

Decision for dispute CAC-UDRP-103867

Case number CAC-UDRP-103867

Time of filing 2021-06-22 10:19:00

Domain names jcdecauxltd.com

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization JCDECAUX SA

Complainant representative

Organization Nameshield (Enora Millocheau)

Respondent

Name Thomas Rankin

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 several trademarks "JCDECAUX" such as the international trademark registration JCDECAUX No. 803987 registered since 2001-11-27.

The Complainant is also the owner of a large domain names portfolio, including the same distinctive wording JCDECAUX, such as <jcdecaux.com> registered since 1997-06-23.

FACTUAL BACKGROUND

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

The Complainant has since 1964 been the worldwide number one in outdoor advertising.

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

The Complainant has more than 964,760 advertising panels in Airports, Rail and Metro Stations, Shopping Malls, on Billboards and Street Furniture.

The Complainant Group is listed on the Premier Marché of the Euronext Paris stock exchange and is part of Euronext 100 index. Employing a total of 10,230 people, the Complainant Group is present in more than 80 different countries and 3,670 cities and has generated revenues of €2,312m in 2020.

The Respondent registered the disputed domain name <jcdecauxltd.com> on 2021-06-09.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain name is 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.

The Complainant contends that the disputed domain name is confusingly similar to its trademark and branded services JCDECAUX. In particular, the addition of the abbreviation "LTD" (for "Limited") to the trademark is not sufficient to escape the finding that the domain name is confusingly similar to the trademark JCDECAUX.

When part of a domain name is identical to a well-known trademark, it increases the likelihood of confusion or association between the domain name holder and the trademark owner. It is, therefore, sufficient to establish identity or confusing similarity for the purposes of the Policy. See *Oki Data Americas, Inc. v. ASD, Inc*, WIPO Case No. D2001-0902; *Dr. Ing. h.c. F. Porsche AG v Vasilij Terkin*, WIPO Case No D2003-003-0888.

It is also a well-established principle in the domain name space that specific top-level domains such as ".com", ".org" or ".net" do not affect the domain name for the purpose of determining whether it is identical or confusingly similar. See, for example, *WIPO Case No. D2006-0451, F. Hoffmann-La Roche AG v. Macalve e-dominios S.A.*

Applying the above well-established principles to the present case, the Panel finds as follows:

(a) The addition of the generic top-Level domain suffix ".COM" does not change the overall impression of the designation of a disputed domain name as being connected to the Complainant's trademark. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant as the true owner of the trademark, and the domain name associated the Complainant.

(b) The mere addition of the word "LTD" to change a domain name so as to avoid it being identical to the trademark is nevertheless in this case confusing or likely to confuse legitimate consumers intending to seek out the Complainant's business.

(c) The Complainant's trademark "JCDECAUX" is a well-known registered trademark that has been used in connection with its business services and offerings for over 50 years. To incorporate the entirety of the Complainant's trademark into the disputed domain name is, in the Panel's view, confusingly similar to the Complainant's trademark.

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.

A complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such a prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the disputed

domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP. See WIPO Case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.

In support of this ground, the Complainant makes the following contentions:

The Respondent is not identified in the WHOIS database as the disputed domain name.

Where information in the WHOIS database is not similar to the disputed domain name, a respondent is not commonly known by the disputed domain name. For example 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>.

The Panel accepts this contention, which is supported by the evidence from the WHOIS database adduced by the Complainant.

Next, the Complainant contends:

- (a) The Respondent is not affiliated with nor authorized by the Complainant in any way, and is not related in any way to its business;
- (b) The Complainant does not carry out any activity for nor has any business with the Respondent;
- (c) Neither licence nor authorization has been granted to the Respondent to make any use of the Complainant's trademark, or apply for registration of the disputed domain name by the Complainant.

As such the Complainant contends that Respondent has no rights or legitimate interests in the disputed domain name.

The Respondent has not filed any administrative compliant response to the Amended Complaint.

Accordingly, the Panel accepts these uncontradicted contentions.

Finally, the Complainant adduced evidence that the disputed domain name resolves to an inactive page that returns the message 'Ce site est inaccessible'.

