk, Starship Tapes & Records*, WIPO Case No. [D2017-2533](#) and *Accenture Global Services Limited v. WhoisGuard Protected, WhoisGuard, Inc. / Basikta James*, WIPO Case No. [D2020-2955](#)). In a situation where a disputed domain name is confusingly similar to a third-party trademark that enjoys certain reputation, it is indeed, rather difficult to imagine any good faith use of the MX server attached to such a domain name.

Therefore, the Panel finds that the disputed domain name has been both registered and is being used in bad faith, and consequently 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 <saintgobainsaint-gobainnet.com> be transferred to the Complainant.

*/Stefan Bojovic/*

**Stefan Bojovic**

Sole Panelist

Date: October 18, 2024