

Decision for dispute CAC-UDRP-105064

Case number	CAC-UDRP-105064
Time of filing	2022-12-20 08:47:03
Domain names	bouygues-es-energie.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	rolland rubini
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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 consisting of the term "BOUYGUES®", such as the international trademark registration BOUYGUES® n° 390771 registered since September 1, 1972 as well as the international trademark BOUYGUES ENERGIES & SERVICES® n° 1172555 registered since March 22, 2013.

Furthermore, the Complainant owns, through its subsidiary BOUYGUES CONSTRUCTION S.A., a number of domain names including the same distinctive wording BOUYGUES® such as <bouygues-es.com>, registered since October 26, 2012.

FACTUAL BACKGROUND

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

The Complainant was founded in 1952 and it is a diversified group of industrial companies 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 80 countries, the Complainant's net profit attributable to the Group amounted to 1,125 million euros.

The Complainant has different subsidiaries, including: BOUYGUES CONSTRUCTION (in the fields of building, public works, energy,

and services) and BOUYGUES ENERGIES & SERVICES (in the fields of designing, building, maintaining and operating infrastructure, buildings and industrial facilities).

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 trademarks including the terms BOUYGUES & ENERGIES, such as the international trademark BOUYGUES ENERGIES & SERVICES® n°1172555 registered since March 22, 2013.

The Complainant also owns, through its subsidiary BOUYGUES CONSTRUCTION S.A., a number of domain names including the distinctive wording BOUYGUES® such as <bouygues-es.com>, registered since October 26, 2012.

The disputed domain name <bouygues-es-energie.com> was registered on December 11, 2022 (hereinafter, the “Disputed Domain Name”).

The Complainant argues that the Disputed Domain Name was registered by Rolland Rubini based in France and it resolves to a website copying the Complainant subsidiary BOUYGUES ENERGIES & SERVICES’ official website <https://www.bouygues-es.fr/energies>.

According to Complainant’s non-contested allegations, the Respondent has no rights or legitimate interest in respect of the Disputed Domain Name and the Complainant is not related in any way to the Complainant’s business.

For the purpose of this case, the Registrar confirmed that the Respondent is the current registrant of the Disputed Domain Name and that the language of the registration agreement is English.

The facts asserted by the Complainant are not contested by the Respondent.

PARTIES CONTENTIONS

COMPLAINANT:

First element: Similarity

The Complainant states that the Disputed Domain Name is confusingly similar to its trademark “BOUYGUES®”.

The Complainant asserts that the addition of the letters “ES” plus the generic term “ENERGIE” are not sufficient to change the overall impression of the designation as being connected to the Complainant’s trademark BOUYGUES®. It does not prevent the likelihood of confusion between the Disputed Domain Name and the Complainant, its trademark and the domain names associated.

The addition of the letters “ES” directly refers to the Complainant’s trademark BOUYGUES ENERGIES & SERVICES® and domain names, and thus worsens the likelihood of confusion.

Second element: Rights or legitimate interest

The Complainant contends that the Respondent is not known as the Disputed Domain Name at the Whois database.

Additionally, 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®, or apply for registration of the Disputed Domain Name by the Complainant.

Furthermore, the Disputed Domain Name resolves to a website copying BOUYGUES ENERGIES & SERVICES’ official website <https://www.bouygues-es.fr/energies>. Thus, the Respondent is not using the Disputed Domain Name in connection with a bona fide offering of goods or services or a legitimate noncommercial or fair use.

Third element: Bad faith

The Complainant states that the Disputed Domain Name is confusingly similar to its trademark BOUYGUES®.

Besides, the Complainant and its subsidiaries are well-known and present worldwide. Thus, the Respondent should have known about the Complainant at the time of the registration of the Disputed Domain Name.

Finally, the Disputed Domain Name resolves to a website copying BOUYGUES ENERGIES & SERVICES’ official website <https://www.bouygues-es.fr/energies>. Therefore, the Complainant contends that the Respondent intentionally attempts to attract, for commercial gain, Internet users to Respondent’s website or other online location by creating a likelihood of confusion with

Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of Respondent or of a product or service on Respondent's website.

RESPONDENT

Respondent did not reply to the Complaint

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

According to Paragraph 4(a) of the Policy, the complainant is required to prove each of the following three elements to obtain an order that a domain name should be transferred or cancelled:

- (i) the domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the domain name has been registered and are being used in bad faith.

The Panel has reviewed in detail the evidence available to it and has come to the following conclusions concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in the proceeding:

(A) THE COMPLAINANT'S RIGHTS AND CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAME TO THE COMPLAINANT'S RIGHTS.

Paragraph 4(a)(i) of the Policy establishes the obligation of the Complainant to demonstrate that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant submitted copies of the following international trademark registrations:

1. The International trademark BOUYGUES® n° 390771 registered since September 1, 1972 at classes 6, 19, 37 & 42;
2. The French trademark BOUYGUES® n° 1197244 registered since March 4, 1982 at classes 6, 16, 19, 28, 35, 37, 40, 41, 42, 43, 44 & 45;

As provided at the evidence, the Complainant's trademarks were registered prior to 2022, the year of the creation date of the Disputed Domain Name.

In the current case, the Disputed Domain Name is composed of the trademark BOUYGUES® together with the letters "ES" plus the

generic term “ENERGIE”. In assessing confusing similarity, the Panel finds the Disputed Domain Name is indeed confusingly similar to the Complainant’s trademark, as it incorporates the entirety of the BOUYGUES® trademark plus the letter ES and the generic term ENERGIE. In this sense, UDRP panels agree that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. See paragraph 1.8. of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition 3.0 (“WIPO Jurisprudential Overview 3.0”).

