Decision for dispute CAC-UDRP-102732

Case number	CAC-UDRP-102732
Time of filing	2019-10-21 10:07:06
Domain names	jcclecaux.com

Case administrator

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

Complainant

Organization	JCDECAUX SA

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Organization	pageee

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the owner of several trademarks. In particular, JCDECAUX SA owns the International Registration No. 803987 "JCDecaux" registered on November 27, 2001 (and duly renewed) for classes 6, 9, 11, 19, 20, 35, 37, 38, 39, 41 and 42. The above trademark is protected in many countries of the world.

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. For more than 50 years JCDECAUX SA has been offering solutions that combine urban development and the provision of public services in approximatively 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.

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 4,030 cities and has generated revenues of €3,619m in 2018.

JCDECAUX SA owns the international trademark registration "JCDecaux" n° 803987 registered since 2001. The Complainant also owns a large domain names portfolio, including the same distinctive wording JCDECAUX, such as <jcdecaux.com>.

The disputed domain name <jcclecaux.com> was registered on October 15, 2019 and is currently inactive.

The Complainant states that the disputed domain name <jcclecaux.com> is confusingly similar to its trademark "JCDecaux" since the substitution of the letter “D” by the letters “CL” is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark "JCDecaux".

Furthermore, the Complainant states that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant also argues that the Respondent has no relationship with Complainant's business and is not authorized or licensed to use the trademark "JCDecaux".

In the Complainant's view, in consideration of the distinctiveness of the Complainant's trademark and reputation it appears obvious that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark JCDecaux, and therefore could not ignore the Complainant. The Complainant also contends that the Respondent has not demonstrated any activity in respect of the disputed domain name, and it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant’s rights under trademark law. On these bases, the Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith.

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

According to paragraph 4(a) of the Policy the Complainant is required to prove each of the following three elements to obtain 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 disputed domain name has been registered and is being used in bad faith.

1) The Complainant has established that it has rights in the trademark "JCDecaux" at least since 2001. The Complainant's trademark was registered well before the registration of the disputed domain name and is widely well-known. The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark, since it is consensus view of UDRP panels that adding, deleting or substituting letters of the Complainant's registered mark does not preclude a finding of confusing similarity. Therefore, a minor difference, as the substitution of the letter "d" of the trademark "JCDecaux" with the letters "cl" is absolutely insufficient to negate the confusing similarity between the disputed domain name and the Complainant's mark. UDRP panels also agree that the top-level domain (TLD), in this case <.com>, is to be ignored for the purpose of determination of identity or confusing similarity between the disputed domain name and the trademark of the Complainant as it is a mere technical requirement of registration (see WIPO Overview 3.0). Accordingly, the Panel finds that the Complainant has proven the first element of the paragraph 4(a) of the Policy.

2) The Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain name as it is not commonly known under the disputed domain name and was never authorized to use it by the Complainant. The Respondent, in the absence of any substantial response, has not shown any facts or element to justify prior rights or legitimate interests in the disputed domain name. The Complainant therefore succeeds also on the second element of the Policy.

3) The Complainant's trademark "JCDecaux" is distinctive and well-known in the most of the countries. It is uncontroverted that Complainant's worldwide use and registration of the "JCDecaux" mark largely precede the registration date of the disputed domain name. The fact that the Respondent has registered a domain name that is almost identical and at least confusingly similar to it clearly indicates that the Respondent had knowledge of the Complainant's trademark at the time of registration of the disputed domain name. This is a clear evidence of registration of the domain name in bad faith. The Complainant has demonstrated that the disputed domain name is merely directed to an error page and therefore it is clear that the disputed domain name is not used for any bona fide offerings since it is not connected to any website. Countless UDRP decisions confirmed that the passive holding of a domain name with knowledge that the domain name infringes another party's trademark rights is evidence of bad faith registration and use (see, in this regard, Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003). The consensus view of UDRP panelists is that passive holding of a domain name may, in appropriate circumstances, be consistent with a finding of bad faith. In particular, previous panels have tended to make such findings in circumstances in which, for example, a Complainant's mark is well-known, and there is no conceivable use that could be made of the domain name that would not amount to an infringement of the Complainant's trade mark rights. As regards to the first aspect, the Complainant has already extensively proved the renowned of its trademark. For what concern the second circumstance, it must be underlined that it is objectively not possible to understand what kind of use the Respondent could make with a domain name which almost exactly corresponds to the Complainant's trademark currently extensively used by the latter. In the light of the above, the present case completely matches to the above requirements and the passive holding of the disputed domain name has to be considered a use in bad faith. In this respect it is important also to consider the decision in case Comerica Inc. v. Horoshiy, Inc. WIPO Case No. D2004-0615 according to which "The very act of having acquired [the domain name] raises the probability of Respondent using [it] in a manner that is contrary to Complainant's legal rights and legitimate interests. [...] To argue that Complainant should have to wait for some future use of the disputed domain names to occur in order to demonstrate Respondent's bad faith use is to render intellectual property law into an instrument of abuse by the Respondent. The result would be the likelihood of the accumulation and use of disputed domain names for the implicit, if not explicit, purpose of misappropriating or otherwise unlawfully undermining Complainant's goodwill and business. The fact that this misappropriation may occur in any as yet undetermined manner at an uncertain future date does not negate Respondent's bad faith. On the contrary, it raises the spectrum of continuing bad faith abuse by Respondent of Complainant's mark, name and related rights and legitimate business interests". The Panel is therefore convinced that, even though the disputed domain name has not yet been actively used, the Respondent's non-use of the disputed domain name equals to use in bad faith (see also Amundi Asset Management v. Amundi, CAC Case No. 102288 and Accor v. VNT Corporation, CAC Case No. 100004). In the light of the above, the Complainant considers that also the third and final element necessary for finding that the Respondent has

engaged in abusive domain name registration and use has been established.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **JCCLECAUX.COM**: Transferred

PANELLISTS

Name	**Avv. Guido Maffei**

DATE OF PANEL DECISION 2019-11-14

Publish the Decision