

Decision for dispute CAC-UDRP-104244

Case number	CAC-UDRP-104244
Time of filing	2021-12-21 09:35:32
Domain names	jcdecaux-holding.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

Organization	thierry boudron
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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 trademark registrations for the term "JCDECAUX", including international trademark registration n° 803987 granted in 2001, as well as of several domain names comprising of such wording, like <jcdecaux.com>, registered in 1997.

FACTUAL BACKGROUND

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

The Complainant is a well-known company which is worldwide leader in outdoor advertising: it offers its services in over 80 countries, employees more than 10.000 people and generates billions of revenues (namely €2,312m in 2020).

The Respondent has registered <jcdecaux-holding.com> on December 16, 2021 and, as of this day, the latter is being used in connection with a parking page with no particular contents.

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

1. The Complainant has, to the satisfaction of the Panel, shown that the disputed domain name is identical or confusingly similar to the Complainant's trademarks (within the meaning of paragraph 4(a)(i) of the Policy). In particular, the Panel finds that the disputed domain name is identical to the Complainant's trademark "JCDECAUX".

As a matter of fact, the disputed domain name exactly reproduces such trademark, with the addition of the word "holding", which is definitely descriptive. It shall be reminded how several previous UDRP panels have held that the addition of a generic term associated to a trademark does not create a new or different right to the mark, nor diminish confusing similarity.

In particular, "... confusing similarity is generally established when the domain name incorporates the complainant's trademark in its entirety, and the addition of descriptive prefixes and suffixes does not avoid confusing similarity. [...]" (see Fendi S.r.l. v. Federico Porcedda, Case No. D2018-1265).

2. 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 Panel finds that the Complainant successfully submitted prima facie evidence that the Respondent has made no use of, or demonstrable preparations to use, neither of the disputed domain name in connection with a bona fide offering of goods or services, nor is making a legitimate non-commercial or fair use of the disputed domain name, nor is commonly known under the disputed domain name. This prima facie evidence was not challenged by the Respondent, which did not file any Response to the complaint of JCDECAUX SA.

As a matter of fact, there are no arguments why the Respondent could have own rights or legitimate interests in the disputed domain name. "JCDECAUX" definitely is a distinctive (and even renown) sign used by the Complainant as business name and trademark in order to denote its services. Therefore, the Panel accepts the contentions of the Complainant that the Respondent has no such rights or legitimate interests in the disputed domain name.

3. The Complainant has, to the satisfaction of the Panel, shown the disputed domain name to have been registered and is

being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

As stated above, the Panel finds that the Complainant successfully submitted prima facie evidence that the Respondent has made no use of, or demonstrable preparations to use, neither of the disputed domain name in connection with a bona fide offering of goods or services, nor is making a legitimate non-commercial or fair use of the disputed domain name, nor is commonly known under the disputed domain name. This prima facie evidence was not challenged by the Respondent.

In the absence of a Response and given the wide reputation of the Complainant and its trademarks, the Panel infers that the Respondent surely had the Complainant's trademark "JCDECAUX" in mind when registering the disputed domain name.

As prior panels have held, the incorporation of a famous mark into a domain name, coupled with an inactive website/parking page, may be evidence of bad faith registration and use (WIPO - D2000-0003 - Telstra Corporation Limited v. Nuclear Marshmallows and WIPO - D2000-0400 - CBS Broadcasting, Inc. v. Dennis Toeppen).

Consequently, the Panel believes that the same was registered and is being used in bad faith by Thierry Boudron, in order to prevent the Complainant from reflecting the mark in the disputed domain name.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. JCDECAUX-HOLDING.COM: Transferred

PANELLISTS

Name	Tommaso La Scala
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DATE OF PANEL DECISION 2022-01-21

Publish the Decision
