# Panel Decision for dispute CAC-ADREU-004103

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| Case number | CAC-ADREU-004103 |
| Time of filing | 2006-12-29 11:20:15 |
| Domain names | saintgobain.eu |

## Case administrator

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| Name | Josef Herian |

## Complainant

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| Organization / Name | Compagnie de saint-Gobain |

## Respondent

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| Organization / Name | GOALLOVER |

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

The Panel is not aware of any other pending legal proceeding regarding the disputed domain name.

FACTUAL BACKGROUND

GOALLOVER (hereafter the Respondent) registered the domain name SAINTGOBAIN.EU (hereafter the Domain Name) on April 7, 2006, first day of the Landrush period for ".eu".

Having noticed the registration, the French Company COMPAGNIE DE SAINT-GOBAIN (hereafter the Complainant) sent a cease and desist letter to the Respondent on July 4, 2006, informing of its trademark rights and requesting the transfer of the litigious domain name.

On July 13, 2006, the Respondent sent a reply stating that the Domain Name had been registered by the Respondent for and on behalf of a Greek individual, and specifying the costs to be considered for acquiring the Domain Name.

Among other documents the reply included an assignment deed to be returned dully signed.

A complaint under the Principles and Rules of ADR was officially filed by the Complainant on December 29, 2006.

The Respondent did not file any response within the 30 days time frame granted by the Court, which issued a notification of Respondent's default by April 2, 2007.

However, the Respondent challenged the notification of Respondent default on the same day.

The Court appointed a single-member Panel on April 10, 2007.

A. COMPLAINANT

The Complainant is the holding company acting on behalf of a worldwide known French group making business in a wide range of industrial areas, for years.

The Complainant claims it holds prior rights as trade and commercial name, domain name and trademark identical to the disputed Domain Name.

The Complainant then alleges that the Respondent accepts to re-assign the disputed Domain Name subject to the refund of its client's

costs, which are well above the reasonable costs for obtaining the registration of a ".eu" domain name. According to the Complainant, it is demonstrating the absence of rights or legitimate interests of the Respondent on the Domain Name in issue.

Last, the registration should be - according to the Complainant - considered as having been made in bad faith, having regard to the well established opininon of panels where the Respondent's sole intent was to sell the Domain Name.

The Complainant reminds the worldwide notoriety of the COMPAGNIE DE SAINT-GOBAIN, and draws especially the attention on the 15 daughter or affiliated companies in the United Kingdom which are using the name SAINT GOBAIN and could not have been ignored by the Respondent.

As a consequence the Complainant requests that the disputed Domain Name be transferred to its benefit.

B. RESPONDENT

Having consideration to the provisions set out in ADR Rules under Paragraph B3, and on a formal point of view, the Respondent should be considered in default, as having failed to submit a proper response within the 30 days time frame.

Nonetheless the respondent challenged the notification of default as allowed by the Rules.

Pursuant to Paragraph B3 (g) of the Rules, the Panel has to evaluate the merits of the challenge and decide whether it should cancel the notification of Respondent's default.

As to reasons for the challenge, the Respondent claims that the ADR proceedings has been filed improperly, as being taken against the incorrect party.

Following its reply to the formal notice sent by the Complainant in July 2006, the Respondent states that it is acting as a registration service provider, for and on behalf of third parties.

However the Panel did not find any evidence supporting the assertions made by the Respondent, especially on the fact that the disputed Domain Name has been registered upon request of a Greek individual.

Considering the provisions set out under Paragraph A1, according to the ADR Rules the Respondent is the domain name holder, in any case where the ADR is filed against speculative and abusive registrations.

According to the EURid WHOIS database, the disputed Domain Name SAINTGOBAIN.EU is held by the Respondent.

In the absence of any further statement by the Respondent, the Panel rejects the challenge of the notification of Respondent default, and finds the Respondent in default.

DISCUSSION AND FINDINGS

Article 22 of the EC Regulation 874/2004 states that an ADR procedure may be initiated by any party where the registration is speculative or abusive within the meaning of Article 21.

Article 21 (1) provides that a registered domain name shall be subject to revocation where the name is identical or confusingly similar to a name in respect of which a right is recognised or established by national and/or Community law, and where:

(a) it has been registered by its holder without rights or legitimate interests in the name; or

(b) it has been registered or is being used in bad faith.

With reference to the first element, the Panel finds that the Complainant has proved its rights on the name SAINTGOBAIN within the meaning of Article 10 (1) of the Regulation.

Indeed the Complainant owns numerous trademarks on the wording SAINT-GOBAIN, among which Community trademarks SAINT-GOBAIN since 1997 and also various national trademarks SAINT-GOBAIN in United Kingdom since 1990, where the Respondent is established.

The Panel is satisfied that the trademarks SAINT-GOBAIN are identical, or at the very least confusingly similar to the disputed Domain Name SAINTGOBAIN.EU. The hyphen has been considered in a number of previous ADR decisions as being a non distinguishable feature.

