

Decision for dispute CAC-UDRP-105134

Case number	CAC-UDRP-105134
Time of filing	2023-01-16 09:12:29
Domain names	bouyguesenergies-services.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	Lundi Mardi
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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, BOUYGUES S.A., founded by Francis Bouygues in 1952, is a diversified group of industrial companies structured by a strong corporate culture. Its businesses are centered on four sectors of activity: construction, energies and services, telecoms and media. The Complainant operates in over 80 countries, with a net profit, attributable to the Group, of 1,125 million euros.

The Complainant owns the following Trademarks:

- International Trademark BOUYGUES, Reg. No. 390771 registered on September 1, 1972 and in force until September 1, 2032;
- French Trademark BOUYGUES, Reg. No. 1197244 registered on March 4, 1982, and in force until March 4, 2032; and
- International Trademark BOUYGUES ENERGIES & SERVICES, Reg. No. 1172555 registered on March 22, 2013, and in force until March 3, 2023.

The disputed domain name <bouyguesenergies-services.com> was registered on **January 9, 2023**, and resolves to a website with pay-per-click ("PPC") with links directing to websites operated by potential competitors of the Complainant.

FACTUAL BACKGROUND

The Complainant, founded by Francis Bouygues in 1952, is a diversified group of industrial companies structured by a strong corporate culture. Its businesses are centered on four sectors of activity: construction, energies and services, telecoms and media. The Complainant operates in over 80 countries, with a net profit, attributable to the Group, of 1,125 million euros.

The Complainant's subsidiary BOUYGUES CONSTRUCTION is a world player in the fields of building, public works, energy, and services; which it is displayed through its website www.bouygues-construction.com. BOUYGUES ENERGIES & SERVICES, one of its own subsidiaries, is an expert in designing, building, maintaining and operating infrastructure, buildings and industrial facilities.

Apart from its Trademarks, the Complainant also owns, through its subsidiary, a number of domain names including the same distinctive wording BOUYGUES such as <bouygues-es.com>, registered since October 26, 2012.

The disputed domain name <bouyguesenergies-services.com> was registered on **January 9, 2023**, and by the time of this Decision resolves to a website with PPC links directing to websites operated by potential competitors of the Complainant, and also, where the disputed domain name is offered for its purchase.

PARTIES CONTENTIONS

Response

The Respondent did not submit any communication during the entire proceeding, nor has submit its Response replying to Complainant's contentions.

Complainant Contentions:

- The Complainant contends that the disputed domain name <bouyguesenergies-services.com> is confusingly similar to its trademark BOUYGUES.
- The Complainant contends that the addition of the terms "ENERGIES" and "SERVICES" 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's trademark. That, on the contrary, these terms directly refer to the Complainant's trademark BOUYGUES ENERGIES & SERVICES, and thus worsens the likelihood of confusion.
- The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name, due to the Respondent is not identified in the Whois database as the disputed domain name, and that therefore Respondent is not commonly known by the disputed domain name under Policy 4(c)(ii).
- Also, the Complainant contends that the Respondent is not affiliated with nor authorized by the Complainant in any way. 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.
- The Complainant contends that the disputed domain name resolves to a parking page with commercial links, that past panels have found it is not a bona fide offering of goods or services or legitimate non-commercial or fair use, citing: *Vance Int'l, Inc. v. Abend*, Forum Case No. FA 970871, concluding that the operation of a pay-per-click website at a confusingly similar domain name does not represent a bona fide offering of goods or services or a legitimate noncommercial or fair use, regardless of whether or not the links resolve to competing or unrelated websites or if the respondent is itself commercially profiting from the click-through fees and *Mayflower Transit LLC v. Domains by Proxy Inc./Yariv Moshe*, WIPO Case No. D2007-1695: "Respondent's use of a domain name confusingly similar to Complainant's trademark for the purpose of offering sponsored links does not of itself qualify as a bona fide use.").
- The Complainant states that past panels have confirmed the notoriety of the trademarks BOUYGUES, citing: *BOUYGUES v. ERIC DENIS*, CAC Case No. 103800, <bouyges-travaux.com>: "The Panel infers, due to the notoriety of the Complainant's mark that the Respondent registered the disputed domain name with actual knowledge of the Complainant's rights in the BOUYGUES mark and finds that it registered the disputed domain name in bad faith per paragraph 4(a)(iii) of the Policy."
- The Complainant states that the addition of the terms "ENERGIES" and "SERVICES" cannot be coincidental, as they directly refer to the Complainant's trademark BOUYGUES ENERGIES & SERVICES and the company BOUYGUES ENERGIES & SERVICES. Thus, the Respondent should have known about the Complainant at the time of the registration of the disputed domain name.
- The Complainant contends that the disputed domain name resolves to a parking page with commercial links, where the Respondent has attempted to attract Internet users for commercial gain to his own website thanks to the Complainant's trademarks for its own commercial gain, which is an evidence of bad faith, citing: *StudioCanal v. Registration Private, Domains By Proxy, LLC / Sudjam Admin, Sudjam LLC*, WIPO Case No. D2018-0497.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is confusingly similar to the trademarks, 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

