

Decision for dispute CAC-UDRP-104396

Case number CAC-UDRP-104396

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Domain names jcdecauxe.com

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization JCDECAUX SA

Complainant representative

Organization NAMESHIELD S.A.S.

Respondent

Name Tammy Fraser

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

Since 1964, JCDECAUX SA is the worldwide number one in outdoor advertising. Throughout the world, the company's success is driven by meeting the needs of local authorities and advertisers by a constant focus on innovation. For more than 50 years JCDECAUX SA 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.

All over the world, the digital transformation is gathering pace: JCDECAUX® now have more than 1,074,113 advertising panels in Airports, Rail and Metro Stations, Shopping Malls, on Billboards and Street Furniture.

The 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 Group is present in more than 80 different countries and 4,033 cities and has generated revenues of €2,312m in 2020.

JCDECAUX SA owns several trademarks containing the term "JCDECAUX" such as the international trademarks

JCDECAUX® n° 803987 registered since November 27, 2001.

JCDECAUX SA is also the owner of a large domain names portfolio, including the same distinctive wording JCDECAUX®, such as <jcdecaux.com> registered since June 23, 1997.

The disputed domain name <jcdecauxe.com> was registered on February 24, 2022. The website related to the disputed domain name is inactive and MX servers are configured.

FACTUAL BACKGROUND

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

I. Confusing similarity

The Complainant states that the disputed domain name <jcdecauxe.com> is confusingly similar to its trademark and branded services JCDECAUX®. The misspelling in the domain name (the addition of the letter “E” at the end of the trademark JCDECAUX®) is not sufficient to escape the finding that the domain name is confusingly similar to the trademark JCDECAUX®.

Thus, this is a clear case of typosquatting, the disputed domain name contains an obvious misspelling of the Complainant’s trademark. It is well established that the slight spelling variations does not prevent a disputed domain name from being confusing similar to the Complainant’s trademark. Please see WIPO Jurisprudential Overview 3.0, 1.9 (“A domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element.”).

Besides, it is also well established that TLDs may typically be disregarded in the assessment under paragraph 4(a)(i) of the Policy when comparing disputed domain names and trademarks.

WIPO Overview 3.0, section 1.11 (“The applicable Top-Level Domain (“TLD”) in a domain name (e.g., “.com”, “.club”, “.nyc”) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.”).

Several UDRP panels confirmed the Complainant’s rights over the term “JCDECAUX”. For instance:

- CAC Case No. 102169, JCDECAUX SA v. dre dre <jcdecaux.com>;
- CAC Case No. 101990, JCDECAUX SA v. Gemma Purnell <jcdeceux.com>;
- CA Case No. 101961, JCDECAUX SA v. dre dre <jcdiecaux.com>.

II. The Respondent does not have any rights or legitimate interest in the domain name(s)

According to the WIPO Case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd., 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 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. For instance 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> (“Here, the WHOIS information of record identifies Respondent as “Chad Moston / Elite Media Group.” The Panel therefore finds under Policy paragraph 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy paragraph 4(c)(ii).”).

The Complainant contends that the Respondent is not affiliated with nor authorized by JCDECAUX SA 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 licence 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.

Furthermore, the disputed domain name resolves to an inactive page. Therefore, the Complainant contends that Respondent did not make any use of disputed domain name since its registration, and it confirms that 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.

III. The domain name(s) has been registered and is being used in bad faith

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, past Panels have held that the JCDECAUX trademark is well-known: 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.").

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.

Moreover, the Complainant states that the disputed domain name is confusingly similar to its trademark and branded goods JCDECAUX®. Indeed, the addition of the letter "E" is not sufficient to escape the finding that the domain name is confusingly similar to the trademark JCDECAUX®. The Complainant states that this misspelling was intentionally designed to be confusingly similar with the Complainant's trademark. Previous UDRP Panels have seen such actions as evidence of bad faith. Please see for instance Forum case no. FA 877979, Microsoft Corp. v. Domain Registration Philippines (finding bad faith registration and use of the <microsoft.com> domain name as it merely misspelled the complainant's MICROSOFT mark.).

