Decision for dispute CAC-UDRP-101954

Case number	CAC-UDRP-101954
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Domain names	jcdecauxx.com

Case administrator

Name	Sandra Lanczová (Case admin)

Complainant

Organization	JCDECAUX SA

Complainant representative

Organization	Nameshield (Laurent Becker)

Respondent

Name	Neil Chamberlain

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant owns the trademark “JCDECAUX” Including international trademark registration “JCDECAUX” number 803987 registered since November 27, 2001 in relation to advertising services. It owns jcdecaux.com.

FACTUAL BACKGROUND

The disputed domain name <jcdecauxx.com> was registered on April 30th 2018 and has not been used.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

Since 1964, JCDecaux S.A. (website at: www.jcdecaux.com) is the worldwide number one in outdoor advertising. 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 approximatively 1,785 cities in 56 countries. The Complainant is

currently the only group present in the three principal segments of outdoor advertising market: street furniture, transport advertising and billboard.

All over the world, the digital transformation is gathering pace: JCDECAUX® now have more than 49,300 screens across 30 countries in Airports, Rail and Metro Stations, Shopping Malls, on Billboards and Street Furniture.

The Group is listed on the Premier Marché of the Euronext Paris stock exchange and is part of Euronext 100 index. Employing a total of 12,000 people, the Group is present in more than 60 different countries and 3,700 cities and has generated revenues of €2,676m in 2013

JCDecaux SA owns several trademarks “JCDECAUX” such as the international trademark registration “JCDECAUX” number 803987 registered since 27 November 2001.

JCDecaux SA is also the owner of a large domain names portfolio, including the same distinctive wording JCDECAUX ®, such as <jcdecaux.com> registered since June 23.

The disputed domain name <jcdecauxx.com> was registered on April 30th 2018.

The domain name is inactive since its registration.

The Complainant states that the disputed domain name <jcdecauxx.com> is confusingly similar to its trademarks and branded services JCDECAUX®, as it incorporates the whole mark before adding the letter “X” at the end and the “.com” gTLD. Therefore, the disputed domain name is confusingly similar to the Complainant’s trademarks.

This is thus a clear case of "typosquatting“, i.e. the disputed domain name obviously contains the Complainant’s trademark, with the mere addition of the letter “X”: JCDECAUXX instead of JCDECAUX.

Previous Panel have concluded that the addition of a letter and of the generic top-level domain “.com” is insufficient to distinguish the domain name from the mark.

See FORUM case no. FA0704000956501 T.R. World Gym-IP, LLC v. William D'Addio : The Panel concluded that the disputed domain name, <worldgyms.com>, was “identical or confusingly similar to the mark WORLD GYM”.

Finally, 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”. Please see WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin.

Thus, the disputed domain name is confusingly similar to the Complainant's trademarks JCDECAUX®.

The Respondent does not have any rights or legitimate interest in the disputed domain name.

According to the WIPO case no. D2003-0455 Croatia Airlines d.d. v. Modern Empire Internet Ltd., the Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests. Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the UDRP.

The Respondent is not known as “JCDECAUXX” and has not acquired trademarks mark rights on this term. Indeed, 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. Please see for instance:

- FORUM case no. FA 96356 - Broadcom Corp. v. Intellifone Corp: Panel stated that the Respondent has “no rights or legitimate interests because the respondent is not commonly known by the disputed domain name or using the domain

name in connection with a legitimate or fair use".

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 name, and he 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 licence nor authorization has been granted to the Respondent to make any use of the Complainant's trademarks JCDECAUX®, or apply for registration of the disputed domain name by the Complainant.

The domain name is inactive. Therefore, the Complainant contends that Respondent did not make any use of disputed domain name since its registration, and it confirms that Respondent has no demonstrable plan to use the disputed domain name. It demonstrates a lack of legitimate interests in respect of the disputed domain name.

