Decision for dispute CAC-UDRP-101925

Case number	CAC-UDRP-101925
Time of filing	2018-03-20 09:44:07
Domain names	ijcdecaux.com

Case administrator

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

Complainant

Organization	JCDECAUX SA

Complainant representative

Organization	Nameshield (Enora MILLOCHEAU)

Respondent

Name	Lance Homstol

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

TRADEMARKS

- US TM (word) JCDecaux no. 2359171, filed on 21 December 1998, registered on 20 June 2000, duly renewed, in class (Nice Classification) 19

- International TM (word) JCDecaux no. 803987, registered on 27 November 2001, duly renewed, in classes (Nice Classification) 6, 9, 11, 19, 20, 35, 37, 38, 39, 41, 42, with designation of Bahrein, Estonia, Republic of Korea, Lithuania, Mexico, Norway, Turkey, Uzbekistan, Azerbaijan, Bosnia and Herzegovina, Switzerland, China, Czech Republic, Algeria, Egypt, Croatia, Hungary, Democratic People's Republic of Korea, Kazakhastan, Morocco, Monaco, Montenegro, The former Yogoslav Republic of Macedonia, Poland, Romania, Serbia, Russian Federation, Slovenia, Slovakia, Ukraine and Vietnam

- EUTM (word) JCDecaux no. 004961454, filed on 8 March 2006, registered on 12 April 2007, duly renewed, in classes 6, 9, 12, 39

DOMAIN NAMES

The Complainant is owner of a large domain name portfolio, comprising in particular the domain name <jcdecaux.com> registered on 23 June 1997 and used as its main website.

COMPANY NAME

The Complainant has been carrying on business under the company name JCDecaux SA (joint stock company under French law) named after its founder Jean-Claude Decaux.

The above-mentioned rights are hereinafter referred to as the JCDECAUX Trademark.

The Complainant has proved its rights in the JCDECAUX Trademark for the purposes of the Policy.

FACTUAL BACKGROUND

The following facts are asserted by the Complainant and not contested by the Respondent.

The Complainant, JCDecaux SA, is well-known worldwide in outdoor advertising being present in three principal segments: street furniture, transport advertising and billboard. The Complainant has more than 49,300 screens across 30 countries in airports, rail and metro stations, shopping malls and on billboards and street furniture. Employing a total of 12,000 people, the Complainant is present in more than 60 countries and 3,700 cities and in 2013 generated revenues of €2,676m.

The Complainant owns several trademarks and a large domain name portfolio, all of them characterized by the presence of the distinctive wording “JCDECAUX“.

The disputed domain name <ijcdecaux.com> was registered on 7 March 2018 and is inactive since its registration.

PARTIES CONTENTIONS

The Complainant states that the disputed domain name is confusingly similar to its trademarks since it contains the whole JCDECAUX Trademark prefixed by the letter “i“ and, thus, this represents a clear case of typosquatting.

The Complainant contends that the Respondent is not known as “IJCDECAUX” and has not acquired trademark mark rights in such term.

The Complainant also states that the Respondent is not affiliated with nor authorized by the Complainant and is not related in any way to its business. The Complainant does not carry out any activity for, nor has any business with the Respondent.

Neither license nor authorization has been granted to the Respondent to make any use of the Complainant’s trademarks or to apply for registration of the disputed domain name.

The disputed domain name is inactive and, therefore, the Complainant contends that the Respondent is not making any use of the disputed domain name and has registered it with the sole aim to take advantage of the good reputation the Complainant had built up in its trademarks and in order to create a likelihood of confusion with the Complainant's trademarks and domain names.

The Complainant has requested the cancellation of the disputed domain name.

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

PRIVACY OR PROXY REGISTRATION

The disputed domain name has been registered with privacy or proxy registration service. Accordingly, the Complainant named the proxy service as Respondent in its Complaint. Upon CAC's Request for Registrar Verification, the registrar of the disputed domain name provided the underlying registrant information. Then CAC requested the Complainant to correct the identification of the Respondent, disclosing the underlying registrant information received from the registrar to the Complainant. The Complainant amended its Complaint to reflect the disclosed underlying registrant information within the time frame fixed by CAC.

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 requires the Complainant to prove each of the following three elements to obtain the cancellation (or the transfer) of the domain name:

(1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service 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.

1. THE COMPLAINANT’S RIGHTS AND CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAME TO THE COMPLAINANT'S MARK

The Complainant has established rights in the JCDECAUX Trademark. The Complainant's mark, registered prior to the registration of the disputed domain name (7 March 2018), is distinctive and well-known worldwide.

The Panel finds that the disputed domain name is confusingly similar to Complainant’s mark, because it contains Complainant’s entire JCDECAUX Trademark and differs from such mark by merely adding the letter “i“ and the top-level domain name “.com“.

