Decision for dispute CAC-UDRP-101855

Case number	CAC-UDRP-101855
Time of filing	2018-01-25 08:55:15
Domain names	jcdecauxbank.com

Case administrator

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

Complainant

Organization	JCDECAUX SA

Complainant representative

Organization	Nameshield (Laurent Becker)

Respondent

Name	Kassie Grecula

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is, inter alia, a registered owner of the following trademark containing word elements "JCDECAUX":

JCDECAUX (word), International (WIPO) Trademark, priority date 20 June 2001, registration date 27 November 2001, trademark no. 803987, registered for goods and services in classes 6, 9, 11, 19, 20, 35, 37, 38, 39, 41, and 42.

Besides other EU and national trademarks consisting of the " JCDECAUX " denomination.
(collectively referred to as "Complainant's trademarks").

The Complainant has also registered a number of domain names under generic Top-Level Domains ("gTLD") and country-code Top-Level Domains ("ccTLD") containing the term "JCDECAUX".

FACTUAL BACKGROUND

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

Prior Panels have held that the addition of words can worsen the confusing similarity between a trademark and a domain

name. Please see for instance:

- WIPO Case No. D2010-2124, Costco Wholesale Corporation and Costco Wholesale Membership, Inc. v. Kenneth Terrill: “The addition of certain words, as here, can “exacerbate […] the confusing similarity between the [Complainant’s] trademark and the Domain Name and increase […] the risk of confusion between the Domain Name and the […] trademarks.”

Given the notoriety of the Complainant, the Respondent was aware of Complainant’s JCDECAUX trademark at the time of registration of the disputed domain name.

See WIPO Case No. D2015-1740 JCDecaux SA v. Whois Privacy Protection Service < jcdecauxna.mobi> (“Given the fame of JCDECAUX trademark and the arguments and evidence of the case, the Panel concludes that the Respondent registered and is using the disputed domain name in bad faith.”)

PARTIES CONTENTIONS

The Parties' contentions are the following:

COMPLAINANT:

CONFUSING SIMILARITY

The Complainant states that:

- The disputed domain name contains “JCDECAUX” word element of Complainant's trademarks in its entirety and it is thus confusingly similar to Complainant’s trademarks.

- The addition of the generic term “BANK“ adds no distinctiveness to the disputed domain name.

- The Complainant refers to previous domain name decisions contending that adding a general term to a trademark can enhance the confusing similarity of the disputed domain name since it might lead internet users to wrongly believe that the said domain name is endorsed by Complainant and is related to its business.

Thus, according to the Complainant the confusing similarity between Complainant’s trademarks and the disputed domain name is clearly established.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant states that:

- The Respondent has not been commonly known by the disputed domain name.

- The Complainant has not authorized, permitted or licensed the Respondent to use Complainant’s trademarks in any manner. The Respondent has no connection or affiliation with the Complainant whatsoever. On this record, Respondent has not been commonly known by the disputed domain name.

- Furthermore, the disputed domain name has not been during its existence genuinely used, which implies that there is no Respondent’s intention to use the disputed domain name for legitimate purposes.

BAD FAITH REGISTRATION AND USE

The Complainant states that:

- Seniority of the Complainant's trademarks predates by 15 years the disputed domain name registration and such trademarks are well-known in relevant business circles. The Respondent can be considered to be aware of the Complainant's trademarks when registering the disputed domain name due to well-known character thereof.

- It is well-founded that registration of the disputed domain name that is confusingly similar to the Complainant's trademarks which enjoys strong reputation, plus other facts, such as above described no genuine use of the disputed domain name, are sufficient to establish bad faith under the 4(a)(iii) of the Policy.

- The Complainant refers to previous domain name decisions contending that registering a domain name incorporating trademarks that enjoy high level of notoriety and well-known character constitute prima facie registration in bad faith, despite a fact that such domain names are not genuinely used.

The Complainant presented the following evidence which has been assessed by the Panel:

- Information about the Complainant and its business;
- Excerpts from various trademark databases regarding Complainant's trademarks;
- Excerpts from various domain name databases regarding Complainant's domain names;
- Screenshots of the disputed domain name website (evidencing no genuine use of the same);
- Screenshots of Google search results for "JCDECAUX"

RESPONDENT:
The Respondent has not provided any response to the Complaint.

RIGHTS

The Panel concluded that the disputed domain name is confusingly similar to trademarks 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

RIGHTS

The disputed domain name and the Complainant's trademarks are nearly identical since both fully incorporate a distinctive word element "JCDECAUX".

Addition of a non-distinctive generic word “BANK” to it cannot prevent the association in the eyes of internet consumers between the disputed domain name and the Complainant’s trademarks and thus the likelihood of confusion still exists.

For sake of completeness, the Panel asserts that the top-level suffix in the domain name (i.e. the “.com”) must be disregarded under the identity and confusing similarity tests as it is a necessary technical requirement of registration.

Therefore, the Panel has decided that there is identity in this case, it also concludes that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant’s assertions that the Respondent is not commonly known by the disputed domain name and is not affiliated with nor authorised by the Complainant are sufficient to constitute a prima facie showing of absence of rights or legitimate interest in the disputed domain name on the part of the Respondent.

In addition, given the fact that (i) the disputed domain name has not been genuinely used and (ii) in the absence of the Respondent's response, the Panel concludes that there is no indication that the disputed domain name was intended to be used in connection with a bona fide offering of goods or services as required by the Policy.

Consequently, the evidentiary burden shifts to the Respondent to show by concrete evidence that it does have rights or legitimate interests in that name. However, the Respondent failed to provide any information and evidence that it has relevant 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 Respondent has not genuinely used the disputed domain name in any manner, however, the Panel concludes (as it has been ruled in many similar cases, as for example Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, <telstra.org>, Jupiters Limited v. Aaron Hall, WIPO Case No. D2000-0574, <jupiterscasino.com>, Ladbroke Group Plc v. Sonoma International LDC, WIPO Case No. D2002-0131, <ladbrokespoker.com>) that the apparent lack of genuine use of the domain name without any active attempt to sell or to contact the trademark holder (passive holding), does not as such prevent a finding of bad faith.

Examples of what may be cumulative circumstances found to be indicative of bad faith include cases in which (i) the Complainant has a well-known trademark and (ii) there is no genuine use of the disputed domain name by the Respondent (irrespective of whether the latter should also result in the generation of incidental revenue from advertising referrals).

Based upon the concepts above, which the Panel finds satisfied in this case, even though there is no real use of the dispute domain name, the Panel contends, on the balance of probabilities, that the disputed domain name is being used (held) by the Respondent in bad faith.

For the reasons described above, since (i) there is only a remote chance that the Respondent has registered the disputed domain name just by a chance and without having a knowledge about the existence of the Complainant’s rights and business (ii) there is no real use of the dispute domain name, the Panel contends, on the balance of probabilities, that the disputed domain name has been registered and is being used by the Respondent in bad faith.

Thus, the Panel has taken a view that 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.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **JCDECAUXBANK.COM**: Transferred

PANELLISTS

Name	**JUDr. Jiří Čermák**

DATE OF PANEL DECISION 2018-03-01

Publish the Decision