Decision for dispute CAC-UDRP-103120

Case number	CAC-UDRP-103120
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Domain names	bouygues-constructionbtp.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	BOUYGUES

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Organization	Above.com Domain Privacy

OTHER LEGAL PROCEEDINGS

None of which the Panel is aware.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of an International trademark for BOUYGUES CONSTRUCTION®, n°732339 registered on April 13th, 2000 (hereinafter referred to as " the BOUYGUES CONSTRUCTION® trademark").

The Complainant is also the owner of numerous trademarks for BOUYGUES®, namely:
- The International trademark BOUYGUES n°390770 registered on September 1, 1972;
- The International trademark BOUYGUES n°390771 registered on September 1, 1972;
- The International trademark BOUYGUES n°949188 registered on September 27, 2007.

The Complainant has established its ownership of each of the foregoing trademarks by means of certificates of registration which the Panel accepts as evidence of the registrations.

FACTUAL BACKGROUND

The following matters relating to the factual background to the dispute are asserted by the Complainant in the Complaint. The Respondent has not filed a Response in the proceeding.

The Complainant is a French diversified group of industrial companies. Its businesses are centered on two hubs: construction, with Bouygues Construction, Bouygues Immobilier, and Colas; and telecoms and media, with French TV channel TF1 and Bouygues Telecom. Operating in 92 countries, the Complainant’s net profit attributable to the Group has amounted to 1,184 million euros.

The Complainant's subsidiary BOUYGUES CONSTRUCTION is a world player in the fields of building, public works, energy, and services as further elucidated on the Complainant's website at http://www.bouygues-construction.com.

As a global player in construction and services, BOUYGUES CONSTRUCTION designs, builds and operates buildings and structures which improve the quality of people's living and working environment: public and private buildings, transport infrastructures and energy and communications networks.

As a leader in sustainable construction, the Group and its 56,980 employees have a long-term commitment to helping their customers shape a better life .

The Respondent has registered the disputed domain name and caused it to resolve to a website that carries links promoting various goods and services that appear from the evidence adduced by the Complainant to be in potential competition with the Complainant. The Complainant has therefore filed this proceeding and requested that the disputed domain name be transferred to it.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:
Complainant made the following contentions.

1. Complainant is a French company engaged in construction, telecommunications and media. Its subsidiary BOUYGUES CONSTRUCTION is a world player in the fields of building, public works, energy, and services.

2. Complainant is the registered owner of the following trademarks :
- The International trademark BOUYGUES n°390770 registered since September 1,1972;
- The International trademark BOUYGUES n°390771 registered since September 1,1972;
- The International trademark BOUYGUES n°949188 registered since September 27, 2007;
- The International trademark BOUYGUES CONSTRUCTION® n°732339 registered since April 13, 2000.

3. Complainant also owns, through its subsidiary, a number of domain names including the same distinctive wording BOUYGUES CONSTRUCTION® such as <bouygues-construction.com>, registered since May 10th, 1999, and <bouygues-tp.com> registered since January 31st, 2013.

4. The disputed domain name <bouygues-constructionbtp.com> was registered on May 14th, 2020 and resolves to a parking page with commercial links.

5. The disputed domain name is confusingly similar to the trademarks BOUYGUES® and BOUYGUES CONSTRUCTION® as it is combined with the generic term “btp”, which is generally understood to mean “ batiments tyravaux publics” and in reference to Complainant, its subsidiaries and their activities, after the word “construction”. The addition of that term does not change the overall impression of the designation as being connected to the Complainant’s trademarks. It also does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademarks and the domain names associated and nor does the hyphen in the domain name or the generic top level domain ”.com.”

6. The Complainant has been recognized in prior UDRP decisions to have standing to bring UDRP proceedings.

7. Accordingly, the disputed domain name is confusingly similar to the Complainant's trademark BOUYGUES CONSTRUCTION®.

8. The Respondent does not have any rights or legitimate interests in the disputed domain name.

9. In support of establishing the prima facie case, the Complainant contends that it is required to make out only a prima facie case that the Respondent lacks rights or legitimate interests in the domain name and that the onus of proof then moves to the Respondent to demonstrate that it has rights or legitimate interests in the domain name.

10. Past panels have held that a Respondent is not commonly known by a disputed domain name if the WHOIS information shows that the domain name holder is not similar to the disputed domain name. The Respondent is not the same as or similar to the disputed domain name as shown by the Whois database in the present case. Nor has the Respondent acquired trademark mark rights on the expression used in the domain name.

11. The Respondent also has no rights or legitimate interests in respect of the domain name as it is not related in any way to the Complainant’s business.

