

## Decision for dispute CAC-UDRP-104963

Case number	CAC-UDRP-104963
Time of filing	2022-11-04 09:23:33
Domain names	bouygues-batiments-ile-defrance.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	Olivier Roussat
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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 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.

#### FACTUAL BACKGROUND

Founded by Francis Bouygues in 1952, BOUYGUES S.A. (the Complainant) is a diversified group of industrial companies structured by a strong corporate culture. Its businesses are 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 1,125 million euros.

The disputed domain name <bouygues-batiments-ile-defrance.com> was registered on October 24, 2022 and resolves to a page under construction. Besides, MX servers are configured on the disputed domain name.

#### PARTIES CONTENTIONS

The Complainant states that the disputed domain name <bouygues-batiments-ile-defrance.com> is confusingly similar to its trademark BOUYGUES BATIMENT®, He contends that the Respondent did not make any use of disputed domain name since its registration. The incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use.

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).

The domain name includes it in its entirety.

The addition of the letter “S” and the terms “ILE DE FRANCE” to the trademark is not sufficient to escape the finding that the domain name is confusingly similar to the trademark BOUYGUES BATIMENT®.

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”. Please see for instance WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasily Terkin.

On the contrary, it worsens the likelihood of confusion, as it directly refers to the BOUYGUES CONSTRUCTION’s subsidiary BOUYGUES BATIMENT ILE DE FRANCE.

Besides, the addition of the gTLD suffix “.COM” is not sufficient to escape the finding that the disputed domain name is confusingly similar to the Complainant’s trademark and does not change the overall impression of the designation as being connected to its trademark.

Indeed, as reminded in the WIPO Overview 3.0 §1.11.1, “the applicable Top Level Domain (“TDL”) 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 confusion similarity test”.

Finally, previous Panel confirmed the right of the Complainant:

- WIPO Case No. D2022-1926, Bouygues v. JEAN-CLAUDE RINGUETTI / Technical Support <bouygues-batiments-iledefrance.com>;
- WIPO Case No. D2022-1334, BOUYGUES Gerald Jean Billion <bouyguesbatiments-iles-de-france.com>;
- WIPO Case No. D2019-1693, Bouygues Redacted for privacy / Rafael Vivier <bouygues-batiments-iles-de-france.com>.

Consequently, the disputed domain name is confusingly similar to the Complainant’s trademark.

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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).

According to the WIPO Case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd., a 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 domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

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.

See for instance 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).”).

The Respondent is not affiliated with nor authorized by the Complainant in any way. 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.

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

Thus, in accordance with the foregoing, the Respondent has no right or legitimate interest in respect of the disputed domain name.

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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).

The disputed domain name <bouygues-batiments-ile-defrance.com> is confusingly similar to its well-known and distinctive trademark and domain names associated. Past panels have confirmed the notoriety of the trademark BOUYGUES BATIMENT®.

See 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].").

Besides, the Complainant is well-known, as it has activities all around the world and all the Google results of the search of the terms "BOUYGUES BATIMENTS ILE DE FRANCE" refers to the Complainant's entity BOUYGUES BATIMENT ILE DE FRANCE.

Consequently, 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.

Furthermore, the disputed domain name resolves to a parking page and MX servers are configured. 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.

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.

Besides, 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. See similar case 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.").

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

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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

The incorporation of a famous mark into a domain name, coupled with an inactive website, is evidence of bad faith registration and use. 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 e-mail purposes.

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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-batiments-ile-defrance.com: Transferred

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## PANELLISTS

Name	Thomas Hoeren
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DATE OF PANEL DECISION 2022-11-26

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Publish the Decision

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