Furthermore the trademark SAINT-GOBAIN has become famous worldwide thanks to a wide and ancient use.

Lastly, the Complainant has provided evidence supporting its prior rights on SAINT-GOBAIN, as a business name, and especially as a domain name, where it holds the domain name SAINT-GOBAIN.COM.

With reference to the right or legitimate interest, Article 21 (2) of the Regulations states that “a legitimate interest may be demonstrated where:

(a) prior to any notice of an ADR procedure, the holder of the domain name has used the domain name or a name corresponding to it in connection with the offering of goods or services or has made demonstrable preparation to do so;

(b) it has been commonly known by the domain name;

(c) it is making a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name in which a right is recognised or established by national and/or community law.”

As previously ruled by the Panel, the Respondent is in default and thus has not proved any right or legitimate interest.

There is no relation, disclosed to the Panel, between the Complainant and the Respondent who did not contest any claim by the Complainant, or provide any evidence of right or legitimate interest in the Domain Name in issue. (see the Panel’s decision in ADR 4049 BORMIOLI ROCCO).

Therefore, the Panel finds that the Respondent has no right or legitimate interests in the domain name SAINTGOBAIN.EU.

The third requirement is that the domain name has been registered or is being used in bad faith.

As the Panel has already held that the Respondent has no right or legitimate interest in the disputed Domain Name there is no need to make a finding as to bad faith for the purposes of Article 21(1). However, as the issue has been argued by the Complainant the Panel finds it is relevant to provide its opinion.

The disputed Domain Name is not in use by the Respondent, neither is there any evidence of the Respondent’s intention or plans to make use of the domain name.

According to the evidence the Complainant has provided to the Panel, the Respondent has offered to transfer the disputed Domain Name subject to the so-called refund of its costs, which amount to more than 1100 €.

This offer is indisputably above the cost for a “.eu” domain name registration.

The Panel regards the aforementioned as an indication of that the domain name was registered primarily for the purpose of selling, renting or otherwise transferring the domain name to the holder of a corresponding name, in respect of which a lawfully recognized right exists (see ADR 00982 SMARTMACHINE)

Pursuant to the investigations made by the Panel, it has been established in a previous ADR decision with similar circumstances that the Respondent has been engaged in a pattern of such conduct. See ADR 01196 MEMOREX.

In the MEMOREX decision the Panel ruled that:
“since the Respondent must have been well aware of the MEMOREX brand, it is evident that the Respondent has registered the Disputed Domain Name in order to prevent the holder of the corresponding trademark registrations from reflecting the name in a corresponding domain name. Judging by the volume of the Respondent’s domain name registrations and the number of such registrations which directly call into mind a commonly known or well-known trademark, the Panel considers that the Respondent may well be considered to have engaged in a pattern of such conduct as meant in Article 21(3) (b) (i) of the Commission Regulation (EC) 874/2004.”

The Panel considers that the Complainant has established a prima facie evidence of the Respondent’s bad faith and the Respondent has

failed to deny or contest the Complainant's claims as well as failed to present any evidence to the contrary. The Panel therefore concludes that the Respondent has registered the domain name in bad faith.

Subsequently, as the criteria of bad faith required by Article 21 (1) (b) of the Commission Regulation (EC) No 874/2004 and Paragraph B 11 (d) (1) (iii) of the ADR Rules is already met, and the domain name is not in use by the Respondent, the Panel does not find it relevant with respect to the decision in this case to proceed to consider whether the disputed domain name is being used in bad faith.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that the domain name SAINTGOBAIN be transferred to the Complainant.

## PANELISTS

| Name | **Alexandre Nappey** |
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DATE OF PANEL DECISION 2007-05-14

## Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The domain name SAINTGOBAIN.EU has been registered during the landrush by the Respondent.
The Complainant sent a warning letter to inform the Respondent of its rights and request the amicable transfer of the domain name.
The Respondent offered to assign the domain name provided that the Complainant accept to bear its costs, which appeared to be well above the reasonable cost for a ".eu" registration.
The Respondent actually explained it was acting as a registration provider (but not as accredited registrar) on behalf of third parties.
An ADR complaint was filed by the Complainant alleging on abusive or speculative registration of a domain name identical to its trademarks, without any right or legitimate interest.
The Respondent was found in default but challenged the notification of default, considering that the ADR proceeding was taken against the incorrect party.

The Panel declines the challenge and confirms that the Respondent is in default. According to the EURid WHOIS database, the Respondent is the domain name holder.
Then the Panel considers that the domain name is identical or at the very least very similar to the prior trademark, domain name and trade name rights held by the Complainant.
Having failed to contest the Complainant assertions, the Respondent is found as having no right or legitimate interest in the domain name.
Subsequently, the Panel considers that the domain name has been registered primarily for the purpose of selling or renting by the respondent who has previously engaged in a pattern of such conduct.

Consequently, the Panel orders that the domain name SAINTGOBAIN.EU be transferred to the Complainant.