

Decision for dispute CAC-UDRP-104204

Case number	CAC-UDRP-104204
Time of filing	2021-12-28 00:00:00
Domain names	bigmat-materiauxreunis.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	BIGMAT FRANCE
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Complainant representative

Organization	Ipside
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Respondent

Organization	Wang Wang
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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 claims rights on several trademark registrations composed with "BIGMAT", such as:

- The French trademark BIGMAT No 1725014, registered on August 16, 1990, for goods and services in classes 2, 6, 11, 16, 17, 19, 27, 28, 35, and 37, and dully renewed;
- The French trademark BIGMAT No 1718111, registered September 25, 1990, for goods and services in classes 2, 6, 11, 16, 17, 19, 27, 28, 35, 37 and 40, and dully renewed (which is the renewal of the French trademark No 1165268 registered on March 9, 1981, under the former French trademark law);
- The European Union trademark BIGMAT No 004144622, registered on November 22, 2004, for goods and services in classes 2, 6, 8, 11, 20, 35 and 37, and dully renewed;
- The international trademark BIGMAT No 463330, registered on September 9, 1981, for goods and services in classes 2, 6, 11, 16, 17, 19, 27, 35 and 37, dully renewed and designating Benelux, Switzerland, Germany, Spain and Italy;
- The international trademark BIGMAT No 855534, registered on January 10, 2005, for goods and services in classes 2, 6, 11, 19 and 37, dully renewed and designating Norway, Turkey, Albania, Bosnia and Herzegovina, Bulgaria, China, Algeria, Croatia, Montenegro, Morocco, Romania, Russian Federation, Serbia, the former Yugoslav Republic of Macedonia, Ukraine;
- The French trademark BIGMAT LES MATERIAUX ET LES CONSEILS DES PROS, No 93495592 registered on December 3,

1993, for goods and services in classes 2, 6, 11, 16, 17, 19, 27, 28, 35 and 37, and duly renewed;

- The French trademark BIGMAT AUX COTES DES HOMMES QUI BATISSENT No 3383736, registered on October 4, 2005, for goods and services in classes 2, 6, 8, 11, 17, 19, 27, 35 and 37, and duly renewed;

- The French trademark BIGMAT IMAT No 4319014, registered on December 1, 2016, for goods and services in classes 2, 6, 11, 19, 35 and 37;

- The French trademark MY BIGMAT No 4518839, registered on January 25, 2019, for goods and services in classes 9, 41 and 42;

- The French trademark BIGMAT LES BATISSEURS ONT LEUR MAISON No 4623164, registered on February 12, 2020, for goods and services in classes 2, 6, 17, 19, 27, 35 and 37;

- The French trademark L'ACADEMIE DES BATISSEURS MY BIGMAT No 4564294, registered on July 2, 2019, for goods and services in classes 9, 41 and 42; and

- The Tunisian trademark BIGMAT No TN/E/2004/2562, registered on December 8, 2004, for goods and services in classes 2, 6, 11, 19 and 37.

The Complainant relies on domain names composed with BIGMAT and generic terms, such as <bigmat-france.fr>, <bigmat-france.com>, <bigmat-france.net>, <bigmat-france.eu>, <bigmat-espacecarrelage.fr>.

FACTUAL BACKGROUND

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

The Complainant, the company BIGMAT FRANCE, is a French limited company organized as cooperative, registered on the Trade and Company Register of Paris (France). Since 1981, BIGMAT is well-known in France in the field of building and renovation materials.

BIGMAT FRANCE has 89 members in the cooperative representing 294 retail outlets. Among these members is the French company MATERIAUX REUNIS S.A.S, registered on the Trade and Company Register of Orléans (France).

The Respondent registered the domain name <bigmat-materiauxreunis.com> on October 6, 2021. This domain name is directed to a website with pornographic content.

The Complainant owns various trademarks with the wording "BIGMAT" in many countries including France, the European Union, Norway, Turkey, Albania, Bosnia and Herzegovina, Bulgaria, China, Algeria, Croatia, Montenegro, Morocco, Romania, the Russian Federation, Serbia, Ukraine and Ex-Yugoslav Republic of Macedonia.

The Complainant has been using the trademark in France as of 1981, and in the European Union as of 2004.

The Respondent is not a member of BIGMAT FRANCE and has no business in association with the Complainant.

On October 26, 2021, the Complainant sent a C&D letter to the abuse address contact of the Registrar which was available on the Whois, and never received any answer

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

COMPLAINANT'S CONTENTIONS

Confusing similarity

The Complainant submits that the disputed domain name <bigmat-materiauxreunis.com> is confusingly similar to the BIGMAT trademarks.

It contends that the disputed domain name wholly incorporates the distinctive element of the Complainant registered trademarks BIGMAT.

The Complainant contends that, since figurative, stylized or design elements in a trademark cannot be represented in a domain name, such elements shall be disregarded for the purpose of the assessment of the confusing similarity.

The word BIGMAT is the part of the disputed domain name that the consumer will remember.

The Complainant asserts that the wording MATERIEUXREUNIS separated by a hyphen from the word BIGMAT in the disputed domain name is just descriptive of products.

The Complainant claims that the disputed domain name <bigmat-materiauxreunis.com> is similar to the Complainant's registered trademarks BIGMAT, in which the Complainant holds prior rights.

