

ADMINISTRATIVE PANEL DECISION

Eiffage v. Pierre Naouri
Case No. D2022-0617

1. The Parties

The Complainant is Eiffage, France, represented by ARAMIS Société d'Avocats, France.

The Respondent is Pierre Naouri, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <eiffageimmobilieriledefrance.com> is registered with IONOS SE (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on February 22, 2022. On February 23, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 24, 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 February 28, 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 March 1, 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 March 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 22, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 24, 2022.

The Center appointed Angelica Lodigiani as the sole panelist in this matter on March 31, 2022. 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 a French company created in 1970 and part of the Eiffage Group. The Complainant operates since 1844 in the fields of infrastructures, energy, construction, and concessions. The Complainant is listed in the French stock exchange and is the third largest French construction and concession group, and the fifth largest in Europe. In 2020, the Eiffage group generated revenues for EUR 16.3 billion, of which 3.7 billion from the construction activity.

The Complainant is the owner of the following trademarks:

- EIFFAGE (word mark), French trademark registration No. 93458596, of March 9, 1993, for services in classes 35, 36, 37, and 42;
- EIFFAGE, European Union trademark registration No. 3300423, filed on August 4, 2003, and registered on December 21, 2004, for goods and services in classes 6, 7, 9, 16, 19, 35, 36, 37, 38, 39, 40, and 42;
- EIFFAGE, French trademark registration No. 3239965, of August 4, 2003, for goods and services in classes 6, 7, 9, 16, 19, 35, 36, 37, 38, 39, 40, and 42;

The disputed domain name was registered on July 9, 2022, and does not lead to an active website.

5. Parties' Contentions

A. Complainant

The Complainant maintains that the disputed domain name is confusingly similar to the EIFFAGE trademark as it includes it entirely with the addition of the descriptive terms "immobilier" and "iledefrance". The French word "immobilier" can be translated in English as "real estate" and refers to the core activity of the Complainant. The wording "iledefrance" is the name of the French region comprising Paris and its suburbs. The addition of these two elements to the disputed domain name cannot prevent a finding of similarity between the two signs.

The Complainant further maintains that the Respondent lacks rights or legitimate interests in the disputed domain name, as it has no business or other kind of relationship with the Respondent, it never licensed its EIFFAGE trademark to the Respondent, nor authorized the Respondent to make any use of it, including as part of the disputed domain name. Moreover, the Respondent does not own any EIFFAGE trademark, and is passively holding the disputed domain name. Passive holding does not amount to a *bona fide* offering of goods or services, nor to a noncommercial or fair use of the disputed domain name.

Lastly, the Complainant contends that the disputed domain name was registered and is being used in bad faith. The Complainant's EIFFAGE trademark is highly distinctive and enjoys reputation. The fact that the disputed domain name includes the word "immobilier" is a clear confirmation of the Respondent's awareness of the Complainant and of its activity. Through the disputed domain name, the Respondent is trying to impersonate the Complainant to mislead the public for some malicious purpose. Furthermore, the Respondent never replied to the Complainant's letter to the Registrar of the disputed domain name informing of the infringement of the Complainant's trademark and requesting the block of the disputed domain name and the Respondent's details provided at the time of the registration of the disputed domain name are presumably incorrect.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to the EIFFAGE trademark, as the latter is entirely incorporated in the disputed domain name and followed by two terms, one referring to the Complainant's principal activity ("immobilier"), and the second being a geographical name ("iledefrance"). According to section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") "[w]here 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".

Therefore, the addition of the terms "immobilier" and "iledefrance" cannot prevent a finding of confusing similarity of the disputed domain name with the Complainant's trademark.

Under these circumstances, the Panel holds that the Complainant has satisfied this element of the Policy.

B. Rights or Legitimate Interests

While the overall burden of proof rests with the complainant, UDRP panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is often primarily within the knowledge of the respondent. As such, where a complainant makes a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name.

In the case at issue, the Panel finds that the Respondent is not authorized to reflect the Complainant's trademark in the disputed domain name, and that the Respondent does not appear to have been commonly known by the name "eiffageimmobilieriledefrance". The disputed domain name is passively held and there is no evidence in the file that before any notice of the dispute, the Respondent was using, or made demonstrable preparations to use, the disputed domain name in connection with a *bona fide* offering of goods or services, or was making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's mark. Moreover, noting the construction of the disputed domain name, which consists of the Complainant's trademark along with two terms that are descriptive of the Complainant's services and a geographic area in which said services are available, the nature of the disputed domain name is such to carry a risk of implied affiliation to the Complainant, contrary to the fact, which cannot constitute fair use. [WIPO Overview 3.0](#), section 2.5.1.

In light of all these circumstances and in the absence of any reply from the Respondent, the Panel is satisfied that the Complainant has at least made a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds that also the second requirement under the Policy is met.

C. Registered and Used in Bad Faith

The Complainant affirms that the EIFFAGE trademark enjoys reputation in its field. The Panel notes that the Complainant has over 150 years of history, is the third French largest group, and the fifth in Europe in the field of construction and concessions, has a high number of completed and ongoing construction projects, a significant turnover, and is quoted at the French Stock Exchange. In light of these circumstances, the Panel

tends to agree with the Complainant on the reputation of its EIFFAGE mark. In any event, the term EIFFAGE is a coined distinctive word that appears to be exclusively associated with the Complainant. Moreover, the Panel notes that the Respondent's name is French and that the email address provided at the time of the registration of the disputed domain name is also a French email address. Therefore, it is likely that the Respondent is an individual of French nationality or at least familiar with France, which is also the Complainant's country. As such, it is not credible that the Respondent registered the disputed domain name without having in mind the Complainant. This is also shown by the fact that the disputed domain name contains the descriptive word "immobilier", which refers to one of the key activities of the Complainant, and the geographic designation "Ile de France", which is the region where the Complainant is located.

The registration of a domain name similar to a third party's well-known trademark without rights or legitimate interests supports an inference of registration in bad faith.

As far as use in bad faith is concerned, the disputed domain name does not lead to an active website. Passive holding of a domain name cannot prevent a finding of bad faith under the so-called doctrine of passive holding. In particular, the following factors have already been considered relevant in applying the passive holding doctrine: (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, and (iv) the implausibility of any good faith use to which the domain name may be put (see section 3.3. of the [WIPO Overview 3.0](#)).

In the instant case, the Panel notes that the EIFFAGE trademark is certainly highly distinctive, if not renowned, at least in France, and that the Respondent failed to submit valuable arguments to support its good faith registration and maintenance of the disputed domain name. By registering and holding a domain name incorporating the Complainant's trademark and two descriptive words referring to the Complainant's activity and location, the Respondent is falsely impersonating the Complainant or at least suggesting the Complainant's sponsorship or endorsement, and is deliberately misleading Internet users searching for the Complainant. Under the circumstances, the Panel cannot see any plausible good faith use that the Respondent could make of the disputed domain name.

The Complainant maintains that the Respondent's name is most likely invented. However, this statement is unsupported and the Panel does not have sufficient elements to conclude that the name used for the registration of the disputed domain name is false. Therefore, this argument should be dismissed. Notwithstanding, the other arguments provided by the Complainant are sufficient for the Panel to conclude that the Respondent registered and is being using the disputed domain name in bad faith.

Therefore, the Panel is satisfied that also the third and last condition under 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 <eiffageimmobilieriledefrance.com> be transferred to the Complainant.

/Angelica Lodigiani/

Angelica Lodigiani

Sole Panelist

Date: April 14, 2022