UDRP panels agree that the TLD may usually be ignored for the purpose of determination of identity or confusing similarity between a domain name and the Complainant’s trademark as it is technical requirement of registration. See paragraph 1.11.1 of WIPO Jurisprudential Overview 3.0.

Therefore, the Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy and the Disputed Domain Name is confusingly similar to Complainant’s “BOUYGUES®» trademark.

(B) RESPONDENT’S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAME.

The second element of the Policy requires that the Complainant establishes that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The generally adopted approach, when considering the second element, is that if a complainant makes out a prima facie case, the burden of proof shifts to the respondent to rebut it with relevant evidence demonstrating rights or legitimate interests in the domain name; see, for example, CAC Case No. 102333, Amedei S.r.l. v sun xin. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (see e.g. WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

In this regard, Paragraph 4 (c) provides with circumstances which could prove rights or legitimate interest in the Disputed Domain Name on behalf of the Respondent such as:

- (i) before any notice to Respondent of the dispute, Respondent is using or provides with demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) The Respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the Respondent has acquired no trademark or service mark rights; or
- (iii) The Respondent is making a legitimate noncommercial or fair use of the 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 reply to the Complaint despite the efforts made by this Center to notify the Complaint. In this regard, the Complainant has confirmed in the Complaint that the Disputed Domain Name is not connected with or authorized by the Complainant in any way.

From the information provided by the Complainant, there is no evidence or reason to believe that the Respondent (as individual, business or other organization) has been commonly known by the Disputed Domain Name.

The Respondent’s name “Rolland Rubini” is all what it links the Disputed Domain Name with the Respondent. Absent of any other evidence such as a personal name, nickname or corporate identifier, the Panel is of the opinion that the Respondent is not commonly known by the Disputed Domain Name.

The Complainant indicates that they have not granted authorization to the Respondent to use their “BOUYGUES®” trademarks. Furthermore, the Complainant asserts that the Respondent is not affiliated with him nor authorized in any way to use the trademark “BOUYGUES®”.

In terms of the evidence provided by the Complainant, the website linked to the Disputed Domain Name resolves to a website replicating the Complainant’s subsidiary official website <https://www.bouygues-es.fr/energies>, which confirms the intention of the Respondent to set up the Disputed Domain Name with intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue and, therefore, the Panel neither finds a bona fide offering of goods and service nor legitimate non-commercial or fair use of the Disputed Domain Name.

Past Panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent.

See paragraph 2.13.1 of WIPO Jurisprudential Overview 3.0.

In light of the reasons above mentioned, the Panel concludes that the Complainant has satisfied the second element of the Policy.

(C) BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME.

Paragraph 4(a)(iii) of the Policy indicates that the Complainant must assert that the Respondent registered and is using the Disputed Domain Name in bad faith. In this sense, Paragraph 4(b) of the Policy sets out four circumstances which if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- circumstances indicating that the Respondent has registered or acquired the Disputed Domain Name primarily for the purpose

of selling, renting, or otherwise transferring the Disputed 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 Disputed Domain Name; or

- The Respondent has registered the Disputed 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 Respondent has engaged in a pattern of such conduct; or
- The Respondent has registered the Disputed Domain Name primarily for the purpose of disrupting the business of a competitor; or
- by using the Disputed Domain Name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's 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.

For the current case, the evidence at hand confirms that Complainant's BOUYGUES® trademark is distinctive and it has a strong reputation in the different industries that the Complainant operates; e.g. Construction, Real Estate, Telecoms and Media. Furthermore, the Complainant claims that its mark is famous and it cites "prior decisions under the UDRP that have recognized the reputation of the BOUYGUES® mark such as CAC Case No. 103800."

The Complainant has provided evidence that the Complainant, directly or via its subsidiaries, operates in different countries.

Panels have found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith.

See paragraph 3.1.4 of WIPO Jurisprudential Overview 3.0.

From this evidence, the Panel concludes that the Respondent had actual knowledge of the Complainant's trademark at the time it registered the Disputed Domain Name.

Furthermore, the Complainant provided with evidence showing that the Disputed Domain Name was set up by the Respondent to mirror Complainant's subsidiary official website <https://www.bouygues-es.fr/energies> with the purpose to attract, for commercial gain, Internet users to the Respondent's website linked to the Disputed Domain Name. In this sense, the Complainant has confirmed that no authorization was granted to the Respondent to register the Disputed Domain Name and no counterargument has been submitted by Respondent. Therefore, the Respondent's intention was to create a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of Respondent or of a product or service on the Respondent's website.

Past panels have held that the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending e-mail, phishing, identity theft, or malware distribution (in some such cases, the respondent may host a copycat version of the complainant's website).

See paragraph 3.4 of WIPO Jurisprudential Overview 3.0.

In light of the evidence presented to the Panel, including: a) the likelihood of confusion between the Disputed Domain Name and the Complainant's BOUYGUES® trademarks, b) the lack of reply to this Complaint by the Respondent, c) the Respondent actual knowledge of the Complainant's trademark at the time he registered the Disputed Domain Name, d) the fact that the Disputed Domain Name is being used to mirror the Complainant's subsidiary genuine website with the purpose to mislead internet consumers, the Panel draws the inference that the Disputed Domain Name was registered and is being used 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-es-energie.com**: Transferred

PANELLISTS

Name	Victor Garcia Padilla
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DATE OF PANEL DECISION 2023-01-20

Publish the Decision
