

## **DISPUTE RESOLUTION SERVICE**

**D00020685**

### **Decision of Independent Expert**

**BOUYGUES**

and

**Bouygues**

#### **1. The Parties:**

Lead Complainant: BOUYGUES  
32, Avenue Hoche  
Paris  
Ile-de-France  
75008  
France

Respondent: Bouygues  
Kent  
United Kingdom

#### **2. The Domain Name(s):**

bouyguesconstruction.co.uk

#### **3. Procedural History:**

10 October 2018 11:44 Dispute received  
10 October 2018 15:24 Complaint validated  
10 October 2018 15:27 Notification of complaint sent to parties  
22 October 2018 11:42 Response received  
25 October 2018 09:45 Notification of response sent to parties  
30 October 2018 01:30 Reply reminder sent

30 October 2018 10:17 Reply received  
30 October 2018 10:18 Notification of reply sent to parties  
30 October 2018 10:19 Mediator appointed  
02 November 2018 10:48 Mediation started  
08 November 2018 14:20 Mediation failed  
08 November 2018 14:20 Close of mediation documents sent  
15 November 2018 10:45 Expert decision payment received

I, James Bridgeman SC, can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

#### **4. Factual Background**

The Complainant, founded in 1952, has grown to become a diversified group of industrial companies engaged in construction, telecoms and media and is listed on the Premier Marché of the Euronext Paris stock exchange.

The Complainant is the owner of the European Trade Mark BOUYGUES CONSTRUCTION, registration number 001589159 which was registered on 16 May 2001. Additionally, the Complainant is the owner a number of internet domain names, that incorporate the words BOUYGUES CONSTRUCTION including <bouygues-construction.com>, created on 10 May 1999.

The disputed domain name <bouyguesconstruction.co.uk> was registered on 19 September 2018 and at the date of the Complaint resolved to an active website which purports to offer construction services and to be hosted by an enterprise called “Bouygues Construction” with an address in South East London, UK.

#### **5. Parties’ Contentions**

The Complainant claims rights in the name and mark BOUYGUES CONSTRUCTION for the purpose of the DRS Policy based on its ownership of the above-described European Union Trade Mark and the goodwill established by use of the BOUYGUES CONSTRUCTION mark and name within the United Kingdom and 80 other jurisdictions in its business of designing, building and operation of buildings and structures, transport infrastructures and energy and communications networks.

The Complainant submits that the disputed domain name is identical to its BOUYGUES CONSTRUCTION name and mark.

The Complainant submits that the disputed domain name is an Abusive Registration arguing that the Respondent has no right nor legitimate interest in the disputed domain name; that the Respondent is not related in any way to the Complainant’s business; that the Respondent is neither affiliated with, nor authorized by the

Complainant in any way; and the Complainant does not carry out any business or activity for or with the Respondent.

The Complainant argues that given the distinctiveness of the Complainant's trademark and reputation, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's marks. The Complainant also submits that the Respondent has no reasonable justification for having registered the disputed domain name, which is identical to the Complainant's name and mark.

The Complainant contends that the Respondent is using the disputed domain name to defraud Internet users for his own profit because the disputed domain name resolves to an active page related to the Complainant's subsidiary BOUYGUES CONSTRUCTION and its activities in the building and infrastructure industry sectors.

The Complainant submits that it follows that the Respondent has registered and is using the disputed domain name to disrupt the Complainant's business by offering competing services on the website to which it resolves.

In Response, the Respondent denies that the disputed domain name was registered to take advantage of the Complainant's trading activities or business and asserts that the disputed domain name was registered after thorough search and consultation.

The Respondent submits that he intends to use the disputed domain name for trading activity outside of the UK/European Union and denies that he is bound by any trademark laws within the UK or European Union for such use.

The Respondent asserts that it is within his rights to source domain names that are not registered or trademarked to any company to establish his business.

The Respondent states that in order to resolve this dispute he will transfer ownership and cease immediate use of the disputed domain name if all his costs for buying the domain name, hosting it and hiring professional to build his site is refunded. The total sum requested to cover these expenses is \$4,320.00. The Respondent states that in the meantime, his IT team has disabled the website until a decision is made or an agreement is reached.

## **6. Discussions and Findings**

The DRS Policy, paragraph 2, requires the Complainant to prove on the balance of probabilities that:

- i The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- ii The Domain Name, in the hands of the Respondent, is an Abusive Registration

“Abusive Registration” is defined by the DRS Policy, paragraph 1, as a Domain Name which either:

- i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or
- ii. is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;

The Complainant has provided convincing evidence that it has Rights in the BOUYGUES CONSTRUCTION name and mark which have been acquired through long and extensive use of the mark in its diverse enterprises in many jurisdictions and its above-mentioned European Union Trade Mark.

The disputed domain name is identical to the Complainant's mark except for the <.co.uk> domain name extension which can be ignored for the purposes of comparison in the circumstances of the present case.

It is most improbable that the registrant of the disputed domain name was unaware of the Complainant, its name and mark when the disputed domain name was selected and registered. Any “search and consultation” carried out by the registrant prior to registration would have disclosed the existence of the Complainant and its pre-existing <bouygues-construction.com>, created on 10 May 1999.

There is no evidence whatsoever that the Respondent is engaged in the construction industry or is known by the name “Boygues” and on the balance of probabilities the website to which the disputed domain name resolves purporting to be hosted by “Bouygues Construction” is a sham.

On the balance of probabilities, the disputed domain name was selected, registered and used in order to target and take predatory advantage of the Complainant's name, mark and reputation for the commercial purposes of the Respondent. The disputed domain name is identical to the Complainant's name and mark which are distinctive in character consisting as they do of an unusual family name in combination with a specific business activity. Additionally, the Complainant is engaged in the construction business and the website to which the disputed domain name resolved on the date of the Complaint purported to advertise construction services for an enterprise called “Bouygues Construction” with an address in South East London, UK.

Furthermore, in the Response, the Respondent offered to sell the disputed domain name for \$4,320.00. This confirms this Expert in finding that the disputed domain name was chosen and registered to target and take predatory advantage of the Complainant's rights and goodwill.

This Expert finds therefore that the Complainant has Rights in respect of the name and mark BOUYGUES CONSTRUCTION which is identical to the disputed domain name; and the disputed domain name, in the hands of the Respondent, is an Abusive Registration. The Complainant is entitled to the relief sought.

## **7. Decision**

This Expert decides and directs that the disputed domain name bouyguesconstruction.co.uk be transferred to the Complainant forthwith.

**Signed .....**  
**James Bridgeman SC**  
**Expert**

**Dated 3 December 2018**