

Decision for dispute CAC-UDRP-104091

Case number	CAC-UDRP-104091
Time of filing	2021-10-25 09:42:15
Domain names	bouygues-travauxpublicsfr.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

Name	WARREN FREDERIC AOUMMEUR
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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 owns rights in the signs "BOUYGUES" and "BOUYGUES TRAVAUX PUBLICS" and shows its following trademarks have been accepted and are in force:

- International trademark BOUYGUES® No. 390771, registered on September 1, 1972 for goods and services in class 06, 19, 37 and 42;
- French trademark BOUYGUES® No. 1197244 registered on March 4, 1982 for goods and services in class 06, 16, 19, 28, 35, 37, 40, 41, 42, 43, 44 and 45;
- International trademark BOUYGUES TRAVAUX PUBLICS® No. 1234824 registered on September 22, 2014 for goods and services in class 37 and 42.

Complainant also operates domain names such as <bouygues-travaux-publics-region.com>, registered since July 6, 2010.

FACTUAL BACKGROUND

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

It is well-established that “a domain name that wholly incorporates a Complainant’s registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP”.

The Complainant provided a list of previous panel decisions:

- WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasily Terkin;
- 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 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy 4(c)(ii).”);
- WIPO Case No. D2000-1164, Boeing Co. v. Bressi (“the Respondent has advanced no basis on which he could conclude that it has a right or legitimate interest in the domain names”);
- Forum Case No. FA 1773444, Ashley Furniture Industries, Inc. v. Joannet Macket / JM Consultants (“The Panel finds that Respondent’s lack of content at the disputed domain shows the lack of a bona fide offering of goods or services or a legitimate noncommercial or fair use per Policy 4(c)(i) and (iii).”);
- CAC Case No. 101586, BOUYGUES v. 1&1 Internet Limited <bouygues-batiments-ile-de-france.com> (“The Respondent registered the Disputed domain name with full knowledge of the Complainant’s well-known trademark.”);
- WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows;
- WIPO Case No. D2000-0400, CBS Broadcasting, Inc. v. Dennis Toeppen;
- CAC Case No. 102827, JCDECAUX SA v. Handi Hariyono (“There is no present use of the disputed domain name but there are several active MX records connected to the disputed domain name. 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.”).

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

Complainant considers that the dispute domain name is confusingly similar to its registered trademarks BOUYGUES and BOUYGUES TRAVAUX PUBLICS.

Complainant establishes that its trademarks “BOUYGUES” and “BOUYGUES TRAVAUX PUBLICS” are distinctive and well-known.

Additionally, Complainant contends that the addition of the abbreviation “FR” (for France) is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademarks, which does not prevent any likelihood of confusion.

Complainant emphasizes that the addition of a specific top level of a domain name such as “.COM”, “.ORG”, “.TV” or “.NET” does not affect the domain name for the purpose of determining the identity or similarity of domain name and a trademark.

- Complainant further asserts that Respondent does not have any rights or legitimate interests in the disputed domain name.

Complainant recalls that it must make a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name, and that once such case is made, Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name.

Complainant argues that Respondent is not commonly known under the disputed domain name nor under the distinctive part "BOUYGUES" or "BOUYGUES TRAVAUX PUBLICS" before the beginning of the dispute, nor ownership of any identical or similar trademark, nor use of any identical or similar brand by the Respondent before the registration by the Respondent of the disputed domain name.

Moreover, Complainant asserts that Respondent was never granted neither license nor authorization to make any use of the disputed domain name.

Furthermore, Complainant highlights that Respondent did not 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 because Respondent has not provided the trademarked goods and services but has used the trademark for cybersquatting practice.

Finally, the disputed domain name resolves to a page under construction.

- Complaint finally comes down to the conclusion that Respondent's registration and use of the disputed domain name amounts to bad faith.

First, Complainant maintains that there is no indication that the disputed domain name was registered and used in bona fide and that it appears reasonable to infer that the Respondent, who is French, has registered and used the domain name with full knowledge of the Complainant's trademark.

Besides, Complainant affirms that it has a considerable reputation due to its expanded exposure and the distinctiveness of its trademark.

Complainant further asserts that the Internet makes it easier to find out that it is well-known across national borders because a simple search on the Internet would reveal Complainant trademark and domain names presence.

Thus, Complainant claims that it is not conceivable 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.

Regarding the passive holding of the disputed domain name by Respondent, Complainant relies that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding.

Besides, Complainant puts forward that its trademarks are distinctive and well-known in its industry. Therefore, Complainant believes that Respondent concealed its identity is also a factor to deduce bad faith.

Finally, Complainant contends that there is no plausible reason why Respondent registered the disputed domain name other than to intentionally attempt to attract for commercial gain Internet users to its website or another online location, and to tarnish the trademarks at issue, by creating a likelihood of confusion with the Complainant's trademarks.

RESPONDENT:

Respondent did not provide any response to the complaint, and is therefore in default.

RIGHTS

Complainant shown it has valid trademark rights in the “BOUYGUES” and “BOUYGUES TRAVAUX PUBLICS” signs.

The Panel agrees and considers Complainant’s trademark rights in the sign BOUYGUES TRAVAUX PUBLICS are established.

