

Decision for dispute CAC-UDRP-104353

Case number	CAC-UDRP-104353
Time of filing	2022-02-14 09:00:51
Domain names	fr-bouyguesbatiment.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	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

BOUYGUES S.A. (the Complainant) is a diversified group of industrial companies centred 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 80 countries, the Complainant's net profit attributable to the Group amounted to 696 million euros.

The Complainant is the owner of several trademarks BOUYGUES BATIMENT, such as the international trademark BOUYGUES BATIMENT n°723515 registered since November 22, 1999, and the European trademark BOUYGUES BATIMENT n°001217223 registered since June 23, 1999.

The Complainant's subsidiary BOUYGUES CONSTRUCTION owns a number of domain names including the same distinctive wording BOUYGUES BATIMENT, such as <bouygues-batiment.com> registered since November 29, 2009.

Finally, the Complainant states and provides evidence to support, that it is the owner of a portfolio of trademarks BOUYGUES CONSTRUCTION, such as the international trademark BOUYGUES CONSTRUCTION, n°732339 registered since April 13,

2000.

The disputed domain name <fr-bouyguesbatiment.com> was registered on February 5, 2022, and resolves to a parking page.

FACTUAL BACKGROUND

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

The Complainant draws Panel attention to previous UDRP decisions:

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”. WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasilij 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).”).

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 [BOUYGUES BATIMENT].”).

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:

COMPLAINANT:

I. The disputed domain name is confusingly similar to the protected mark

According to the Complainant, the disputed domain name <fr-bouyguesbatiment.com> is confusingly similar to the BOUYGUES BATIMENT mark as the domain name fully incorporates the BOUYGUES BATIMENT mark, adding a hyphen and the abbreviation "FR" (for France) which, according to the Complainant, is not sufficient to escape the finding that the disputed domain name is confusingly similar to the BOUYGUES BATIMENT mark.

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 trademark and is not sufficient to escape the finding that the disputed domain name is confusingly similar to the Complainant's trademark.

II. The Respondent does not have any rights or legitimate interest in 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 trademark BOUYGUES BATIMENT, or apply for registration of the disputed domain name by the Complainant.

Finally, the Complainant provides that the disputed domain name resolves to a parking page. Therefore, the Complainant contends that the 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.

III. The disputed domain name has been registered and is being used in bad faith

According to the Complainant, the Respondent has registered and is using the disputed domain name in bad faith. The Complainant states that the disputed domain name is confusingly similar to its well-known and distinctive trademark and the domain name associated.

The Complainant further states that given the distinctiveness of the Complainant's trademarks and its reputation, it is reasonable to infer that the Respondent, who is French, has registered and used the domain name with full knowledge of the Complainant's trademark.

The Complainant is well-known, as it has activities all around the world, and all the Google results of the search of the terms "FR BOUYGUES BATIMENT" refer to the Complainant's entity BOUYGUES CONSTRUCTION, i.e. the parent company of BOUYGUES BATIMENT.

Furthermore, the disputed domain name resolves to a parking page. 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, or an infringement of the Complainant's rights under trademark law.

Finally, the Complainant provides that although the disputed 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.

PARTIES CONTENTIONS

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

The UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (UDRP) of the Internet Corporation for Assigned Names and Numbers (ICANN) (the "Policy") provides that complainant must prove each of the following to obtain transfer or cancellation of the domain name:

1. that respondent's domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights; and
2. that respondent has no rights or legitimate interests in respect of the domain name; and
3. the domain name has been registered and is being used in bad faith.

1) The disputed domain name is confusingly similar to a trademark in which the Complainant has rights

The Complainant has provided evidence and proved to be the owner of a trademark BOUYGUES BATIMENT.

