

## Decision for dispute CAC-UDRP-103582

Case number CAC-UDRP-103582

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Time of filing 2021-02-17 09:41:25

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Domain names group-jcdecaux.com

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### Case administrator

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

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### Complainant

Organization JCDECAUX SA

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### Complainant representative

Organization Nameshield (Laurent Becker)

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### Respondent

Name ricardo perez

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#### 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.

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#### IDENTIFICATION OF RIGHTS

The Complainant owns the international trademark n° 803987 for the sign « JCDECAUX », registered on November 27, 2001, in classes 6, 9, 11, 19, 20, 35, 37, 38, 39, 41 and 42, among others in Switzerland, Estonia, Sri Lanka and Hungary.

The Complainant also owns several domain names using the sign « JCDECAUX », in particular the domain name <jcdecaux.com> registered on June 22, 1997.

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#### FACTUAL BACKGROUND

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

The disputed domain name is identical to the Complainant's trademark JCDECAUX. Past panels have held that the JCDECAUX trademark is well-known. Please see WIPO Case No. DCC2017-0003, JCDecaux SA v. Wang Xuesong, Wangxuesong ("The Panel is satisfied that the Respondent must have been aware of the Complainant's well-known JCDECAUX trade mark when it registered the Domain Name.").

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. See WIPO Case No D2004-0673 Ferrari Spa v American Entertainment Group Inc.

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#### PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

First, Complainant considers the disputed domain name to be confusingly similar to its JCDECAUX trademarks.

Complainant proves its trademark rights on the sign JCDECAUX through a registration certificate for the international trademark JCDECAUX n° 803987 as well as through several previous panel decisions, such as CAC Case N° 120169, JCDECAUX SA v. dre dre <jicdecaux.com>, CAC Case N° 101990, JCDECAUX SA v. Gemma Purnell <jcdeceux.com>, and CAC Case N° 101961, JCDECAUX SA v. dre dre <jcdiecaux.com>.

Complainant adds that TLDs may typically be disregarded when assessing the risk of confusion between the disputed domain names and trademarks.

Furthermore, Complainant argues that Respondent does not have any rights or legitimate interests in the disputed domain name.

Complainant recalls that it shall only make a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name, and that Respondent then carries the burden of proving the latter rights or interests.

Complainant specifies that Respondent is not identified in the WHOIS database by the disputed domain name and as a result that Respondent was not commonly known by the disputed domain name.

Complainants underlines that Respondent was never affiliated with, authorized by, granted a license from, or related to Complainant's company to use or register the disputed domain name.

Complainant also asserts that because the disputed domain name resolves to a parking page, Respondent did not and does not use the disputed domain name, which shows its lack of interests in the disputed domain name.

Finally, Complainant claims that the disputed domain name was registered and is being used in bad faith.

Complainant emphasizes the well-known character of its JCDECAUX trademark to establish that Respondent could not have ignored Complainant's rights when registering the disputed domain name.

Complainant also recalls that Respondent does not use the disputed domain name but merely attempts to attract internet users to its online location by creating a confusion with Complainant's trademark.

RESPONDENT:

Respondent is Ricardo Perez. Respondent did not provide any response to the complaint, and is therefore in default.

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#### RIGHTS

Complainant claims rights in the JCDECAUX trademark through an international registration since 2001. This is generally sufficient to establish rights in a mark in accordance with Policy 4(a)(i). Previous case law on Policy 4(a)(i) considered that trademark registration in a single jurisdiction is sufficient to show Complainant's rights. For recent case law, see ACINDAR INDUSTRIA ARGENTINA DE ACEROS S.A. v. Sandeep Rangu, Case n°102400 (CAC March 19, 2019), "To satisfy paragraph 4(a)(i) of the Policy it is enough that the Panel is satisfied that the Complainant has registered rights in a trademark that predates the registration of the disputed domain name in a single jurisdiction (even if that single jurisdiction is not one in which the Respondent resides or operates) (Koninklijke KPN N.V. v. Telepathy, Inc D2001-0217 (WIPO May 7, 2001); see also WIPO Case Nos. D2012-0141 and D2011-1436). The Complainant has clearly satisfied such in relation to the trademark ACINDAR".

The Panel agrees and considers Complainant's trademark rights in the JCDECAUX sign are established.

The Complainant adds that TLDs are generally disregarded when assessing similarity between prior trademarks and the disputed domain name. Under Policy 4(a)(i), top-level domains are indeed generally disregarded in the similarity test. For recent case law, see CREDIT MUTUEL ARKEA v. Domain Administration, Case n° 102345 (CAC March 14, 2019) "The suffix is ignored for similarity. The applicable Top Level Domain ("TLD") in a domain name (e.g. ".com") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test, see CANAL + FRANCE v. Franck Letourneau, WIPO Case No. DTV2010-0012, <canalsat.tv>."

The Panel agrees that the disputed domain name is causing confusion with Complainant's trademark, since it reproduces entirely its trademark with the mere addition of the term "group".

