

Decision for dispute CAC-UDRP-104103

Case number	CAC-UDRP-104103
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Time of filing	2021-10-26 09:13:32
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Domain names	jcdceaux.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 S.A.S.
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Respondent

Organization	Fred Perry LLC
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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 is the registered owner of several trademarks for JCDECAUX including the international trademark registration for JCDECAUX no.803987 registered on November 11, 2001.

FACTUAL BACKGROUND

The Complainant is a French company that is a prominent and well known enterprise engaged in outdoor advertising and the provision of related goods and services. It has been engaged in that field since 1964, operates in approximately 80 countries and employs 10,230 people. It owns several trade marks for JCDECAUX and a large number of domain names which it uses in its business. The Respondent registered the disputed domain name on October 20, 2021 and, although it does not resolve to an active website, the Complainant is concerned at the potential it has for diminishing the standing of the Complainant in the eyes of the public and for confusing the public.

PARTIES CONTENTIONS

THE PARTIES' CONTENTIONS

COMPLAINANT:

1. The Complainant is a French company that is a prominent and well known enterprise engaged in outdoor advertising and the provision of related goods and services.
2. The Complainant is the registered owner of several trademarks for JCDECAUX including the international trademark registration for JCDECAUX no.803987 registered on November 11, 2001. It has also registered a large number of domain names which include the distinctive word "JCDECAUX" and which it uses in its business.
3. The Respondent registered the disputed domain name on October 20, 2021.
4. The disputed domain name resolves to an inactive web page.
5. The disputed domain name is confusingly similar to the JCDECAUX trademark.
6. The Respondent does not have any rights or legitimate interests in the disputed domain name.
7. The disputed domain name has been registered and is being used in bad faith.

RESPONDENT

The Respondent did not file a Response in this proceeding.

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

DISCUSSION AND FINDINGS

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

A. Administrative deficiency

By notification dated October 26, 2021 and in accordance with paragraph 4 (b) of the Rules, the CAC notified the Complainant

that the Complaint was administratively deficient in that the Complaint had not sufficiently identified the Respondent.

The notification invited the Complainant to have regard to the Registrar's Verification available in the online case file in the form of a Nonstandard Communication regarding the appropriate identification of the domain name holder. Also on October 26, 2021, the Complainant filed an Amended Complaint and the CAC determined that the Complaint should be admitted to proceed further in the Administrative Proceeding.

The Panel has reviewed all of the above matters and makes a finding that within the meaning of paragraph 4(b) of the Rules, the administrative deficiency has been corrected and that this matter has proceeded properly to the Panel in accordance with the Policy and the Rules.

B. Substantive matters

Paragraph 15 of the Rules provides that the Panel is to 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.

In that regard, the Panel also notes that the onus is on the complainant to make out its case and past UDRP panels have consistently said that a complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

The Panel therefore turns to discuss the various issues that arise for decision on the facts as they are known.

For the complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

- (i) The domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) The respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) The domain name has been registered and is being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.

A. Identical or Confusingly Similar

The Complainant has adduced evidence that the Panel accepts that it is the registered owner of the international trademark registration no. 803987, registered on November 27, 2001 for JCDECAUX and as such has rights in that trademark.

The Panel next finds that the disputed domain name <jcdceaux.com> is confusingly similar to the JCDECAUX trademark for the following reasons.

First, the disputed domain name includes a slight variation of the JCDECAUX trademark, namely "jcdceaux", and that word is by far the dominant part of the disputed domain name as nothing else is included in it other than the generic top-level domain ".com".

Accordingly, the attention of the internet user would naturally be drawn to the term "jcdceaux" in the disputed domain name and would inculcate in the mind of the user the idea that the disputed domain name was an official domain name of the Complainant.

Secondly, as the Complainant submits, the change in the spelling of the trademark so that it reads "jcdceaux" by reversing the letters "e" and "c" is minor and it is universally accepted that such an example of typosquatting cannot negate confusing

similarity that is otherwise present, as it is in this case.

Thirdly, it is also accepted in this jurisdiction that the presence of a top-level domain such as “.com” cannot negate confusing similarity that is otherwise present as it is in this case.

Fourthly, the disputed domain name would convey to the objective bystander that it related to the activities of the Complainant, giving rise to inevitable confusion.