In UDRP cases where a domain name incorporates the entirety of a trademark, the domain name is normally considered confusingly similar to that mark under the first element of the UDRP (see paragraph 1.7 WIPO Overview 3.0).

UDRP Panels also agree that a domain name consisting of a common, obvious, or intentional misspelling of a trademark is confusingly similar to the relevant mark for the purposes of the first element of the UDRP (so called typosquatting cases - see paragraph 1.9 WIPO Overview 3.0).

Examples of such typos include:

- adjacent keyboard letters
- the substitution of similar-appearing characters (e.g., upper vs lower-case letters or numbers used to look like letters)
- the use of different letters that appear similar in different fonts
- the use of non-Latin internationalized or accented characters
- the inversion of letters and numbers
- the addition or interspersion of other terms or numbers.

The Complainant is quite often victim of abusive registrations, including typosquatting cases, in which letters of its well-known JCDECAUX Trademark are inverted or other non-distinctive terms or letters are added to such mark. See, inter alia, CAC Case 101892 <jcdacaux.com>, CAC Case 101867 <jcdecuax.com>, CAC Case 101852 <us-jcdecaux.com>.

Hence, considering the above-mentioned UDRP case law and judging the present case on its own merits, this Panel finds that the slight differences between the domain name <ijcdecaux.com> and the Complainant's mark, i.e. the addition of the letter "i" and the TLD (which is a technical requirement), are insufficient to distinguish one from the other under the Policy. See Forum Case FA1802001773956 <icreditone.com> and <icredit1.com>.

Accordingly, the Panel finds that the Complainant has proven the first element of the paragraph 4(a) of the Policy.

2. THE RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS TO THE DISPUTED DOMAIN NAME

It is a consensus view of UDRP Panels that the Complainant shall establish a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name to shift the burden of proof to the Respondent.

According to the contentions of the Complainant and the documentary evidences provided in this case, the Respondent, an individual named Lance Homstol:

- is not affiliated with nor authorized by the Complainant in any way
- has no any business relationship with the Complainant
- has not obtained any grant of licence or authorization of the Complainant to use the JCDECAUX Trademark or to apply for the registration of the disputed domain name
- is not commonly known by the domain name
- has not acquired any trademark or service mark rights in the term "IJCDECAUX"
- has not actively used or demonstrably prepared to use the domain name in connection with a bona fide offering of goods or services
- has not made a legitimate non-commercial or fair use of the domain name (which does not consist in a generic or descriptive term), without intent for commercial gain to misleadingly divert consumers or to tarnish the Complainant's trademark.

The Panel finds that the Complainant has established its prima facie case and the Respondent, in not formally responding to the Complaint, has failed to invoke any of the circumstances, which could demonstrate any rights or legitimate interests in the disputed domain name. Thus, the Panel is satisfied that the Complainant has met the second requirement of the paragraph 4(a) of the Policy.

3. BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAME

The Respondent has used a privacy or proxy registration service. Although the use of such service is not in and of itself an indication of bad faith, the circumstances and the manner in which such service is used, including whether the Respondent is operating a commercial and trademark-abusive website, may however impact the Panel's assessment of bad faith (see paragraph 3.6 of the WIPO Overview 3.0).

The Respondent has registered the disputed domain name confusingly similar to Complainant's mark, since it incorporates the JCDECAUX Trademark in its entirety and differs from such mark merely by adding the non-distinctive letter “i“ and the TLD “.com“ (which is disregarded for the purpose of determination of confusing similarity between the disputed domain name and the trademark of the Complainant as it is a technical requirement of registration). Given the distinctiveness and reputation of the Complainant's mark worldwide, it is inconceivable that the Respondent could have registered the disputed domain name for a mere chance without actual knowledge of the Complainant's rights in such well-known mark and the intention to exploit such reputation.

The disputed domain name is not actively used. UDRP Panels consider the following factors when applying the passive holding doctrine:
- the degree of distinctiveness and/or reputation of the Complainant’s trademark
- the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good faith use
- the Respondent’s concealing its identity (privacy or proxy service) or use of false contact details
- the implausibility of any good faith use to which the disputed domain name may be put.

Taken into account all circumstances of this case, the Panel finds that it is implausible that there is any legitimate purpose in the registration and use of the disputed domain name by the Respondent.

The Panel, thus, finds that the Complainant has discharged the burden of proof to show that the disputed domain name has been registered and is being used in bad faith (paragraph 4(a)(iii) of the Policy).

Since the Complainant has requested the cancellation of the disputed domain name, this Panel orders the disputed domain name <ijcdecaux.com> be cancelled.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **IJCDECAUX.COM**:

PANELLISTS

Name	**Avv. Ivett Paulovics**

DATE OF PANEL DECISION 2018-04-13

Publish the Decision