Decision for dispute CAC-UDRP-103477

Case number	CAC-UDRP-103477
Time of filing	2020-12-22 10:52:34
Domain names	jcdecaux-uk.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)

Complainant

Organization	JCDECAUX SA

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	Xander Shaffer

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 submitted evidence that it is the registered owner of the international trademark registration No. 803987 for "JCDecaux" (word), registered since 27 November 2001 for classes 6, 9, 11, 19, 20, 35, 37, 38, 39, 41 and 42, which has been designated for numerous countries around the world.

The Complainant also provided information, supported by evidence, that it is the registered holder of the domain name <jcdecaux.com> which was registered and used since 23 June 1997.

FACTUAL BACKGROUND

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

Since 1964, the Complainant is the worldwide number one in outdoor advertising. Throughout the world, the Complainant's success is driven by meeting the needs of local authorities and advertisers by a constant focus on innovation. For more than 50 years the Complainant has been offering solutions that combine urban development and the provision of public services in approximately 80 countries. The Complainant is currently the only group present in the three principal segments of the

outdoor advertising market: street furniture, transport advertising, and billboard.

All over the world, the digital transformation is gathering pace: the Complainant now has 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 the Euronext 100 index. Employing a total of 13,210 people, the Complainant's Group is present in more than 80 different countries and 3,890 cities and has generated revenues of €3,890m in 2019.

The disputed domain name <jcdecaux-uk.com> was registered on 15 December 2020.

The Registrar confirmed that the Respondent is the current registrant of the disputed domain name and that the language of the registration agreement is English.

The Respondent has not filed a Response.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Complainant made the following contentions:

The Complainant states that the disputed domain name <jcdecaux-uk.com> is confusingly similar to its trademarks and branded services JCDECAUX®.

The addition of the geographical abbreviation "UK" (which refers to the United Kingdom, where the Complainant has activities) to the trademark is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark JCDECAUX.

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" (for instance WIPO Case No. D2003-0888).

Furthermore, the Complainant contends that the addition of the gTLD ".COM" does not change the overall impression of the designation as being connected to Complainant's trademark. It does not prevent the likelihood of confusion between the disputed domain name and Complainant, its trademark, and its domain names associated. The Complainant refers to WIPO Case No. D2006-0451 in which the panel concluded that: "It is also well established that the specific top level of a domain name such as ".com", ".org" or ".net" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar."

Finally, the Complainant argues that past Panels have confirmed the Complainant rights over the term "JCDECAUX". For instance: CAC Case No. 102733 <jcdecaux-hk.com>; WIPO Case No. D2019-1143 <usa-jcdecaux.com>; and CAC Case No. 102306 <jcdecaux-fr.com>.

Thus, the Complainant concludes that the disputed domain name is confusingly similar to the Complainant's trademark JCDECAUX.

Regarding Respondent's rights or legitimate interests, the Complainant points to the decision in the WIPO case No. D2003-0455, according to which the complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests and once such prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a) (ii) of the UDRP.

The Complainant asserts that the Respondent is not identified in the WHOIS database as the disputed domain name. Past

panels have held that a Respondent was not commonly known by a disputed domain name if the Whois information was not similar to the disputed domain name. Thus, the Respondent is not known as the disputed domain name. In support of its arguments, the Complainant refers to Forum Case No. FA 1781783 in which the panel found that the respondent was not commonly known by the disputed domain name under paragraph 4(c)(ii) of the UDRP Policy.

The Complainant contends that the Respondent is not affiliated with nor authorized by the Complainant in any way. 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.

Neither license nor authorization has been granted to the Respondent to make any use of the Complainant’s trademark JCDECAUX or apply for registration of the disputed domain name by the Complainant.

Besides, the Complainant argues that the disputed domain name is identical to the Complainant’s website in the United Kingdom. Therefore, the Complainant contends that the Respondent did not make any use of the disputed domain name since its registration, and it confirms that the Respondent has no demonstrable plan to use the disputed domain name. It demonstrates a lack of legitimate interests in respect of the disputed domain name.

Therefore, the Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Turning to the bad faith argument, the Complainant asserts that the disputed domain name is confusingly similar to the Complainant's trademark JCDECAUX. The Complainant asserts that its trademark JCDECAUX was already known for decades and protected in several countries at the time of the registration. The Complainant is doing business in more than 80 countries worldwide and is listed at the Euronext Paris stock exchange.

