Decision for dispute CAC-UDRP-102428

Case number	CAC-UDRP-102428
Time of filing	2019-04-02 08:10:16
Domain names	jcdecauxchina.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	JCDECAUX SA

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	cai jin yan

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided legal proceedings relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

JCDECAUX SA owns several trademarks “JCDECAUX” such as the international trademark registration JCDECAUX® n° 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 23 June1997.

The disputed domain name <jcdecauxchina.com> was registered on 21 March 2019.

The domain name redirects to a pornographic website.

FACTUAL BACKGROUND

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

Since 1964, JCDECAUX SA 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 more than 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® now have more than 1,058,830 advertising panels 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 13,030 people, the Group is present in more than 80 different countries and 4,031 cities and has generated revenues of €3,619m in 2018.

PARTIES CONTENTIONS

COMPLAINANT:

The disputed domain name <jcdecauxchina.com> is confusingly similar to its trademark JCDECAUX®. The addition of the geographical term “China” in the trademark is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark JCDECAUX ®. It is well-established that a disputed domain name that wholly incorporates a Complainant’s registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP.

The addition of the gTLD “.COM” does not change the overall impression of the designation as being connected to Complainant’s trademark. It does not prevent the likelihood of confusion between the disputed domain name and Complainant, its trademark and its domain names associated.

The Respondent "See PrivacyGuardian.org" as the owner of the disputed domain name <jcdecauxchina.com> is obvious not able to make out a prima facie case that it had possession of rights or legitimate interests in the disputed domain name according to the information available on the Whois database. The Respondent is not commonly known by a disputed domain name because the Whois information is not similar to the disputed domain name. Thus, the Respondent is not known under the disputed domain name. Thus, the Respondent has registered the disputed domain name only in order to create a likelihood of confusion with the Complainant’s trademark.

The Respondent is not related in any way with the Complainant in respect of the disputed domain name <jcdecauxchina.com> and 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 trademark JCDECAUX®, or apply for registration of the disputed domain name by the Complainant.

The disputed domain name redirects to a pornographic website. Such use tarnishes its trademark JCDECAUX® and does not evidence noncommercial or fair use of the disputed domain name by the Respondent.

The Respondent must have been aware of the Complainant's well-known JCDECAUX trade mark when it registered the disputed domain name. Furthermore, the Complainant’s JCDECAUX® trademark has created significant good will and consumer recognition around the world and has been registered by Complainant on 2001, several years prior the registration of the disputed domain name.

The Complainant contends that given the distinctiveness of the Complainant's trademark and its reputation, it is inconceivable that the Respondent could not have registered the disputed domain name without actual knowledge of Complainant's rights in the trademark. Due to the fame of the Complainant's trademark the Respondent had have actual knowledge of Complainant's rights in the mark prior to registering the disputed domain name and finds that actual knowledge is adequate evidence of bad faith.

Moreover, the disputed domain name redirects to a pornographic website by attempting to attract Internet traffic and commercially benefit from the goodwill of the Complainant’s trademark. Use of a disputed domain name to create confusion

as to the source, sponsorship, affiliation or endorsement of the content therein constitutes bad faith. Besides, the Complainant contends that the Respondent's use of the domain name to resolve to an adult-oriented website is independent evidence of Respondent's bad faith registration and use.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED

RIGHTS

The disputed domain name <jcdecauxchina.com> is confusingly similar to its trademark JCDECAUX®. The addition of the geographical term "China" in the trademark is not sufficient to escape the finding that the domain name is confusingly similar to the trademark JCDECAUX ®. It is well-established that a domain name that wholly incorporates a Complainant's registered trademark is sufficient to establish confusing similarity for purposes of the UDRP.

The addition of the gTLD ".COM" does not change the overall impression of the designation as being connected to Complainant's trademark. It does not prevent the likelihood of confusion between the disputed domain name and Complainant, its trademark and its domain names associated.

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 Respondent is not commonly known by the disputed domain name. The Whois information is quite different from the disputed domain name.

The Respondent is not related in any way with the Complainant in respect of the disputed domain name and does not carry out any activity nor any business with the Respondent. Neither licence nor authorization has been granted to the Respondent to make any use of the Complainant's trademark or apply for registration of the disputed domain name by the Complainant.

The Respondent has registered the disputed domain name only in order to create a likelihood of confusion with the Complainant's trademark.

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 is confusingly similar to the Complainant's trademark JCDECAUX®. The Respondent must have been aware of the Complainant's well-known JCDECAUX trade mark when it registered the disputed domain name. The Complainant's JCDECAUX® trademark has created significant goodwill and consumer recognition around the world and has been registered by Complainant in 2001, several years prior the registration of the disputed domain name.

Given the distinctiveness of the Complainant's trademark and its reputation, it is inconceivable that the Respondent could not have registered the disputed domain name without actual knowledge of Complainant's rights in the trademark. Due to the fame of the Complainant's trademark it is obvious that the Respondent had have knowledge of Complainant's rights in the mark prior to registering the disputed domain name and that this knowledge is also evidence of bad faith.

The disputed domain name redirects to a pornographic website by attempting to attract Internet traffic and commercially benefit from the goodwill of the Complainant's trademark. Such use of the disputed domain name to resolve to an adult-oriented website is evidence by itself of Respondent's bad faith registration.

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

The disputed domain name <jcdecauxchina.com> is confusingly similar to its trademark JCDECAUX®. The addition of the geographical term “China” in the trademark is not sufficient to escape the finding that the domain name is confusingly similar to the trademark. The addition of the gTLD “.COM” does not prevent the likelihood of confusion between the disputed domain name and Complainant, its trademark and its domain names associated.

The Respondent is not commonly known by a disputed domain name. The Whois information is quite different from the disputed domain name. The Respondent is not related in any way with the Complainant in respect of the disputed domain name and does not carry out any activity nor any business with the Respondent. Neither licence nor authorization has been granted to the Respondent to make any use of the Complainant’s trademark or apply for registration of the disputed domain name by the Complainant.

Due to the fame of the Complainant's trademark it is obvious that the Respondent had actual knowledge of Complainant's rights in the mark prior to registering the disputed domain name and that actual knowledge is adequate evidence of bad faith.
The disputed domain name redirects to a pornographic website by attempting to attract Internet traffic and commercially benefit from the goodwill of the Complainant’s trademark. Such use of the domain name to resolve to an adult-oriented website is actual evidence of Respondent’s bad faith registration of the disputed domain name.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **JCDECAUXCHINA.COM**: Transferred

PANELLISTS

Name	**JUDr. Vojtěch Trapl**

DATE OF PANEL DECISION 2019-04-29

Publish the Decision