Decision for dispute CAC-UDRP-102827

Case number	CAC-UDRP-102827
Time of filing	2019-12-17 09:31:21
Domain names	igpdecaux.net

Case administrator

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

Complainant

Organization	JCDECAUX SA

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	Handi Hariyono

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

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 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.

All over the world, the digital transformation is gathering pace: JCDECAUX® now have more than 1,074,113 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 13,040 people, the Group is present in more than 80 different countries and 4,033 cities and has generated revenues of €3,472m in 2017.

JCDECAUX SA is present worldwide, notably present in Italy, through its subsidiary IGP DECAUX.

JCDECAUX SA owns several trademarks containing the term “DECAUX” such as the international trademarks JCDECAUX® n° 803987 registered since November 27, 2001 and DECAUX® n° 991341 registered since April 4, 2008.

JCDECAUX SA is also the owner of a large domain names portfolio, including the same distinctive wording DECAUX®, such as <decaux.com> registered since June 23, 1997. It also owns, through its subsidiary IGP DECAUX, the domain name <igpdecaux.it>, registered since December 5, 2001 and used for its official website.

The disputed domain name <igpdecaux.net> was registered on December 12, 2019. The website related to the disputed domain name is inactive and MX servers are configured.

FACTUAL BACKGROUND

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

It is well-established that “a domain name that wholly incorporates a Complainant’s registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP”. Please see for instance WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin.

Please see for instance:

- Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com> (“Here, the WHOIS information of record identifies Respondent as “Chad Moston / Elite Media Group.” The Panel therefore finds under Policy 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy 4(c)(ii).”)

- Forum Case No. FA 699652, The Braun Corporation v. Wayne Loney

Please see for instance:

- WIPO Case No. D2000-1164, Boeing Co. v. Bressi (“the Respondent has advanced no basis on which he could conclude that it has a right or legitimate interest in the domain names”);

- Forum Case No. FA 1773444, Ashley Furniture Industries, Inc. v. Joannet Macket / JM Consultants (“The Panel finds that Respondent’s lack of content at the disputed domain shows the lack of a bona fide offering of goods or services or a legitimate noncommercial or fair use per Policy 4(c)(i) and (iii).”).

Please see WIPO Case No. D2004-0673, Ferrari S.p.A. v. American Entertainment Group, Inc ("Complainant’s trademark is well-known and Respondent undoubtedly knew about it when registering the contested domain name. Said domain name would most likely not have been registered if it were not for Complainant’s trademarks. [...] The Panel therefore finds that the Respondent has registered and is using the domain name at issue in bad faith.")

Please see similar case WIPO Case No. D2019-2371 Marlink SA v. Obabko Nikolay Vladimirovich (“Albeit that there are no concrete examples of such use, it seems inconceivable that the Respondent will be able to make any good faith use of the disputed domain name as part of an email address. The Panel notes in this connection that passive holding of a domain name does not prevent a finding of bad faith use under paragraph 4(a)(iii) of the Policy. See section 3.3 of WIPO Overview 3.0 and Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003.”).

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).

This is a case of "typosquatting“, i.e. the disputed domain name contains an obvious misspelling of the Complainant’s trademark. It is well established that the specific top level of a domain name such as “.com”, “.org” or in casu “.net” does not affect the domain name for the purpose of determining whether it is identical or confusingly similar.

Previous panels have found that the slight spelling variations does not prevent a domain name from being confusingly similar to the complainant’s trademark. Adding the letters IGP before the trademark DECAUX in the domain name IGPDECAUX does not take away the confusing similarity between the domain name and the trademark - no matter whether or not the letter combination IGP are considered distinctive or simply generic as referring to the abbreviation "Impressa Generale Pubblicata" claimed by the Complainant.

Simple exchange or adding of letters is not a sufficient element to escape the finding that the disputed domain name is confusingly similar to the Complainant’s trademarks and domain names.

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).

The Complainant contends that the Respondent is not affiliated with him nor authorized by him in any way to use his trademarks in a domain name or on a website. The Complainant does not carry out any activity for, nor has any business with the Respondent.

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).

Given the circumstances of the case, including the provided information of the use and reputation of the Complainant’s trademark DECAUX and the distinctive nature of this mark, it is inconceivable to the Panel in the current circumstances that the Respondent registered the disputed domain name without prior knowledge of the Complainant and the Complainant’s mark. This Panel finds it to be a clear indication of prior knowledge that the Respondent have combined the letters IGP with the distinctive DECAUX trademark of the Complainant in the disputed domain name making the domain name identical to the company name of the Italian subsidiary IGPDecaux rendering it highly improbable that the letters IGP have been chosen randomly.

The Panel therefore finds that the disputed domain name was registered in bad faith.

The disputed domain name does not currently resolve to an active website. In this case the Complainant has however evidenced that there are several active MX records connected to the disputed domain name, which enables the Respondent to send emails using an e-mail address that contains the disputed domain name.

Though no concrete examples of such use have been presented to this Panel, it seems inconceivable that the Respondent will be able to make any good faith use of the disputed domain name as part of an e-mail address. The Panel notes in this connection that passive holding of a domain name does not prevent a finding of bad faith use under 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

1. The three essential issues under the paragraph 4(a) of the Policy are whether:

i. the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

ii. the Respondent has no rights or legitimate interests with respect to the disputed domain name; and

iii. the disputed domain name has been registered and is being used in bad faith.

2. The Panel reviewed carefully all documents provided by the Complainant. The Respondent did not provide the Panel with any documents or statements. The Panel also visited all available websites and public information concerning the disputed domain name, namely the WHOIS databases.

3. The UDRP Rules clearly say in its Article 3 that any person or entity may initiate an administrative proceeding by submitting a complaint in accordance with the Policy and these Rules.

4. The Panel therefore came to the following conclusions:

a) The Complainant states and proves that the disputed domain name is confusingly similar to its trademarks and its domain names. Indeed, the trademark is partially incorporated in the disputed domain name.

The disputed domain name is therefore deemed identical or confusingly similar.

b) The Respondent is not generally known by the disputed domain name and have not acquired any trademark or service mark rights in the name or mark, nor is there any authorization for the Respondent by the Complainant to use or register the disputed domain name.

The Panel therefore finds that the Respondent does not have rights or legitimate interest with respect to the disputed domain name.

c) It is clear that the Complainant's trademarks and website(s) were used by the Complainant long time before the disputed domain name was registered. There is no present use of the disputed domain name but there are several active MX records connected to the disputed domain name. It is concluded that it is inconceivable that the Respondent will be able to make any good faith use of the disputed domain name as part of an e-mail address.

The Panel therefore finds that the disputed domain name has been registered and is being used in bad faith.

For the reasons stated above, it is the decision of this Panel that the Complainant has satisfied all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **IGPDECAUX.NET**: Transferred

PANELLISTS

Name	**Lars Karnoe**

DATE OF PANEL DECISION 2020-01-24

Publish the Decision