Decision for dispute CAC-UDRP-101990

Case number	CAC-UDRP-101990
Time of filing	2018-05-09 09:13:31
Domain names	jcdeceux.com

Case administrator

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

Complainant

Organization	JCDECAUX SA

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	Gemma Purnell

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

The Complainant JCDECAUX SA is the owner of several trademarks “JCDECAUX” such as the international trademark “JCDECAUX” registered on 27 November 2011 (No. 803987) in various countries incl. China, Swiss and Poland, inter alia for services in class 35, such as advertising services.

FACTUAL BACKGROUND

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

The Complainant is a joint stock company registered in France, specialized in outdoor advertising. Founded in 1964, the Complainant is the global market leader in outdoor advertising and offering its services in more than 80 countries, including Thailand. The Complainant operates more than 1 million advertising panels in airports, rail stations, metro stations, shopping malls and on billboards as well as street furniture. The Complainant is listed on the Premier Marché of the Euronext Paris stock exchange and is part of Euronext 100 index. The Complainant has registered numerous domain names comprising the trademark “JCDECAUX” under several different TLDs, including, inter alia, <Jcdecaux.com>, <Jcdecaux.net> and <JcdecauxUK.com>.

The disputed domain name <jcdeceux.com> has been registered with the Respondent on 1 May 2018. The domain name is inactive since its registration.

On 3 May 2018 the Czech Arbitration Court (CAC) received the Complaint.

The Complainant requests the Panel to decide:

Cancellation of the disputed domain name <jcdeceux.com>.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

1. Identity or confusing similarity

With reference to paragraph 4(a)(i) of the Policy the Complainant states that the disputed domain name is confusingly similar to its trademark “JCDECAUX”. The Complainant states, that the disputed domain name is an obvious misspelling of the Complainant´s trademark, where the letter “a” is substituted by the letter “e”, and that the substitution of only one letter and the use of the gTLD “.com” are not sufficient to escape the finding, that the disputed domain name is confusingly similar to its trademarks. In the Complainant’s opinion these differences do not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademarks and domain names associated.

The Complainant refers to the following prior UDRP cases:
- CAC Case No. 101892, JCDECAUX SA v. Lab-Clean Inc. (jcdacaux.com)
- CAC Case No. 101919, JCDECAUX SA v. Nil (jcdaceux.com)
- CAS Case No. 101713, JCDECAUX SA v. Casey Kolp (jcdecaaux.com)
when stating, that it is well established, that a slight spelling variation does not prevent a disputed domain name from being confusingly similar to the Complainant´s trademark. In the Complainant´s opinion this is a clear case of "typosquatting“, i.e. the disputed domain name contains an obvious misspelling of the Complainant’s trademark; "JCDECEUX" instead of "JCDECAUX".

2. No rights or legitimate interests of the Respondent

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

The Complainant contends that the Respondent is not affiliated with nor authorized by the Complainant in any way 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 by the Complainant to make any use of the Complainant’s trademarks “JCDECAUX”, or apply for registration of the disputed domain name.

The Complainant also contends that the Respondent is not known as “JCDECEUX” and has not acquired trademark rights reg. this term. In this respect, the Complainant refers to FORUM Case No. FA 96356, Broadcom Corp. v. Intellifone Corp. when stating, that 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, which is the case here as well.

Since the disputed domain name links to an inactive website, the Complainant contends that the Respondent did not make any use of the disputed domain name since its registration, and that the 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.

3. Registration and use in bad faith

The Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith.

The Complainant states, that the trademark “JCDECAUX” is well-known and refers to WIPO Case No. DCC2017-0003, JCDecaux SA v. Wang Xuesong (“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.”) in this regard.

The Complainant states that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark “JCDECAUX” because of the distinctiveness of the Complainant's trademarks and its reputation.

This is underlined by the fact, that the disputed domain name is confusingly similar to the Complainant's trademarks “JCDECAUX”. The disputed domain name is a case of typosquatting. This has been considered as a hallmark of bad faith according to Policy 4(a) (iii) (See FORUM Case No. 157321, Computerized Sec. Sys., Inc. v. Bennie Hu (“The Panel finds that Respondent’s registration and use of a domain name that differs from Complainant’s mark by only one letter indicates “typosquatting”, which is evidence of bad faith registration and use.”).

