

Decision for dispute CAC-UDRP-104410

Case number CAC-UDRP-104410

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Domain names igpdecaux.media

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization JCDECAUX SA

Complainant representative

Organization NAMESHIELD S.A.S.

Respondent

Name Paolo Valdem

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 many registered marks domestically, regionally and internationally. For example:

- International trademark registration JCDECAUX® n° 803987 registered on 27 November 2001; and
- International trademark registration DECAUX® n° 991341 registered on 4 November 2008.

It also has a large domain names portfolio, including the same distinctive wording JCDECAUX, including <jcdecaux.com> registered on 23 June 1997 and <igpdecaux.net> registered on 12 December 2019.

In common law jurisdictions, it has rights arising from use.

It has been found to be a well-known mark by other panels, see WIPO Case No. DCC2017-0003, JCDecaux SA v. Wang Xuesong, Wangxuesong.

FACTUAL BACKGROUND

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

Since 1964, JCDECAUX SA, the Complainant, has been the world leading outdoor advertising provider. For over 50 years it has been offering its 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, it now has more than 964,760 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. It employs a total of 10,230 people in those 80 different countries and 3,670 cities and generated revenues of €2,312m in 2020. IGPDECAUX is the Complainant's subsidiary and the number one outdoor advertising company in Italy with 77.420 advertising panels in 130 cities, 5 airports (Bergame, Genoa, Milan Linate and Malpensa, Turin), 5 metros (Brescia, Milan, Naples, Rome, Turin) and 80 transport concessions (bus and tram).

The Respondent is an individual resident in Milan, Italy who registered the disputed domain name on 4 March 2022.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant states that the disputed domain name <igpdecaux.media> is confusingly similar to its trademark. The term "IGPDECAUX" was born in late 2001 from the merger between IGP (a company owned by du Chène de Vère family leader in transit advertising) and JCDecaux Comunicazione Esterna Italia, branch of the French group JCDecaux and RCS MediaGroup. It is well-established that "a domain name that wholly incorporates a Complainant's registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP". See for instance WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasily Terkin. Furthermore, Complainant contends that the addition of the new gTLD ".MEDIA" does not change the overall impression of the designation as being connected to Complainant's trademark. It does not prevent the likelihood of confusion between the disputed domain name and Complainant, its trademark and its domain names associated. See WIPO Case No. D2006-0451, F. Hoffmann-La Roche AG v. Macalve e-dominios S.A. ("It is also well established that the specific top level of a domain name such as ".com", ".org" or ".net" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar."). Thus, the disputed domain name is confusingly similar to the Complainant's trademark.

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. See 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 it 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, or apply for registration of the disputed domain name by the Complainant. Furthermore, the disputed domain name redirects to the Registrar parking 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.

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. The Complainant asserts that its trademark 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 trademark is well-known. 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 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, and therefore could not ignore the Complainant. Besides, the disputed domain name is not used. 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. 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. See for instance: WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows and WIPO Case No. D2000-0400, CBS Broadcasting, Inc. v. Dennis Toeppen. On these grounds, the Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith.

RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

The Respondent contacted CAC during this administrative proceeding with new contact email address (with claims that the current registration email is no longer active). No substantive response to the complaint was filed. Respondent in email sent on April 1, 2022 stated that “I am willing to sell the domain at a good price.”

Although the CAC provided cooperation to the Respondent to log in into the case file and file its response, the Respondent did not do so.

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

This is a simple case of classic typosquatting. There is no doubt as to the Complainant’s Rights as it is a well-known brand and its marks are marks with a reputation and include registered international marks. Other panels have found the same. See WIPO Case No. DCC2017-0003, JCDecaux SA v. Wang Xuesong, Wangxuesong.

