

## **ADMINISTRATIVE PANEL DECISION**

### **Compagnie De Saint-Gobain v. Navin Nimbrad, Saint Gobain Case No. D2023-0033**

#### **1. The Parties**

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

Respondent is Navin Nimbrad, Saint Gobain, India.

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

The disputed domain name <stgobainweber.com> (the “Domain Name”) is registered with Google LLC (the “Registrar”).

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 4, 2023. On January 5, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On January 5, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Contact Privacy Inc. Customer 7151571251) and contact information in the Complaint. The Center sent an email communication to Complainant on January 6, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on January 10, 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 Respondent of the Complaint, and the proceedings commenced on January 12, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 1, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on February 3, 2023.

The Center appointed John C. McElwaine as the sole panelist in this matter on February 17, 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**

Complainant is a French company involved in the production, processing, and distribution of materials for the construction and industrial markets. Relevant to this proceeding, Complainant owns a European Union Trademark registration for the SAINT-GOBAIN mark, Registration No. 001552843, registered on December 18, 2001, in International Classes 1, 2, 3, 6, 7, 8, 9, 10, 11, 12, 17, 19, 20, 21, 22, 23, 24, 37, 38, 40, and 42. In addition, Complainant owns the following International Trademark Registrations ("I.R."):

- SAINT-GOBAIN, I.R. No. 740184 registered on July 26, 2000;
- SAINT-GOBAIN, I.R. No. 740183 registered on July 26, 2000;
- SAINT-GOBAIN, I.R. No. 596735 registered on November 2, 1992; and
- SAINT-GOBAIN, I.R. No. 551682 registered on July 21, 1989.

Collectively, these trademark registrations are referred to herein as the "SAINT-GOBAIN Mark."

On December 23, 2022, Respondent registered the Domain Name with the Registrar. The Domain Name does not resolve to a functioning website.

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

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

As background information, Complainant alleges that it is global company based in France specializing in the sustainable habitat and construction markets. Complainant further alleges that its subsidiary, which is named Weber, is the leader in mortar-based solutions, with 10,000 employees and a presence in 60 countries worldwide.

With respect to the first element of the Policy, Complainant contends that the Domain Name is confusingly similar to its well-known and distinctive SAINT-GOBAIN Mark. In addition, Complainant points out that the Domain Name directly refers to the name of Complainant's subsidiary Saint-Gobain Weber.

With respect to the second element of the Policy, Complainant asserts that Respondent cannot have any rights or legitimate interests in the Domain Name because a) Respondent is neither known by the Domain Name nor has it been licensed by Complainant to use the Domain Name; and b) Respondent's passive holding of the Domain Name with no demonstrable plan to use the Domain Name demonstrates a lack of legitimate interests in respect of the Domain Name.

With respect to the third element of the Policy, Complainant alleges that given the distinctiveness of Complainant's SAINT-GOBAIN Mark and their reputation, it is reasonable to infer that Respondent registered the Domain Name with full knowledge of Complainant's trademark rights. Complainant points out that prior panels have held that the incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use. Lastly, Complainant provided evidence that several MX servers are configured for the Domain Name, which suggests that the Domain Name may be actively used for email purposes.

##### **B. Respondent**

Respondent did not reply to Complainant's contentions.

## 6. Discussion and Findings

Even though Respondent has defaulted, paragraph 4(a) of the Policy requires that, in order to succeed in this UDRP proceeding, Complainant must still prove its assertions with evidence demonstrating:

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

Because of Respondent's default, the Panel may accept as true the reasonable factual allegations stated within the Complaint and may draw appropriate inferences therefrom. See *St. Tropez Acquisition Co. Limited v. Anonymous Speech LLC and Global House Inc.*, WIPO Case No. [D2009-1779](#); *Bjorn Kassoe Andersen v. Direction International*, WIPO Case No. [D2007-0605](#); see also paragraph 5(f) of the Rules ("If a Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint"). Having considered the Complaint, the Policy, the Rules, the Supplemental Rules, and applicable principles of law, the Panel's findings on each of the above-cited elements are as follows.

### A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires Complainant to show that the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights.

Ownership of a trademark registration is sufficient evidence that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2. Complainant has provided evidence that it is the owner of trademark registrations for SAINT-GOBAIN. The Panel finds that Complainant owns valid trademark rights in the SAINT-GOBAIN Mark, and that the Domain Name is confusingly similar to this trademark as it is incorporated entirely and thus recognizable within the Domain Name. Therefore, Complainant has satisfied paragraph 4(a)(i) of the Policy.