Finally, the disputed domain name is inactive. In the Complainants opinion the current passive holding of the disputed domain name, in the context of typosquatting, does not prevent a finding of bad faith registration and use (See FORUM Case No. FA 1727521, Bloomberg Finance L.P. v. Wilson Brown / bloomberq <bloomberq.com>: “The failure to make an active use or show evidence of preparations of use of the disputed domain name is evidence of bad faith registration and use pursuant to Policy 4(a)(iii).”).

RESPONDENT:

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

I.
As the Respondent did not file an administratively compliant Response, pursuant to paragraph 14(b) of the Rules, the Panel may draw such inferences therefrom as it considers appropriate. Thus, the Panel considers the contentions of the Complainant as conceded by the Respondent.

II.
The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to

the Complainant‘s trademarks (within the meaning of paragraph 4(a)(i) of the Policy).

The Panel agrees with the Complainant that the disputed domain name is confusingly similar to the Complainant‘s trademarks. The disputed domain name directly and almost entirely incorporates the Complainant’s “JCDECAUX” trademark, except for the exchange of one letter. The Panel agrees with prior panel decisions, that it is not sufficient to replace a single letter of a trademark in order to exclude the risk of confusion (see e.g. CAC Case No. 101892, JCDECAUX SA v. Lab-Clean Inc.) at least in this case.

Furthermore, a domain name which consists of a common, obvious, or intentional misspelling of a trademark can be considered to be confusingly similar to the relevant mark. This is the case here, since the vowel "A" has been exchanged for the vowel "E", only. There is no indication that this difference is anything else but a misspelling, particularly as no other name or trademark "jcdeceux" is known.The addition of the top level domain “.com” to the misspelled trademark of the Complainant cannot change this assessment. The top level domain “.com” is merely instrumental to the use in the Internet (See FORUM case FA0008000095491, The Forward Association Inc. v. Enterprises Unlimited, 03. October 2000) and not able to affect the confusing similarity between the trademark “JCDECAUX” and the disputed domain name.

III.
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).

No arguments, why the Respondent could have own rights or legitimate interests in the disputed domain name are at hand. To the full satisfaction of the Panel the Complainant has shown that no case as listed in paragraph 4 (c) of the UDRP Rules is relevant in this case. In particular, the Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services as he is not using the disputed domain name at all and there is no evidence that he intends to use it in such a way. Further, the Respondent is not commonly known by the disputed domain name. Neither the Respondent ´s name nor its contact details contain a reference to “jcdeceux”.

Therefore, the Panel accepts the contentions of the Complainant that the Respondent has no such rights or legitimate interests in the disputed domain name.

IV.
The Complainant has, to the satisfaction of the Panel, shown the disputed domain name to have been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

The timing of the registration of the disputed domain name indicates the Respondent‘s bad faith in registering such domain name, as, at that time, the Complainant‘s trademark “JCDECAUX” was already known for decades and protected in several countries. The Complainant is also doing business in more than 80 countries worldwide and is listed at the Euronext Paris stock exchange. Hence, it seems very plausible, that the Respondent knew the trademark of the Complainant at the time of registration.

Furthermore, the Complainant´s trademark “JCDECAUX” is quite unique. Hence, it does not seem very plausible, that the Respondent has registered the disputed domain name freely and without reference to the Complainant‘s trademarks. This must be all the more true since no reference of the Respondent to the domain name <jcdeceux.com> is discernible. Moreover, the trademark “JCDECAUX” is anything but generic, so that it is not likely that the Respondent wished to describe any goods or services by choosing the disputed domain name. Hence, the Panel has no reason to disbelieve the Complainant, when it argues that the Respondent knew the Complainant and its activities at the time of registration.

Furthermore, the Panel agrees with the Complainant that the use of the disputed domain name is a typical case of typosquatting which in turn is a strong indicator of registration and use of a domain name in bad faith. Lastly, the fact that the disputed domain name was inactive does not support the Respondent. If that would be the case, trademark owners would not be able to enforce their trademark rights in this kind of situation. The Panel, at least in this kind of cases, regards

the mere holding of a domain name in dispute as use of such domain name and, as use in bad faith.

Therefore, the Panel considers the Respondent's conduct to be the manifestation of registration and use in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **JCDECEUX.COM**:

PANELLISTS

Name	**Dominik Eickemeier**

DATE OF PANEL DECISION 2018-06-15

Publish the Decision