Decision for dispute CAC-UDRP-101921

Case number	CAC-UDRP-101921
Time of filing	2018-03-19 09:55:03
Domain names	jcedcaux.com

Case administrator

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

Complainant

Organization	JCDECAUX SA

Complainant representative

Organization	Nameshield (Enora MILLOCHEAU)

Respondent

Name	Mike Ott

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the owner of several trade mark registrations for JCDECAUX, including International trade mark registration number 803987, which was registered on 27 November 2001.

This trade mark registration predates the registration of the disputed domain name on 8 March 2018.

The Complainant is also the owner of a large portfolio of domain names that incorporate its trade mark JCDECAUX , including <jcdecaux.com> which was registered on 23 June 1973.

FACTUAL BACKGROUND

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

The Complainant, JCDecaux S.A., is a worldwide leading outdoor advertising company. The Group is listed on the Premier Marché of the Euronext Paris stock exchange and is part of Euronext 100 index.

The Complainant owns several trade mark registrations for JCDECAUX. It is also the owner of a large portfolio of domain names, including <jcdecaux.com>, which has been registered since 23 June 1997.

The disputed domain name <jcedcaux.com> was registered on 8 March 2018.

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 requires the Complainant to prove each of the following three elements:

(i) The disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights.
(ii) The Respondent has no rights or legitimate interests in the disputed domain name.
(iii) The disputed domain name has been registered and used in bad faith.

Identical or confusingly similar

The Complainant asserts that:
(i) The disputed domain name <jcedcaux.com> is confusingly similar to its trade mark JCDECAUX.
(ii) The inversion of the letters “D” and “E” in the trade mark “JCDECAUX” and the use of the gTLD “.com” are insufficient to change the overall impression that the disputed domain name is confusingly similar to the Complainant’s trade mark. (See CAC No. 101867, JCDECAUX SA v. Noah (<jcdecuax.com>).)
(iii) This is a clear case of "typo-squatting" in that the disputed domain name contains an obvious misspelling of the Complainant’s trade mark JCDECAUX. It asserts that previous panels have found that slight spelling variations do not prevent a disputed domain name from being confusingly similar to a complainant’s trade mark. (See CAC Case No. 101517, Boehringer Ingelheim Pharma GmbH & Co.KG v. Raju Khan <boehringeringelhein.com>).)
(iv) It is well-established that a domain name that wholly incorporates a Complainant’s registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP. (See WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin).

It is well established that the generic top level suffix " .com" may be disregarded when considering whether a disputed domain name is confusingly similar to a trade mark in which the Complainant has rights.

The Panel is satisfied that the Complainant is the owner of the registered trade mark JCDECAUX that predates the registration of the disputed domain name. The only difference between the Complainant's trade mark, JCDECAUX and the disputed domain name is change in position of the letters "d" and "e". The misspelling of the Complainant's trade mark does not prevent the disputed domain name being confusingly similar mark in which the Complainant has rights.

The Panel finds that the disputed domain name is confusingly similar to the Complainant's trade mark JCDECAUX, and that the requirements of paragraph 4(a)(i) of the Policy have been met.

No rights or legitimate interests

The Complainant asserts that the Respondent has no rights or legitimate interests in the disputed domain name and states that:
(i) The Respondent is not known as “JCEDCAUX” and has not acquired rights in this name. It says past panels have held that a Respondent was not commonly known by a disputed domain name if the WHOIS information was not similar to the disputed domain name. (See FORUM case no. FA 96356 - Broadcom Corp. v. Intellifone Corp.)
(ii) The Respondent is not affiliated with the Complainant nor authorised to use the Complainant’s trade mark JCDECAUX. The Complainant does not carry out any activity for, nor has any business with the Respondent and that the Respondent is not related in any way to its business.
(iii) The domain name is inactive and that the Respondent has not made any use of disputed domain name since its registration. This confirms that the Respondent has no demonstrable plan to use the disputed domain name and demonstrates a lack of legitimate interests in the disputed domain name.
(iv) Once the Complainant makes out a prima facie case that the Respondent lacks rights or legitimate interests, the Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the UDRP (See WIPO case no. D2003-0455 Croatia Airlines d.d. v. Modern Empire Internet Ltd.)

The Panel finds that there is nothing to indicate that the Respondent is commonly known as “JCEDCAUX”. The Respondent is not affiliated with the Complainant nor authorised to use the Complainant's trade mark JCDECAUX.

The Complainant has established a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name. The burden of proof now shifts to the Respondent. The Respondent has not filed a Response, nor disputed any of the Complainant's submissions. The Respondent has made no claim to either having any relevant prior rights of its own, or to having become commonly known by the disputed domain name. There is no evidence that the Respondent has used or has been preparing to use the disputed domain name in connection with a bona fide offering of goods or services, or for a legitimate non-commercial or fair use, without intent for commercial gain.

Accordingly, the Panel finds that the Complainant has shown that the Respondent has no rights or legitimate interests in respect of the disputed domain name and that the requirements of paragraph 4(a)(ii) of the Policy have been met.

Registered and used in bad faith

The Complainant asserts that:
(i) The disputed domain name is confusingly similar to its trade mark JCDECAUX.
(ii) Registering the domain name with the misspelling of the Complainant's trade mark JCDECAUX was intentionally designed to be confusingly similar to the Complainant’s trade mark. The Complainant submits that previous panels have seen such action as evidence of bad faith. (FORUM Case No. FA 877979, Microsoft Corp. v. Domain Registration Philippines and FORUM Case No. FA 157321 Computerized Sec. Sys., Inc. v. u.)
(iii) Given the distinctiveness of the Complainant's trade mark and reputation, the Respondent has registered the disputed domain name with full knowledge of the Complainant's trade mark JCDECAUX.
(iv) The Respondent registered the disputed domain name to take advantage of the reputation the Complainant had built up

in its JCDECAUX trade mark and to create a likelihood of confusion with the Complainant’s trade mark.

The Respondent has not filed a response nor disputed any of the Complainant's submissions. The Complainant's numerous trade mark registrations for JCDECAUX predate the registration of the disputed domain name, which was registered using a privacy service. There appears no reason why the Respondent would register the disputed domain name other than to create a likelihood of confusion with the Complainant's trade mark JCDECAUX.

The Respondent has provided no evidence of actual or contemplated good faith use of the disputed domain name. It is possible in certain circumstances for a passive holding by the Respondent to amount to the disputed domain name being used in bad faith. (WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows.) In the present case there does not appear to be any plausible actual use of the disputed domain name that would be legitimate.

Considering the evidence submitted and the circumstances of the case, the Panel finds that the disputed domain name was registered and used in bad faith and that the requirements of paragraph 4(a)(iii) of the Policy have been met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **JCEDCAUX.COM**:

PANELLISTS

Name	**Mrs Veronica Bailey**

DATE OF PANEL DECISION 2018-04-25

Publish the Decision