It is open for the Panel to draw the inference that the Respondent did not make any use of the disputed domain name since its registration, and therefore supports the Complainant's contention that Respondent has no demonstrable plan to use the disputed domain name.

Accordingly, the Panel considers that the evidence adduced by the Complainant supports its contention that there is no bona fide offering of goods or services nor a legitimate non-commercial or fair use of the disputed domain name. See *Ustream.TV, Inc. v. Vertical Axis, Inc*, WIPO Case No. D2008-0598.

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.

There are two elements that must be satisfied – registration and use in bad faith.

Registration in bad faith

The evidence shows that the Complainant's trademark "JCDECAUX" is a well-known trademark, and has been so 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.

The Panel notes a past panel decision that referred to the well-known nature of the Complainant's trademark. See WIPO

Case No. DCC2017-0003, JCDecaux SA v. Wang Xuesong, Wangxuesong.

The Complainant also adduced evidence of Google search results for the terms “JCDECAUX LTD”, and “JCDECAUX LIMITED” (which is the Complainant’s entity in the United Kingdom. The result of the searches refers to the Complainant.

The Panel accepts that given the distinctiveness of the Complainant’s trademark, the well-known nature of the Complainant’s trademark and its reputation, the inescapable inference is that the Respondent registered the disputed domain name with full knowledge of the Complainant’s trademark.

Accordingly, the Panel accepts that the disputed domain name was registered by the Respondent in bad faith.

Use in bad faith

The Panel has already referred to the uncontroverted facts set out in the Amended Complaint and accepts the evidence and contention that the disputed domain name resolves to an inactive page.

The Complainant contends that the Respondent has not demonstrated any activity in respect of the disputed domain name, and it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant’s rights under trademark law.

The incorporation of a registered trademark that is famously known into a disputed domain name coupled with an inactive website, without any administratively compliant response from a respondent, are irrefragable arguments in support of the requirement that the use by the Respondent of the disputed domain name is in bad faith. See also WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows; WIPO Case No. D2000-0400, CBS Broadcasting, Inc. v. Dennis Toeppen.

The Complainant also cites the CAC Case No. 102827, JCDECAUX SA v. Handi Hariyono where in that case there was no present use of the disputed domain name but there were several active MX records connected to the disputed domain name. It was concluded by the panel that it was inconceivable that the respondent would be able to make any good faith use of the disputed domain name as part of an e-mail address.

This conduct, the bona fides of which are clearly left unexplained by the Respondent, is in the Panel’s view evidence of bad faith. See WIPO Case No. D2018-0497, StudioCanal v. Registration Private, Domains By Proxy, LLC / Sudjam Admin, Sudjam LLC; Forum Case No. FA 1623939, Citigroup Inc. v. Kevin Goodman.

The Czech Arbitration Court has also provided written notice of the Amended Complaint to the Respondent with no administratively compliant responses made in respect to any good faith use of the disputed domain name.

In the circumstances, it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would be legitimate.

The Panel, therefore, concludes that the Respondent’s holding of the disputed domain name in this particular case satisfies the requirement that the disputed domain name is being used in bad faith by the Respondent.

Accordingly, the Panel finds that the registration of the disputed domain name and its use were in bad faith.

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

The Complainant owns the registered trademark "JCDECAUX" and the domain name < jcdecaux.com > which are used in connection with its goods or services for a considerable time. It is a well-known trademark.

The Respondent registered the disputed domain name <jcdecauxltd.com> on 2021-06-09.

The Complainant challenges the Respondent's registration of the disputed domain name under paragraph 4(a)(i) of the Uniform Dispute Resolution Policy ("Policy") and seeks relief that the disputed domain name be transferred to the Complainant.

The Respondent failed to file any administratively compliant response.

For the reasons articulated in the Panel's reasons above, the Complainant has satisfied the Panel of the following:

- (a) The disputed domain name is confusingly similar to the Complainant's well-known trademark "JCDECAUX".
- (b) The Respondent has no rights or legitimate interests in respect of the disputed domain name.
- (c) The disputed domain name has been registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

- 1. JCDECAUXLTD.COM: Transferred

PANELLISTS

Name	Adjunct Prof William Lye, OAM QC
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DATE OF PANEL DECISION 2021-07-25

Publish the Decision
