

ADMINISTRATIVE PANEL DECISION

Bouygues v. Roland Pernaud
Case No. D2023-1452

1. The Parties

The Complainant is Bouygues, France, represented by ADVANT Altana, France.

The Respondent is Roland Pernaud, France.

2. The Domain Name and Registrar

The disputed domain name <bouygues-groupes.com> is registered with Network Solutions, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 4, 2023. On April 4, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 6, 2023, 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 (Perfect Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 11, 2023, 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 amendment to the Complaint on April 12, 2023.

The Center verified that the Complaint together with the amendment to the 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 April 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 11, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 12, 2023.

The Center appointed Alexandre Nappey as the sole panelist in this matter on May 22, 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 Bouygues SA, a French company founded by Mr. Francis Bouygues in 1952.

The Complainant gradually expanded its activities around three sectors of activity: construction, telecom, and medias, both in France and in other countries and has since branched out into new lines of business.

The Complainant has become the group's holding company and is established in more than 80 countries throughout five continents.

The Complainant is the owner of numerous word or semi-figurative trademarks comprising BOUYGUES registered in many countries, among which, for example:

- French trademark BOUYGUES (word) No. 1197243 of March 4, 1982, in classes 6, 16, 19, 28, 35, 37, 40, 41, 42, 43, 44, and 45.
- French trademark BOUYGUES (word) No. 92408370 of March 3, 1992, in classes 6, 7, 9, 16, 19, 28, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, and 45;
- International Trademark BOUYGUES No. 390770, registered on September 1, 1972, in classes 6, 19, 37, and 42;

The disputed domain name was registered on February 8, 2023, and does not resolve to any active website.

According to the Complaint, the Respondent has used the disputed domain name as a signature in various emails sent from an account "[...]@bouygues-groupes.com" using the name of a former employee of the Complainant, and which has been used to send emails to various companies. Copies of those emails have been annexed to the Complaint.

5. Parties' Contentions

A. Complainant

Identity or confusing similarity:

First the Complainant indicates that the disputed domain name is confusingly similar with its prior trademarks BOUYGUES. The domain name <bouygues-groupes.com> wholly incorporates the Complainant's trademarks BOUYGUES. This term is easily identified in the disputed domain name, regarding its attack position and it is the first word a consumer will perceive of the domain name. The word "groupes" is the French translation for the English word "groups" which is extremely common within the framework of business of the company. The only distinctive term is "Bouygues", then, the domain name is necessarily confusingly similar to the Complainant's trademarks.

Rights of legitimate interests:

The Complainant claims that the Respondent cannot have any intellectual property right on the sign BOUYGUES, as the name <bouygues-groupes.com> has no apparent association with any other person or entity than Bouygues itself. Moreover, the trademarks owner has not licensed or otherwise permitted the Respondent (who is unknown and has voluntarily used privacy services to hide his/its real identity) to use any of its trademarks or to apply for any domain name incorporating any of its marks.

The Complainant also states that the Respondent is not making a fair use and a noncommercial use of the disputed domain name. The Respondent has the clear intent for commercial gain misleadingly to divert consumers or to tarnish the trademarks or services marks at issue.

Moreover, the Respondent has no interest in respect of the disputed domain name, since the website “www.bouygues-groupes.com” pretends to be an official Bouygues’ website.

Above all, the disputed domain name has been used to send and to sign emails from email boxes comprised of “[...]@bouygues-groupes.com” to potential business partners and/or real Bouygues’ clients falsely signed on behalf of an employee of Bouygues.

By doing so, the Respondent impersonated the former CTO of Bouygues Telecom and current member of the Complainant’s Board.

Thus, the disputed domain name is not being used in connection with a *bona fide* offering of goods and services nor with purposes other than a bad faith passive holding intention.

Bad faith:

Finally, on the third element of the Policy, the Complainant claims that the Respondent acted in bad faith when registering and using the disputed domain name. Registration took place in bad faith as the Respondent was fully aware of the existence of the Complainant when it acquired the disputed domain name as the BOUYGUES trademarks are well-known: it is clear that the Respondent registered the disputed domain name for the purpose of disrupting the business of Bouygues group. And use was also made in bad faith insofar the Respondent created and sent fraudulent emails impersonating a former employee of the Complainant: the Respondent wanted to use and benefit Bouygues’ reputation to achieve his fraud.

B. Respondent

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

6. Discussion and Findings

Notwithstanding the default of the Respondent, it remains up to the Complainant to make out its case in accordance with paragraph 4(a) of the Policy, and to demonstrate that:

- (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 is being used in bad faith.

However, under paragraph 14(b) of the Rules, where a Party does not comply with any provision of the Rules, the Panel “shall draw such inferences therefrom as it considers appropriate”.

Having considered the Parties’ contentions, the Policy, the Rules, the Supplemental Rules and applicable law, the Panel’s findings on each of the above-mentioned elements are the following.

A. Identical or Confusingly Similar

The Panel is satisfied that the Complainant owns numerous trademark rights in BOUYGUES. This trademark is fully reproduced in the disputed domain name.

The addition of the term “groupes” (French word for “groups”) does not prevent a finding of confusing

similarity. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)).

Accordingly, the Panel finds that the Complainant has succeeded in showing that the disputed domain name is identical or confusingly similar to a service mark in which the Complainant has rights.

B. Rights or Legitimate Interests

Under the Policy, a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in a disputed domain name. Once such a *prima facie* case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Complainant has clearly satisfied its burden of evidence here: the Complainant has argued that it does not know the Respondent, is not linked to the Respondent, and that to its knowledge the Respondent has no rights or legitimate interests in the disputed domain name. Besides, the disputed domain name is not used in connection with a *bona fide* offering of goods or services. On the contrary, the Respondent is using the domain name for a phishing scheme which demonstrates a lack of rights or legitimate interests.

Furthermore, the composition of the disputed domain name, consisting of the Complainant's well-known trademark with an additional term, cannot constitute fair use in these circumstances as it carries a risk of implied affiliation and effectively impersonates or suggests sponsorship or endorsement by the Complainant.

See section 2.5.1 of [WIPO Overview 3.0](#).

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, which has not been rebutted by the Respondent. The Complainant is therefore deemed to have satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy identifies, in particular but without limitation, four circumstances which, if found by this Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. Paragraph 4(b) of the Policy reads:

“For the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that you have registered, or you have 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 your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have 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 you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.”

Each of the four circumstances in paragraph 4(b) of the Policy, if found, would be an instance of “registration and use of a domain name in bad faith”.

Bad faith is obvious in the present case:

First, the Respondent had necessarily the Complainant’s well-known trademarks in mind when it chose the disputed domain name. The addition of the term “groupes” only strengthens the likelihood of confusion since it refers to the idea of an affiliation or a group of BOUYGUES companies.

Second, the Complainant submitted printouts showing that the Respondent has operated a phishing scheme impersonating the Complainant and trying to confuse the companies with which it established contacts. The use of a misleading email address, to impersonate the Complainant, lured a number of entities. It attracted them for the commercial gain of the Respondent. The disputed domain name was used as a signature in the footer of those fraudulent emails.

Therefore, the Panel also finds that the disputed domain name was registered and is being used by the Respondent in bad faith.

Accordingly, the third criteria set out in paragraph 4(a) of the Policy is also satisfied.

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, <bouygues-groupes.com>, be transferred to the Complainant.

/Alexandre Nappey/

Alexandre Nappey

Sole Panelist

Date: June 5, 2023