No rights or legitimate interests

The Complainant claims that the Respondent has no prior rights or legitimate interests in respect of the disputed domain name.

The Complainant contends that the Respondent was not given any authorization to use the Complainant's trademark BIGMAT, or to register the disputed domain name.

The Complainant asserts that the Respondent is not known by, or commonly associated with the disputed domain name, nor has registered any trademark including "BIGMAT-MATERIEUXREUNIS". The Complainant has not submitted to the Panel evidence supporting this statement.

According to the Complainant, the Respondent cannot have rights or legitimate interests in the disputed domain name <bigmat-materiauxreunis.com>, because it is composed with the Complainant's trademark BIGMAT, with the addition of MATERIAUX REUNIS, which is the corporate name of one of the Complainant's members.

The Complainant claims that the use of the disputed domain name in relation to pornographic and gambling activities is detrimental to the image and notoriety of the Complainant.

Bad faith (in registration and in use)

The Complainant claims that the Respondent registered and used the disputed domain name <bigmat-materiauxreunis.com> in bad faith.

The Complainant asserts that the Respondent knew or should have known the existence of the Complainant's trademarks BIGMAT, because the Complainant's trademarks are widely known throughout France and Europe.

According to the Complainant, the WIPO Arbitration and Mediation Center has considered that this behavior is characteristic of registration and use in bad faith (WIPO Case No D2014-1693 Barclays Bank PL c. Andrew Barnes; WIPO Case No D2011-0874).

The Complainant contends that the Respondent is using the disputed domain name <bigmat-materieureunis.com> on a website featuring pornographic and online gambling content, which demonstrates that the main purpose of the disputed domain name registration is to attract Internet users, for commercial gain, by creating a likelihood of confusion with the Complainant trademarks BIGMAT.

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The disputed domain name is composed with the Complainant's trademarks BIGMAT.

The figurative elements of the registered trademarks BIGMAT is not relevant in the assessment identity or confusing similarity with the disputed domain name.

The position of the word BIGMAT at the beginning of the disputed domain name makes the Complainant's trademark BIGMAT immediately recognizable.

The disputed domain name only differs from the trademark BIGMAT by the addition of the term "MATERIEUXREUNIS", which is a generic term that does not avoid the confusing similarity.

Moreover, this generic term is the corporate name of one of the Complainant's members.

Thus, the disputed domain name <bigmat-materiauxreunis.com> is confusingly similar to the Complainant's trademarks BIGMAT.

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

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights or legitimate interests in the disputed domain name by demonstrating any of the following:

- (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 Respondent did not respond to the Complaint to rebut Complainant's prima facie case. Consequently, it did not provide any evidence or allege any circumstance to establish that it has rights or legitimate interests in the disputed domain name.

The Respondent is not related in any way with the Complainant, nor has ever been authorized by the Complainant to use the BIGMAT trademark to register the disputed domain name.

There is no indication that the Respondent is commonly known by the "BIGMAT" word.

There is no evidence of any use of the disputed domain name for gambling services.

The Respondent uses the disputed domain name for a website with pornographic content.

Therefore, the Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services.

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

Paragraph 4(b) of the Policy sets out examples of circumstances that will be considered by a Panel to be evidence of bad faith registration and use of the disputed domain name.

It provides that:

“For the purposes of paragraph 4(a)(iii), 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 the respondent 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 of a competitor; or
- (iv) by using the Domain Name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to your website 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 the respondent’s website or location or of a product or service on the respondent’s website or location.”

According to the Complainant, a simple Google search using the keyword “BIGMAT” only shows links to the Complainant’s website and its products or to the website of its members and sales outlets.

The trademark BIGMAT is used by the company called MATÉRIAUX RÉUNIS, which is a partner of the Complainant.

This is the only possible use of the trademark BIGMAT together with the corporate name "MATERIAUX REUNIS".

The Respondent was well aware of the Complainant’s rights on the well-known trademark BIGMAT when it registered the disputed domain name.

Given the use of the disputed domain name to resolve to adult content, the Panel is of the opinion that the Respondent has registered the disputed domain name primarily for the purpose of taking advantage of its reputation.

The Respondent has intentionally attempted to illegitimately attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant’s well-known trademark BIGMAT, in the meaning of paragraph 4(b) (iv) of the Policy.

The Panel is of the opinion that it is sufficient evidence for a finding of bad faith registration and use.

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 Respondent did not contest the complaint.

The disputed domain name <bigmat-materiauxreunis.com> incorporates the well-known BIGMAT trademark, with the addition of generic terms which are the corporate name of one of the Complainant's members. It means that the addition of these terms does not avoid any confusing similarity. The disputed domain name is therefore confusingly similar to the BIGMAT trademark.

The Respondent is not commonly known by the disputed domain name and is not related in any way with the Complainant nor has ever been authorized by the Complainant to use one of the many BIGMAT trademarks to register the disputed domain name. The use of the disputed domain name to resolve to adult content is not legitimate.

The Respondent was well aware of the well-known BIGMAT trademarks when it registered the disputed domain name that it used to attract internet users to a website offering adult content.

This is bad faith registration and use.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **BIGMAT-MATERIAUXREUNIS.COM**: Transferred

PANELLISTS

Name	Marie-Emmanuelle Haas, Avocat
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DATE OF PANEL DECISION 2022-02-01

Publish the Decision
