Decision for dispute CAC-UDRP-107004

Case number	CAC-UDRP-107004
Time of filing	2024-10-29 13:05:31
Domain names	bouyguescontructions-uk.com

Case administrator

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

Complainant

Organization	BOUYGUES

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Name	David Robert

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

In this proceeding the Complainant relies on the following trademark registration:

- International Trademark Registration under the Madrid system No. 732339 “BOUYGUES CONSTRUCTION” (word), registration date is April 13, 2000 and protected inter alia in Albania, Armenia, Benelux, Germany, Italy, Kazakhstan, Mongolia, Serbia, Spain, Ukraine, Uzbekistan and Vietnam.

The Complainant also refers to its portfolio of domain names owned by its subsidiary, including <bouygues-construction.com>, registered since May 10, 1999.

FACTUAL BACKGROUND

THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

The Complainant states that it was founded in 1952 and is a diversified group of industrial companies. Its business consists of four sectors: Construction, Energies, Media and Telecoms. The Complainant claims that it operates in over 80 countries and its net profit amounts to 1,040 million euros.

Complainant's subsidiary, "BOUYGUES CONSTRUCTION", is a world player in the fields of building, public works, energy and services and it operates the website http://www.bouygues-construction.com/.
The disputed domain name was registered on October 25, 2024 and the Complainant alleges that it resolves to a parking page. "MX servers" are configured.
The Complainant contends that the disputed domain name is confusingly similar to its "BOUYGUES CONSTRUCTION" trademark.

The Complainant asserts that the addition of the letter "S" at the end of the term "CONSTRUCTION" and the geographical term "UK" for the "United Kingdom" is not sufficient to avoid confusion.
The addition of the term "UK" reinforces the risk of confusion as it refers to the Complainant's subsidiary activities in the United Kingdom and the addition of the gTLD ".COM" does not change the overall impression of the designation as being connected to the Complainant's trademark.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Complainant asserts that the Respondent is not identified in the Whois database as the disputed domain name.
The Complainant contends that 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 or apply for registration of the disputed domain name.
The Complainant contends that Respondent did not make any use of disputed domain name since its registration, and it confirms that the 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.

THE DISPUTED DOMAIN NAME WAS REGISTERED AND BEING USED IN BAD FAITH

The Complainant states that the disputed domain name is confusingly similar to its trademarks. The Complainant refers to past UDRP decisions that have established that the "BOUYGUES CONSTRUCTION" mark is well-known.

The Complainant and its subsidiary "BOUYGUES CONSTRUCTION" are well-known, as "BOUYGUES CONSTRUCTION" is a world player in the fields of building, public works, energy and services.

Given the distinctiveness of the Complainant's trademarks and reputation, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademarks.

The Complainant contends that 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.

The Complainant relies on the "passive holding" doctrine and previous UDRP decisions where panels held that the incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use.

The fact that "MX" servers are configured, in the Complainant's view, indicates that the disputed domain name may be actively used for e-mail purposes and any e-mail emanating from the disputed domain name could not be used for any good faith purpose.

Therefore, the Complainant states the disputed domain name was registered and being used in bad faith.

PARTIES CONTENTIONS

The Complainant's contentions are summarized in the "Factual Background" section above

No administratively compliant Response has been filed

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

A. Identical or confusingly similar

The Complainant provides evidence of the International Trademark registration for the word mark "BOUYGUES CONSTRUCTION".

As confirmed by the "**WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition**" ("WIPO Overview 3.0"): "where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case" (see sec. 1.2.1).
Therefore, the Complainant proved it has trademark rights.
The test for confusing similarity under the UDRP is relatively straightforward and typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.
The disputed domain name incorporates the "BOUYGUES CONSTRUCTION" mark of the Complainant. The addition of the letter "s" (indicating plural – "constructions") and a geographical element "UK" does not change overall perception of the disputed domain name as being confusingly similar to the Complainant's mark.
As noted in WIPO Overview 3.0: "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 sec. 1.8). The Complainant's mark is a dominant element in the disputed domain name and is clearly recognizable within the disputed domain name.

The gTLD ".com" is to be disregarded under the confusing similarity test as it does nothing to eliminate confusion.
Therefore, the Panel finds that the first requirement of the Policy has been satisfied.

B. Rights or Legitimate Interests

The general rule is the following:

(i) a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests; and
(ii) once such prima facie case is made, the burden shifts to the respondent who has to demonstrate his rights or legitimate interests in respect of the domain name under paragraph 4 (c) of the Policy.