Accordingly, and for all of those reasons, the disputed domain name is confusingly similar to the Complainant’s JCDECAUX trademark and the Complainant has thus shown the first of the three elements that it must establish.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

But by virtue of paragraph 4(c) of the Policy, it is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [respondent] of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) you [respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you [respondent] are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Thus, if a respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the domain name, the complainant will have failed to discharge its onus and the complaint will fail.

It is also well-established that a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests and that when such a prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent cannot do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Panel, after considering all of the evidence in the Complaint, finds that the Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name.

That prima facie case is made out from the following considerations.

The evidence of the Complainant is to the effect that the Respondent is not related in any way to the Complainant’s business, is not affiliated with the Complainant or authorized by it in any way to use the trademark JCDECAUX or any variation of it and does not carry out any activity for, nor has any business with, the Complainant.

It is also clear from the evidence that, as Complainant contends, the Respondent is not commonly known by the disputed domain name under Policy 4(c)(ii).

As has already been indicated, this is a clear case of typosquatting, which can never give rise to a right or legitimate interest in a

domain name, as typosquatting is clearly an attempt to mislead internet users.

These facts give rise to the prima facie case made out by the Complainant.

The Panel also notes that the Complainant's submissions are supported by prior UDRP decisions.

The Respondent has not filed a Response or made any other answer to the claims of the Complainant and is in default. Accordingly, the prima facie case has not been rebutted and the Complainant has made out the second of the three elements that it must establish.

C. Registered and Used in Bad Faith

The Complainant must prove on the balance of probabilities both that the disputed domain name was registered in bad faith and that it is being used in bad faith: *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003.

Paragraph 4(b) of the Policy sets out four circumstances, any one of which is evidence of the registration and use of a domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive. The four specified circumstances are:

- (i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the site or location.

The Panel finds that the Complainant has shown that the Respondent registered and used the disputed domain name in bad faith both in general and in particular because the Respondent's conduct puts the case squarely within paragraph 4(b) (iii) of the Policy and probably within other provisions of paragraph 4 (b) as well.

That is so for the following reasons.

First, the Complainant's trademark is famous and the disputed domain name is confusingly similar to it. The conclusion must be that the disputed domain name was registered with the intention of confusing internet users which amounts to bad faith registration and use.

Secondly, it must also follow that the Respondent had actual notice of the Complainant's trademark. It has regularly been held that to copy a trademark in a domain name, or use it with a slight variation, knowing that the disputed domain name is based on the trademark of another party, constitutes bad faith registration and use of the disputed domain name. The Panel makes that finding in the present case.

Thirdly, the disputed domain name does not resolve to an active website. This means that the Respondent is not using the

disputed domain name for a legitimate purpose and, indeed, it is impossible to contemplate how the Respondent could use such a prominent name for any purpose other than an illegitimate one.

Fourthly, the disputed domain name was set up with MX records which, as the Complainant submits, suggests that it may be actively used for e-mail purposes which would, by itself, be improper as the Respondent has no right to use the Complainant's trademark in that or any other manner.

Fifthly, the evidence shows that Respondent's conduct potentially puts the case within paragraph 4(b) (iii) of the Policy. That is so because if the disputed domain name remains registered to the Respondent, there is a very real danger that it will be used to attract business away from the Complainant to the Respondent and thus disrupt the Complainant's business.

Sixthly, by using the disputed domain name, the Respondent is clearly intending to attract internet users, which can only generate confusion in the market as to the legitimacy of any site to which the disputed domain name resolves. That brings the case within the provisions of paragraph 4(b) (iv) of the Policy.

The Panel also agrees with the submission of the Complainant that setting up the disputed domain name with MX records suggesting that it may be actively used for e-mail purposes constitutes bad faith.

Finally, having regard to the registration of the disputed domain name, based as it is on the Complainant's JCDECAUX trademark, and its retention by the Respondent, the Panel finds that such conduct constitutes registration and use of the disputed domain name in bad faith as that expression is generally understood.

As the Complainant also submits, the foregoing activities have been held in previous UDRP decisions cited by the Complainant to constitute bad faith.

Accordingly, the Complainant has shown the third of the three elements that it must establish and is entitled to the relief it seeks.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **JCDCEAUX.COM**: Transferred

PANELLISTS

Name	The Hon. Neil Brown, QC
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DATE OF PANEL DECISION	2021-11-22
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Publish the Decision