

## Decision for dispute CAC-UDRP-104027

Case number	CAC-UDRP-104027
Time of filing	2021-09-27 09:19:42
Domain names	bouygues-travauxpublics-fr.com

### Case administrator

Organization	Denisa Bilík (CAC) (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	Francois Frederic
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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 is the owner of several trademarks BOUYGUES, such as the international trademark BOUYGUES n° 390771 registered since September 1, 1972 and the French trademark BOUYGUES n° 1197244 registered since March 4, 1982.

The Complainant is also the owner of the international trademark BOUYGUES TRAVAUX PUBLICS n°1234824 registered since September 22, 2014.

The Complainant also owns, through its subsidiary, a number of domain names including the same distinctive wording BOUYGUES TRAVAUX PUBLICS such as <bouygues-travaux-publics-region.com>, registered since July 6, 2010.

The disputed domain name <bouygues-travauxpublics-fr.com> was registered on September 7, 2021 and resolves to a page under construction. Besides, MX servers are configured.

#### FACTUAL BACKGROUND

Founded by Francis Bouygues in 1952, the Complainant is a diversified group of industrial companies structured by a strong

corporate culture. Its businesses are 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. Operating in over 81 countries, the Complainant's net profit attributable to the Group amounted to 696 million euros.

Its subsidiary BOUYGUES CONSTRUCTION is a world player in the fields of building, public works, energy, and services, one of its own subsidiaries, is an expert in complex projects involving tunnels, engineering structures and road, port and rail infrastructures. Operating in France and many other countries, the entity has acknowledged expertise in managing large-scale projects with high added value and in setting up PPP projects.

The Complainant contends that the disputed domain name is confusingly similar to its trademarks BOUYGUES and BOUYGUES TRAVAUX PUBLICS, because the trademarks BOUYGUES and BOUYGUES TRAVAUX PUBLICS are included in their entirety.

The Complainant contends that the addition of the abbreviation "FR" (for France) and hyphens is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademarks. It does not change the overall impression of the designation as being connected to the Complainant's trademarks. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant and its trademark.

Furthermore, the Complainant contends that the addition of the gTLD ".COM" does not change the overall impression of the designation as being connected to the Complainant's trademarks. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademarks and its domain names associated.

Thus, the Complainant is of the view, that the disputed domain name is confusingly similar to the Complainant's trademarks BOUYGUES and BOUYGUES TRAVAUX PUBLICS.

The Complainant asserts that the Respondent is not identified in the Whois database as the disputed domain name. Past panels have held that a Respondent was not commonly known by a disputed domain name if the WHOIS information was not similar to the disputed domain name.

The Complainant contends that the Respondent is not affiliated with nor authorized by the Complainant in any way. The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant does not carry out any activity for, nor has any business with the Respondent.

Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademarks BOUYGUES and BOUYGUES TRAVAUX PUBLICS, or apply for registration of the disputed domain name by the Complainant.

Furthermore, the disputed domain name to a page under construction. Therefore, the Complainant contends that Respondent did not make any use of disputed domain name since its registration, and it confirms that Respondent has no demonstrable plan to use the disputed domain name. It demonstrates a lack of legitimate interests in respect of the disputed domain name.

Thus, the Complainant contends that the Respondent has no right or legitimate interest in respect of the disputed domain name.

The Complainant states that the disputed domain name is confusingly similar to its well-known and distinctive trademarks BOUYGUES and BOUYGUES TRAVAUX PUBLICS.

Past panels have confirmed the notoriety of the trademark BOUYGUES. Besides, all of the results of a Google search of the terms "BOUYGUES TRAVAUX PUBLICS" refers to the Complainant and its subsidiaries.

Consequently, given the distinctiveness of the Complainant's trademarks and its reputation, it is reasonable in the view of Complainant to infer that the Respondent has registered and used the domain name with full knowledge of the

Complainant's trademark.

Furthermore, the domain name resolves to a page under construction. Besides, the disputed domain name has been set up with MX records. The Complainant contends that the Respondent has not demonstrated any activity in respect of the disputed domain name, and it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, an infringement of the Complainant's rights under trademark law, or an attempt to attract, for commercial gain, Internet users to his own website, by creating a likelihood of confusion with Complainant's trademark as to the source, sponsorship, affiliation or endorsement of Respondent's website.