In relation to the **FIRST UDRP Element**, the Complainant has sufficiently proved before the Panel, that owns Trademark Rights over the term BOUYGUES, being:

- International Trademark BOUYGUES, Reg. No. 390771 registered on September 1, 1972 and in force until September 1, 2032;
- French Trademark BOUYGUES, Reg. No. 1197244 registered on March 4, 1982, and in force until March 4, 2032; and
- International Trademark BOUYGUES ENERGIES & SERVICES, Reg. No. 1172555 registered on March 22, 2013, and in force until March 3, 2023.

The disputed domain name <**bouyguesenergies-services.com**> is composed by Complainant's Trademark BOUYGUES and the terms "ENERGIES" and "SERVICES", which are intrinsically related to Complainant's activity, and it is not perceived as a mere coincidence. For the purposes of the UDRP such scenario can be considered as generic words added to a well-known trademark (see *BOUYGUES v. ERIC DENIS*, CAC Case No. 103800), being confusingly similar to Complainant's Trademark BOUYGUES. Concurrently, the Complainant also owns the International Trademark BOUYGUES ENERGIES & SERVICES, therefore the disputed domain name can be considered as almost identical to that Complainant's Trademark. However, since the distinctiveness lies in the Trademark BOUYGUES, this Panel concludes that the disputed domain name is confusingly similar to Complainant's Trademark BOUYGUES.

In relation to the addition of terms, Section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0"), has established 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. The nature of such additional term(s) may however bear on assessment of the second and third elements."

Regarding the gTLD, it is well established by the Domain Name Jurisprudence that for the purposes of the analysis of the First UDRP Element, in this case, the gTLD ".com", "is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test" (see Section 1.11.1 of the WIPO Jurisprudential Overview 3.0).

Therefore, the disputed domain name <**bouyguesenergies-services.com**> is confusingly similar to Complainant's BOUYGUES Trademarks.

Regarding the **Second UDRP Element**, to this Panel it is clear that:

- the Respondent registered the disputed domain name on January 9, 2023, meaning more than 50 years after the Complainant's acquired its trademark rights at international level over the term BOUYGUES on September 1, 1972 (Reg. No. 390771).
- the Respondent has been identified as "lundi mardi", and no evidence suggests that it corresponds or has become commonly known by the disputed domain name or owns any corresponding registered trademark including the terms "bouyguesenergies-services.com".
- the Complainant has never granted the Respondent any authorization, license or right to make any use of the Complainant's trademark BOUYGUES, or apply for registration of the disputed domain name by the Complainant; that nor is the Respondent affiliated to the Complainant in any form or has carry out any activity for, nor has any business with the Respondent.
- the Respondent is not making a bona fide offering of goods or services nor for a legitimate non-commercial or fair use of the disputed domain name, which is based on Complainant's Trademark BOUYGUES, to resolve to a website with PPC links directing to websites operated by potential competitors of the Complainant; action that generates revenues to the Respondent; and furthermore, this Panel notes that the disputed domain name it is offered for its purchase, through the following highlighted heading: "*Interested in bouyguesenergies-services.com? Our Domain Broker Service may be able to get it for you. Find it how.*"

In relation to PPC's websites, Section 2.9 of the WIPO Jurisprudential Overview 3.0, states that:

"Applying UDRP paragraph 4(c), panels have found **that the use of a domain name to host a parked page comprising PPC links does not represent a bona fide offering where such links compete with or capitalize on the reputation and goodwill of the complainant's mark or otherwise mislead Internet users.**

(...) Panels have recognized that the use of a domain name to host a page comprising PPC links would be permissible – and therefore consistent with respondent rights or legitimate interests under the UDRP – **where the domain name consists of an actual dictionary word(s) or phrase and is used to host PPC links genuinely related to the dictionary meaning of the word(s) or phrase comprising the domain name, and not to trade off the complainant's (or its competitor's) trademark.**" (emphasis added).

