Decision for dispute CAC-UDRP-107482

Case number	CAC-UDRP-107482
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Domain names	bouyguesconstructionsuk.com

Case administrator

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

Complainant

Organization	BOUYGUES

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Organization	FRANCIS DANIEL

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 a large portfolio of trademarks. In particular, BOUYGUES owns:

(i) the International Registration No. 732339 "BOUYGUES CONSTRUCTION" registered on April 13, 2000 (and duly renewed) for class 37 - the above trademark is protected in several countries;

(ii) the EUTM No. 1589159 "BOUYGUES CONSTRUCTION" registered on May 16, 2001 (and duly renewed) for class 37.

FACTUAL BACKGROUND

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

The Complainant, BOUYGUES S.A., was founded by Francis Bouygues in 1952. It is a diversified Group of industrial companies, structured by a strong corporate culture. Its businesses are centred on four sectors of activity: Construction, Energies and services, Media and Telecoms. Operating in over 80 countries, the Complainant’s net profit attributable to the Group amounted to 56 billion euros in 2023.

The Complainant underlines that it is the owner of several trademarks consisting of the wording "BOUYGUES CONSTRUCTION". The Complainant also states that the disputed domain name <bouyguesconstructionsuk.com> is confusingly similar to its trademarks "BOUYGUES CONSTRUCTION" because the additions of the letter "s" and of the geographic identificator "uk" at the end of "bouyguesconstruction" are not sufficient to avoid confusion with the Complainant's trademark "BOUYGUES CONSTRUCTION".

The domain name in dispute <bouyguesconstructionsuk.com> has been registered on February 7, 2025.

The Complainant asserts that the Respondent is not identified in the Whois database as the disputed domain name. Furthermore, the Complainant informs that the Respondent is not authorized to use the Complainant trademarks and that there is no affiliation between the Complainant and the Respondent. The Complainant also contends that the Respondent has no right nor legitimate interest in the disputed domain name and that the Respondent is not related in any way to the Complainant's business. The Complainant declares that it does not carry out any activity for, nor has any business with the Respondent.

The Complainant points out that, given the distinctiveness and reputation of the Complainant's trademarks (prior UDPR panels have established that the trademark "BOUYGUES CONSTRUCTION" is well-known), it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademarks. The Complainant notes that the disputed domain name directs to a parking page and that said domain name is configured with MX records that allow it to be used to send e-mails that Internet users could well assume were sent by the Complainant.

PARTIES CONTENTIONS

The Complainant´s contentions are summarised 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

According to paragraph 4(a) of the Policy the Complainant is required to prove each of the following three elements to obtain the transfer of the disputed domain name:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

(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 is being used in bad faith.

1) The Complainant has established that it has rights in the trademark BOUYGUES CONSTRUCTION at least since 2000. The Complainant's trademark was registered well before the registration of the disputed domain name and is widely well-known. The Panel notes that the consensus view in previous UDRP panel decisions is that in determining confusing similarity under paragraph 4(a) of the Policy, the generic Top-Level Domain ("gTLD") suffix (".com" in this particular instance) should be disregarded. Therefore, the comparison has to be made between the signs BOUYGUES CONSTRUCTION and BOUYGUESCONSTRUCTIONSUK. According to prior UDRP panels, the fact that a domain name wholly incorporates a complainant's registered mark is sufficient to establish identity or confusing similarity for purposes of the Policy despite the addition of other words to such marks (see, between many others General Electric Company v. Recruiters, WIPO Case No. D2007-0584). In the present case the only differences between the signs are: (i) the addition of the letter "S" in the domain name as well as (ii) the addition of the geographical indicator "UK" at the end of the same disputed domain name. The Panel notes that in a recent previous case almost identical to the one at issue and related to the domain name <bouygues-constructions-uk.com> (see BOUYGUES v. Christian Gobert, WIPO Case No. D2024-2008), the Panel has held that: "although the addition of other terms here, an "s" to the word "construction" and the two letters suffix "uk" which designates the United Kingdom, the Panel finds the addition of such letter and suffix does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy". This Panel's view is that also in this case there is a clear and obvious confusing similarity between the disputed domain name and the mark since the disputed domain name contains many recognizable aspects of the mark and, as a consequence, the signs result to be almost identical aurally and visually notwithstanding the above-mentioned additions (see, between many others, L. Perrigo Company, Perrigo Pharma International Dac v. Privacy Service Provided By Withheld for Privacy ehf / The Carr, WIPO Case No. D2022-2470). The Complainant therefore succeeds on the first element of the Policy.

2) The Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain name as it is not commonly known under the disputed domain name and was never authorized to use it by the Complainant. The Respondent, in the absence of any substantial response, has not shown any facts or element to justify prior rights or legitimate interests in the disputed domain name. The Complainant therefore succeeds also on the second element of the Policy.

3) The Complainant's trademark BOUYGUES CONSTRUCTION is distinctive and well-known in many countries. It is uncontroverted that Complainant's worldwide use and registration of the BOUYGUES CONSTRUCTION mark largely precede the registration date of the disputed domain name. The fact that the Respondent has registered a domain name that is almost identical to it clearly indicates that the Respondent had knowledge of the Complainant's trademark at the time of registration of the disputed domain name. This is a clear evidence of registration of the domain name in bad faith. The Complainant has demonstrated that the disputed domain name is merely directed to a parking page and therefore it is clear that the disputed domain name is not used for any bona fide offerings since it is not connected to any active website. The fact that the Respondent effectively passively holds the disputed domain name cannot prevent a finding of use in bad faith (see Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003). The Panel wishes to stress that the disputed domain name holds no Internet content; it means that customers searching for information on the Complainant and the Complainant's service may come to the conclusion that there are problems at the Complainant's site, that the Complainant's web information and services are no longer in active use. Such 'non-use' by the Respondent can have the same negative result on the Complainant as active use of a disputed domain name, and amounts to bad faith use" (FIL Limited v. George Dyle, WIPO Case No. D2014-1418). Furthermore, the Complainant has provided evidence that the Respondent has set up "MX-records" for the disputed domain name. This entails that the Respondent can send e-mails through the e-mail address "@bouyguesconstructionsuk.com". The Respondent can therefore use (or may already have used) the disputed domain name to send fraudulent e-mails such as messages containing spam and/or phishing attempts that Internet users could well assume were sent by the Complainant. (See also Conféderation Nationale du Crédit Mutuel, Crédit Industriel et Commercial v. Khodor Dimassi, WIPO Case No. D2016-1980; Paris Saint-Germain Football v. MHP Private, WIPO Case No. D2019-0036). Albeit that there are no concrete examples of such use, it seems 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. The Panel finds that the mere conduct of making preparation for sending e-mails which are very likely to confuse the recipient of such e-mails as to their origin, is without justification and is inconsistent with the Complainant's exclusive rights in the BOUYGUES CONSTRUCTION trademark (see Accenture Global Services Limited v. Registration Private, Domains by Proxy, LLC / Richa Sharma, Name Redacted, WIPO Case No. D2019-2453). As a result of the above, the Panel finds that the disputed domain name was registered and is being used in bad faith. The Complainant therefore succeeds also on the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **bouyguesconstructionsuk.com**: Transferred

PANELLISTS

Name	**Guido Maffei**

DATE OF PANEL DECISION 2025-05-13

DATE OF PANEL DECISION 2020-06-18

Publish the Decision