Therefore, the Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

The domain name(s) has been registered and is being used in bad faith

By registering the domain name <jcdecauxx.com>, which contains the Complainant's trademarks and the mere addition of the letter "X" at the end, the Complainant can state that this practical was intentionally designed to be confusingly similar with the Complainant's trademarks. Previous UDRP Panels have seen such actions as evidence of bad faith. Please see for instance:
- FORUM case no. FA 877979, Microsoft Corp. v. Domain Registration Philippines: finding bad faith registration and use of the <microssoft.com> domain name as it merely misspelled the complainant's MICROSOFT mark.
- FORUM case no. FA 157321 Computerized Sec. Sys., Inc. v. Hu: finding that the respondent engaged in typosquatting, which is evidence of bad faith registration and use under Policy ¶ 4(a)(iii)).

Given the distinctiveness of the Complainant's trademark and reputation, the Complainant can states that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark JCDECAUX®, and therefore could not ignore the Complainant.

Thus, the disputed domain name was registered by the Respondent in an effort to take advantage of the good reputation Complainant had built up in its JCDECAUX® trademarks, with the sole aim to create a likelihood of confusion with the Complainant's trademarks and domain names.

On these bases, the Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith.

RESPONDENT:

The Respondent has been subject to a hacked Microsoft Business 365 where illegal activity has taken place on its account, which include domains and users being added to its account - Microsoft have acknowledged that the Respondent's account has been hacked and have ceased all use of our account, domain name and emails.

RIGHTS

Identical or Confusingly Similar

The Disputed domain name consists of a misspelled version of the Complainant's JCDECAUX mark (which is registered as an international registration since 2001 for advertising services) and the gTLD .com. The Panel agrees that misspellings such as addition of a a letter does not distinguish the Disputed domain name from the Complainant's JCDECAUX trade mark

pursuant to the Policy. See Twitch Interactive Inc. v Antonio Teggi, FA 1626528 (Forum Aug 3, 2015) (where an addition ‘c’ was added).

The gTLD .com does not serve to distinguish the Disputed domain name from the Complainant’s mark. See Red Hat Inc v Haecke FA 726010 (Forum July 24, 2006) (concluding that the redhat.org domain name is identical to the Complainant's red hat mark because the mere addition of the gTLD was insufficient to differentiate the Disputed domain name from the mark).

The Complainant has, to the satisfaction of the Panel, shown the Disputed domain name is 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 not authorised the use of its mark. The Respondent maintains its account has been hacked. As such it appears that the unknown true Respondent has not answered this Complaint and there is no evidence or reason to suggest the Respondent is, in fact. commonly known by the Disputed domain name. See Alaska Air Group, Inc. and its subsidiary, Alaska Airlines v. Song Bin, FA1408001574905 (Forum September 17, 2014) (holding that the respondent was not commonly known by the disputed domain name as demonstrated by the WHOIS information and based on the fact that the complainant had not licensed or authorized the respondent to use its ALASKA AIRLINES mark).

Since the Disputed domain name has not been used, it has not been used for a bona fide offering of goods and services or a legitimate non commercial fair use.

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 Disputed domain name seeks to take advantage of the situation where Internet users may make a typographical error. Typosquatting itself is evidence of relevant bad faith registration and use. See Diners Club int'l Ltd. v Domain Admin ****** It's all in the name ******, FA 156839 (Forum June 23, 2003) (registering a domain name in the hope that Internet users will mistype the Complainant’s mark and be taken to the Respondent’s site is registration and use in bad faith).

The overriding objective of the Policy is to curb the abusive registration of domain names in circumstances where the registrant seeks to profit from or exploit the trade mark of another. Passive holding of a domain name containing a mark with a reputation can be bad faith registration and use. See Telstra Corporation Limited v Nuclear Marshmallows, D2000-0003 (WIPO Feb. 18, 2000).

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 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).

PRINCIPAL REASONS FOR THE DECISION

The Disputed domain name is a typosquatted version of the Complainant’s mark and, therefore, intentionally confusingly similar to it. Although the Disputed domain name has not been used, typosquatting and inactive use of a Disputed domain name containing the registered trade mark of another is bad faith registration and use and cannot be a legitimate use or constitute rights in the Disputed domain name.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

1. **JCDECAUXX.COM**: Transferred

PANELLISTS

Name	**Dawn Osborne**

DATE OF PANEL DECISION 2018-05-15

Publish the Decision