

## **ADMINISTRATIVE PANEL DECISION**

**BOUYGUES v. Karen Jang**

Case No. D2022-4266

### **1. The Parties**

The Complainant is BOUYGUES, France, represented by Nameshield, France.

The Respondent is Karen Jang, France.

### **2. The Domain Name and Registrar**

The disputed domain name <bouygue-es.com> (the “Disputed Domain Name”) is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 9, 2022. On November 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On November 10, 2022, the Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the Disputed Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on November 16, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on November 17, 2022.

The Center verified that the Complaint, together with the amended Complaint, satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 18, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 8, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 16, 2022.

The Center appointed Isabelle Leroux as the sole panelist in this matter on January 6, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### 4. Factual Background

The Complainant is the well-known French group of industrial companies headquartered in France and active in three main sectors namely: construction and promotion (with Bouygues Construction, Bouygues Immobilier, and Colas), telecom and media (with Bouygues Telecom and French TV channel TF1).

For the needs and purposes of its activities, the Complainant is the owner of numerous trademarks, including the following:

- International trademark BOUYGUES No. 390771 registered on September 1, 1972, duly renewed and designating Austria, Bulgaria, Benelux Office for Intellectual Property, Switzerland, Czech Republic, Germany, Egypt, Spain, Hungary, Italy, Liechtenstein, Morocco, Monaco, Montenegro, Republic of North Macedonia, Portugal, Romania, Serbia, Slovakia, and San Marino for goods and services in international classes 6, 19, 37, and 42;
- French trademark BOUYGUES No.1197244 registered on March 4, 1982, duly renewed and designating goods and services in international classes 6, 16, 19, 28, 35, 37, 40, 41, 42, 43, 44, and 45;
- International trademark BOUYGUES ENERGIES & SERVICES No. 1172555 registered on March 22, 2013, and designating Australia, Finland, United Kingdom, Ghana, Ireland, Singapore, Turkey, Switzerland, Czech Republic, Germany, Hungary, Italy, Morocco, and Mozambique for goods and services in international classes 35, 37, 38, 39, 42, and 45;

Hereafter the “Trademarks” or “Trademark”.

The Complainant also owns several domain names, including the term BOUYGUES *i.e.*:

- <bouygues-es.com>, registered on October 26, 2012;
- <bouygues-es.fr>, registered on October 26, 2012.

The Disputed Domain Name <bouygues-es.com> was registered on November 7, 2022, and resolves to an inactive page.

#### 5. Parties' Contentions

##### A. Complainant

a) The Disputed Domain Name is identical or at least confusingly similar to the Complainant's Trademarks since it incorporates the Complainant's Trademark in full. The addition of the letters “ES” directly refers to the Complainant's Trademark “BOUYGUES ENERGIES & SERVICES”.

b) The Respondent has no rights nor legitimate interests in the Disputed Domain Name since:

- The Complainant has never granted any license or authorization to use its Trademark to the Respondent;
- The Respondent is not commonly known by the Disputed Domain Name;
- There is no evidence that the Respondent has a history of using, or preparing to use, the Disputed Domain Name in connection with a *bona fide* offering of goods and services.

c) The Respondent registered and used the Disputed Domain Name in bad faith given the following factors:

- the Disputed Domain Name is confusingly similar to its well-known and distinctive Trademarks;
- the Disputed Domain Name resolves to an inactive page.

Finally, the Complainant requests that the Disputed Domain Name be transferred to the Complainant.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

First of all, the Panel finds that the Complainant has provided evidence that it has prior rights in the BOUYGUES Trademarks considering they have been filed and registered several years before the Disputed Domain Name.

Then, the Panel notices that the Disputed Domain Name is composed of the quite identical reproduction of the BOUYGUES Trademarks in their entirety to which has only been (i) deleted the letter "s" and (ii) added the letters "es" preceded by a hyphen.

The deletion of the letter "s" and the addition of the letters "es" does not prevent a finding of confusing similarity since the BOUYGUES Trademark is fully recognizable. Furthermore, the letters "ES" could be understood as referring to the Complainant's Trademark "BOUYGUES ENERGIES & SERVICES".

Finally, the generic Top-Level Domain ("gTLD") ".com" is viewed as a standard registration requirement and as such is disregarded for the purpose of determining whether a domain name is identical or confusingly similar to a trademark.

Consequently, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's Trademark. The first element of paragraph 4(a)(i) of the Policy is thus fulfilled.

### **B. Rights or Legitimate Interests**

Numerous UDRP panels have found that, even though the complainant bears the general burden of proof under paragraph 4(a) (ii) of the UDRP, the burden of production shifts to the respondent once the complainant makes a *prima facie* showing that the respondent lacks rights or legitimate interests. See *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#).

Hence, after the Complainant has made a *prima facie* showing that the Respondent has no rights or legitimate interests in the Disputed Domain Name, it will be deemed to have satisfied paragraph 4(a)(ii) of the UDRP when the Respondent fails to submit a response.

In this case, the Complainant brings forward the following elements:

- The Respondent is not known under the Disputed Domain Name;
- No license or authorization has been granted by the Complainant to the Respondent; and
- The Respondent has not used the Disputed Domain Name for a *bona fide* offering goods and services as the Disputed Domain Name redirected to an inactive page.

Therefore, the Panel finds that the Complainant has made a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name.

Moreover, the Panel notes that the nature of the Disputed Domain Name, combining the entirety of the Complainant's distinctive trademark carries a risk of implied affiliation (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 2.5.1).

The Respondent has not come forward with relevant evidence demonstrating rights or legitimate interests in the Disputed Domain Name.

Given these circumstances, the Panel finds that the second element of paragraph 4(a)(ii) of the Policy is satisfied.

### **C. Registered and Used in Bad Faith**

The Panel considers that the Respondent could not plausibly ignore the existence of the Complainant's Trademarks at the time the Disputed Domain Name was registered since (i) the Disputed Domain Name was registered several years after the registration of the Complainant's Trademarks (ii) the Complainant's Trademarks have been recognized as well-known by previous UDRP panels and the Respondent is located in France, the Complainant's place of origin.

Regarding the well-known character of the Complainant's Trademarks, see e.g.: *Bouygues v. 徐林楠 (lin nan xu)*, WIPO Case No. [D2022-4017](#) ("Given the distinctiveness and well-established fame of the Complainant's trademark, the Panel finds that the registration of the disputed domain name clearly targeted such well-known trademarks, and that the Respondent knew, or at least should have known, of the existence of the Complainant's well-known marks").

Moreover, the incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use. Please see for instance: *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); *CBS Broadcasting, Inc. v. Dennis Toeppen*, WIPO Case No. [D2000-0400](#).

Therefore, the Panel finds that the Respondent registered the Disputed Domain Name because of its reference to the Trademarks owned by the Complainant and the registration was therefore made in bad faith.

This added to the Respondent's failure to reply to the Complainant's contentions provide no basis for the Panel to believe that the Disputed Domain Name might conceivably be put to good faith use.

Finally, the Panel finds that MX servers were configured which suggests that the Disputed Domain Name may be actively used for email purposes.

Taking into account all of the above, it is not possible to conceive of any plausible actual or contemplated active use of the Disputed Domain Name by the Respondent that would not be illegitimate.

Consequently, the Panel finds that the third and final element of the Policy is met.

### **7. Decision**

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Disputed Domain Name, <bouygue-es.com> be transferred to the Complainant.

*/Isabelle Leroux/*

**Isabelle Leroux**

Sole Panelist

Date: January 20, 2023