Decision for dispute CAC-UDRP-102554

Case number	CAC-UDRP-102554
Time of filing	2019-06-28 09:37:30
Domain names	jcdeoaux.com

Case administrator

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

Complainant

Organization	JCDECAUX SA

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	James S Gavrios

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant bases its Complaint on the International trademark registration “JCDECAUX”, No. 803987, registered since November 27, 2001, protected for goods and services in classes 06, 09, 11, 19, 20, 35, 37, 38, 39, 41 and 42, designating several countries for protection.

FACTUAL BACKGROUND

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

The Complainant is JCDECAUX SA and is the worldwide number one in outdoor advertising. The Complainant is currently the only group present in the three principal segments of outdoor advertising market: street furniture, transport advertising and billboard.

JCDECAUX have now more than 1,061,200 advertising panels in Airports, Rail and Metro Stations, Shopping Malls, on Billboards and Street Furniture. Employing a total of 13,030 people, the Group is present in more than 80 different countries and 4,030 cities and has generated revenues of €3,619m in 2018.

JCDECAUX SA owns several trademarks “JCDECAUX” such as the international trademark registration JCDECAUX, No. 803987 registered since November 27, 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 June 23, 1997.

The disputed domain name <jcdeoaux.com> was registered on June 21, 2019 and is currently inactive.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED

The Complainant's contentions are the following:

The disputed domain name is confusingly similar to the Complainant's earlier trademark and branded services JCDECAUX since it contains an obvious misspelling of the Complainant’s trademark. The substitution of the letter “C” by the letter “O” in the Complainant’s trademark is insufficient to avoid confusing similarity.

Therefore, the disputed domain name is a clear case of typosquatting. Previous UDRP panels have found that slight spelling variations do not prevent a disputed domain name from being confusingly similar to the Complainant’s trademark.

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

The Complainant further contends that the Respondent lacks rights or legitimate interests in the disputed domain name for a number of reasons.

First, the Complainant asserts that the Respondent is not known as the disputed domain name.

The Complainant further asserts that the Respondent is not affiliated with nor authorized by the Complainant in any way. The Complainant does not carry out any activity for, nor has any business with the Respondent. The Respondent is not a Complainant’s licensee, nor has ever been authorised to make use of the Complainant’s trademark or to apply for the registration of the disputed domain name.

The Complainant’s further asserts that disputed domain name is a typosquatted version of the JCDECAUX trademark. Typosquatting is an attempt to take advantage of Internet users’ typographical errors and can be evidence of the Respondent’s lack of rights or legitimate interests in a domain name.

Lastly, the Complainant points out that the disputed domain name resolves to an inactive webpage and that the Respondent did not make any use of disputed domain name since its registration, and that it confirms that Respondent has no demonstrable plan to use the disputed domain name, which is further evidence of the Respondent’s lack of rights or legitimate interests.

The Complainant further argues that the disputed domain name has been registered, and is been used in bad faith.

The Complainant’s maintains that its JCDECAUX trademark is well-known trademark and therefore, that the Respondent has registered the disputed domain name with full knowledge of the Complainant’s trademark.

Furthermore, the disputed domain name is a form of typosquatting. Typosquatting is also evidence of bad faith.

The Complainant also asserts 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.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the 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 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 Domain Name to have 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. Confusing Similarity

The Panel agrees that the substitution of the letter “C” by the letter “O” in the Complainant’s trademark is insufficient to avoid confusing similarity.

As a matter of fact, despite the slight misspelling, the Complainant’s trademark is still recognizable within the disputed domain name. Previous UDRP CAC and WIPO decisions, even involving the Complainant, have recognized that typosquatting usually entails a finding of confusing similarity for the purpose of the first element under the Policy.

Moreover, the extension “.com” is not to be taken into consideration when examining the similarity between the Complainant’s trademarks and the disputed domain name (WIPO Case No. D2005-0016, Accor v. Noldc Inc.). The mere adjunction of a gTLD such as “.com” is irrelevant as it is well established that the generic Top Level Domain is insufficient to avoid a finding of confusing similarity (WIPO Case No. 2013-0820, L’Oréal v Tina Smith, WIPO Case No. D2008-0820 Titoni AG v Runxin Wang and WIPO Case No. D2009-0877, Alstom v. Itete Peru S.A.).

Therefore, the Panel is satisfied that the first condition under the Policy is met.

II. Lack of Respondent's rights or legitimate interests

The complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such prima facie case is made, the burden of proof shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the Policy.

Based on the available evidence, the Respondent does not appear to be known by the disputed domain name. The Respondent is not a licensee of, nor has any kind of relationship with, the Complainant. The Complainant has never authorised the Respondent to make use of its trademark, nor of a confusingly similar trademark in the disputed domain name.

Finally, the disputed domain name is a typosquatted version of the Complainant’s trademark and does not lead to any active webpage. Such use does not amount to a bona fide offering of goods or services, or to a legitimate non-commercial or fair use of the disputed domain name.

The Panel notes that the Respondent had an opportunity to comment on the Complaint's allegations by filing a Response, which the Respondent failed to do.

Thus, the Panel is satisfied that the Complainant has at least established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. Accordingly, the Panel takes the view that also the second requirement under the Policy is met.

III. Bad Faith

The Complainant's trademark is a well-known one as recognized also by past panels and the disputed domain name is a typosquatting of the Complainant's trademark. Therefore, the Panel concludes that at the time of registration of the disputed domain name, the Respondent was well aware of the Complainant's trademark and has intentionally registered one of its possible misspellings.

Numerous UDRP panels have found that typosquatting constitutes bad faith (see, amongst others, FORUM case no. FA0612000877979, Microsoft Corp. v. Domain Registration Philippines; ARCELORMITTAL S.A. v. stave co ltd, CAC Case No. 102180; Calvin Klein Trademark Trust, Calvin Klein, Inc. v. Moniker Privacy Services, WIPO Case No. D2015-2305; Wikimedia Foundation Inc v. Privacy Protect.org/Domain Tech Enterprises, WIPO Case No. D2015-1705; Moneyweek Limited v. he jianyi Case No. D2015-1700).

The disputed domain name is inactive. Under certain circumstances, the passive holding of a domain name cannot prevent a finding of bad faith. Factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put (See paragraph 3.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition [WIPO Jurisprudential Overview 3.0)].

In the present case, the following factors should be considered:

(i) the Complainant's trademark is a well-known one, being also highly distinctive;

(ii) the Respondent failed to submit any response and has not provided any evidence of actual or contemplated good faith use of the disputed domain name;

(iii) the Respondent registered the disputed domain name containing an obvious, common and intentional misspelling of the Complainant's trademark, which is a typical pattern used for abusive "typosquatting" registrations; and

(iv) any good faith use of the disputed domain name would be implausible, as the trademark JCDECAUX is univocally linked to the Complainant and the Respondent has no business relationship with the Complainant, nor was ever authorised to use a domain name confusingly similar to the Complainant's trademark.

In light of the foregoing, the Panel concludes that the Respondent has registered and has been using the disputed domain name in bad faith. Thus, also the third and last condition under the Policy is satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **JCDEOAUX.COM**: Transferred

PANELLISTS

Name	**Delia-Mihaela Belciu**

DATE OF PANEL DECISION 2019-08-05

Publish the Decision