

Decision for dispute CAC-UDRP-104483

Case number	CAC-UDRP-104483
Time of filing	2022-04-08 08:34:57
Domain names	igpdecauxmedia.com

Case administrator

Organization	Denisa Bilík (CAC) (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

Name	Paolo Valdem
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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 owner of several trademarks. In particular, JCDECAUX SA owns:

- a) the International Registration No. 803987 "JCDecaux" registered on November 27, 2001 (and duly renewed) for classes 6, 9, 11, 19, 20, 35, 37, 38, 39, 41 and 42; and
- b) the International Registration No. 991341 "DECAUX" registered on April 11, 2008 (and duly renewed) for classes 6, 9, 11, 12, 20, 35, 37, 38, 39, 41 and 42.

The above trademarks are protected in many countries of the world.

FACTUAL BACKGROUND

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

Since 1964, JCDECAUX SA is the worldwide number one in outdoor advertising. 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.

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 3,670 cities and has generated revenues of € 2,312m in 2020.

JCDECAUX SA owns several trademarks "JCDecaux" and "DECAUX". The Complainant also owns a large domain names portfolio, including the same distinctive wordings "JCDECAUX" and "DECAUX", such as <jcdecaux.com> and <igpdecaux.net>.

IGPDECAUX is the name of a Complainant's subsidiary operating in Italy and born in 2001 from the merger between IGP, JCDecaux Comunicazione Esterna Italia, branch of the French group JCDecaux, and RCS Media Group.

The disputed domain name <igpdecauxmedia.com> was registered on April 4, 2022 and resolves to a parking page.

The Complainant states that the disputed domain name <igpdecauxmedia.com> is confusingly similar to its protected trademarks and to the company name IGPDECAUX.

Furthermore, the Complainant states that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant also argues that the Respondent has no relationship with Complainant's business and is not authorized or licensed to use its trademarks.

In the Complainant's view, in consideration of the distinctiveness and reputation of the Complainant trademarks it appears obvious that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademarks and therefore could not ignore the Complainant. The Complainant also 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 disputed 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. On these bases, the Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith.

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

According to paragraph 4(a) of the Policy the Complainant is required to prove each of the following three elements to obtain the transfer of the disputed domain name:

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

1) The Complainant's mark "DECAUX" is totally encompassed in the disputed domain name <igpdecauxmedia.com>. The prefix "IPG" clearly refers to the Complainant since its Italian subsidiary is known as "IGPDECAUX" and due to the fact that Complainant owns the corresponding domain name <igpdecaux.net> registered since December 12, 2019 (see JCDECAUX vs. Paolo Valdem - CAC Case No. 104410; JCDECAUX vs. Handi Hariyono - CAC Case No. 102827 and JCDECAUX vs. Sean Sterling - CAC Case No. 102339). Furthermore, the addition of a generic term such as "media", which describes the very field of business of the proprietor of the earlier trademarks, is absolutely not sufficient to distinguish the disputed domain name from the Complainant trademarks (see, between many others, VIVENDI vs. 1337 Serices LLC - CAC Case No. 103780). Furthermore, as previous panels have stated, a domain name that wholly incorporates a Complainant's registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP (See, between many others, Dr. Ing. h.c. F. Porsche AG vs. Vasiliy Terkine.g - WIPO Case No. D2003-0888). Finally, the generic Top-Level Domain ".com" is obviously a mere standard registration requirement and should be disregarded when assessing whether a disputed domain name is confusingly similar to the trademarks in which the Complainant has rights (see, between many others, Credit Mutuel Arkea vs. Domain Administration - CAC Case No. 102345). The Complainant therefore succeeds on the first element of the Policy.

2) The Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain name as it is not commonly known under the disputed domain name and was never authorized to use it by the Complainant. The Respondent, in the absence of any substantial response, has not shown any facts or element to justify prior rights or legitimate interests in the disputed domain name. The Complainant therefore succeeds also on the second element of the Policy.

3) Taking into account (i) the reputation and fame of the Complainant trademarks, (ii) the fact that "DECAUX" trademark appears to be incorporated in its entirety in the disputed domain name and (iii) that said domain name corresponds to a Complainant's subsidiary name (IGPDECAUX) followed by a generic term related to the Complainant business (media), the Panel concludes that the Respondent must have known of the Complainant trademarks when he registered the disputed domain name. The adoption of a well-known trademark into a domain name by someone with no apparent connection with the name suggests opportunistic bad faith (see *The Gap, Inc. v. Deng Youqian*, WIPO Case No. D2009-0113; *SembCorp Industries Limited v. Hu Huan Xin*, WIPO Case No. D2001-1092; *Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. D2000-0163). Moreover, the Respondent's use of the disputed domain name merely to indicate that the disputed domain name "is available for sale" (passive holding) is sufficient to demonstrate bad faith use. This, in particular, due to the reputation of the Complainant trademarks and the fact that it is not possible to conceive of any plausible good faith use of such domain names by anyone other than the Complainant (see *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003). The Respondent did not respond and in the absence of any evidence by the Respondent or a satisfactory and credible explanation of how the registration and use of the disputed domain name, which incorporates the well-known "DECAUX" trademark, has not been in bad faith, the Panel finds that paragraph 4(a)(iii) of the Policy has also been satisfied. Furthermore, in *JCDECAUX vs. Paolo Valdem* - CAC Case No. 104410, the Panel finds registration in bad faith in a case where the same Respondent of the present procedure (Paolo Valdem) had registered the domain name <igpdecaux.media> in a case almost identical to the one at hand. Therefore, the Respondent's bad faith is also shown by a pattern of conduct consisting in registering domain names that incorporate well-known trademarks of others (See e.g. *Valeant Pharmaceuticals International and Valeant Canada Limited vs Johnny Carpela*, WIPO Case No. D2005-0786 and *Alloy Rods Global, Inc. vs Nancy Williams*, WIPO Case No. D2000-1392). The Complainant therefore succeeds also on the third element of the Policy.

Accepted

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

1. IGPDECAUXMEDIA.COM: Transferred
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PANELLISTS

Name	Avv. Guido Maffei
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DATE OF PANEL DECISION 2022-05-06

Publish the Decision