### B. Rights or Legitimate Interests

Under the Policy, paragraph 4(a)(ii), Complainant has the burden of establishing that Respondent has no rights or legitimate interests in the Domain Name. Because it is difficult to produce evidence to support a negative statement, the threshold for the complainant to prove a lack of rights or legitimate interests is low. Complainant need only make a *prima facie* showing on this element, at which point the burden of production shifts to Respondent to present evidence that it has rights or legitimate interests in the Domain Name. If Respondent has failed to do so, Complainant is deemed to have satisfied its burden under paragraph 4(a)(ii) of the Policy. See *Vicar Operating, Inc. v. Domains by Proxy, Inc. / Eklin Bot Systems, Inc.*, WIPO Case No. [D2010-1141](#); see also *Nicole Kidman v. John Zuccarini, d/b/a Cupcake Party*, WIPO Case No. [D2000-1415](#); *Inter-Continental Hotels Corporation v. Khaled Ali Soussi*, WIPO Case No. [D2000-0252](#).

The Policy paragraph 4(c), provides a non-exhaustive list of circumstances in which a respondent could demonstrate rights or legitimate interests in a contested domain name:

- "(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

With respect to Complainant’s contention that Respondent is not commonly known by the Domain Name, the Panel notes that the Whois information lists Respondent as “Navin Nimbrad” and the Panel therefore finds, based on the record and the lack of evidence otherwise, that Respondent is not commonly known by the Domain Name. See *Moncler S.p.A. v. Bestinfo*, WIPO Case No. [D2004-1049](#) (“the Panel notes that the Respondent’s name is “Bestinfo” and that it can therefore not be “commonly known by the Domain Name.”). While the Respondent’s organization is listed as “Saint Gobain”, the Panel’s find such incorporation in the registration details was merely an attempt to misleadingly legitimize the registration of the Domain Name as if in connection with the Complainant, considering the Respondent’s lack of affiliation or authorization from the Complainant, as further described below and as addressed in the third element. The Respondent’s intent to affiliate the Domain Name with the Complainant is readily apparent in the composition of the Domain Name itself, wherein the Complainant’s trademark is coupled together with the name of the Complainant’s subsidiary, thus creating a risk of implied affiliation, contrary to the fact, which cannot constitute fair use.

Complainant contends it has not authorized, licensed, or permitted Respondent to use the SAINT-GOBAIN Mark, which is an *indicia* of a lack of rights or legitimate interests in the Domain Name. See e.g., *Cartier International A. G. v. Blogger Pty Ltd, Publishing Australia*, WIPO Case No. [DAU2013-0037](#) (finding that in the absence of any license or permission from the Complainant to use any of its trademarks or to apply for or use any domain name incorporating those trademarks, it is clear that no actual or contemplated *bona fide* or legitimate use of the domain name could be claimed by Respondent). Although Respondent has been properly notified of the Complaint by the Center, Respondent failed to submit any response to rebut these points. The Panel agrees that the silence of a respondent may support a finding that it has no rights or legitimate interests in respect of the domain name. See *Alcoholics Anonymous World Services, Inc., v. Lauren Raymond*, WIPO Case No. [D2000-0007](#); *Ronson Plc v. Unimetal Sanayi ve Tic.A.S.*, WIPO Case No. [D2000-0011](#).

Complainant contends, to the best of its knowledge, that Respondent has failed to make any use of the Domain Name since the date of registration. Complainant points out that Respondent’s Domain Name leads to an inactive website, and as such, is not in connection with a *bona fide* offering of goods or services pursuant to Policy paragraph 4(c)(i). See *Société nationale des télécommunications: Tunisie Telecom v. Ismael Leviste*, WIPO Case No. [D2009-1529](#) (noting that passive holding of a disputed domain name “does not constitute a legitimate use of such a domain name” that would give rise to a legitimate right or interest in the name); *Philip Morris USA Inc. v. Daniele Tornatore*, WIPO Case No. [D2016-1302](#) (Respondent had no rights or legitimate interests in the disputed domain name where the disputed domain name resulted to an inactive website); *Philip Morris USA Inc. v. Elijah Etame*, WIPO Case No. [D2016-0968](#) (“the Panel cannot imagine any potentially legitimate interest that Respondent might have in the disputed domain names based on the manner in which the disputed domain names have been used on the inactive websites”).

