Decision for dispute CAC-UDRP-101690

Case number	CAC-UDRP-101690
Time of filing	2017-09-20 09:33:18
Domain names	BOUYGUES-BTP.COM

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	BOUYGUES TRAVAUX PUBLICS

Complainant representative

Organization	Nameshield (Maxime Benoist)

Respondent

Name	Christian GAZAIGNES

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that relate to the Disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the registrant of the following trademarks:

- French trademark registration No. 98763439, "BOUYGUES TP", registered on December 9, 1998, for goods and services in classes 37 and 42.

- International trademark registration No. 1234824, "BOUYGUES TRAVAUX PUBLICS", registered on September 22, 2014, for goods and services in classes 37 and 42.

- International trademark registration No. 949188, "BOUYGUES", registered on September 27, 2007, for goods and services in classes 6, 19, 37.

- International trademark registration No. 390770, "BOUYGUES", registered on September 1, 1972, for goods and services in classes 6, 19, 37, 42.

The Disputed domain name was registered by the Respondent on September 7, 2017.

FACTUAL BACKGROUND

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FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant, Bouygues SA, was founded by Francis Bouygues in 1952. It is a diversified industrial group, organized around the sectors of construction (Bouygues Construction, Bouygues Immobilier, and Colas); telecoms (Bouygues Telecom) and media (TF1).

The Complainant points out that Bouygues Travaux Publics is a subsidiary of Bouygues Construction, which in turn is a subsidiary of Bouygues Construction, a world player in the fields of building, public works, energy, and services.

The Complainant asserts that it has a worldwide reputation in public works, and carries out large civil engineering and infrastructure projects, underground works, linear projects, and river and maritime engineering in France and internationally, having since 1975 worked on projects in more than 80 countries.

The Complainant underlines that it is the owner of several international trademarks containing the word "BOUYGUES" and of the French trademark "BOUYGUES TP".

The Complainant adds that it is also the owner a number of domain names that contain the distinctive word "BOUYGUES", including the domain name <bouygues-tp.com>.

The Complainant states that the Disputed domain name is confusingly similar to its French trademark "BOUYGUES TP" and its international trademark "BOUYGUES".

The Complainant considers that the addition of the letter "B" before the letters "TP" in the Disputed domain name is not sufficient to avoid confusion with the Complainant's trademark "BOUYGUES TP".

The Complainant submits that the addition of the letter "B" is a misspelling of the trademark "BOUYGUES TP".

The Complainant points out that the word "BTP" is the acronym of "Bâtiment Travaux Publics", which is the wording commonly used in the French language for indicating the civil engineering sector.

The Complainant observes that when a distinctive mark is paired with less distinctive terms, the resulting combination is usually considered confusingly similar to the distinctive mark.

The Complainant claims that even with the addition of the letter "B" the Disputed domain name gives an overall impression of connection with the Complainant's trademarks.

For the above-mentioned reasons, the Complainant considers that the Disputed domain name is confusingly similar to the Complainant's trademarks.

The Complainant states that the Respondent is not authorized to use the Complainant's trademarks and that there is no affiliation between the Complainant and the Respondent.

The Complainant states that the Respondent has no right nor legitimate interest in the disputed domain name and that the Respondent is not related in any way to the Complainant's business. The Complainant declares that it does not carry out any activity for, nor has any business with the Respondent.

The Complainant observes that the Disputed domain name is not resolving to any active website. The Complainant considers that this fact demonstrates a lack of legitimate interest in respect of the Disputed domain name.

The Complainant argues that the Respondent has registered the Disputed domain name with the sole aim to prevent the Complainant to register it and that this can be considered as passive holding.

The Complainant notes that the Disputed domain name has been registered with a whois privacy service.

The Complainant adds that, after the registrar verification, it appears that the Respondent registered the Disputed domain name using false whois data and trying to pass himself as one of the Complainant's top managers.

On the basis of the above-mentioned elements the Complainant contends that the Respondent has no right or legitimate interests in respect of the Disputed domain name.

The Complainant argues that by registering the Disputed domain name with the misspelling of the trademark "BOUYGUES TP" the Respondent shows that his intention was to register a domain name confusingly similar to the Complainant's trademarks and that this fact is evidence of bad faith.

The Complainant points out that, given the distinctiveness and reputation of the Complainant's trademarks, it is reasonable to infer that the Respondent has registered the Disputed domain name with full knowledge of the Complainant's trademarks.

The Complainant considers also that the fact that the Disputed domain name does not resolve to any active website and that false whois data were used for the registration constitute further evidence of bad faith.

On these bases the Complainant concludes that the Respondent has registered and is using the Disputed domain name in bad faith.

In light of the above, the Complainant requests the transfer in its favor of the Disputed domain name.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

In accordance with paragraph 4(a) of the Policy, in order to obtain the transfer of the Disputed domain name, the Complainant has to demonstrate 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 in respect of the Disputed domain name; and

(iii) The Disputed domain name has been registered and is being used in bad faith.

IDENTICAL OR CONFUSINGLY SIMILAR

The first requirement that the Complainant must establish is that the Disputed domain name is identical with, or confusingly similar to, the Complainant's trademark or service mark rights.

There are two elements of this test: the Complainant must demonstrate that it has rights in a trademark or service mark and, if so, the Disputed domain name must be shown to be identical or confusingly similar to the trademark or service mark.

