Decision for dispute CAC-UDRP-103401

Case number	CAC-UDRP-103401
Time of filing	2020-11-10 10:39:08
Domain names	jcdecaux.website

Case administrator

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

Complainant

Organization	JCDECAUX SA

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Organization	SlonKoto

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 owner, inter alia, of the following trademark registration for JCDECAUX:

- International trademark registration n. 803987 for JCDECAUX (word mark), registered on November 27, 2001 in international classes 6, 9, 11, 19, 20, 35, 37, 38, 39, 41 and 42.

FACTUAL BACKGROUND

Since 1964, the Complainant has engaged in outdoor advertising and has been offering solutions that combine urban development and the provision of public services in approximatively 80 countries for more than 50 years.

The Complainant is currently present in the three principal segments of outdoor advertising market, namely street furniture, transport advertising and billboard, with more than 1,061,630 advertising panels in airports, rail and metro stations, shopping malls, on billboards and street furniture.

The Complainant’s Group is listed on the Premier Marché of the Euronext Paris stock exchange and is part of Euronext 100

index. Employing a total of 13,210 people, the Group is present in more than 80 different countries and 3,890 cities and has generated revenues of 3,890 million Euro in 2019.

The Complainant also owns a large portfolio of domain names containing the trademark JCDECAUX, including the domain name <jcdecaux.com>, registered since June 23, 1997 and used by the Complainant to promote its products and services under the trademark JCDECAUX.

The disputed domain name <jcdecaux.website> was registered on November 3, 2020 and is currently not pointed to an active website. According to the screenshot submitted by the Complainant and not challenged by the Respondent, the disputed domain name was previously pointed to a website mirroring the Complainant's official website for Estonia, available at the domain name <jcdecaux.ee>.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS

COMPLAINANT

The Complainant contends that the disputed domain name <jcdecaux.website> is identical to the trademark JCDECAUX in which the Complainant has rights as it reproduces the trademark in its entirety with the mere addition of the new generic Top Level Domain "website".

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant states that the Respondent has no rights or legitimate interests and that, also based on the information published in the Whois records, the Respondent is not commonly known by the disputed domain name.

The Complainant further contends that the Respondent is in no way affiliated or authorized by the Complainant to use the trademark JCDECAUX and has not been authorized to apply for registration of the disputed domain name on behalf of the Complainant.

Moreover, the Complainant highlights that the Respondent is not using the disputed domain name in connection with a bona fine offering of goods or services or a legitimate non-commercial or fair use of the disputed domain name, as the Respondent has pointed the disputed domain name to a website identical to that of the Complainant in Estonia and, in doing so, the Respondent is obviously trying to pass itself off as an affiliate of the Complainant.
With reference to the circumstances evidencing bad faith, the Complainant indicates that, considering the name and content of the website to which the disputed domain name resolves, the Respondent was undoubtedly well aware of the Complainant at the time of registration. The Complainant further states that, by registering and using the disputed domain name, which is virtually identical to the Complainant's trademark, the Respondent must have been wanting to intentionally attract internet users to its website, which mimics the Complainant's website, in order to confuse users into believing that Respondent is some way affiliated or associated with the Complainant.

RESPONDENT

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

1. The Panel finds that the disputed domain name is identical the Complainant's word trademark JCDECAUX as it entirely reproduces the Complainant's trademark with the mere addition of the new generic Top-Level domain ".website", which can be disregarded being a mere technical requirement for registration.

2. The Complainant stated that the Respondent is not affiliated with or authorized by the Complainant in any way. There is no evidence of the fact that the Respondent might have been commonly known by the disputed domain name or by a name corresponding to the disputed domain name. According to the evidence on records, the Respondent pointed the disputed domain name to a website which imitated the look and feel and the content of the Complainant's official website for Estonia, thus inducing Internet users to believe that the Respondent and its website were affiliated with the Complainant. The Panel finds that, in light of such use of the disputed domain name, the Respondent did not make use, or demonstrable preparations to use, of the disputed domain name in connection with a bona fide offering of goods or services, or a legitimate non-commercial or fair use. Therefore, and in the absence of a Response, the Panel finds that the Complainant has made a prima facie case that the Respondent has no rights or legitimate interest in the disputed domain name.

3. As to the bad faith at the time of the registration, the Panel finds that, in light of the distinctiveness of the Complainant's trademark, with which the disputed domain name is confusingly similar, of the prior registration and use of the trademark JCDECAUX by the Complainant and of the content of the website to which the disputed domain name resolved, the Respondent was clearly well aware of the Complainant's trademark at the time of the registration of the disputed domain name.

Moreover, in view of the above-described use of the disputed domain name to redirect users to a web site mirroring one of the Complainant's official websites, the Panel finds that the Respondent intentionally attempted to attract Internet users to its website, likely for commercial gain, by causing a likelihood of confusion with the Complainant's trademark JCDECAUX as to the source, sponsorship, affiliation or endorsement of its website, according to 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. **JCDECAUX.WEBSITE**: Transferred

PANELLISTS

Name	**Luca Barbero**

DATE OF PANEL DECISION 2020-12-22

Publish the Decision