

Decision for dispute CAC-UDRP-103668

Case number	CAC-UDRP-103668
Time of filing	2021-03-18 09:06:04
Domain names	fr-bouygues-construction.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	BOUYGUES
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Complainant representative

Organization	Nameshield (Enora Millocheau)
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Respondent

Organization	BOUYGUES CONSTRUCTION
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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 has provided evidence of ownership of the following trademarks:

International trademark BOUYGUES CONSTRUCTION, registered on 13th April 2000 under No. 732339, duly renewed, and covering services in international class 37.

FACTUAL BACKGROUND

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

The Complainant submitted references to prior panel decisions:

CAC Case No. 102808, BOUYGUES v. Anthony James <bouygues-construction-au.com> (“Whether the letters “au” may be intended as a geographic indication or not, their inclusion along with the Complainant’s distinctive mark does not avoid a finding of confusing similarity under the Policy. Said mark is clearly recognizable in the disputed domain name as the first and most dominant element thereof. Neither the letters “au”, nor the dashes or hyphens, serve to distinguish the disputed domain name from said mark. The generic Top-Level Domain, in this case “.com”, is typically disregarded for the purposes of the comparison exercise.”).

Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com> (“Here, the WHOIS information of record identifies Respondent as “Chad Moston / Elite Media Group.” The Panel therefore finds under Policy paragraph 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy paragraph 4(c)(ii).”).

CAC case No. 101387, BOUYGUES v. Laura Clare <bouygeus-construction.com> (“Here only two characters of the disputed domain name are different from the Complainant's well known registered mark [BOUYGUES CONSTRUCTION]”).

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

THE DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

The Complainant, Bouygues, is a French industrial group founded in 1952. The Complainant operates in various sectors including construction and real estate development.

The disputed domain name is confusingly similar to the Complainant's trademark "BOUYGUES CONSTRUCTION". The addition of the term "fr" and the hyphens are not sufficient to escape the finding that the domain name is confusingly similar to the trademark "BOUYGUES CONSTRUCTION". It does not change the overall impression of the designation as being connected to the Complainant's trademark "BOUYGUES CONSTRUCTION" and does not prevent the likelihood of confusion between the disputed domain name and the Complainant's trademark.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DOMAIN NAME

The Respondent has no rights to the disputed domain name, and any use of the trademarks "BOUYGUES CONSTRUCTION" has to be authorized by the Complainant.

The Respondent usurped the Complainant's subsidiary BOUYGUES CONSTRUCTION's identity whereas it is not affiliated with the Complainant.

Lastly, the Complainant states it did not find any fair or non-commercial uses of the disputed domain name at stake.

THE DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The domain name <FR-BOUYGUES-CONSTRUCTION.COM> was registered and is used in bad faith.

Given the distinctiveness of the Complainant's trademarks and its reputation, the Respondent has registered and used the domain name with full knowledge of the Complainant's trademark.

The Respondent usurped the Complainant's subsidiary's identity, which additionally evidences the Respondent's knowledge of the Complainant.

The current inactive use of the disputed domain name which reproduces the Complainant's trademark is a further evidence of bad faith registration and use on the part of the Respondent.

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

COMPLAINANT:

RESPONDENT:

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

Notwithstanding the fact that no Response has been filed, the Panel shall consider the issues present in the case based on the statements and documents submitted by the Complainant.

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following elements:

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

A. Identical or Confusingly Similar

The Complainant must establish that it has a trademark or service mark and that the disputed domain name is identical or confusingly similar to that trademark or service mark for the Complainant to succeed.

The Complainant, Bouygues, is a diversified group of industrial companies operating worldwide on several fields, notably in the construction and real estate development sectors.

As regards the question of identity or confusing similarity for the purpose of the Policy, it requires a comparison of the disputed domain name with the trademarks in which the Complainant holds rights. According to section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), "this test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name".

Also, according to section 1.7 of the WIPO Overview 3.0, "in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing".

