Decision for dispute CAC-UDRP-101852

Case number	CAC-UDRP-101852
Time of filing	2018-01-25 08:54:15
Domain names	us-jcdecaux.com

Case administrator

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

Complainant

Organization	JCDECAUX SA

Complainant representative

Organization	Nameshield (Laurent Becker)

Respondent

Name	james white

OTHER LEGAL PROCEEDINGS

There are no pending or decided legal proceedings which relate to the dispute domain name that the Panel is aware of.

IDENTIFICATION OF RIGHTS

EU Trade Mark Registration No. 004961454 JCDecaux

FACTUAL BACKGROUND

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

The Complainant has provided outdoor advertising goods and services for more than 50 years. According to the facts set out in the Complaint the Complainant is part of the JCDecaux group of companies that has a presence in more than 75 countries, employs 13,030 people and had a global gross revenue figure of 3,392.8 Million Euro. Notably 8% of this gross revenue was derived from North America.

The Complainant owns several trademarks containing or consisting of the word “JCDECAUX“ that predate the creation date of the disputed domain name, including EU Trademark Registration No. 004961454 JCDecaux. The Complainant is also the registrant of numerous domain names containing the word “JCDECAUX“, including <jcdecaux.com> created on 23 June 1997. The Complainant has provided extracts from the website located at www.jcdecaux.com showing it has been extensively used by the Complainant to promote the JCDECAUX trademark.

As evidenced by a WHOIS extract provided with the Complaint the disputed domain name was registered on 17 January 2018 by the Respondent "James White" (not "17 January 2017" as is erroneously indicated in the body of the Complaint). Mr White provides his address as one located in the United States of America.

The disputed domain name does not resolve to any website. However on 18 January 2018, when the disputed domain name had only been registered for one day, an e-mail was sent from an e-mail address using the disputed domain name to the Complainant's own travel department, namely from t.mason@us-jcdecaux.com. The e-mail falsely purported to be from "Jcdecaux North America Inc." and it sought private information about the Complainant's internal travel arrangements for staff.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is 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 name (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 name has been registered and is 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

Paragraph (4)(a) of the Policy lists three elements that the Complainant must prove to merit a finding that the disputed domain name registered by the Respondent be transferred to the Complainant:

1) the domain name is identical or confusingly similar to a trademark or service mark ("mark") in which the Complainant has rights; and
2) the Respondent has no rights or legitimate interests in respect of the domain name; and
3) the domain name has been registered and is being used in bad faith.

The Panel is satisfied the Complainant has satisfied all three elements for the principal reasons set out below.

A. RIGHTS IN AN IDENTICAL OR CONFUSINGLY SIMILAR TRADEMARK

As mentioned above the Complainant asserts it has numerous trademark registrations containing or consisting of the word JCDECAUX. The Panel notes in particular that the Complainant has evidenced rights in EU Trade Mark Registration No. 004961454 JCDecaux, which predate the registration date of the disputed domain name.

To satisfy paragraph 4(a)(i) of the Policy it is enough that the Panel is satisfied that the Complainant has registered rights in a trademark that predates the registration of the disputed domain name in a single jurisdiction (even if that single jurisdiction is not one in which the Respondent resides or operates) (Koninklijke KPN N.V. v. Telepathy, Inc D2001-0217

(WIPO May 7, 2001); see also WIPO Case Nos. D2012-0141 and D2011-1436). The Complainant has clearly satisfied such in relation to the trademark JCDECAUX.

The next question is whether the disputed domain name is confusingly similar to the JCDECAUX trademark.

The Panel disregards the gTLD suffix ".com" for the purpose of this comparison. However the Panel further notes that if such a suffix were to add anything it would only make the disputed domain name more similar to the Complainant's well used <jcdecaux.com> domain name, which has the same suffix.

Further the Panel finds that in circumstances where the Complainant has a strong trading presence in the United States of America and the registrant claims to be from the United State of America the inclusion of the prefix "us-" does not diminsh the likelihood of confusion as it is likely to be viewed as falsely indicating a connection with the Complainant's business in the United States of America. Given the global nature of the internet and the fact that persons communicating online are unable to verify each others physical locations other than from information they see or hear on their computers or devices it is likely for internet users to see some elements of domain names that allude to locations, countries or jurisdictions (like "US-" or "EU-") as indicating geographic origin. This is indeed the purpose of country code top level domains. Likewise the inclusion of a geographic indicator in a domain name prior to the ".com" gTLD suffix may serve the same purpose and be unlikely to reduce the confusion caused by the additional inclusion of the trademark in the domain name. The Panel refers to the decisions in Disney Enterprises Inc v. Orients Rugs & More /NA, Claim No. FA1404001555495 (FORUM, May 21, 2014) and Donald J. Trump v. Web-adviso, D2010-2220 (WIPO, March 5, 2011) which both similarily disregarded the inclusion of "india" as a geographic indicator in the domain names following well-known trademarks.

The disputed domain name is confusingly similar to the JCDECAUX trademark.

NO RIGHTS OR LEGITIMATE INTERESTS

The Respondent's name according to the WHOIS extract is "James White". This name bears no resemblance to "JCDECAUX". Further, the disputed domain name does not resolve to a website so there is no basis to conclude legitimate interests from any such use.

However, what is most telling is that the disputed domain name has been used as part of an attempt to obtain information from an officer of the Complainant by pretending to be another officer of the Complainant. Such conduct could not be further from indicating a legitimate interest in the disputed domain name.

It is clear that the Respondent has no rights or interests in the disputed domain name.

BAD FAITH

The Panel finds that the Complainant has established that the Respondent has used the disputed domain name as part of a dishonest attempt to obtain the Complainant's own internal information from the recipients of e-mails by pretending to be an officer of the Complainant. Such a blatant attempt to dishonestly acquire information from a Complainant is a clear example of bad faith.

However the severity of such bad faith is worsened by the fact that the Respondent engaged in analogous behaviour in relation to another well-known trademark that was the subject of Bollare v. James White, Case No. 101771 (CAC, November 30, 2017). That case involved the registration of the domain name <us-bollare.com> and the use of that domain name to, as in the present matter, attempt to obtain the Complainant's own internal information from the recipients of e-mails by pretending to be an officer of the Complainant. Unsurprisingly the Respondent was found to have acted in bad faith and the domain name was transferred.

Although one should treat the fact that a Respondent has been found to have acted in bad faith on one previous occasion with caution, and not by itself conclusive of a course of conduct, given the uncanny similarities between the matter metioned

in the preceding paragraph and the present matter it is clear that the Respondent has adopted a particular dishonest practice of registering and using domain names containing well-known trademarks for the purpose of obtaining information from e-mail recipients.

It is clear that the Respondent has registered and used the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **US-JCDECAUX.COM**: Transferred

PANELLISTS

Name	**Mr Andrew Norman Sykes**

DATE OF PANEL DECISION 2018-02-27

Publish the Decision