Besides, the Complainant points to the fact that past panels have held that the JCDECAUX trademark is well-known (see WIPO Case No. DCC2017-0003: “The Panel is satisfied that the Respondent must have been aware of the Complainant's well-known JCDECAUX trademark when it registered the Domain Name.”).

Moreover, the disputed domain name resolves to a website copying the Complainant’s official website for the United Kingdom.

Thus, given the distinctiveness of the Complainant's trademark and reputation, the Complainant can state 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.

Furthermore, the Complainants points out that the disputed domain name is identical to the Complainant’s website in Estonia. Therefore, the Complainant contends that the Respondent intentionally attempts to attract, for commercial gain, Internet users to the Respondent’s website or other online location by creating a likelihood of confusion with Complainant’s trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent or of a product or service on the Respondent’s website.

On these bases, the Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith.

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

This is a mandatory administrative proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the CAC Supplemental Rules.

Paragraph 15 of the Rules provides that the Panel shall decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules, and any rules and principles of law that it deems applicable.

According to Paragraph 4(a) of the Policy, the Complainant must prove each of the following: (i) the 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 domain name; (iii) the domain name has been registered and is being used in bad faith.

A. Identical or confusingly similar domain name

The Complainant demonstrated that it owns the asserted international trademark registration for the word "JCDecaux" which was registered already 19 years earlier than the disputed domain name. It is well established that a nationally or regionally registered trademark confers on its owner sufficient rights to satisfy the requirement of having trademark rights for the purposes of standing to file a UDRP case. Therefore, the Panel finds that the Complainant has established such rights.

It is also well established that the generic top-level suffix .com may be disregarded when considering whether a disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights, as it is a necessary technical requirement of a domain name.

The disputed domain name incorporates the Complainant's trademark "JCDecaux" in its entirety. The adding of a prefix "UK-" must be considered insufficient to prevent or diminish confusing similarity. This is true especially given that "UK" is widely recognized as the country code for the United Kingdom and the prefix would very likely be perceived as a geographical designation, thus lacking distinctive character. This finding is consistent with earlier decisions of CAC (eg. CAC Case No. 101270 and CAC Case No. 101503).

The Panel, therefore, finds that the disputed domain name is confusingly similar to the trademark in which the Complainant has rights.

B. Lack of rights or legitimate interests

The Respondent has not filed a Response and has neither provided any other information that would oppose the Complainant's allegations. Therefore, the Panel holds that the Complainant successfully presented its prima facie case that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

In particular, the Respondent is not in any way connected with the Complainant nor is it authorized to use the Complainant’s

trademark for its commercial activities. In addition, the Respondent is not commonly known by the disputed domain name pursuant to Paragraph 4(c)(ii) of the Policy. Furthermore, it was demonstrated by evidence submitted by the Complainant that the disputed domain name has not been used for a bona fide offering of goods or services or a legitimate non-commercial or fair use.

The Panel, therefore, finds that the Respondent has no rights or legitimate interest in the disputed domain name.

C. Registration and use of the disputed domain name in bad faith

With respect to the bad faith argument, the Panel has already found that the domain name is confusingly similar to the Complainant's trademark "JCDecaux". The Complainant submitted evidence that the Panel believes sufficiently demonstrates the Respondent must have or at least should have been aware of the existence of the Complainant, its well-known trademark, and its <jcdecaux.com> domain name.

It is well established that mere registration of a domain name that is confusingly similar to a trademark by an unaffiliated entity can lead to the presumption of bad faith. Furthermore, typical circumstances demonstrating respondent's bad faith include a situation where the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location (see Paragraph 4(b)(iv) of the Policy).

Taking into account the above-described facts and evidence submitted by the Complainant, the Panel considers this a clear-cut case. Not only there is (i) a high degree of similarity between the disputed domain name and the Complainant's trademark; and (ii) absence of rights or legitimate interests coupled with no response to Complaint with conceivable or credible explanations of the Respondent's conduct; but (iii) the website operated on the disputed domain name copies the overall appearance, graphic design, images and other elements of the Complainant's UK website, including the Complainant’s trademark. Therefore, the Panel believes there is no doubt that the disputed domain name has been registered and has been used by the Respondent in bad faith.

In conclusion, the Panel finds that all three elements required by Paragraph 4(a) of the Policy were met and makes the following decision.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **JCDECAUX-UK.COM**: Transferred

PANELLISTS

Name	**Mgr. Vojtěch Chloupek**

DATE OF PANEL DECISION 2021-02-03

Publish the Decision