

Decision for dispute CAC-UDRP-103798

Case number	CAC-UDRP-103798
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Time of filing	2021-05-12 09:36:24
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Domain names	jcdeceux.com
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Case administrator

Organization	Denisa Bilík (CAC) (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	Matthew Phillips
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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.

IDENTIFICATION OF RIGHTS

The Complainant owns International Trademark Registration No. 803987, registered on November 27, 2001, for the trademark JCDECAUX.

FACTUAL BACKGROUND

Since 1964, the Complainant has been the worldwide number one in outdoor advertising. It 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 – specifically, street furniture, transport advertising and billboards. As the worldwide digital transformation is gathering pace the Complainant now has more than one Million advertising panels in airports, rail and metro stations, shopping malls, on billboards and on 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 <jcdeceux.com> was registered on May 3, 2021. The disputed domain name does not resolve to

any website content. However, mail exchange (MX) records have been configured for the domain name thus indicating that Respondent intends to use it for sending emails.

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

A. The disputed domain name is confusingly similar to a trademark or service mark in which the Complainant has rights

Paragraph 4(a)(i) of the Policy requires that the Complainant demonstrates its ownership of trademark rights and that the disputed domain name is confusingly similar to such trademark. Boehringer Ingelheim Animal Health France / Merial v. S Jon Grant, 103255 (CAC September 30, 2020) (“it is imperative that the Complainant provides evidence that it has rights in a trade mark or service mark, following which the Panel shall assess whether or not the disputed domain name is identical or confusingly similar to the Complainant’s trade mark(s).”).

The Complainant has submitted screenshots from the website of the World Intellectual Property Organization (“WIPO”) as evidence that it owns registered rights to its asserted trademark. The disputed domain name, which was registered long subsequent to the existence of the Complainant’s trademark rights, is a misspelling of the trademark JCDECAUX substituting the letter “E” for the letter “A” in the mark. The domain name further adds the “.com” gTLD. Thus, the Complainant asserts that the second level of the disputed domain name is confusingly similar to the asserted trademark and will lead internet users to wrongly believe that the disputed domain name is endorsed by the Complainant. Prior panels have found confusing similarity under similar fact situations. Star Stable Entertainment AB v. Carolina Rodrigues, 103789 (CAC May 5, 2021) (“The disputed domain name consists of the Complainant’s whole trademark (STAR STABLE), written in a misspelled way, with an ‘s’ instead of an ‘a’ in the middle of the second word. Such misspelling is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark of the Complainant.”).

Also, the extension “.com” typically adds no meaning or distinctiveness to a disputed domain name and may be disregarded in the paragraph 4(a)(i) analysis. Novartis AG v. Wei Zhang, 103365 (CAC December 9, 2020) (“it is generally accepted that the addition of the top-level suffix in the domain name (e.g., ‘.com’) is to be disregarded under the confusing similarity test”).

Accordingly, the Panel finds that the Complainant has rights to its claimed trademark and that the typographical variation thereof in the disputed domain name is insufficient to avoid a finding that it is confusingly similar to the Complainant’s trademark. Thus, the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. The Respondent has no rights or legitimate interests in respect of the disputed domain name

Pursuant to paragraph 4(a)(ii) of the Policy, a complainant has the burden of making a prima facie showing that the respondent has no rights or legitimate interests in a domain name. *Cephalon, Inc. v. RiskIQ, Inc.*, 100834 (CAC September 12, 2014). Once this burden is met, it then shifts to the respondent to demonstrate that it does have rights or legitimate interests in the domain name.

Paragraph 4(c) of the Policy offers the Respondent several examples of how to demonstrate its rights or legitimate interests to the disputed domain name.

With reference to Paragraph 4(c)(ii) of the Policy the Complaint states that the Respondent is not related in any way to the Complainant and has not received any license or authorization to use the Complainant's trademark. The Respondent has not participated in this case and so it does not contest this. As such, the Panel concludes that the Respondent is not affiliated with the Complainant, nor is it authorized or licensed to use the Complainant's trademark or to seek registration of any domain name incorporating the aforementioned trademark. Furthermore, the Registrar for the disputed domain name identifies the Registrant as Matthew Phillips. There is no evidence that the Respondent is known otherwise. Based upon the available evidence in this case, the Panel cannot conclude that the Respondent is commonly known by the disputed domain name or that it has any rights to the Complainant's trademark.

Next, under Paragraphs 4(c)(i) and 4(c)(iii) of the Policy the Panel considers whether the Respondent is using the disputed domain name to make a bona fide offering of goods or services or whether it is making a legitimate non-commercial or fair use of the disputed domain name. The disputed domain name does not resolve to any website content. Resolving a disputed domain name to an error page or to no content at all does not demonstrate a bona fide use thereof. See *Kohler Co. v. xi long chen*, FA 1737910 (FORUM August 4, 2017) (where the disputed domain name resolves to an inactive webpage displaying the message "website coming soon!" the Panel held that the "Respondent has not made a bona fide offering of goods or services, or a legitimate non-commercial or fair use of the domain."). The Complainant submits a screenshot of the resolution of the disputed domain name which shows only a message explaining that the website is inaccessible. This provides support for the conclusion that the Respondent is not using the disputed domain name and thus has not demonstrated any rights or legitimate interests therein under Policy paragraphs 4(c)(i) or (iii). As noted, the Respondent has not appeared in these proceedings and so does not offer any explanation for its lack of use of the disputed domain name.

