Decision for dispute CAC-UDRP-101972

Case number	CAC-UDRP-101972
Time of filing	2018-04-25 08:41:27
Domain names	bouygues-constructions.com

Case administrator

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

Complainant

Organization	BOUYGUES S.A.

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	Jay thakkar

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner, among others, of the following trademark registrations relating to "BOUYGUES CONSTRUCTION" which enjoy protection in numerous countries:

- Word mark BOUYGUES CONSTRUCTION, France, Registration No. 99820969, registered on November 3, 1999 and duly renewed;

- Word mark BOUYGUES CONSTRUCTION, World Intellectual Property Organization (WIPO), Registration No. 732339, registered on April 13, 2000 and duly renewed;

- Word mark BOUYGUES CONSTRUCTION, Brazil, Registration No. 840723768, registered on August 2, 2016;

- Word mark BOUYGUES CONSTRUCTION, Perù, Registration No. S00081607, registered on May 2, 2014;

- Word mark BOUYGUES CONSTRUCTION, Philippines, Registration No. 4201411778, registered on January 9, 2015;

- Word mark BOUYGUES CONSTRUCTION, European Union Intellectual Property Office (EUIPO), Registration No. 1589159, registered on May 16, 2001 and duly renewed.

FACTUAL BACKGROUND

The Complainant, BOUYGUES S.A., was founded by Francis Bouygues in 1952. It is a diversified Group of industrial companies, structured by a strong corporate culture. Its businesses are centered on two hubs: (i) construction, with Bouygues Construction, Bouygues Immobilier, and Cola; and (ii) telecoms and media, with French TV channel TF1 and Bouygues Telecom. The Complainant points out that Bouygues Construction is a world player in the fields of building, public works, energy, and services.

The Complainant underlines that it is the owner of several trademarks consisting of the wording "BOUYGUES CONSTRUCTION". The Complainant also states that the disputed domain name <bouygues-constructions> is confusingly similar to its trademarks "BOUYGUES CONSTRUCTION" because the addition of the letter "s" at the end of the term "construction" is not sufficient to avoid confusion with the Complainant's trademark "BOUYGUES CONSTRUCTION".

The Complainant informs that the Respondent is not authorized to use the Complainant trademarks and that there is no affiliation between the Complainant and the Respondent. The Complainant also contends 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 points out that, given the distinctiveness and reputation of the Complainant's trademarks (prior UDPR panels have established that the trademark "BOUYGUES CONSTRUCTION" is well-known), it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademarks. The Complainant notes that the disputed domain name directs to a parking page with pay per click links in relation with the Complainant and its activity since its registration; therefore, in the Complainant's view, the Respondent has registered the disputed domain name with the aim of creating a likelihood of confusion between it and the Complainant´s trademarks and to take advantage of this confusion in the Internet users' minds.

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

Paragraph 4(a) of the Policy provides that to obtain the transfer of the disputed domain name, the Complainant must prove that each of the following elements is present:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

(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.

1) The Complainant has established that he has rights in the trademark "BOUYGUES CONSTRUCTION" at least since November 1999. The Complainant's trademark was registered well before with respect to the registration of the disputed domain name (April 8, 2018) and is widely well-known. The Panel finds that the disputed domain name is confusingly similar to the Complainant trademark "BOUYGUES CONSTRUCTION" as it includes the trademark "BOUYGUES CONSTRUCTION" in its entirety with the mere addition of (i) the letter "s" at the end of the term "construction" (ii) a hyphen between the words "bouygues" and "constructions" and (iii) the Top-Level domain ".com". Actually, in the Panel's view, the mere addition of the common plural signifier “s” does not avoid the confusing similarity between the disputed domain name and the mark (see SeeHalcyon Yarn, Inc. v. Henry Chan, WIPO Case No. D2004-0336; Dr. Ing. h.c. F. Porsche Aktiengesellschaft v. John Smith, WIPO Case No. D2014-1859; Bollore v. Tom Fey, CAC Case No. 101790). In addition, the panel agrees with previous decision in which it was stated that the presence of an hyphen in the disputed domain name does not take away the similarity between said domain name and the trademark (see, for example, Aktieselskabet af 21. november 2001 v. Zhang Lixiang, CAC Case No. 101920). Furthermore, in accordance with the consensus view of past UDRP panels, the Panel finds that the Top-Level domain ".com" is not sufficient to exclude the likelihood of confusion. The Complainant therefore succeeds on the first element of the Policy.

2) The Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain name as it is not commonly known under the disputed domain name and was never authorized to use it by the Complainant. The Respondent, in the absence of any Response, has not shown any facts or element to justify prior rights or legitimate interests in the disputed domain name. The Complainant therefore succeeds on the second element of the Policy.

3) Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:

(i) circumstances indicating that the Respondent has registered or 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 the 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 its website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location.

The Respondent registered the disputed domain name years after the use and registration of the "BOUYGUES

CONSTRUCTION" mark by the Complainant. The Complainant's prior registrations and longstanding use of the "BOUYGUES CONSTRUCTION" trademark suggest that the Respondent registered the disputed domain name with full knowledge of the Complainant and of its "BOUYGUES CONSTRUCTION" trademark (see Sanofi-Aventis v. Abigail Wallace, WIPO Case No. D2009-0735 and E. Remy Martin & C° v. Zhang Xiao, WIPO Case No. D2017-2102). Therefore, especially in consideration of the strong reputation achieved by "BOUYGUES CONSTRUCTION" the Panel's view is that the Respondent was surely aware of the Complainant's trademark when he registered the disputed domain name.

The Respondent parked the disputed domain name offering pay-per-click links in relation with the Complainant and its activity. This circumstance reveals the Respondent's primary motive in relation to the registration and use of the disputed domain name which is, in the Panel's view, to profit from the Complainant's goodwill in the "BOUYGUES CONSTRUCTION". According to previous decisions, by diverting Internet users to the website associated with the disputed domain name, the Respondent is benefiting from pay-per-click revenue and profits, which is evidence of use of the disputed domain name in bad faith (see, Accor SA v. Domain Administrator, PrivacyGuardian.org / Zhichao Yang, WIPO Case No. D2017-1322 and Accor SA v. Jan Everno, The Management Group II, WIPO Case No. D2017-2212).

As the conduct described above falls within paragraph 4(b)(iv) of the Policy (see Triumph International Vietnam Ltd v. Tran Quoc Huy, WIPO Case No. D2017-0340), the Panel concludes that the Respondent registered and is using the disputed domain name in bad faith pursuant to the paragraph 4(a)(iii) of the Policy. The Complainant therefore succeeds also on the third element 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-CONSTRUCTIONS.COM**: Transferred

PANELLISTS

Name	**Avv. Guido Maffei**

DATE OF PANEL DECISION 2018-05-23

Publish the Decision