12. The Complainant contends that the Respondent is not affiliated with it nor authorized by it in any way to use the BOUYGUES CONSTRUCTION®. trademark. The Complainant does not carry out any activity for, nor has any business with the Respondent.

13. The disputed domain name resolves to a parking page with competing commercial links which is not a bona fide offering of goods or services or a legitimate non-commercial or fair use.

14. For all of these reasons, the Respondent has no rights or legitimate interests in respect of the disputed domain name.

15. The disputed domain name has been registered and is being used in bad faith. That is so for the following reasons.

16. The domain name <bouygues-constructionbtp.com> is confusingly similar to the Complainant’s BOUYGUES CONSTRUCTION® trademark as it contains the trademark in its entirety. The BOUYGUES CONSTRUCTION® trademark is well-known. Moreover, the abbreviation “btp” in the domain name means “batiments travaux publics" and refers to the Complainant, its subsidiaries and their activities.

17. Given the distinctiveness of the Complainant's trademarks and reputation, it is reasonable to infer that the Respondent has registered the domain name with full knowledge of the Complainant's trademarks.

18. Furthermore, the disputed domain name redirects to a parking page with competing commercial links and the Respondent has thus attempted to attract Internet users for commercial gain to its own website by means of using the Complainant’s trademark and for its own commercial gain, which is evidence of bad faith.

19. Accordingly, the Respondent has registered and is using the disputed domain name in bad faith.

20. As the Complainant has made out all of the grounds specified in the Policy It follows that the Complainant is entitled to relief and the Panel should therefore order that the disputed domain name be transferred to the Complainant.

RESPONDENT:
The Respondent did not file a Response.

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

DISCUSSION AND FINDINGS

This is a mandatory administrative proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”) of the Internet Corporation for Assigned Names and Numbers (“ICANN”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the CAC Supplemental Rules.

A. Administrative deficiency.
By notification dated June 18, 2020 and in accordance with paragraph 4 (b) of the Rules, the CAC notified the Complainant that the Complaint was administratively deficient in that the Complaint had not sufficiently identified the Respondent. The notification invited the Complainant to have regard to the Registrar’s verification available in the online case file in the form of a non-standard communication regarding the appropriate identification of the domain name holder. On June 18, 2020, the Complainant filed an Amended Complaint and the CAC determined that the Complaint should be admitted to proceed further in the Administrative Proceeding.

The Panel has reviewed all of the above matters and makes a finding that within the meaning of paragraph 4(b) of the Rules, the administrative deficiencies have been corrected and that this matter has proceeded properly to the Panel in accordance with the Policy and the Rules.

B. Substantive matters
Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable. In that regard, the Panel also notes that the onus is on the Complainant to make out its case and past UDRP panels have consistently said that a complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

The Panel therefore turns to discuss the various issues that arise for decision on the facts as they are known.

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:
(i) The 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 domain name; and
(iii) The domain name has been registered and is being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.
A. Identical or Confusingly Similar

The Complainant has adduced evidence that the Panel accepts that it is the registered owner of the BOUYGUES

CONSTRUCTION® trademark and as such has rights in that trademark.

As stated above, the Complainant is also the registered owner of other BOUYGUES trademarks. However , the Complainant is obliged only to make its case by reference to one trademark and the BOUYGUES CONSTRUCTION® trademark is clearly much closer to the domain name than the other trademarks and the Panel will therefore determine the case by reference to that trademark. But it notes the other trademarks and finds that they underline the association between the Complainant and the BOUYGUES name.

The Panel next finds that the disputed domain name <bouygues-constructionbtp.com> is confusingly similar to the BOUYGUES CONSTRUCTION® trademark for the following reasons.

First, the domain name includes the entirety of the BOUYGUES CONSTRUCTION® trademark and those two words make up what is by far the dominant part of the domain name. Accordingly, the attention of the internet user would naturally be drawn to that part of the domain name and would inculcate in the mind of the internet user the idea that the domain name is an official domain name of the Complainant, as it includes the Complainant's well-known name and trademark.

Secondly, the domain name includes some letters that have been added to the expression BOUYGUES CONSTRUCTION® , namely "btp" which are widely understood to mean "batiments tyravaux publics" and as in reference to Complainant, its subsidiaries and their public building works activities. This can only strengthen in the mind of the internet user the notion that the domain name is an official domain name of the Complainant that is invoking the well-known activities of the Complainant.

Thirdly, the fact that the domain name would undoubtedly convey to the objective bystander that it related to the Complainant and its activities would also generate inevitable confusion which is at the essence of this element in the Policy.

