

ADMINISTRATIVE PANEL DECISION

Bouygues v. Michael Johnson
Case No. D2022-0891

1. The Parties

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

The Respondent is Michael Johnson, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <thebouyguesuk.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 March 15, 2022. On March 15, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 17, 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 March 18, 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 18, 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 21, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 10, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 11, 2022. The Respondent sent an email communication on April 20, 2022.

The Center appointed Oleksiy Stolyarenko as the sole panelist in this matter on April 19, 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 founded in 1952 by Francis Bouygues. Its businesses are centered on three sectors of activity: construction, telecoms and media. As of 2021 the Complainant operates in 80 countries, employs 124,600 employees with the net profit attributable amounted to EUR 1,125 million.

The Complainant's subsidiary Bouygues UK operates in the United Kingdom in the sectors of building, infrastructure and industry.

The Complainant has registered BOUYGUES trademark worldwide, for a broad range of goods and services in classes 6, 16, 19, 28, 35, 37, 40, 41, 42, 43, 44 and 45 related to the activities of the Complainant. Some of the Complainant's trademark registrations are indicated below:

- International Registration for BOUYGUES and design No. 390771 registered on September 1, 1972 for the goods and services in classes 6, 19, 37, 42;
- European Union ("EU") Trade Mark for BOUYGUES EUROPE No. 010635431 dated July 6, 2012, for the services in classes 35, 36, 41;
- French Trademark Registration for BOUYGUES and design No. 1197244 registered on September 1, 1972 for the goods and services in classes 06, 16, 19, 28, 35, 37, 40, 41, 42, 43, 44, 45.

The Complainant, also owns numerous domain names corresponding to and/or containing BOUYGUES trademark, including <bouygues.com> registered by the Complainant on December 30, 1997 and <bouygues-uk.com> registered by the Complainant on January 23, 2002. The Complainant actively promotes its activities under these domain names and other domain names incorporating BOUYGUES trademark.

The Respondent appears to be an individual located in the United Kingdom. According to the Whois, the disputed domain name was registered on March 8, 2022. The disputed domain name does not resolve to an active website.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has strong rights in the BOUYGUES trademark by virtue of its longstanding use and registration of the mark in a number of jurisdictions around the world. The Complainant is a big company and its activities and initiatives receive attention of the relevant sectors of commerce worldwide. Previous UDRP panels confirmed the Complainant's rights on the BOUYGUES trademark and that such trademark is well known within the sector.

The Complainant argues that the disputed domain name is identical or confusingly similar to the Complainant's BOUYGUES mark as it incorporates the Complainant's registered BOUYGUES trademark entirely. The term "uk" according to the Complainant refers to the shorthand for "United Kingdom", a country where the Complainant is commercially active. The addition of the terms "the" and "uk" to the disputed domain name is not sufficient to distinguish it from the Complainant's marks.

The Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has not authorized the Respondent to use the BOUYGUES mark in the disputed domain name.

The Respondent is not commonly known by the disputed domain name.

The Respondent was fully aware of the Complainant's reputation and the Complainant's trademark rights on the BOUYGUES mark when the Respondent registered the disputed domain name.

The disputed domain name was registered in bad faith by the Respondent for the purpose of creating confusion with Complainant's marks to divert or mislead third parties for the Respondent's illegitimate profit.

Therefore, the disputed domain name has been registered by the Respondent in an unfair manner and in bad faith. It is also inconceivable that the Respondent had any good faith intentions at the point of registering the disputed domain name.

The Complainant seeks a decision that the disputed domain name be transferred to the Complainant.

B. Respondent

The Respondent did not reply to the Complainant's contentions. However, on April 20, 2022, the Center received a communication from the registrant's email address stating, "I keep getting emails from you. My email was hacked. I just sorted it out".

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has proved its rights in the BOUYGUES mark through international registrations dating back to 1972 designating numerous countries worldwide, and also through EU and national trademark registrations registered in various countries of the world.

Therefore, the Panel considers that the Complainant has satisfied the threshold requirement of having trademark rights.

The disputed domain name is comprised of the terms "the", "Bouygues", "uk" and combined with the generic Top-Level Domain ("gTLD") ".com".

Thus, the Panel finds that the disputed domain name incorporates the Complainant's BOUYGUES trademark entirely.

Furthermore, the Panel considers that the disputed domain name is confusingly similar to the Complainant's the BOUYGUES trademark.

The Panel notes that addition of the terms "the" and "uk" to the disputed domain does not prevent the Complainant's trademark from being recognizable in the disputed domain name.

The gTLD is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. See section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)). Therefore, the Panel disregards the gTLD for the purposes of this comparison.

The Panel finds that according to a side-by-side comparison, the disputed domain name reproduces the Complainant's BOUYGUES trademark and, thus, that the Complainant's trademark is recognizable within the disputed domain name.

Previous UDRP panels have consistently held that the addition of a term to a disputed domain name that incorporates a trademark in its entirety typically does not prevent the finding of confusing similarity. See section 1.8 of the [WIPO Overview 3.0](#).

