

ADMINISTRATIVE PANEL DECISION

Compagnie De Saint-Gobain v. smyers smyers
Case No. DCO2023-0091

1. The Parties

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

The Respondent is smyers smyers, United States of America ("United States").

2. The Domain Name and Registrar

The disputed domain name <saint-gobains.co> is registered with NameCheap, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on October 19, 2023. On October 19, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 19, 2023, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 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 October 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 November 3, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 23, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on November 24, 2023.

The Center appointed Ganna Prokhorova as the sole panelist in this matter on December 8, 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 company incorporated in France. Founded 350 years ago, it has become a leading company specialized in the field of construction material, operating worldwide and employing nearly 170,000 people with its EUR 51.2 billion turnover in 2022.

The Complainant holds a number of trademark registrations for or containing "SAINT-GOBAIN" around the globe, including, *inter alia*, in the United States where the Respondent is based:

- International Trademark Registration No. 551682 for the mark SAINT-GOBAIN in Classes 1, 6, 7, 9, 11, 12, 16, 17, 19, 20, 21, 22, 23, 24, 37, 39, 41 registered on July 21, 1989,
- International Trademark Registration No. 740183 for the mark SAINT-GOBAIN in Classes 1, 2, 3, 6, 7, 8, 9, 10, 11, 12, 17, 19, 20, 21, 22, 23, 24, 37, 38, 40, 42 registered on July 26, 2000 designating United States.

The Complainant is the owner of many domain names, one of which is <saint-gobain.com> registered on December 29, 1995, which resolves to the Complainant's main website.

The disputed domain name was registered on October 9, 2023, and resolves to an inactive page.

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:

(a) The disputed domain name is identical or confusingly similar to the Complainant's trademark. The Complainant's trademark is reproduced in its entirety. The addition of the letter "s" is not sufficient to escape the finding that the disputed domain name is confusingly similar to the Complainant's trademark.

(b) The Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has not obtained any authorization from the Complainant to use the Complainant's trademark as part of a disputed domain name or otherwise. The Respondent is not known by the disputed domain name. Moreover, the disputed domain name is not being used in relation to a *bona fide* offering of goods or services and the Respondent is not making legitimate or fair use of the disputed domain name. The disputed domain name resolves to an inactive page. 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 it. It demonstrates a lack of legitimate interests in respect of the disputed domain name.

(c) Both the Respondent's registration and use of the disputed domain name establish the Respondent's bad faith. Given the history of the SAINT-GOBAIN brand and reputation that the Complainant has acquired in the Complainant's trademark, the Respondent obviously knew the prior rights and wide use of SAINT-GOBAIN by the Complainant. The disputed domain name resolves to a page with no activity and amounts to passive holding, which evidences bad faith registration and use.

B. Respondent

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

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all the elements listed in paragraph 4(a) of the Policy have been satisfied, as following:

- (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 in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Panel will further analyze the potential concurrence of the above circumstances.

Moreover, the Panel has taken note of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") and, where appropriate, will decide consistent with the consensus views captured therein.

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 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. The addition of the letter "s" is not sufficient to escape the finding that the disputed domain name is confusingly similar to the Complainant's trademark SAINT-GOBAIN.

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.

The Panel notes that the Respondent is not commonly known by the disputed domain name, whereas the Complainant has prior rights in the trademarks, which precede the Respondent's registration of the disputed domain name by years.

Furthermore, the Panel finds that the Respondent is not commonly known by the disputed domain name.

Moreover, the Respondent is not affiliated with the Complainant in any way. The Respondent has not been authorized by the Complainant to register or use the disputed domain name or to seek the registration of any domain name incorporating the Complainant's mark. The Complainant has not licensed or otherwise permitted the Respondent to use any of its trademarks or to register the disputed domain name incorporating its trademarks.

There is no evidence in the case file that the Respondent is conducting any *bona fide* business in connection with the disputed domain name under the circumstances where it resolves to an inactive website. Neither there is evidence that the Respondent has used or made demonstrable preparations to use the disputed domain name in connection with a legitimate noncommercial or fair use or a *bona fide* offering of goods and services.

Based on the available record, 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 with full knowledge of the Complainant's trademarks, and the Panel agrees. The term "saint-gobains" has no apparent existence or meaning except as a reference to the Complainant's SAINT-GOBAIN trademark and its services. Therefore, the Panel believes that the disputed domain name to be connected with such a well-known trademark but used by someone with no connection with the Complainant suggests opportunistic bad faith.

Prior UDRP panels have found that the non-use of a domain name 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. Having reviewed the available record, the Panel notes the reputation of the Complainant's trademark and the composition of the disputed domain name, 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 Respondent has not participated in these proceedings and has failed to rebut the Complainant's contentions and to provide any evidence of actual or contemplated good-faith use and indeed none would seem plausible.

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-gobains.co> be transferred to the Complainant.

/Ganna Prokhorova/

Ganna Prokhorova

Sole Panelist

Date: December 17, 2023