Decision for dispute CAC-UDRP-101961

Case number	CAC-UDRP-101961
Time of filing	2018-04-12 09:51:52
Domain names	jcdiecaux.com

Case administrator

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

Complainant

Organization	JCDECAUX SA

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	dre dre

OTHER LEGAL PROCEEDINGS

The Panel is unaware of other proceedings which may be pending of have been decided and which are related to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of a number of trademarks such as International Registration No. 803987 JCDECAUX protected since 2001. The Complainant is also the owner of a number of registered domain names such as <jcdecaux.com>, registered in 1997.

FACTUAL BACKGROUND

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

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

See FORUM case No. FA 0956501 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”.

The Respondent is not known as “JCDIECAUX” 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 disputed 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.

See WIPO case no. D2000-1164, Boeing Co. v. Bressi: the Panel stated that the “Respondent has advanced no basis on which the Panel could conclude that it has a right or legitimate interest in the domain names”;

FORUM case No. FA 933276 2007, George Weston Bakeries Inc. v. McBroom: “finding that the respondent had no rights or legitimate interests in a domain name under either Policy 4(c)(i) or Policy 4(c)(iii) where it failed to make any active use of the domain name”.

By registering the disputed domain name, which contains the Complainant’s trademarks and the mere addition of the letter “i” in the trademark and the “.com” gTLD”, 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.

The disputed domain name is inactive since its registration. Failure to actively use a domain name is evidence of bad faith registration and use pursuant to Paragraph 4(a)(iii) of the Policy. See Marsh Supermarkets Company, LLC, formerly known as Marsh Supermarkets, Inc. v. Choi Sungyeon, FA1312001532854 (Forum Feb. 25, 2014) (“Therefore, the Panel finds that Respondent registered and is using the <marshsupermarkets.com> domain name in bad faith pursuant to Paragraph 4(a)(iii) of the Policy because Respondent has failed to make an active use of the disputed domain name.”). The JCDECAUX trademark is well-known internationally (See JCDecaux SA v. Wang Xuesong, Wangxuesong: “The Panel is satisfied that the Respondent must have been aware of the Complainant's well-known JCDECAUX trade mark when it registered the Domain Name.), the Complainant contends that the incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use. See, e.g., Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No.D2000-0003; CBS Broadcasting, Inc. v. Dennis Toeppen, WIPO Case No.D2000-0400.

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

A. Procedural Issues

The Respondent's failure to file a Response does not automatically result in a decision in favor of the Complainant (see, e.g., Airbus SAS, Airbus Operations GmbH v. Alesini Pablo Hernan / PrivacyProtect.org, WIPO Case No. D2013-2059). However, the Panel may draw appropriate inferences from the Respondent's default.

B. Requirements under Paragraph 4(a) of the Policy

According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that the disputed domain name should be transferred or cancelled:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

The Panel has examined the evidence available to it and has come to the following conclusion concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

RIGHTS

The disputed domain name is confusingly similar to the Complainant’s Trademark, company name and domain. This finding is based on the settled practice in evaluating the existence of a likelihood of confusion of:

a) disregarding the top-level suffix in the domain name (i.e. “.com”), and

b) not finding that the addition of a single letter (such as “I”) would be sufficient to distinguish a domain name from a trademark. The disputed domain name is a misspelling of the Trade Mark. It differs from the Trade Mark only by an additional letter (i.e., it inserts the letter "i" into "JCDecaux" so that it reads "JCDiecaux").

It is well established that "typosquatting" can constitute confusing similarly (Deutsche Bank Aktiengesellschaft v. New York TV Tickets Inc., WIPO Case No. D2001-1314, DaimlerChrysler Corporation v. Worshipping, Chrisler, and Chr, aka Dream Media and aka Peter Conover, WIPO Case No. D2000-1272 and Playboy Enterprises v. Movie Name Company, WIPO Case No. D2001-1201).

The Panel considers this to be a clear case of typosquatting. The disputed domain name is confusingly similar to the Trade Mark. Therefore, the Panel comes to the conclusion that the Complainant has satisfied the requirement under Paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

The onus to make out a prima facie case that the Respondent lacks rights or legitimate interests is placed on the Complainant. However, once such prima facie case is made, 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 Policy (see e.g. WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

The Complainant has put forward that the Respondent is not commonly known by the disputed domain name. Neither is the Respondent in any way related to the Complainant. Nor has the Respondent been granted an authorization or license to use the disputed domain name by the Complainant. This has not been contested by the Respondent. Instead, the Respondent failed to provide any information and evidence whatsoever that could have shown 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).

Therefore, the Panel concludes that the Respondent did not establish any right or legitimate interest to the disputed domain name (within the meaning of Paragraph 4(a)(ii) of the Policy). The Complainant has therefore also satisfied the requirement under Paragraph 4(a)(ii) of the Policy.

BAD FAITH

The Panel finds that the Complainant has established that the disputed domain name was registered and is being used by the Respondent in bad faith. For this purpose, the Complainant has successfully put forward prima facie evidence that the Respondent has not made use, or demonstrable preparations to use, of either the disputed domain name in connection with a bona fide offering of goods or services, or of making a legitimate non-commercial or fair use of the disputed domain name.

The disputed domain name has been inactive since its registration. Failure to actively use a domain name can be considered as evidence of a bad faith registration and use pursuant to the Policy. See Marsh Supermarkets Company, LLC, formerly known as Marsh Supermarkets, Inc. v. Choi Sungyeon, FA1312001532854 (Forum Feb. 25, 2014) where it was held that Respondent registered and was using the <marshsupermarkets.com> domain name in bad faith because the Respondent failed to make an active use of the disputed domain name.

The JCDECAUX trademark is well-known internationally (See JCDecaux SA v. Wang Xuesong, Wangxuesong: “The Panel is satisfied that the Respondent must have been aware of the Complainant's well-known JCDECAUX trade mark when it registered the Domain Name.” The incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use. See, e.g., Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No.D2000-0003; CBS Broadcasting, Inc. v. Dennis Toeppen, WIPO Case No. D2000-0400.

In the absence of a Response and given the reputation of the Complainant and its trademarks, company name and domain as supported by the Complainant’s evidence, the Panel must conclude that the Respondent was fully aware of the Complainant's trademarks, domain and company name "JCDECAUX" at the time of registering the disputed domain name <JCDIECAUX.COM>.

Therefore, it has been established to the satisfaction of the Panel that the disputed domain name was registered and is being used (at least passively) in bad faith, in order to prevent the Complainant from making proper use of the mark in the disputed domain name.

Conclusion

The Panel concludes that the Respondent has registered and is using the disputed domain name in bad faith (within the meaning of Paragraph 4(a)(iii) of the Policy).

The Complainant has therefore also satisfied the requirement under 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. JCDIECAUX.COM:

PANELLISTS

Name	Udo Pfleghar

DATE OF PANEL DECISION 2018-05-28

Publish the Decision