The Panel finds that the disputed domain name <fr-bouyguesbatiment.com> fully incorporates the Complainant's BOUYGUES BATIMENT trademark. Essentially, the Respondent has appropriated the trademark BOUYGUES BATIMENT by adding a hyphen and the abbreviation "FR" (for France) to presumably lead consumers to believe that it is affiliated with the Complainant. Previous UDRP panels have found that the fact that a domain name wholly incorporates a complainant's registered mark is sufficient to establish identity or confusing similarity for the purposes of the Policy (see, e.g., Oki Data Americas Inc. v ASD, Inc., WIPO Case No. D2001-0903).

Additionally, the disputed domain name not only fully incorporates the BOUYGUES BATIMENT trademark but also includes a purely generic top-level domain ("gTLD") "com". Previous UDRP panels have also held that the gTLD ".com" is not to be taken into account when assessing whether a domain name is identical or confusingly similar to a trademark. See e.g., Wiluna Holdings, LLC v. Edna Sherman, FA 1652781 (Forum January 22, 2016). Moreover, the "use or absence of punctuation marks, such as hyphens, does not alter the fact that a name is identical to a mark."

The Panel finds that the disputed domain name <fr-bouyguesbatiment.com> shows a clear visual, phonetic and conceptual resemblance to the Complainant's BOUYGUES BATIMENT mark, and could confuse Internet users into thinking that the disputed domain name is associated with the Complainant or its trademarks.

In these circumstances, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark BOUYGUES BATIMENT.

2) The Respondent lacks rights or legitimate interests in the disputed domain name

Under the Policy, a complainant is required to make out a prima facie case that a respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy (see WIPO Overview 2.0, paragraph 2.1).

The Panel finds that the Respondent does not have a legal right to use the BOUYGUES BATIMENT mark as part of its domain name. The disputed domain name resolves to a parking page. The Respondent is not in any way affiliated with the Complainant, nor is it authorized to register the disputed domain name. Past panels have found it is not a bona fide offering of goods or services or legitimate non-commercial or fair use.

In a present case, the Respondent failed to file a Response in which it could have provided evidence in support of its rights or legitimate interests. Therefore, all these circumstances are sufficient to establish a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name.

The Panel thus takes the view that the Respondent lacks rights or legitimate interests in the disputed domain name.

3) The disputed domain name has been registered and is being used in bad faith

The Panel agrees with the Complainant that its trademark BOUYGUES BATIMENT is distinctive and well-known globally. The registration of the Complainant's well-known trademark BOUYGUES BATIMENT predates the registration of the disputed domain name. Given the distinctiveness of the Complainant's trademark and reputation, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark. Since the Complainant is present in France, as well as the Respondent, the addition of the abbreviation "FR" worsens the likelihood of confusion between the disputed domain name and the Complainant's trademark. The Panel finds that such actions constitute bad faith pursuant to paragraph 4(b)(iv) of the Policy, which provides: "by using the domain name, respondent has intentionally attempted to attract, for commercial gain, Internet users to respondent's web site 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 respondent's web site or location or of a product or service on respondent's web site or location."

The fact that the Respondent has registered the disputed domain name that is confusingly similar to them indicates and in the absence of any evidence contrary (or any administratively compliant response at all) being put forward by the Respondent, that the Respondent, according to this Panel, had knowledge of the Complainant's trademark and that it had such knowledge before the registration and use of the disputed domain name.

Further, the disputed domain name resolves to a parking page. The Panel thus takes the view that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or location by creating a likelihood of confusion with the Complainant's mark. This further suggests that the Respondent's sole intention in registering the disputed domain name was to take unfair advantage of the Complainant's BOUYGUES BATIMENT mark and reputation, and suggests registration and use in bad faith.

Accordingly, the Panel concludes that the Complainant has satisfied the third element of the Policy, that is that the Respondent's registration and use of 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. **FR-BOUYGUESBATIMENT.COM**: Transferred

PANELLISTS

Name	Mgr. Barbora Donathová, LL.M.
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DATE OF PANEL DECISION 2022-03-14

Publish the Decision