For all the foregoing reasons, the Panel finds that the first element of paragraph 4(a) of the Policy has therefore been satisfied by the Complainant.

B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires the complainant to establish that the respondent has no rights or legitimate interests in the domain name. Once the complainant establishes a *prima facie* case against the respondent under this ground, the burden of production shifts to the respondent to rebut it. See section 2.1 of the [WIPO Overview 3.0](#). In this case, the Respondent did not rebut the Complainant's *prima facie* case regarding the lack of rights or legitimate interests.

However, the overall burden of proof remains with the Complainant. Paragraph 4(c) of the Policy provides circumstances that demonstrate the respondent's rights or legitimate interests to the disputed domain name, and that the complainant frequently address to show that the activities of the respondent does not fall under the *bona fide* offering of goods or services (paragraph 4(c)(i) of the Policy), that the respondent is not commonly known by the disputed domain name (paragraph 4(c)(ii) of the Policy) and that the respondent is not making a legitimate noncommercial or fair use of the disputed domain name (paragraph 4(c)(iii) of the Policy).

The Panel finds that because the disputed domain name is confusingly similar to the Complainant's BOUYGUES trademarks, any use of such domain name by the Respondent carries a risk of implied affiliation with the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

According to the Complainant, the Respondent is not an authorized or licensed to use the Complainant's BOUYGUES trademark in the disputed domain name, as well as not in any way affiliated with the Complainant.

The Panel also notes that the Respondent failed to come forward with any relevant evidence confirming use or demonstrable preparations to use of the disputed domain name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name.

Taking into account the reputation and long period of use of the Complainant's BOUYGUES trademark, and in the corresponding Complainant's domain name and website, and in the absence of evidence to the contrary, the Panel finds that the Respondent is not involved in a *bona fide* offering of goods or services (under paragraph 4(c)(i) of the Policy) and the Respondent's activities does not fall under a legitimate noncommercial use (under paragraph 4(c)(iii) of the Policy).

According to the Registrar's information, "Michael Johnson" is the registrant of the disputed domain name. The Panel did not find any evidence that the Respondent is commonly known by the disputed domain name. The Panel concludes that the Respondent is not commonly known by the disputed domain name under paragraph 4(c)(ii) of the Policy.

Thus, the Panel finds that the Complainant has satisfied the second element of the Policy, namely paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

As the Panel established above, the Complainant's BOUYGUES trademark was used in commerce well before the registration of the disputed domain name on March 8, 2022.

Previous UDRP panels have already recognized the wide reputation of the BOUYGUES trademark in the construction sector: “Indeed, given the fact that the Complainant’s trademarks are well-known in the construction services, the Respondent cannot credibly claim to have been unaware of the existence of the previous trademarks (see section 3.2.2 of the [WIPO Overview 3.0](#)) and previous UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith (see section 3.1.4 of the [WIPO Overview 3.0](#))”. See *Bouygues v. Whois Privacy Protection Foundation / Warren Frederic, Aoummeur*, WIPO Case No. [D2021-4339](#).

The Panel agrees and considers that the well-known character of the BOUYGUES trademark within the relevant sector is established.

The Panel finds with a high degree of certainty that the Respondent knew of the Complainant’s BOUYGUES trademark when registering the disputed domain name. This conclusion is supported by the well-known character of the mark within the construction sector and the fact that the Complainant actively works in the United Kingdom in this particular sector. Therefore, it is highly unlikely that the Respondent has registered the disputed domain name without knowing of activities of the Complainant.

Furthermore, the Respondent’s use of the geographical term “uk” in the disputed domain name has a potential to mislead the Internet users that the disputed domain name is operated by the Complainant or the Complainant’s authorized agent or representative of the Complainant in the United Kingdom.

The Respondent failed to reply to the Complainant’s contentions to disprove allegations of illegal activity or provide any evidence of a good-faith use or to show rights or legitimate interests in the disputed domain name.

The Panel concludes that the Respondent’s intent for registering the disputed domain name, which reproduces the Complainant’s trademark along with the term “the” and geographic term “uk” has always been to capitalize on the goodwill of the Complainant’s trademark.

According to previous UDRP panel decisions, passive holding may indeed amount to bad faith use in certain circumstances. See section 3.3 of [WIPO Overview 3.0](#).

Furthermore, the Panel finds it implausible that the disputed domain name could be used by the Respondent in good faith considering that it is confusingly similar to the Complainant’s trademark. The Panel finds that the fact that the disputed domain name does not currently resolve to an active website does not prevent a finding of bad faith in these circumstances.

Therefore, based on the confirmed reputation, fame, long term and worldwide use of the Complainant’s BOUYGUES trademark, and in the absence of the response from the Respondent providing any explanation or evidence of actual or contemplated good-faith use, the Panel finds the Respondent registered and used the disputed domain name in bad faith and that the Complainant consequently has satisfied the third element of the Policy, namely, paragraph 4(a)(iii) of the Policy.

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 <thebouyguesuk.com> be transferred to the Complainant.

/Oleksiy Stolyarenko/

Oleksiy Stolyarenko

Sole Panelist

Date: May 3, 2022