Furthermore, the domain name resolves to an inactive page. Besides, the disputed domain name has been set up with MX records. 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, an infringement of the Complainant's rights under trademark law, or an attempt to attract, for commercial gain, Internet users to his own website, by creating a likelihood of confusion with Complainant's trademark as to the source, sponsorship, affiliation or endorsement of Respondent's website.

As prior WIPO UDRP panels have held, the incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use:

- WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows;
- WIPO Case No. D2000-0400, CBS Broadcasting, Inc. v. Dennis Toeppen.

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

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).

This is a case of "typosquatting", i.e. the disputed domain name contains an obvious misspelling of the Complainant's trademark. It is well established that the specific top level of a domain name such as ".com" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar.

Previous panels have found that the slight spelling variations does not prevent a domain name from being confusingly similar to the complainant's trademark. Adding the letter E in the end of the trademark JCDECAUX in the domain name JCDECAUXE does not take away the confusing similarity between the domain name and the trademark.

Simple exchange or adding of letters is not a sufficient element to escape the finding that the disputed domain name is confusingly similar to the Complainant's trademarks and domain names.

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).

The Complainant contends that the Respondent is not affiliated with him nor authorized by him in any way to use his trademarks in a domain name or on a website. The Complainant does not carry out any activity for, nor has any business with the Respondent.

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).

Given the circumstances of the case, including the provided information of the use and reputation of the Complainant's trademark DECAUX and the distinctive nature of this mark, it is inconceivable to the Panel in the current circumstances that the Respondent registered the disputed domain name without prior knowledge of the Complainant and the Complainant's mark.

The Panel therefore finds that the disputed domain name was registered in bad faith.

The disputed domain name does not currently resolve to an active website. In this case the Complainant has however evidenced that there are active MX records connected to the disputed domain name, which enables the Respondent to send emails using an e-mail address that contains the disputed domain name.

Though no concrete examples of such use have been presented to this Panel, it seems inconceivable that the Respondent will not be able to make any good faith use of the disputed domain name as part of an e-mail address. The Panel notes in this connection that passive holding of a domain name does not prevent a finding of bad faith use under 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

1. The three essential issues under the paragraph 4(a) of the Policy are whether:

i. the disputed 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 with respect to the disputed domain name; and

iii. the disputed domain name has been registered and is being used in bad faith.

2. The Panel reviewed carefully all documents provided by the Complainant. The Respondent did not provide the Panel with any documents or statements. The Panel also visited all available websites and public information concerning the disputed domain name, namely the WHOIS databases.

3. The UDRP Rules clearly say in its Article 3 that any person or entity may initiate an administrative proceeding by submitting a complaint in accordance with the Policy and these Rules.

4. The Panel therefore came to the following conclusions:

a) The Complainant states and proves that the disputed domain name is confusingly similar to its trademarks and its domain names. Indeed, the trademark is partially incorporated in the disputed domain name.

The disputed domain name is therefore deemed identical or confusingly similar.

b) The Respondent is not generally known by the disputed domain name and have not acquired any trademark or service mark rights in the name or mark, nor is there any authorization for the Respondent by the Complainant to use or register the disputed domain name.

The Panel therefore finds that the Respondent does not have rights or legitimate interest with respect to the disputed domain name.

c) It is clear that the Complainant's trademarks and website(s) were used by the Complainant long time before the disputed domain name was registered. There is no present use of the disputed domain name but there are active MX records connected to the disputed domain name. It is concluded that it is inconceivable that the Respondent will be able to make any good faith use of the disputed domain name as part of an e-mail address.

The Panel therefore finds that the disputed domain name has been registered and is being used in bad faith.

For the reasons stated above, it is the decision of this Panel that the Complainant has satisfied all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. JCDECAUXE.COM: Transferred

PANELLISTS

Name	Lars Karnoe
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DATE OF PANEL DECISION 2022-03-31

Publish the Decision