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 shall make a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy 4(a)(ii), the burden then shifts to Respondent. This standard and burden of proof have been established through continuous case law, see LESAFFRE ET COMPAGNIE v. Tims Dozman, Case n° 102430 (CAC May 2, 2019), "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 Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name."

The Complainant alleges that Respondent is not commonly known by the disputed domain name as it is not identified as such in the WHOIS database. Previous case law has indeed referred to the information in the WHOIS database to conclude that Respondent was not known under the disputed domain name, see Urban One, Inc. v. F A, Case n° FA2102001933089, (FORUM March 22, 2021) « The WHOIS information for the disputed domain name lists the registrant as "F A." Therefore, the Panel finds that Respondent is not commonly known by the disputed domain name, and thus has no rights under Policy 4(c) (ii). ».

In the present case, the Panel finds that Respondent is not commonly known by the disputed domain name.

The Complainant also asserts that Respondent has never been allowed by Complainant to register or use the disputed domain name by means of a license, an affiliation or an authorization from Complainant's company. This is generally considered as evidence that Respondent lacks rights or legitimate interests in the disputed domain name, see SANDRO ANDY v. ji zhou chen, Case n° 102369 (CAC March 23, 2019), « In the opinion of the Panel, Complainant has made a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name. Complainant has not licensed or otherwise permitted Respondent to use any of its trademarks or to register the disputed domain name incorporating its trademarks. Respondent is not making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers or to tarnish the trademarks of Complainant. ». The Panel agrees that Respondent is not related in any way to Complainant's business, which also points towards a finding that it does not have any rights or legitimate interests in the disputed domain name.

The Complainant further argues that Respondent did not use the disputed domain name given that it points to a parking page.

Long-standing case law has established that such holding of the domain name to redirect consumers to a parking page shows that Complainant does not use the domain name in connection to any bona fide offering of goods or services, see *AMUNDI ASSET MANAGEMENT v. Null null*, Case n° 102393 (CAC April 12, 2019). « Moreover, the disputed domain name resolves to a parking web page with the commercial links and the disputed domain name, therefore, does not constitute a bona fide offering of goods and services or a legitimate non-commercial fair use. ». For that reason, the Panel finds that Respondent does not use the domain name in connection to any bona fide offering of goods or services.

The Panel therefore conclude that Complainant has made a prima facie case and has therefore satisfied Policy 4(a)(ii).

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#### BAD FAITH

The Complainant argues that Respondent could not ignore Complainant's rights in the well-known JCDECAUX trademark at the time of registration.

The case law has previously held that it was possible to infer constructive knowledge of complainant's rights at the time of registration, and thus bad faith registration, from the well-known character of complainant's mark, see *PepsiCo, Inc. v. Smith power production*, Case n° 102378, (CAC April 14, 2019) « Complainant contends that 1) the mere registration of a domain name incorporating a misspelling of a famous or widely-known trademark by an unaffiliated entity creates a presumption of bad faith because it may be inferred that the Respondent, at the time it registered the domain name, knew of Complainant's exclusive rights in the famous and well-known PepsiCo names and marks; (...) The Panel agrees with the Complainant and finds that the above constitutes bad faith registration and use of the disputed domain name, and thus the element of paragraph 4(a)(iii) of the Policy has been satisfied. ».

The Panel acknowledges the well-known nature of the JCDECAUX trademark in the field of outdoor advertising and thus finds that Respondent could not ignore Complainant's rights at the time of registration, and as a result, registered the disputed domain name in bad faith.

The Complainant further asserts that Respondent used the disputed domain name leading to a parking page in bad faith because it registered it with the sole purpose of attracting internet users to its website by creating a confusion with Complainant's mark. In similar cases, previous Panels have found use in bad faith, see *ARCELORMITTAL (SA) v. Milton Liquors ILC*, n° 102360 (CAC April 2, 2019) « In the Panel's view, the Respondent has intentionally registered the disputed domain name which reproduces the Complainant's trademark almost identically. By the time the disputed domain name was registered, it is unlikely that the Respondent did not have knowledge of the Complainant's trademark. The Complainant also proved that the Respondent used the disputed domain name to lead to a parking page, with sponsored links. These facts, confirm that the disputed domain name is used to intentionally attempt to attract, for commercial gain, Internet users to the Respondent's website, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. ».

The Panel agrees and finds this situation amounts to use in 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).

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#### 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.

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#### PRINCIPAL REASONS FOR THE DECISION

The Complainant holds trademark rights for the JCDECAUX sign. The disputed domain name is reproducing Complainant's trademark. The Respondent failed to establish legitimate rights or legitimate interests in the disputed domain name. The Complainant has established that Respondent registered and uses the disputed domain name in bad faith.

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FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **GROUP-JCDECAUX.COM**: Transferred
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## PANELLISTS

Name	<b>Nathalie Dreyfus</b>
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DATE OF PANEL DECISION **2021-03-31**

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Publish the Decision

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