As prior WIPO UDRP panels have 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.

Finally, 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 purposes.

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

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#### PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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#### 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).

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#### 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).

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#### 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).

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#### 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.

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#### PRINCIPAL REASONS FOR THE DECISION

##### A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires that the Complainant establish that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights. Consequently, the Complainant must prove that it has rights to a trademark, and that the disputed domain name is identical or confusingly similar to this trademark.

The Complainant owns "BOUYGUES" and "BOUYGUES TRAVAUX PUBLICS" trademark registrations effective in various jurisdictions.

The disputed domain name includes the Complainant's very long trademark BOUYGUES TRAVAUX PUBLICS in its entirety combined with the letters "fr" devided by a hyphen, which is short for France and relates to the Complainant's business destination in France.

The addition of the letters "fr" does not prevent a finding of confusing similarity under the first element.

The Panel finds that the addition of only two letters to the Complainant's very long trademark does not prevent a finding of confusing similarity under the first element.

Accordingly, the Panel finds that the disputed domain name is confusingly similar with the Complainant's respective trademark and hence the first element of the Policy has been fulfilled.

#### B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires that the Complainant establish that the Respondent has no rights or legitimate interests to the disputed domain name.

It is widely accepted among UDRP panels that once a complainant has made a prima facie showing indicating the absence of the respondent's rights or legitimate interests in a disputed domain name the burden of production shifts to the respondent to come forward with relevant evidence of such rights or legitimate interests. If the respondent fails to do so, the complainant is deemed to have satisfied the second element of the Policy (See, e.g., Document Technologies, Inc. v. International Electronic Communications Inc., WIPO Case No. D2000-0270 and section 2.1 of WIPO Overview 3.0).

The Complainant has credibly submitted that the Respondent is not a licensee of the Complainant, nor has it been otherwise allowed by the Complainant to use the Complainant's trademark in domain names or otherwise. The Complainant has also credibly submitted that the Respondent has no rights or legitimate interests to the disputed domain name.

Accordingly, the Panel finds that the Complainant has made a prima facie case that has not been rebutted by the Respondent. The Panel finds that there are no other circumstances that provide the Respondent with any rights or legitimate interests in the disputed domain name. Therefore, the Panel finds that the second element of the Policy is fulfilled.

#### C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires that the Complainant establish that the disputed domain name has been registered and is being used in bad faith. Paragraph 4(b) of the Policy provides that 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 a domain name in bad faith:

"(i) circumstances indicating that [the respondent 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 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 or 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 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 Panel agrees with Complainant that the combination of the distinctiveness of Complainant's famous trademark and its extensive use across the world for several decades and the copied very long trademark BOUYGUES TRAVAUX PUBLICS make it highly unlikely that the Respondent did not know about the Complainant before the registration of the disputed domain name.

Therefore, the Respondent knew or should have known that, when registering and using the disputed domain name, he would do so in violation of the Complainant's earlier rights.

Furthermore, the domain name resolves to a page under construction and is not actively used with content. Besides, the disputed domain name has been set up with MX records. The Panel finds that the Respondent has not demonstrated any activity in respect of the disputed domain name, and it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, an infringement of the Complainant's rights under trademark law, or an attempt to attract, for commercial gain, Internet users to his own website, by creating a likelihood of confusion with Complainant's trademark as to the source, sponsorship, affiliation or endorsement of Respondent's website.

As prior WIPO UDRP panels have 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 (WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows; WIPO Case No. D2000-0400, CBS Broadcasting, Inc. v. Dennis Toeppen).

Finally, 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 purposes. It is concluded that it is inconceivable that the Respondent will be able to make any good faith use of the disputed domain name as part of an e-mail address.

Hence, the Panel finds that the disputed domain name was registered and is being used in bad faith. Therefore, the Panel finds that the third element of the Policy is fulfilled.

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FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOUYGUES-TRAVAUXPUBLICS-FR.COM**: Transferred

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## PANELLISTS

Name	Jan Christian Schnedler, LL.M.
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DATE OF PANEL DECISION 2021-10-20

Publish the Decision

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