Decision for dispute CAC-UDRP-102437

Case number	CAC-UDRP-102437
Time of filing	2019-04-11 10:10:26
Domain names	jcdecauxglobal.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	JCDECAUX SA

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	Da Boo

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the holder of the International trademark JCDECAUX with registration No.803987, registered on 27 November 2001 for goods and services in International Classes 6, 9, 11, 19, 20, 35, 37, 38, 39, 41 and 42 (the "JCDEAUX trademark").

FACTUAL BACKGROUND

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

The Complainant was established in 1964. It is the worldwide number one in outdoor advertising and is the only group present in the three principal segments of outdoor advertising market: street furniture, transport advertising and billboard. The Complainant employs a total of 13,030 people and is present in approximatively 80 countries and 4,031 cities. It has more than 1,058,830 advertising panels in airports, rail and metro stations, shopping malls, on billboards and street furniture. The Complainant is listed on the Premier Marché of the Euronext Paris stock exchange and is part of Euronext 100 index, and has generated revenues of EUR 3,619 million in 2018.

The Complainant's official website is located at the domain name <jcdecaux.com>, registered since 23 June 1997.

The disputed domain name <jcdecauxglobal.com> was registered on 5 April 2019, and redirects to a Registrar parking page with commercial links.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant submits that the disputed domain name is confusingly similar to the Complainant's JCDECAUX trademark, as it incorporates the trademark in its entirety. The addition of the term "global" is not sufficient to escape the finding that the disputed domain name is confusingly similar to the JCDECAUX trademark. It does not change the overall impression of the designation as being connected to this trademark and does not prevent the likelihood of confusion between the disputed domain name and the Complainant's trademark. On the contrary, it reinforces the likelihood of confusion, as the Complainant's social media accounts are named "jcdecauxglobal".

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, and has not granted any licence or authorization to the Respondent to make any use of the JCDECAUX trademark or to apply for registration of the disputed domain name. The disputed domain name points to a parking page with commercial links related to the Complainant, which is not a bona fide offering of goods or services or legitimate non-commercial or fair use. The Complainant asserts that the Respondent has registered the domain name only in order to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademark.

According to the Complainant, the disputed domain name has been registered and is being used in bad faith. The Complainant contends that the JCDECAUX trademark is distinctive and well-known, and the Respondent has registered the disputed domain name with full knowledge of it. The disputed domain name points to a parking page with commercial pay per click links related to the Complainant. The use of pay-per-click links on the Respondent's website located at the disputed domain name which is confusingly similar to the JCDECAUX trademark shows that the Respondent must have intended to use the disputed domain name to attract Internet users to its website for commercial gain and such intentional use constitutes bad faith. In such circumstance it is irrelevant whether the commercial gain from misled Internet users is gained by the Respondent or by a third party, because the Respondent controls and cannot disclaim responsibility for the content appearing on the website to which the disputed domain name resolves.

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

Pursuant to the Policy, paragraph 4(a), the Complainant must prove each of the following to justify the transfer of the disputed domain name:
(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
(iii) the Respondent has registered and are using the disputed domain names in bad faith.

In this case, the Provider has employed the required measures to achieve actual notice of the Complaint to the Respondent, and the Respondent was given a fair opportunity to present its case.

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: "[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name …"

In this proceeding, the Respondent has not used the opportunity provided to it under the Rules and has not submitted a substantive Response addressing the contentions of the Complainant and the evidence submitted by it.

The Complainant has provided evidence and has thus established its rights in the JCDECAUX trademark.

The Panel notes that a common practice has emerged under the Policy to disregard in appropriate circumstances the general Top-Level Domain ("gTLD") section of domain names for the purposes of the comparison under the Policy, paragraph 4(a)(i). The Panel sees no reason not to follow the same approach here, so it will disregard the ".com" gTLD section of the disputed domain name.

The relevant part of the disputed domain name is therefore the sequence "jcdecauxglobal". It consists of the elements "jcdecaux" and "global". The "jcdecaux" element is identical to the JCDECAUX trademark. Due to its distinctiveness, it dominates the disputed domain name, while the generic "global" element may be regarded as describing a website directed at the global audience. All this make it likely that Internet users may regard the disputed domain name as referring to a website of the Complainant directed at the global audience.

In view of the above, the Panel finds that the disputed domain name is confusingly similar to the JCDECAUX trademark in which the Complainant has rights.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name, stating that the Respondent has not been authorized by the Complainant to use the JCDECAUX trademark, that the Respondent is not carrying out a bona fide use of the disputed domain name, but uses it for a website that contains pay per click links related to the Complainant. Thus, the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Respondent has not submitted a Response and has not alleged that is has rights and legitimate interests in the disputed

domain name and has not disputed the Complainant's allegations in this proceeding.

The disputed domain name is confusingly similar to the distinctive JCDECAUX trademark and Internet users may regard it as referring to a website of the Complainant directed at the global audience. As contended by the Complainant and undisputed by the Respondent, the disputed domain name resolves to a website that contains commercial pay per click links related to the Complainant, and the JCDECAUX trademark was registered many years before the registration of the disputed domain name.

In the lack of any denial by the Respondent of the above, this combination of circumstances satisfies the Panel that it is more likely than not that the Respondent, being aware of the goodwill of the Complainant's JCDECAUX trademark, has registered and used the disputed domain name in an attempt to exploit the trademark's goodwill to attract Internet users to the Respondent's website and to expose them to pay per click links related to the Complainant for commercial gain. Such conduct is not legitimate and does not give rise to rights and legitimate interests of the Respondent in the disputed domain name.

Therefore, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain name.

Paragraph 4(b) of the Policy lists four illustrative alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

"(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location."

As discussed above, the disputed domain name fully incorporates the JCDECAUX trademark in combination with the element "global" which creates the appearance of a website directed at the global audience. The JCDEAUX trademark has been registered in many jurisdictions around the world for many years before the registration of the disputed domain name. The Respondent does not deny that it is linked it to a website that contains pay per click links related to the Complainant, and, as submitted by the Complainant, it is irrelevant whether the commercial gain from misled Internet users is gained by the Respondent or by a third party, because the Respondent controls and cannot disclaim responsibility for the content appearing on the website to which the disputed domain name resolves.

Taking the above into account, the Panel accepts that as more likely than not that the Respondent has registered the disputed domain name with knowledge of the Complainant and targeting the JCDECAUX trademark in an attempt to attract traffic to the disputed domain name by confusing Internet users that they are reaching an online location related to the Complainant and then expose them to pay per click links related to the Complainant that are expected to generate commercial gain. This satisfies the Panel that the Complainant has established that the Respondent has registered and used the disputed domain name in bad faith under Paragraph 4(b) (iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **JCDECAUXGLOBAL.COM**: Transferred

PANELLISTS

Name	**Assen Alexiev**

DATE OF PANEL DECISION 2019-05-21

Publish the Decision