If the respondent fails to do so, the second element of the Policy is satisfied, see "**Julian Barnes v. Old Barn Studios**", WIPO Case No. D2001-0121 and sec. 2.1 of WIPO Overview 3.0.
The disputed domain name was registered on October 25, 2024. It resolves to a web page with the notice: "This website has not yet been published".
The Respondent did not respond.
While failure to respond does not per se demonstrate that the Respondent does not have rights or legitimate interests, it allows the Panel to draw such inferences as it considers appropriate, see paragraph 14(b) of the Rules and **CAC Case No. 101284**: "A respondent is not obliged to participate in a proceeding under the Policy, but if it fails to do so, reasonable inferences may be drawn from the information provided by the complainant".
The Complainant has made a prima facie case of Respondent's lack of rights or legitimate interests.
The Respondent is not known by the disputed domain name and is identified as an individual from the UK with no apparent connection to the Complainant's business, the disputed domain name or any name corresponding to the disputed domain name.
The Complainant has not granted any license or authorization to use its trademark registered many years prior to the registration of the disputed domain name to the Respondent and the Complainant is not doing any business with the Respondent.

The disputed domain name has not been actively used.
The Panel finds that in the circumstances of the present dispute the Respondent does not have rights or legitimate interests in respect of the disputed domain name.

Therefore, the Panel finds that the Complainant has satisfied the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists non-exhaustive circumstances indicating registration and use in bad faith. These circumstances are non-exhaustive and other factors can also be considered in deciding about the bad faith element.
It is well established that bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark (see sec. 3.1 of WIPO Overview 3.0). Targeting with an intent to take an unfair advantage of the complainant's mark is important in establishing bad faith under the UDRP.
As noted in "**UDRP Perspectives on Recent Jurisprudence**", updated on August 30, 2024, sec. 3.3: "Targeting can be established by either direct evidence (e.g. content of the website) or circumstantial evidence such as strength of the mark and nature of a disputed domain name (e.g. mark plus a term describing Complainant's business), timing of registration of a domain name and timing of trademark registration, geographic proximity of the parties".

The Panel finds that the disputed domain name was registered and is being used in bad faith based on the following:

- The nature of the disputed domain name – fully incorporating Complainant's trademark plus a geographical term (UK, a country where the Complainant does business through its subsidiary) and the timing of the registration of the disputed domain name – October 25, 2024, many years after the Complainant obtained protection for its trademark and started its business under the same name;

- Passive holding of the disputed domain name in the circumstances of this case indicates both registration and use in bad faith. The WIPO Overview 3.0 states that "from the inception of the UDRP, panelists have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding" and the panelists "will look at the totality of the circumstances in each case" (sec. 3.3), see also sec. 3.7 of UDRP Perspectives.

The Panel notes that passive holding per se does not indicate bad faith. The Complainant provided only limited evidence that its trademark is well-known, namely screenshots of its main website and its subsidiary's website at the domain name <bouygues-construction.com>.

The Panel exercising its powers under par. 10 of the UDRP conducted its own "Google" search for the terms corresponding to the trademark of the Complainant and to the disputed domain name and the search results were indeed related to the Complainant and its subsidiary. "Google" such search results confirm Complainant's claims that its mark is distinctive in a market sense and is widely used.

The Panel also takes note of the early UDRP decisions in respect of the same Complainant and the same trademark, including the following: CAC Case No. 106786 and CAC Case No. 106044. The fact that MX servers are configured and that the disputed domain name may be used for e-mail purposes, in the circumstances of this dispute, is an additional indication of bad faith (see e.g. CAC Case No. 106298: "While, in the abstract, the creation of such record does not indicate any ill intent, in the circumstances of the present case where a domain name that is confusingly similar to the Complainant's distinctive trademark, and particularly also similar to its own legitimate domain name, has been created by the Respondent, this MX record does require some further explanation which the Respondent has not provided...").

Based on the above, the Panel finds that the passive holding doctrine applies to this dispute, as articulated in "Telstra Corporation Limited v. Nuclear Marshmallows", WIPO Case No. D2000-0003, <telstra.org> as the Complainant's mark is distinctive, the Respondent failed to respond and provide any evidence of actual or contemplated good-faith use of the disputed domain name and taking into account all of the above, any good faith use of the disputed domain name by the Respondent is implausible.

The Panel notes that the disputed domain name was registered only recently, on October 25, 2024. In such circumstances, the Panel appreciates that the Respondent did not have enough time to develop any active website at the disputed domain name prior to the dispute. However, given the nature of the disputed domain name (exact match of the Complainant's mark plus the "UK" element plus "s"), it is highly unlikely that the Respondent is able to develop a website that would not infringe on Complainant's rights and indeed there is implausibility of good faith use of the disputed domain name.

Based on the above, the Panel finds that Respondent's behavior falls within, at least, par. 4 b (iv) of UDRP and the Respondent by using the disputed domain name has intentionally attempted to attract, for commercial gain, Internet users to his web site, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement and that the Respondent targeted the Complainant with an attempt to take unfair advantage of the Complainant's mark.

The Panel holds that the third requirement of the Policy has been satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **bouyguescontructions-uk.com**: Transferred

PANELLISTS

Name	**Igor Motsnyi**

DATE OF PANEL DECISION 2024-11-24

Publish the Decision