Decision for dispute CAC-UDRP-107228

Case number	CAC-UDRP-107228
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Domain names	bouyguesconstructions-uk.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	BOUYGUES

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Name	Prosperite Europe

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 trademarks consisting of BOUYGUES CONSTRUCTION, such as the international trademark BOUYGUES CONSTRUCTION registration no. 732339 registered since April 13, 2000 and the European trademark BOUYGUES CONSTRUCTION registration no. 001589159 registered since May 16, 2001 Further, the Complainant's subsidiary Bouygues Construction S.A. owns at least one domain name consisting of the same distinctive wording BOUYGUES CONSTRUCTION, namely, <bouygues-construction.com>, registered since May 10, 1999.

FACTUAL BACKGROUND

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

The Complainant was founded by Francis Bouygues in 1952 and is a diversified group of industrial companies structured by a strong corporate culture. The Complainant's group has a presence in more than 80 countries. In 2023, the Complainant's group generated sales of 56 billion EUR. The Complainant's subsidiary Bouygues Construction is a world player in the fields of building, public works, energy, and services. As a global player in construction and services, Bouygues Construction designs, builds and operates buildings and structures which improve the quality of people's living and working environment, including public and private buildings, transport infrastructures and energy and communications networks.

The Complainant owns several trademarks at least one domain name, characterised by the presence of the distinctive term "BOUYGUES CONSTRUCTION". The Complainant contends that a previous panel has recognized its rights in the trademark "BOUYGUES CONSTRUCTION".

On January 1, 2025, the Respondent, Prosperite Europe, an individual or entity located in London, England, registered the disputed domain name <bouyguesconstructions-uk.com>.

The disputed domain name resolves to a parking page. Further, MX servers are configured.

According to the information on the case file, 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 because no Response was filed.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.
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

THREE ELEMENTS COMPLAINANT MUST ESTABLISH UNDER THE POLICY

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 disputed domain name should be transferred or cancelled:

(i) the disputed 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 disputed domain name; and

(iii) the disputed domain name has been registered and are being used in bad faith.

The Panel has examined 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 these proceedings:

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

Sufficient evidence has been submitted by the Complainant of its trademark rights in the term BOUYGUES CONSTRUCTION for building construction and related products and services. Further, the Complainant's subsidiary is the owner of a domain name that incorporates its trademark, namely <bouygues-construction.com>. All of the aforementioned were created and registered well prior to January 1, 2025, the creation date of the disputed domain name. It is well established that a nationally or regionally registered trademark confers on its owner sufficient rights to satisfy the requirement of having trademark rights for the purposes of standing to file a UDRP case. As such, the Panel finds that the Complainant possesses rights in its BOUYGUES CONSTRUCTION® trademark.

UDRP panels have held that where the asserted trademark is recognizable within a disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under paragraph 4(a)(i) of the Policy. See, e.g., LEGO Juris A/S v. DBA David Inc/ DomainsByProxy.com, Case No. D2011-1290 (WIPO, September 20, 2011) ("the mere addition of the words ‚Ninjago' and ‚Kai' is not sufficient to exclude the likelihood of confusion between the disputed domain name and the Complainant's trademark.").

In the present case, the disputed domain name consists of the BOUYGUES CONSTRUCTION® trademark with the addition of an "s" to the term "construction" followed by the geographical term "-UK", designating United Kingdom. In assessing confusing similarity, the Panel finds the disputed domain name is confusingly similar to the Complainant's trademark, as it incorporates the entirety of the BOUYGUES CONSTRUCTION® trademark and differs from such mark merely by adding an "s" to the term "construction", a hyphen, and the geographical term "UK". The Complainant's distinctive trademark forms the dominant part of the disputed domain name and is readily apparent.

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 WIPO Overview 3.0). Thus, the TLD in this case ".com" can be ignored in this case for the purpose of considering whether the confusingly similar element is met.

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 mark.

(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 by UDRP panels, 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; 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.).

However, the burden of proof still remains with the Complainant to make out its prima facie case on a balance of probabilities; see, for example, CAC Case No. 102263, Intesa Sanpaolo S.p.A. v Ida Ekkert. Moreover, the wording of paragraph 4(a)(ii) of the Policy requires a complainant to establish that the respondent has no rights or legitimate interests in the domain name in issue. Simply establishing that the complainant also has rights in the domain name in issue is insufficient.

