Decision for dispute CAC-UDRP-106786

Case number	CAC-UDRP-106786
Time of filing	2024-08-09 08:56:12
Domain names	bouygues-constructionuk.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	BOUYGUES

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Organization	HENRY THIERRY

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 (the Complainant) holds trademark registrations of BOUYGUES CONSTRUCTION, such as the international trademark BOUYGUES CONSTRUCTION n°732339 registered since April 13, 2000.

FACTUAL BACKGROUND

Founded by Francis Bouygues in 1952, the Complainant is a diversified group of industrial companies with businesses centered on four activity sectors: Construction, Energies and services, Media, and Telecoms. It is reported that the Complainant has a business presence in over 80 countries, with net attributable profit amounting to 973 million euros.

The Complainant's subsidiary, BOUYGUES CONSTRUCTION, is a world player in building, public works, energy, and services.

The Disputed Domain Name was registered by the Respondent on 3 August 2024.

PARTIES CONTENTIONS

The Respondent did not file any response to the Complaint after the Czeck Arbitration Court (the "CAC") successfully discharged its responsibility of notification of the Complaint to the Respondent under the Rules.

The Complainant contends that the requirements of the Policy have been met and that the Disputed Domain Name should be transferred to it.

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 that there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

I. The Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.
The Panel finds that the Complainant has established its registered trademark rights regarding the name "BOUYGUES CONSTRUCTION" by providing the relevant trademark registration information.
It is a firmly established principle that UDRP panels, including this one, do not consider the suffix or the top-level-domain part of the disputed domain name when assessing the issue of identical or confusing similarity under paragraph 4 (a) of the Policy. In the present case, the part of the Disputed Domain Name considered for the confusing similarity test is "bouygues-constructionuk", with the ".com" disregarded.

The Panel accepts the Complainant's contention that adding the geographical term "UK" for "United Kingdom" is insufficient to avoid the likelihood of confusion. The Panel finds that the distinctive part of the Disputed Domain Name is "bouygues-construction," which is identical to the Complainant's registered trademark "BOUYGUES CONSTRUCTION". Thus, there is a likelihood of confusion between the disputed domain name and the Complainant's trademark It does not change the overall impression of the designation as connected to the Complainant's trademark. Likewise, inclusion of a hyphen "-" between the "bouygues" and "construction" will not help reduce the similarity between the Disputed Domain Name and the Complainant's trademark.

As to the Complainant's contention that the inclusion of the term "UK" reinforces the risk of confusion as it refers to the Complainant's subsidiary's activities in the United Kingdom, the Panel considers that such confusion relates to the bad faith element under the UDRP but not the confusing similarity test under the first element of the UDRP which should focus on the test of the visual and phonetical similarity between the Disputed Domain Name and the trademark that the Complainant has registered trademark rights.

Based on these considerations, the Panel finds that the Complainant has successfully demonstrated the first element of the UDRP. The Disputed Domain Name is confusingly similar to the Complainant's registered trademark "BOUYGUES CONSTRUCTION".

II. The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Complainant has declared that the Complainant has never authorized any third parties to use its trademark or register a domain name comprising the trademark. The Respondent reproduces the Complainant's trademark on a parking website and domain name without any license or authorization from the Complainant, which is strong evidence of the lack of legitimate interest.

While the Complainant bears the overall burden of proof in UDRP proceedings, various UDRP panels have recognised that if a complainant makes out a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name, then the burden of proof of this element shifts to the Respondent. There is no evidence submitted before this Panel indicating that the Respondent is commonly known by the Disputed Domain Name and has acquired trademark or service mark rights related to the "BOUYGUES CONSTRUCTION".
Having considered the totality of the evidence in the present case, the Panel accepts that the Complainant has made out a prima facie case that the Respondent lacks rights or legitimate interests in respect of the Disputed Domain Name.
III. The Disputed Domain Name has been registered and is being used in bad faith.

Paragraph 4(a) of the Policy requires the Complaint to prove both registration and use in bad faith. Nonetheless, Paragraph 4(b) of the Policy sets out particular scenarios, which shall be evidence of the registration and use of a domain name in bad faith. They are:

- circumstances indicating that you have registered or you have 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 your documented out of pocket costs directly related to the domain name; or

- you have 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 you have engaged in a pattern of such conduct; or

- you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- by using the domain name, you have 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 your website or location or of a product or service on your website or location.

The evidence provided by the Complainant indicates that the Complainant's trademark "BOUYGUES CONSTRUCTION" has become a commercial symbol that enjoys enormous goodwill globally. As such, the Panel infers that the Respondent must know the Complainant's mark when registering the Disputed Domain Name. Having found that the Respondent has no rights and legitimate interests with respect to the Disputed Domain Name, the Panel firmly believes that it was not a mere coincidence for the Respondent to register the Disputed Domain Name. (WIPO Case No. D2004-0673, Ferrari S.p.A v. American Entertainment Group. Inc.)

Moreover, the Complainant has produced evidence proving that the Disputed Domain Name is resolved to a parking site and has been set up with an MX record for email purposes. The Panel follows the CAC Case No. 102827, JCDECAUX SA v. Handi Hariyono, 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 email address.
The Panel finds that Respondent's registration and use of the Disputed Domain Name constitute a clear case of bad faith under paragraph 4b(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **bouygues-constructionuk.com**: Transferred

PANELLISTS

Name	**Dennis Weiping CAI**

DATE OF PANEL DECISION 2024-09-19

Publish the Decision