Based on the foregoing, Complainant has made a *prima facie* showing of Respondent’s lack of any rights or legitimate interests and Respondent has failed to come forward to rebut that showing. As provided for by paragraph 14 of the Rules, the Panel may draw such inference from Respondent’s default as it considers appropriate. The Panel finds that Respondent does not have rights or legitimate interests in the Domain Name and that Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

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

Under paragraph 4(a)(iii) of the Policy, Complainant must show that Respondent registered and is using the Domain Name in bad faith. A non-exhaustive list of factors constituting bad faith registration and use is set out in paragraph 4(b) of the Policy.

Bad faith registration can also be found where respondents “knew or should have known” of complainant’s trademark rights and nevertheless registered a domain name in which they had no right or legitimate

interest. See *Accor v. Kristen Hoerl*, WIPO Case No. [D2007-1722](#). Here, the SAINT-GOBAIN Mark represents the goodwill of a well-known, international brand. Complainant's SAINT-GOBAIN Mark was in use in commerce for decades before Respondent's registration of the Domain Name. Moreover, the fact that the name of Complainant's subsidiary was used demonstrates that the Respondent knew of Complainant and its corporate structure. Based on Complainant's submission, which was not rebutted by Respondent, Respondent must have known of Complainant's SAINT-GOBAIN Mark when it registered the Domain Name. See *WhatsApp Inc. v. Francisco Costa*, WIPO Case No. [D2015-0909](#) (finding that "it is likely improbable that Respondent did not know about Complainant's WHATSAPP trademark at the time it registered the Disputed Domain Name considering the worldwide renown it has acquired amongst mobile applications, and the impressive number of users it has gathered since the launch of the WhatsApp services in 2009".)

The fact that the Domain Name does not resolve to an active website does not obviate a finding of bad faith. When a domain name is being passively held, the question of bad faith does not squarely fall under one of the aforementioned non exhaustive factors set out in paragraph 4(b) of the Policy. The three-member panel in *Magazine Publishers Inc. and Les Publications Conde Nast S.A. v. ChinaVogue.com*, WIPO Case No. [D2005-0615](#), made the following observations in its determination that the respondent was acting in bad faith:

- (i) the complainant's trademark has a strong reputation and is widely known, as evidenced by its substantial use in the United States of America and in other countries;
- (ii) the respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the domain name;
- (iii) the respondent registered the domain name in 1999, and seems not to have been using the domain name;
- (iv) the respondent did not reply to the complainant's communications before the proceedings; and
- (v) the respondent did not reply to the complainant's contentions.

In this case, given the fact that Complainant's SAINT-GOBAIN Mark was combined with its subsidiary's name "Weber", it is apparent that Complainant has a known reputation. Respondent did not respond to the Complaint and has provided no evidence of its intended use of the Domain Name. However, given the unique nature of the SAINT-GOBAIN Mark, it is likely that the Domain Name was registered to draw an association with Complainant. See *e.g., Banco do Brasil S.A. v. Sync Technology*, WIPO Case No. [D2000-0727](#) (holding that the exact copying of Complainant's mark, which deprived Complainant from legitimately reflecting its mark in a corresponding domain name, constitutes bad faith use where domain is passively held). In fact, Complainant provided evidence that an MX server was configured for the Domain Name, which suggests that the Domain Name may be actively used for email purposes.

Based on the uncontested facts discussed in the previous sections, Respondent does not appear to have any rights or legitimate interests in the Domain Name nor does there appear to be any justification for Respondent's choice to register the Domain Name. Accordingly, on balance, there does not appear to be any other reason for Respondent's registration of the Domain Name other than for the possibility to trade off the goodwill and reputation of Complainant's SAINT-GOBAIN Mark or otherwise create a false association with Complainant. With no response from Respondent, this claim is undisputed. Lastly, the Respondent also engaged the use of a privacy service to mask its contact details and once disclosed, the Respondent's organization reflected an apparent attempt to legitimize the registration as if in connection with the Complainant. This is additionally evidence of bad faith registration and use.

In sum, the Panel finds that Respondent knew or should have known of Complainant's trademark rights and that Respondent's present passive holding of the Domain Name is evidence of registration and use of the Domain Name in bad faith. For these reasons, the Panel holds that Complainant has met its burden of showing that Respondent registered and is using the Domain Name in bad faith.

## 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 Domain Name, < saint-gobainweber.com > be transferred to Complainant.

*/John C McElwaine/*

**John C McElwaine**

Sole Panelist

Date: March 3, 2023