Decision for dispute CAC-UDRP-102169

Case number	CAC-UDRP-102169
Time of filing	2018-09-18 09:33:57
Domain names	jicdecaux.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

There are no other legal proceedings the Panel is aware of which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant owns several trademarks “JCDECAUX” such as the international trademark registration “JCDECAUX” number 803987 registered on November 27, 2001.

FACTUAL BACKGROUND

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

Since 1964, JCDECAUX S.A. (hereinafter referred to as 'Complainant') is the worldwide number one in outdoor advertising. For more than 50 years the Complainant has been offering solutions that combine urban development and the provision of public services in approximately 80 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 trademark has more than 1,074,113 advertising panels in Airports, Rail and Metro Stations, Shopping Malls, on Billboards and Street Furniture.

The Complainant group is listed on the Premier Marché of the Euronext Paris stock exchange and is part of Euronext 100 index. Employing a total of 13,040 people, it is present in more than 80 different countries and 4,033 cities and has generated revenues of €3,472m in 2017.

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

The Complainant is also the owner of a large domain names portfolio, including the same distinctive wording JCDECAUX, such as <jcdecaux.com> registered since June 23, 1997.

The disputed domain name <jicdecaux.com> was registered on September 11, 2018.

The disputed domain name remains inactive since its registration.

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

Identical and/or Confusingly Similar

The Panel notes that the Complainant owns several trademarks “JCDECAUX” such as the international trademark registration “JCDECAUX” number 803987 registered on November 27, 2001. Registering a mark with a trademark registration authorities is sufficient to establish rights in a mark under paragraph 4(a)(i) of the Policy. See Home Depot Product Authority, LLC v. Samy Yosef / Express Transporting, FA 1738124 (FORUM July 28, 2017) (finding that registration with the USPTO was sufficient to establish the complainant’s rights in the HOME DEPOT mark). Therefore, the Panel finds the Complainant has sufficiently established rights in the “JCDECAUX” mark per paragraph 4(a)(i) of the Policy.

The Complainant contends that the disputed domain name is confusingly similar to its trademark JCDECAUX, as it incorporates the whole mark and simply adds the letter “i” and the “.com” gTLD. 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 “i”: JICDECAUX instead of JCDECAUX. Previous panels 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.

The Panel agrees with the Complainant. See FORUM Case No. FA 0956501, T.R. World Gym-IP, LLC v. William D'Addio (“The

addition of the letter “s” and of the generic top-level domain “.com” is insufficient to distinguish the domain name from the mark.“).

Thus, the Panel concludes that the disputed domain name is confusingly similar to the Complainant's trademark JCDECAUX.

Rights or Legitimate Interests

Complainant must first make a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain name under paragraph 4(a)(ii) of the Policy, then the burden shifts to Respondent to show it does have rights or legitimate interests. See Advanced International Marketing Corporation v. AA-1 Corp, FA 780200 (FORUM Nov. 2, 2011) (finding that a complainant must offer some evidence to make its prima facie case and satisfy paragraph 4(a)(ii) of the Policy); see also Neal & Massey Holdings Limited v. Gregory Ricks, FA 1549327 (FORUM Apr. 12, 2014) (“Under Policy ¶ 4(a)(ii), Complainant must first make out a prima facie case showing that Respondent lacks rights and legitimate interests in respect of an at-issue domain name and then the burden, in effect, shifts to Respondent to come forward with evidence of its rights or legitimate interests”).

The Complainant contends that the Respondent is not known as “JICDECAUX”, but as “DRE DRE“, and has not acquired trademark rights on this term. The Complainant further contends that the Respondent is not affiliated with nor authorized by the Complainant in any way. The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and it 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 trademark JCDECAUX, or apply for registration of the disputed domain name by the Complainant.

The Complainant avers that the disputed domain name remains inactive. Therefore, the Complainant contends that Respondent did not make any use of disputed domain name since its registration, and it argues that the Respondent has no demonstrable plan to use the disputed domain name.

The Panel notes that use of a domain name to resolve to an inactive website may not be considered a legitimate use within the meaning of paragraph 4(c)(i) or (iii) of the Policy. See Nutri/System IPHC, Inc. v. Usama Ayub, FA1725806 (FORUM June 5, 2017) (“Respondent does not use the <nutrisystemturbo.us> domain for a bona fide offering of goods or services because the domain name resolves to a website that currently is designated as ‘under construction.’”).

The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against Respondent. As Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that Respondent has no rights or legitimate interests in the disputed domain name.

Registration and Use in Bad Faith

The Complainant contends that past panels have held that the JCDECAUX trademark is well-known. Please see WIPO Case No. DCC2017-0003, 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 also contends that the Respondent, by registering the disputed domain name, which contains the Complainant’s trademark and the mere addition of the letter “i” and the “.com” gTLD”, intended to cause confusing similarity with the Complainant’s trademark. The Complainant has submitted previous UDRP precedents which have seen such actions as evidence of bad faith: 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; NAF 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 paragraph 4(a)(iii) of the Policy).

The Complainant contends that given the distinctiveness and reputation of the Complainant's trademark, the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark JCDECAUX. The Panel infers, due to the fame of the Complainant's mark that Respondent had actual knowledge of the Complainant's rights in the mark prior to registering the disputed domain name and finds that actual knowledge is adequate evidence of bad faith under paragraph 4(a)(iii) of the Policy. See Orbitz Worldwide, LLC v. Domain Librarian, FA 1535826 (FORUM Feb. 6, 2014) ("The Panel notes that although the UDRP does not recognize 'constructive notice' as sufficient grounds for finding Policy ¶ 4(a)(iii) bad faith, the Panel here finds actual knowledge through the name used for the domain and the use made of it.").

Finally, the Complainant contends that the disputed domain name remains inactive and that 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.

The Panel agrees that the passive holding of a domain name does not necessarily circumvent a finding that the domain name is being used in bad faith within the requirements of paragraph 4(a)(iii) of the Policy. See Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003 (finding that in considering whether the passive holding of a domain name, following a bad faith registration of it, satisfies the requirements of paragraph 4(a)(iii) of the Policy, the panel must give close attention to all the circumstances of the respondent's behavior, and a remedy can be obtained under the Policy only if those circumstances show that the respondent's passive holding amounts to acting in bad faith.).

The particular circumstances of this case that the Panel has considered are:

i) The Complainant is the worldwide number one in outdoor advertising. For more than 50 years the Complainant has been offering solutions that combine urban development and the provision of public services in approximately 80 countries. The Complainant is currently the only group present in the three principal segments of outdoor advertising market: street furniture, transport advertising and billboard. As such, the Complainant's mark 'JCDECAUX ' is considered as being a well-known and reputable trademark; and

ii) The Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the disputed domain name.

Taking into account all of the above, the Panel concludes that Respondent's passive holding of the disputed domain name constitutes bad faith under paragraph 4(a)(iii) of the Policy and that Respondent is using the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **JICDECAUX.COM**: Transferred

PANELLISTS

Name	**Mr. Ho-Hyun Nahm, Esq.**

DATE OF PANEL DECISION 2018-10-22

Publish the Decision