The Complainant has proven ownership of the registered trademarks, "BOUYGUES" and "BOUYGUES TP" , identified in section "Identification of rights" above.

On the question of identity or confusing similarity, what is required is simply a comparison and assessment of the Disputed domain name itself to the Complainant's trademarks.

The Disputed domain name differs from the Complainant's trademark "BOUYGUES TP" only by the addition of the hyphen, of the letter "B" after the hyphen, and of the top-level domain ".com".

The Panel observes that the distinctive part of the trademark "BOUYGUES TP" is the word "BOUYGUES", while the word "TP" is the acronym of the French words "Travaux Publics" (Public Works).

It is well accepted that the hyphen is not relevant in the confusing similarity test (see, for example, WIPO case No. D2016-0676).

It is a common view that where a trademark is the distinctive part of a domain name, the domain name is considered to be confusingly similar to the trademark (see, for example, WIPO case No. D2017-1266).

In the present case the letter "B" after the hyphen has no impact on the distinctive part "BOUYGUES TP" or "BOUYGUES". Furthermore, the word "BTP", which constitutes the second part of the Disputed domain name, has a specific meaning in the French language. Indeed, it is the acronym of "Bâtiment et Travaux Publics" (Building and Public Works), which is a wording commonly used for indicating the construction sector. It is well established that where the relevant trademark is recognizable within the domain name, the addition of other terms would not prevent a finding of confusing similarity.

It is also well established that the top-level domain may generally be disregarded in the confusing similarity test (see, for example, WIPO case No. D2016-2547).

Therefore, the Panel considers that the Disputed domain name is confusingly similar to the Complainant's trademarks.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

The second requirement that the Complainant must prove is that the Respondent has no rights or legitimate interests in the Disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in the Disputed domain name:

(i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the

[Disputed] domain name or a name corresponding to the [Disputed] domain name in connection with a bona fide offering of goods or services; or

(ii) [the Respondent] (as an individual, business, or other organization) [has] been commonly known by the [Disputed] domain name, even if [the Respondent] [has] acquired no trademark or service mark rights; or

(iii) [the Respondent] [is] making a legitimate noncommercial or fair use of the [Disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

This is a non-exhaustive list of circumstances in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement falls on the Complainant. UDRP panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”.

Accordingly, it is usually sufficient for a complainant to raise a prima facie case against the respondent and the burden of proof on this requirement shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name.

The Panel finds that the Complainant has made out a prima facie case that the Respondent does not have rights or legitimate interests in the Disputed domain name.

The Respondent has no affiliation with the Complainant.

The Complainant has not authorized the Respondent to use the Complainant's trademark.

In the absence of a Response by the Respondent, there is no indication in the present case that the Respondent is commonly known by the Disputed domain name.

Furthermore, the Respondent has failed to demonstrate any of the other non-exclusive circumstances evidencing rights or legitimate interests under the Policy, paragraph 4(c) or other evidence of rights or legitimate interests in the Disputed domain name.

The Respondent does not appear to be commonly known by the name "BOUYGUES" or by a similar name.

The Respondent does not appear to make any legitimate noncommercial or fair use of the Disputed domain name, nor any use in connection with a bona fide offering of goods or services.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

REGISTERED AND USED IN BAD FAITH

Under the third requirement of the Policy, the Complainant must establish that the Disputed domain name has been both registered and used in bad faith by the Respondent.

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, including:

(i) circumstances indicating that [the Respondent] [has] registered or [has] acquired the [Disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the [Disputed] domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of [the Respondent's] documented out-of-pocket costs directly related to the [Disputed] domain name; or

(ii) [the Respondent] [has] registered the [Disputed] domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the Respondent] [has] engaged in a pattern of such conduct; or

(iii) [the Respondent] [has] registered the [Disputed] domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the [Disputed] domain name, [the Respondent] [has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent's] web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the Respondent's] web site or location or of a product or service on [the Respondent's] web site or location.

The Panel, on the basis of the evidence presented, agrees with the Complainant's contentions that the Disputed domain name was registered in bad faith and that it has been used in bad faith.

In particular, the Panel accepts the Complainant's unchallenged assertions that the Respondent intentionally registered the Disputed domain name with the misspelling of the trademark "BOUYGUES TP". The Panel agrees that this fact constitutes evidence of registration in bad faith (see, for example, WIPO Case No. D2004-0971).

Indeed, taking into account the distinctiveness and reputation of the trademark "BOUYGUES", it is inconceivable that the Respondent was not aware of the Complainant's rights in the trademark "BOUYGUES" when registering the Disputed domain name. If the Respondent had legitimate purposes in registering and using the Disputed domain name it would have filed a Response in this proceeding.

Furthermore, it is well established that registration together with "inaction" or "passive holding" may constitute bad faith use (see, for example, WIPO case No. D2000-0075).

The Panel, having taken into account the distinctiveness and reputation of the Complainant's trademark, the fact that no response to the complaint has been filed, and the concealment of the Respondent's identity considers that the Disputed domain name was used in bad faith.

Accordingly, the Panel finds that the Disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **BOUYGUES-BTP.COM**: Transferred

PANELLISTS

Name	**Michele Antonini**

DATE OF PANEL DECISION 2017-10-30

Publish the Decision