In the present case, the Complainant asserts that the Respondent is not commonly known by the disputed domain name, is not in any way affiliated with the Complainant, nor has the Respondent been granted an authorization to register the disputed domain name or to use Complainant's BOUYGUES CONSTRUCTION® trademark. Further, the Complainant contends that the Respondent has not used the disputed domain name since it was registered, nor has the Respondent demonstrated any plans to use it. This has not been contested by the Respondent. Instead, the Respondent has not responded in any form and thus has failed to provide any information and evidence whatsoever that could have shown that it has relevant rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

While the Panel acknowledges that respondents may properly be afforded a reasonable period of time after registration of a domain name in order to put such domain name to use, in the particular circumstances of this case taking into account the Complainant's prima facie case and the Respondent's use of the typical typosquatting tactic of adding a difficult to discern "s" to a trademark, the Panel concludes that neither the Respondent nor the evidence establishes that the Respondent has any right or legitimate interest to the disputed domain name. The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

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

The third element requires Complainant to show that the disputed domain name has been registered and used in bad faith under paragraph 4(a)(iii) of the Policy. Further, Paragraph 4(b) of the Policy sets out four circumstances, in particular but without limitation, any one of which may be evidence of the registration and use of a domain name in bad faith. The four specified circumstances are:

(i) circumstances indicating that the respondent has registered or 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 the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has 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 the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the 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 or service on the site or location.

The Panel finds that the Complainant has shown that the Respondent registered and used the disputed domain name in bad faith in general (i.e. under paragraph 4(a)(iii) of the Policy) for the following reasons:

The Complainant's trademark is distinctive and enjoys considerable reputation as confirmed by other UDRP panels including CAC case No. 101387, BOUYGUES v. Laura Clare ("Given the distinctiveness of the Complainant's trademarks and reputation, it is reasonable to infer that the Respondent has registered the domain name with full knowledge of the Complainant's trademarks"). Accordingly, it is therefore reasonable to infer that the Respondent either knew, or should have known, that the disputed domain name would be identical, or confusingly similar to, the Complainant's trademarks and that they registered the disputed domain name with knowledge of the Complainant's trademarks.

It follows that the Respondent had actual notice of the Complainant's trademark. It has regularly been held that to copy a trademark in a domain name, or use it with a slight variation, knowing that the disputed domain name is based on the trademark of another party, constitutes bad faith registration and use of the disputed domain name. The Panel makes that finding in the present case.

The Respondent is not commonly known by the disputed domain name and Complainant states that the Respondent has never been authorized by the Complainant to use the Complainant's trademark(s) and/or register the disputed domain name, nor is there affiliation between the Complainant and the Respondent.

The disputed domain name is not being actively used, but rather it resolves to a page with the words "Website unpublished This website has not yet been published". The consensus view of panels states "the non-use of a domain name (including a blank or 'coming soon' page) would not prevent a finding of bad faith under the doctrine of passive holding." and further, "While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put." (see Paragraph 3.3 WIPO Overview 3.0). The Panel finds that most of these factors apply here, because (i) the Complainant's BOUYGUES CONSTRUCTION® trademark is distinctive and well-established, (ii) the Respondent has not responded to the Complaint nor given any justification for its registration of the disputed domain name, (iii) the fact that the Respondent's identity was concealed in the Whois is not probative in this case, as concealing registrant details has evolved to become standard procedure for Whois records subsequent to the time the WIPO Overview 3.0 was developed, and (iv) the descriptive nature of the related geographic term "UK" included within the disputed domain name improperly suggests a close association with the Complainant and its business, thus the Panel finds no plausible use of the disputed domain name that could be considered as in good faith.

The disputed domain name has been set up with MX records, indicating that they could be actively used for e-mail purposes. It would be difficult for an e-mail recipient to spot and/or be suspicious about the inclusion of the "s" and the geographic term "-uk" in email addresses originating from the disputed domain name, which are only minor differentiators compared to e-mails originating from the Complainant's own legitimate website <bouygues-construction.com>. Accordingly, the potential for actual or attempted e-mail related fraud and/or phishing is high. The existence of MX records and potential for associated fraudulent e-mail activity can be a factor indicating bad faith. See 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."). In this instant case, the Panel finds no conceivable good faith purpose for e-mail addresses originating from the disputed domain name and thus the existence of MX records supports a finding of bad faith.

On the balance of probabilities, the Panel finds that the Respondent was aware of Complainant and its BOUYGUES CONSTRUCTION® trademark and was targeting the Complainant when it registered the disputed domain name.

As a final point, the Panel may draw a negative inference from the Respondent's silence though these proceedings.

In light of the above analysis, the Panel concludes that the Complainant has made out its case that the disputed domain name was registered and is being used in bad faith, and thus has satisfied the requirement under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	**Claire Kowarsky**

DATE OF PANEL DECISION 2025-01-30

Publish the Decision