As described in the First UDRP Element Section, the disputed domain name exactly reproduces Complainant's Trademark BOUYGUES, adding generic terms, which are intrinsically related to Complainant's business activity, and it is not perceived as a mere coincidence. The disputed domain name resolves to a website with PPC commercial links, action which generates revenues for the Respondent, links that divert consumers, and tarnish Complainant's Trademark BOUYGUES.

Therefore, this Panel finds that Complainant has successfully made a *prima facie* case, which was not rebutted in any manner by the Respondent, and concludes that the Respondent have no rights or legitimate interests in respect of the disputed domain name.

In relation to the **Third UDRP Element**, this Panel analyses the following:

Registration in Bad Faith:

The Complainant is a recognized French company founded on 1952, which acquired its first Trademark Rights over the term BOUYGUES in 1972, meaning that it has more than 50 years in the market. The Respondent registered the disputed domain name on January 9, 2023, based on a well-known Trademark for PPC commercial links and potential purchase of the disputed domain name.

The Complainant contends that given the notoriety and reputation of the Trademark BOUYGUES; the Respondent should have known about the Complainant at the time of the registration of the disputed domain name.

As additional bad faith consideration factors, Section 3.2.1 of the WIPO Jurisprudential Overview 3.0 states:

"Particular circumstances panels may take into account in assessing whether the respondent's registration of a domain name is in bad faith include: (i) the nature of the domain name (e.g., a typo of a widely-known mark, **or a domain name incorporating the complainant's mark plus an additional term such as a descriptive or geographic term, or one that corresponds to the complainant's area of activity or natural zone of expansion**), (...) (iii) **the content of any website to which the domain name directs**, including any changes in such content and the timing thereof, (iv) **the timing and circumstances of the registration** (...) (vi) **a clear absence of rights or legitimate interests coupled with no credible explanation for the respondent's choice of the domain name**, or (viii) other indicia generally suggesting that the respondent had somehow targeted the complainant." (emphasis added).

Section 3.2.2 of the WIPO Jurisprudential Overview 3.0 indicates:

"Noting the near instantaneous and global reach of the Internet and search engines, and **particularly in circumstances where the complainant's mark is widely known (including in its sector) or highly specific and a respondent cannot credibly claim to have been unaware of the mark** (particularly in the case of domainers), **panels have been prepared to infer that the respondent knew, or have found that the respondent should have known, that its registration would be identical or confusingly similar to a complainant's mark.** Further factors including the nature of the domain name, the chosen top-level domain, any use of the domain name, or any respondent pattern, may obviate a respondent's claim not to have been aware of the complainant's mark." (emphasis added).

Moreover, the circumstance that the disputed domain name substantially corresponds to Complainant's Trademark and its business activity, the nature of the commercial links, added to the intent to entice its purchase through the heading offer ("*Interested in bouyguesenergies-services.com? Our Domain Broker Service may be able to get it for you. Find it how.*"), suggest that the Respondent was very aware of the Complainant's Trademark at the time of the registration and registered the disputed domain name having the Complainant in mind.

Therefore, this Panel concludes that the disputed domain name has been registered in bad faith.

Bad Faith Use

In relation to this point, the Complainant contends that the disputed domain name resolves to a parking page with commercial links, where the Respondent has attempted to attract Internet users for commercial gain to his own website thanks to the Complainant's trademarks for its own commercial gain, which is an evidence of bad faith, citing: *StudioCanal v. Registration Private, Domains By Proxy, LLC / Sudjam Admin, Sudjam LLC*, WIPO Case No. D2018-0497:

"In that circumstance, whether the commercial gain from misled Internet users is gained by the Respondent or by the Registrar (or by another third party), it remains that the Respondent controls and cannot (absent some special circumstance) disclaim responsibility for, the content appearing on the website to which the disputed domain name resolve [...] so the Panel presumes that the Respondent has allowed the disputed domain name to be used with the intent to attract Internet users for commercial gain, by

creating a likelihood of confusion with the Complainant's trademark as to the source, affiliation, or endorsement of the Respondent's website to which the disputed domain name resolves. Accordingly, the Panel finds that the disputed domain name was registered and is being used in bad faith."

This Panel agrees with such view and with the Complainant's contention.

According to the evidence submitted before this Panel, and as described along this Decision, the disputed domain name resolves to a website with PPC links directing to websites operated by potential competitors of the Complainant; where, also, the disputed domain name it is offered for its purchase; with all of it, falling into Paragraph 4(c)(iv) of the Policy.

Therefore, this Panel concludes that, the disputed domain name is being used in faith as well.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. **bouyguesenergies-services.com**: Transferred

PANELLISTS

Name	María Alejandra López García
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DATE OF PANEL DECISION 2023-02-12

Publish the Decision