It is also now well established that the addition of a generic top level domain, such as ".com" in the present case, cannot negate confusing similarity that is otherwise present, as it is in the present case.

Finally, the Complainant has cited several prior UDRP decisions which it correctly submits support all of the foregoing contentions.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's BOUYGUES CONSTRUCTION® trademark and the Complainant has thus shown the first of the three elements that it must establish.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

But by virtue of paragraph 4(c) of the Policy, it is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

(i) before any notice to you [respondent] 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 [respondent] (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 [respondent] are making a legitimate non commercial 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.

Thus, if a respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the domain name, the complainant will have failed to discharge its onus and the complaint will fail.

It is also well-established that a complainant is required to make out only a prima facie case that the respondent lacks rights or legitimate interests and that when such a prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent cannot do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

The Panel, after considering all of the evidence in the Complaint, finds that the Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name.

That prima facie case is made out from the following considerations.

The evidence of the Complainant is to the effect that the Respondent is not related in any way to the Complainant or the Complainant's business, is not affiliated with the Complainant or authorized by it in any way to use the BOUYGUES CONSTRUCTION® trademark and does not carry out any activity for, nor has any business with, the Complainant.

It is also clear from the evidence that the Respondent is not commonly known by the domain name under Policy paragraph 4(c)(ii).

The disputed domain name points to a parking page with competing commercial links which do not constitute a bona fide offering of goods or services or legitimate non-commercial or fair use. The Panel has examined the links as they appear on the Complainant's exhibit to that effect and it is plain that the links relate to various fields of activities of the Complainant such as "construction", "construction maison" and "emploi public". Thus, the Respondent, which is presumably being paid for carrying the links on its website, is dishonestly using the Complainant's trademark for its own commercial benefit. It is now well-established that such conduct cannot give rise to a right or legitimate interest in the domain name and the Panel so holds in the present proceeding.

Finally, the Complainant has cited several prior UDRP decisions which it correctly submits support all of the foregoing contentions.

These facts give rise to the prima facie case made out by the Complainant.

The Respondent has not filed a Response or made any other answer to the claims of the Complainant and is in default. Accordingly, the prima facie case has not been rebutted and the Complainant has therefore made out the second of the three elements that it must establish.

C. Registered and Used in Bad Faith

The Complainant must prove on the balance of probabilities both that the disputed domain name was registered in bad faith and that it is being used in bad faith: Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003.

Paragraph 4(b) of the Policy sets out four circumstances, any one of which is evidence of the registration and use of a domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive. The four specified circumstances are:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the 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 domain name; or
(ii) the respondent has registered the 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 domain name primarily for the purpose of disrupting the business of a competitor; or
(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to

the respondent's website 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 website or location or of a product or service on the site or location.

The Panel finds that the Complainant has shown that the Respondent registered and used the disputed domain name in bad faith both in general and in particular because the Respondent's conduct puts the case squarely within paragraph 4(b) (iv) of the Policy and probably within the other provisions of paragraph 4 (b) as well as within the general notion of bad faith.

That is so because the Complainant is right in submitting that the combination of several factors makes it clear beyond any doubt that the domain name has been registered and used in bad faith. The BOUYGUES CONSTRUCTION® trademark is well-known, the domain name includes an abbreviation that clearly invokes the Complainant's activities and the Respondent must therefore be taken to have registered the domain name with full knowledge of the Complainant's trademark. That is evidence of bad faith registration in itself.

Likewise, it is bad faith use when the Respondent proceeded to use the domain name to achieve its illegitimate objective. Moreover, the disputed domain name redirects to a parking page with commercial links to the Complainant's potential competitors and to other businesses in the same fields as the Complainant. By trading on this potential confusion, the Respondent has thus attempted to attract Internet users for commercial gain to its own website, which is evidence of bad faith.

The Respondent has also clearly registered the domain name primarily for the purpose of disrupting the business of a competitor, namely the Complainant, within the meaning of paragraph 4(b) (iii) of the Policy. Finally, knowing what the Respondent is prepared to do, the Panel finds that it would have been more than willing to sell the domain name to the Complainant if it could induce that result and to do so within the meaning of paragraph 4(b) (i) of the Policy or within the general notion of bad faith.

Finally, the Complainant has cited several prior UDRP decisions which it correctly submits support all of the foregoing contentions.

Accordingly, the Respondent has registered and used the disputed domain name in bad faith.

As the Complainant has succeeded in establishing all three elements under the Policy, it is entitled to the relief it seeks.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	**The Hon. Neil Brown, QC**

DATE OF PANEL DECISION 2020-07-14

Publish the Decision