

Decision for dispute CAC-UDRP-104010

Case number	CAC-UDRP-104010
Time of filing	2021-09-13 09:14:21
Domain names	bouygues-travaux-publics-fr.com

Case administrator

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

Organization	BOUYGUES
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Complainant representative

Organization	NAMESHIELD S.A.S.
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Respondent

Organization	Ahmadou Sy
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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

Complainant states, and provides evidence to support, that it is the owner of certain trademark registrations that consist of or contain the mark BOUYGUES (the "BOUYGUES Trademark"), including Int'l Reg. No. 390771 for BOUYGUES (registered September 1, 1972) and French Reg. No. 1197244 (registered March 4, 1982); and BOUYGUES TRAVAUX PUBLICS (the "BOUYGUES TRAVAUX PUBLICS Trademark"), including Int'l Reg. No. 1234824 (registered September 22, 2014).

FACTUAL BACKGROUND

Complainant states that it is "a diversified group of industrial companies structured by a strong corporate culture" with businesses "centered on three sectors of activity: construction, with Bouygues Construction, Bouygues Immobilier, and Colas; and telecoms and media, with French TV channel TF1 and Bouygues Telecom." Complainant further states that it operates in more than 80 countries and has "net profit attributable to the Group" in the amount of 696 million euros.

The Disputed Domain Name was created on August 31, 2021, and is not being used in connection with an active website, although Complainant states that "there are several active MX records connected to the disputed domain name."

Complainant contends, in relevant part, as follows:

Paragraph 4(a)(i): Complainant states that the disputed domain name is confusingly similar to the BOUYGUES Trademark and the BOUYGUES TRAVAUX PUBLICS Trademark because it includes both of those trademarks in their entirety.

Paragraph 4(a)(ii): Complainant states that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because, inter alia, “Respondent is not identified in the Whois database as the disputed domain name”; “Respondent is not affiliated with nor authorized by the Complainant in any way”; “[n]either license nor authorization has been granted to the Respondent to make any use of the Complainant’s trademarks”; and “Respondent did not make any use of disputed domain name since its registration.”

Paragraph 4(a)(iii): Complainant states that the Disputed Domain Name was registered and is being used in bad faith because, inter alia, “given the distinctiveness of the Complainant’s trademarks and its reputation, it is reasonable to infer that the Respondent, a French organization, has registered and used the domain name with full knowledge of the Complainant’s trademark”; and “although the domain name appears to be unused, it has been set up with MX records... which suggests that it may be actively used for email purpose.”

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 UDRP).

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 UDRP).

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 UDRP).

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

Identical or Confusingly Similar: Paragraph 4(a)(i):

Based upon the trademark registrations cited by Complainant, it is apparent that Complainant has rights in and to the BOUYGUES Trademark and the BOUYGUES TRAVAUX PUBLICS Trademark.

As to whether the Disputed Domain Name is identical or confusingly similar to the BOUYGUES Trademark or the BOUYGUES TRAVAUX PUBLICS Trademark, the relevant comparison to be made is with the second-level portion of the Disputed Domain Name only (i.e., “bouygues-travaux-publics-fr”) because “[t]he applicable Top Level Domain (‘TLD’) in a domain name (e.g., ‘.com’, ‘.club’, ‘.nyc’) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.” WIPO Overview of WIPO Overview 3.0, section 1.11.1.

Here, the Disputed Domain Name contains the BOUYGUES Trademark as well as the BOUYGUES TRAVAUX PUBLICS

Trademark in its entirety plus the letters “fr”, which is an abbreviation for France. As set forth in section 1.7 of 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.” Further, section 1.8 of WIPO Overview 3.0 states: “Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.”

Accordingly, the Panel finds that Complainant has proven the first element of the UDRP.

Rights or Legitimate Interests: Paragraph 4(a)(ii)

Complainant states that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because, inter alia, “Respondent is not identified in the Whois database as the disputed domain name”; “Respondent is not affiliated with nor authorized by the Complainant in any way”; “[n]either license nor authorization has been granted to the Respondent to make any use of the Complainant’s trademarks”; and “Respondent did not make any use of disputed domain name since its registration.”

WIPO Overview 3.0, section 2.1, states: “While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of ‘proving a negative’, requiring information that is often primarily within the knowledge or control of the respondent. As such, 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.”

The Panel finds that Complainant has established its prima facie case and without any evidence from Respondent to the contrary, the Panel is satisfied that Complainant has satisfied the second element of the UDRP.

Registered and Used in Bad Faith: Paragraph 4(a)(iii)

Whether a domain name is registered and used in bad faith for purposes of the UDRP may be determined by evaluating four (non-exhaustive) factors set forth in paragraph 4(b) of the UDRP: (i) circumstances indicating that the registrant has registered or the registrant 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 registrant’s documented out-of-pocket costs directly related to the domain name; or (ii) the registrant 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 registrant has engaged in a pattern of such conduct; or (iii) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant’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 the registrant’s website or location or of a product or service on the registrant’s website or location.

Further, WIPO Overview 3.0, section 3.3, states: “From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or ‘coming soon’ page) would not prevent a finding of bad faith under the doctrine of passive holding.

“While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the

implausibility of any good faith use to which the domain name may be put.”

Accordingly, the Panel finds that Complainant has proven 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-TRAVAUX-PUBLICS-FR.COM:** Transferred

PANELLISTS

Name	Douglas M. Isenberg
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DATE OF PANEL DECISION	2021-10-19
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Publish the Decision