The mark is present in full in the disputed domain name. The new characters at the front are “IPG” but these also reference the Complainant as its subsidiary is known by that abbreviation, so it reinforces that the reference is to the Complainant. Previous UDRP Panels have stated in this regard that “minor alterations cannot prevent a finding of confusing similarity between the trademark and the domain name” (see LinkedIn Corporation v. Daphne Reynolds, WIPO Case No. D2015-1679). The disputed domain name includes, and so is conceptually, aurally and visually similar to the distinctive name and registered marks of the Complainant. Previous Panels have also stated: “..Respondent has engaged in typosquatting ..a practice by which a registrant deliberately introduces slight deviations into well-known marks for commercial gain. See, e.g.,

Marriott International, Inc. v. Seocho, Forum Claim No. 149187 (finding <marriottt.com> confusingly similar to <marriott.com>). ..Because Respondent has committed typosquatting, the Domain Name is, by definition, confusingly similar to Complainant's RANDSTAD Mark" (see Edmunds.com, Inc v. Triple E Holdings Limited, WIPO Case No. D2006-1095). Furthermore, the generic Top-Level Domain ".media" in the second-level portion is a standard registration requirement and should be disregarded when assessing whether a disputed domain name is confusingly similar to the trademark in which the Complainant has rights (see Arcelormittal S.A v. James, supra and Credit Mutuel Arkea v. Domain Administration, CAC Case No. 102345). The generic suffix adds nothing to the analysis and that has long been the rule.

The Complainants' burden under the second limb of the Policy is to make a prima facie case for the Respondent to rebut. See Croatia Airlines d.d. v. Modern Empire Internet Ltd. WIPO Case No. D2003-0455. 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. See 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>. Although there was a privacy service in WHOIS, once the Registrar verified, it was revealed that the Respondent is Paolo Valdem of via Mazzolari, 33, 20142, Milan, Italy. So the Respondent is not known by the disputed domain name.

There is also no "evidence that the Respondent engages in, or has engaged in any activity or work, i.e., legitimate or fair use of the disputed domain name, that demonstrates a legitimate interest in the disputed domain name" (see Bollore v. Tywonia W Hill, WIPO Case No. DCO2017-0012). There is no evidence that the Respondent has made a bona fide offering or use or that it holds any financial services licence or is regulated by any recognised regulator. There is no active use and the disputed domain name is parked. While passive holding is fact sensitive, here there are no relevant facts on the face of it and the Respondent has not come forward to explain her reasons for registration and holding. In such a case, we are entitled to draw such inferences as are appropriate and they are that registration was not for a legitimate purpose or interest. The Respondent has therefore been granted an opportunity to come forward and answer or present compelling arguments that it has rights or legitimate interests in the disputed domain name but has failed to do so.

As to bad faith, it is most likely that the disputed domain name was registered for use in phishing perhaps by email. Such a practice consists of attracting potential or actual customers to a web page which imitates the real page to have those customers disclose confidential information like a credit card or bank account number, for the purpose of unlawfully charging such bank accounts or withdrawing money out of them. It is certainly typosquatting and previously panels have stated: "There can be no doubt that the Respondent registered the disputed domain name and is using it to attract, for commercial gain, Internet users to its website. The evidence also establishes the Respondent must have been aware of the Complainant's rights at the time of registration; indeed, those rights are the reason for having chosen the disputed domain name for typosquatting purposes. Such conduct qualifies as 'bad faith' within the meaning of paragraph 4(b)(iv) of the Policy" (see Accenture Global services Limited v. Vistaprint Technologies Ltd, WIPO Case No. D2015-1922). WIPO Overview 3.0 para. 3.1.4 states that "Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith." Previously panels also stated the following: "The Panel established that the registration and passive holding of a domain name which has no other legitimate use and clearly refers to the Complainant's trademark may constitute registration and use in bad faith" (see Telstra Corporation Limited v. Nuclear Marshmellows, WIPO Case No. D2000-0003).

The Panel finds that the three limbs of the policy are made out by the Complainant, which has discharged its burden and proved bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. IGPDECAUX.MEDIA: Transferred

PANELLISTS

Name **Victoria McEvedy**

DATE OF PANEL DECISION **2022-04-27**

Publish the Decision