For all of the above-stated reasons, this Panel finds, by a preponderance of the evidence, that the Complainant has made a prima facie showing under Paragraph 4(a)(ii) of the Policy and that the Respondent has not refuted this to show that it has any rights or legitimate interests in the disputed domain name.

C. The disputed domain name was registered and is being used in bad faith

The Complainant argues that the Respondent registered the disputed domain name in bad faith as it must have been aware of the Complainant's rights in its asserted well-known trademark at that time. Actual knowledge of rights in a trademark at the time of registering a disputed domain name is generally sufficient as a foundation upon which to build a case for bad faith under Policy paragraph 4(a)(iii), and can be demonstrated through evidence that an asserted trademark is well-known. See *AutoZone Parts, Inc. v. Ken Belden*, FA 1815011 (FORUM December 24, 2018) (the "Complainant contends that Respondent's knowledge can be presumed in light of the substantial fame and notoriety of the AUTOZONE mark, as well as the fact that Complainant is the largest retailer in the field. The Panel here finds that Respondent did have actual knowledge of Complainant's mark, demonstrating bad faith registration and use under Policy paragraph 4(a)(iii).") See also *Spectrum Brands, Inc. v. Guo Li Bo*, FA 1760233 (FORUM January 5, 2018) ("[T]he fact Respondent registered a domain name that looked identical to the SPECTRUM BRANDS mark and used that as an email address to pass itself off as Complainant shows that Respondent knew of Complainant and its trademark rights at the time of registration.")

The Complainant argues that its trademark is well-known around the world and, in support, it submits screenshots from its own website which contains images showing various uses of its products, its financial results, and various statistics such as the number of countries in which it operates, the number of people employed by the Complainant, and how many advertising panels it has deployed. The Complainant's securities are also publicly traded on the Paris stock exchange and it forms part of the

Euronext 100 index. From this claim of a strong reputation, the Complainant asserts that the Respondent must have been aware of the Complainant's well-known trademark. Respondent does not attempt to refute this. In light of the Complainant's evidence and the fact that the asserted trademark is rather distinctive and unlikely to be replicated by mere chance, the Panel finds it highly likely that the Respondent registered the disputed domain name with actual knowledge of the Complainant's trademark. Next, the Complainant argues that the Respondent registered and uses the disputed domain name in bad faith. The failure to actively use a disputed domain name can be evidence of bad faith registration and use pursuant to paragraph 4(a)(iii) of the Policy. See Dermtek Pharmaceuticals Ltd. v. Sang Im / Private Registration, FA 1522801 (FORUM November 19, 2013) (holding that because the respondent's website contained no content related to the domain name and instead generated the error message "Error 400- Bad Request," the respondent had registered and used the disputed domain name in bad faith pursuant to paragraph 4(a)(iii) of the Policy). Also see Young Microbrush, LLC v. Eduardo Tarrio / Micro Brush, FA 1944632 (FORUM June 7, 2021) ("Further, the Domain Name resolves to an inactive web site. Passive holding of a domain name is also evidence of bad faith."). The Complainant submits a screenshot showing that the disputed domain name resolves to a page displaying a message that the site is inaccessible. As there is no evidence that the disputed domain name has resolved to any website content, the Panel finds that the Respondent is passively holding the disputed domain name and that this supports the conclusion that it registered and uses the domain name in bad faith under paragraph 4(a)(iii) of the Policy.

Finally, the Complainant asserts that, in addition to the lack of any website that resolves from the disputed domain name, it "has been set up with MX records which suggests that it may be actively used for email purposes." Prior decisions have inferred an intent to use a disputed domain name for the sending of email based upon the creation of associated MX records. In The Standard Bank of South Africa Limited v. N/A / mark gersper, FA 1467014 (FORUM December 5, 2012), the Panel noted that the "Complainant contends this phishing could be carried out via email and not just through a website. Complainant has examined the domain name's MX records and they apparently allow the transmission of email, which would not be necessary if the domain name was merely parked. The Panel finds Complainant's allegations about the possibility of Respondent using the disputed domain name for phishing sufficient...". This inference has been adopted in other decisions. See, e.g., Pepsico, Inc. v. Allen Othman, 102380 (CAC April 25, 2019) ("The Complainant submits, fairly, that the preparatory steps in relation to email addresses could enable the inappropriate sending or receipt of email communications purporting to emanate from, or intending to be received by, the Complainant. These preparatory steps (configuring 'MX' or mail exchange records) have [been] considered in relation to 'use' for the purposes of the Policy by other Panels, which the present Panel has considered of its own motion.").

In the present case, the Complainant submits a screenshot showing that an MX record has been created for the disputed domain name thus indicating that it may be used for the sending and receiving of emails. While, in the abstract, the creation of such record does not indicate any ill intent, in the circumstances of the present case where a typosquatted domain name that is confusingly similar to the Complainant's well-known trademark has been created by the Respondent, this MX record does require some further explanation which the Respondent has not provided. As such, the Panel finds that the existence of an MX record for the disputed domain name further supports the conclusion that it has been registered and used in bad faith under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **JCDECEUX.COM**: Transferred

PANELLISTS

Name	Steven M. Levy, Esq.
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DATE OF PANEL DECISION	2021-06-10
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Publish the Decision
