Decision for dispute CAC-UDRP-101406

Case number	CAC-UDRP-101406
Time of filing	2017-01-10 08:51:08
Domain names	Jcdecauxbillboards.com, Jcdecauxdirect.com, Jcdecauxdooh.com, Jcdecauxinternational.com, Jcdecauxmedia.com, Jcdecauxoutdoor.com, Jcdecauxrailway.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	JCDECAUX SA

Complainant representative

Organization	Nameshield (Maxime Benoist)

Respondent

Organization	Administrative Contact

OTHER LEGAL PROCEEDINGS

The panel is not informed of other legal proceedings relating to the Disputed domain names.

IDENTIFICATION OF RIGHTS

The Complainant owns several trademarks “JCDECAUX”, including many national trademarks based on the international trademark registration “JCDECAUX” with number 803887, registered on 27 November 2001.

The Complainant is also the owner of many domain names incorporating the JCDECAUX trademarks, such as <jcdecaux.com>, which has been registered since 23 June 1997.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

Since 1964, JCDecaux S.A. (the Complainant) is the worldwide number one in outdoor advertising. Its official website can be found at www.jcdecaux.com. Throughout the world, the company’s success is driven by meeting the needs of local authorities and advertisers by a constant focus on innovation. For more than 50 years JCDecaux SA has been offering

solutions that combine urban development and the provision of public services in many countries. The Complainant is currently the only group present in the three principal segments of the outdoor advertising market: street furniture, transport advertising and billboards.

JCDecaux SA owns several trademarks “JCDECAUX” including many national trademarks based on the international trademark registration “JCDECAUX” with number 803887, which has been registered since 27 November 2001. JCDecaux SA is also the owner of a large domain names portfolio including the distinctive wording JCDECAUX, such as <jcdecaux.com>, which has been registered since 23 June 1997.

The Disputed domain names <Jcdecauxbillboards.com>, <Jcdecauxdirect.com>, <Jcdecauxdooh.com>, <Jcdecauxinternational.com>, <Jcdecauxmedia.com>, <Jcdecauxoutdoor.com>, <Jcdecauxrailway.com> ("the Disputed Domain Names") were all registered by the Respondent on 1 November 2016.

I. The Complainant states that the Disputed Domain Names are confusingly similar to the Complainant’s trademarks JCDECAUX and associated domain names.

The Complainant states that the Disputed Domain Names <Jcdecauxbillboards.com>, <Jcdecauxdirect.com>, <Jcdecauxdooh.com>, <Jcdecauxinternational.com>, <Jcdecauxmedia.com>, <Jcdecauxoutdoor.com>, <Jcdecauxrailway.com> are confusingly similar to its trademarks JCDECAUX. Indeed, the Disputed Domain Names contain the Complainant’s registered trademarks JCDECAUX in their entirety.

The terms "billboards", “direct”, “dooh”, “international”, “media”, “outdoor”, and “railway” added at the end of each Disputed Domain Name, are terms linked to the Complainant’s outdoor advertising activity. These elements are not sufficient to escape the finding that the Disputed Domain Names are confusingly similar to the JCDECAUX trademarks and do not change the overall impression of the designation as being connected to the JCDECAUX trademarks of the Complainant. By contrast, the addition of these generic words in the Disputed Domain Names reinforces confusing similarity with the Complainant respective trademarks.

Moreover, the term JCDECAUX is a fanciful term, only known in relation to the Complainant. It has no meaning whatsoever in English, French or in any other language. A Google search of the expression JCDECAUX displays several results, all of them being related to the Complainant.

Hence, the Disputed Domain Names are confusingly similar to the Complainant's trademarks JCDECAUX.

II.The Complainant further asserts that the Respondent does not have any rights or legitimate interest in the Disputed Domain Names.

The Complainant contends that the Respondent is not affiliated with nor authorized by JCDECAUX in any way. The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names, and he is not related in any way to his business. The Complainant does not carry out any activity for, nor has any business with the Respondent.

Neither a licence nor an authorization has been granted to the Respondent to make any use of the Complainant’s JCDECAUX trademarks, or to apply for registration of the Disputed Domain Names by the Complainant.

Furthermore, websites in relation with the Disputed Domain Names all display web pages containing pay-per-click links related to the Respondent’s activity and it is inconceivable that the Respondent does not know the Complainant’s trademarks.

Thus, the Complainant contends that the Respondent has no rights or legitimate interest on the Disputed Domain Names.

Indeed, the Respondent has registered the Disputed Domain Names only in order to create a likelihood of confusion and to try to generate commercial gain.

Therefore, the Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names.

III.The Disputed Domain Names have been registered and are being used in bad faith

The Disputed Domain Names are confusingly similar to the Complainant's trademarks JCDECAUX. The Respondent registered the Disputed Domain Names by using the Complainant’s trademarks and a generic term associated to its activity.

Given the distinctiveness and reputation of the Complainant's trademarks, and also the generic terms used in the Disputed Domain Names, the Complainant states that the Respondent has registered the Disputed Domain Names with full knowledge of the Complainant's trademarks JCDECAUX, and uses them for the purpose of generating commercial gain because the Disputed Domain Names are dependent of the Complainant’s trademarks.

Furthermore, all websites under the Disputed Domain Names display web pages containing sponsored pay-per-clicks links.The Complainant contends that the Respondent has intentionally registered the Disputed Domain Names in order to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant’s trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent’s websites.The Complainant asserts that the Disputed Domain Names have been used by the Respondent for the purposes of intentionally attempting to attract Internet users in order to generate pay-per-click or other advertising revenue, by creating a likelihood of confusion with the Complainant’s trademark. This conduct disrupts the Complainant's business by diverting consumers away from the Complainant's official website.

Based on this, the Complainant concludes that the Respondent has registered and is using the Disputed Domain Names in bad faith.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Disputed Domain Names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Disputed Domain Names (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Disputed Domain Names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

PRINCIPAL REASONS FOR THE DECISION

The Disputed Domain Names are confusingly similar to the JCDECAUX trademarks of the Complainant, since the Disputed Domain Names contain the JCDECAUX trademarks in their entirety.

The terms "billboards", “direct”, “dooh”, “international”, “media”, “outdoor”, and “railway” added at the end of each of the Disputed Domain Names, are terms linked to the Complainant’s outdoor advertising activity. These elements are not sufficient to escape the finding that the Disputed Domain Names are confusingly similar to the trademark JCDECAUX.

Accordingly, the Panel finds that the Disputed Domain Names are confusingly similar to the JCDECAUX trademarks of the Complainant.

The Panel further finds that the Complainant successfully asserted that the Respondent does not have any rights or legitimate interest in respect of the Disputed Domain Names and that the Respondent has registered and used the Disputed Domain Names only to create confusion with the Complainant's JCDECAUX trademarks.

The incorporation of the well-known JCDECAUX trademarks into the Disputed Domain Names, in combination with the fact that all the websites under the Disputed Domain Names display web pages containing pay-per-clicks links, shows the absence of rights or legitimate interests and the bad faith on the part of the Respondent.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **JCDECAUXBILLBOARDS.COM**: Transferred
2. **JCDECAUXDIRECT.COM**: Transferred
3. **JCDECAUXDOOH.COM**: Transferred
4. **JCDECAUXINTERNATIONAL.COM**: Transferred
5. **JCDECAUXMEDIA.COM**: Transferred
6. **JCDECAUXOUTDOOR.COM**: Transferred
7. **JCDECAUXRAILWAY.COM**: Transferred

PANELLISTS

Name	**Tom Joris Heremans**

DATE OF PANEL DECISION 2017-02-17

Publish the Decision