The Panel also agrees that the disputed domain name is confusingly similar to the disputed domain name as it identically reproduces Complainant’s trademarks “BOUYGUES” and “BOUYGUES TRAVAUX PUBLICS”, with the addition of the abbreviation “FR” (for France) and the gTLD “.COM”, which do not permit to dismiss the likelihood of confusion with the “BOUYGUES TRAVAUX PUBLICS” trademark.

Under Policy 4(a)(i), top-level domains are indeed generally disregarded in the similarity test, see ARCELORMITTAL (SA) v. acero, Case n° 102399 (CAC March 20, 2019) “As stated in 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” (see par. 1.7).

In the present case the Complainant’s “ArcelorMittal” trademark is clearly recognizable in the disputed domain name. The addition of the “mx” element does not change an overall impression of the disputed domain name and indicates connection with Mexico where the Complainant has business activity.

The .com domain zone shall be disregarded under the identity or the confusing similarity test as it does not add anything to the distinctiveness of the disputed domain name.

Therefore, the Panel finds that the first requirement of the Policy has been satisfied.”.

As a result, the Panel finds that Complainant has satisfied Policy 4(a)(i).

NO RIGHTS OR LEGITIMATE INTERESTS

Complainant shall make a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain name, under Policy 4(a)(ii). The burden of proof then shifts to Respondent. This standard and burden of proof have been established through continuous case law, see LESAFFRE ET COMPAGNIE v. Tims Dozman, Case No. 102430 (CAC, April 2, 2019) “The Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP (please see, for example, WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).”.

Complainant asserts that Respondent is not commonly known under the disputed domain name, and that Complainant never granted any right or authorization to Respondent to use Complainant’s trademarks.

In addition, it can be highlighted that Respondent did not reply to the complaint. Previous panels have held that such mutism from the Respondent’s part was proof that Complainant and Respondent had no relation and that Respondent is not commonly known under the disputed domain name (see FILEHIPPO S.R.O. v. whois agent, Case No. 102279 (CAC January 31, 2019), “In the absence of a response, the Panel accepts the Complainant’s allegations as true that the Respondent has no authorization to use the Complainant’s trademarks in the disputed domain name. Hence, as the Complainant has made out its prima facie case, and as the Respondent has not demonstrated any rights or legitimate interests as illustrated under paragraph 4(c) of the Policy, nor has the Panel found any other basis for finding any rights or legitimate interests of the Respondent in the disputed domain name, the Panel concludes that the Complainant has satisfied the requirements of

paragraph 4(a)(ii) of the Policy.”).

Therefore, the Panel concludes that Complainant has made a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name and has therefore satisfied Policy 4(a)(ii).

BAD FAITH

Complainant argues that given the distinctiveness and reputation of its trademark and domain name containing its trademarks “BOUYGUES”, Respondent could not ignore Complainant’s prior rights when registering the disputed domain name.

In addition, the Panel acknowledges the well-known nature of the “BOUYGUES” and “BOUYGUES TRAVAUX PUBLICS” trademarks in the fields of construction, telecoms and media. Therefore, Respondent could not ignore Complainant’s rights at the time of registration. Previous panels concluded that such domain name registration when the Complainant is well-known is a typical case of bad faith registration (see JCDECAUX SA v. Charles Russam, Case No. 102392 (CAC March 13, 2019) “According to most panels, the complainant is required to make out a prima facie case that the domain name has been registered and is being used in bad faith. Once such prima facie case is made, the respondent carries the burden of demonstrating that this is not the case.

To the Panel view, elements and information provided for by the Complainant at that stage, are sufficient to establish such prima facie case, notably because of the following:

- Given the reputation of the Complainant, the Respondent could hardly ignore the Complainant's existence and activities when registering the disputed domain name.”).

Complainant further asserts that the disputed domain name is the subject of a passive holding, which demonstrates the bad faith of Respondent.

Previous panels have found that such behaviour was evidence that Respondent was showing disputed domain name registration and use, in bad faith (see *Crédit Foncier de France v. WhoisGuard Protected, WhoisGuard, Inc. / Uyi Edionwe*, WIPO Case No. D2019-3037 (January 22, 2020), “Respondent is using the disputed domain name, which it registered long after Complainant’s trademark CRÉDIT FONCIER had become famous in France, to resolve to an inactive web site. Moreover, it is impossible to conceive of any legitimate use to which the disputed domain name could be put that would not constitute a bad faith use of Complainant’s well known trademark. See, e.g., *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003. Accordingly, the Panel finds that Respondent has registered and is using the disputed domain name in bad faith.”).

Consequently, the Panel finds that Respondent did not register the disputed domain name in connection to any bona fide offering of goods or services and that it then was not registered in good faith.

Therefore, Panel considers that the disputed domain name is also used in bad faith.

Following the above, the Panel considers that the disputed domain name was 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

Complainant holds trademark rights for the BOUYGUES and BOUYGUES TRAVAUX PUBLICS signs. The disputed domain name is reproducing Complainant's trademark. Respondent failed to establish legitimate rights or legitimate interests in the disputed domain name. Complainant has established that Respondent registered and uses the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BOUYGUES-TRAVAUXPUBLICSFR.COM**: Transferred
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PANELLISTS

Name	Nathalie Dreyfus
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DATE OF PANEL DECISION **2021-12-01**

Publish the Decision