The disputed domain name wholly incorporates the Complainant's trademark "BOUYGUES CONSTRUCTION" in addition to the term "fr", as well as hyphens. This addition does not prevent a finding of confusing similarity with the Complainant's

trademarks. The fact that a domain name wholly incorporates a complainant's trademark is sufficient to establish identity or confusing similarity for the purpose of the Policy, despite the addition of other words to such marks. In addition, the element "fr" in the disputed domain name may be understood as the country code for France, where the Complainant is established.

It is well accepted by UDRP panels that a generic Top-Level Domain ("gTLD"), such as ".com", is typically ignored when assessing whether a domain name is identical or confusingly similar to a trademark.

This Panel concludes that the disputed domain name is confusingly similar to the Complainant's trademark and therefore finds that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, any of the following circumstances, if found by the Panel, may demonstrate the respondent's rights or legitimate interests in the disputed domain name:

(i) before any notice to it 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 has been commonly known by the disputed domain name, even if it has acquired no trademark or service mark rights; or

(iii) the respondent is making a legitimate non-commercial 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.

The consensus view of UDRP panels on the burden of proof under paragraph 4(a)(ii) of the Policy is summarized in section 2.1 of the WIPO Overview 3.0, which states: "[...] where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element."

In the absence of rebuttal from the Respondent, the Panel finds that the Respondent impersonated the Complainant's subsidiary's identity in the whois information of the disputed domain name. Previous UDRP decisions have made clear that a respondent that uses a complainant's trade mark as part of its business, company or domain name without authorization cannot be considered to have demonstrated that it has been commonly known by that name or domain name. The adoption of the name in such circumstances is not legitimate as the intention is to create an impression of association with the Complainant. Hence this intention will never amount to a legitimate interest as it is often nothing more than a ruse to mask an illegitimate use of the Complainant's trade mark in a domain name. See WIPO case Case No. D2015-2245, BASF SE v. kou xiansheng, bashifurunhuayouwuxiyouxiangongsi.

The Complainant has not at any time authorised or licensed the Respondent to use BOUYGUES or BOUYGUES CONSTRUCTION as a domain name, business or trading name, trade mark or in any other way.

The Panel concludes that the Respondent has no right or legitimate interests in the disputed domain name and therefore finds that the requirement of paragraph 4(a)(ii) of the Policy is satisfied.

C. Registration and Use in Bad faith

For the purpose of Paragraph 4(a) (iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of the domain names in bad faith:

(i) circumstances indicating that the holder has registered or has 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 holders documented out-of-pocket costs directly related to the domain name; or

(ii) the holder 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 holder has engaged in a pattern of such conduct; or

(iii) the holder has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the holder has intentionally attempted to attract, for commercial gain, Internet users to the holder's 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 your website or location or of a product or service on the holder's website or location.

The Panel considers that the Respondent' conduct in this case constitutes bad faith registration and use of the disputed domain name within the meaning of paragraph 4(a)(iii) of the Policy. The evidence on the record shows that the Respondent was certainly aware of the existence of the Complainant and of the rights of the Complainant, in particular in light of the high notoriety of the Complainant and its trademarks.

Past UDRP panels held, the incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use.

The Panel must examine all the circumstances of the case to determine whether the Registrant is acting in bad faith. Examples of what may be circumstances found to be indicative of bad faith include the complainant having a well-known trademark, no response to the complaint having been filed, and the registrant's concealment of its identity. Panels may draw inferences about whether the domain name was used in bad faith given the circumstances surrounding registration, and vice versa.

The relevant issue is not limited to whether the Registrant is undertaking a positive action in bad faith in relation to the domain name, but instead whether, in all the circumstances of the case, it can be said that the Registrant is acting in bad faith.

In light of all the elements above, the Panel concludes that the Respondent has registered and is using the disputed domain name in bad faith, and finds that the requirement of paragraph 4(a)(iii) of the Policy is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. FR-BOUYGUES-CONSTRUCTION.COM: Transferred

PANELLISTS

Name	Arthur Fouré
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DATE OF PANEL DECISION 2021-04-21

Publish the Decision
