

Decision for dispute CAC-UDRP-104272

Case number CAC-UDRP-104272

Time of filing 2022-01-17 09:25:22

Domain names jcdecaux.vip

Case administrator

Organization Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization JCDECAUX SA

Complainant representative

Organization NAMESHIELD S.A.S.

Respondent

Name saasxs dsa

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 "JCDECAUX" such as the international trademark registration JCDECAUX n° 803987 registered since November 27, 2001.

The Complainant 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 <jcdecaux.vip> was registered on January 13, 2022 and is not used.

FACTUAL BACKGROUND

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

Since 1964, the Complainant 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.

The Complainant now has more than 1,061,200 advertising panels in Airports, Rail and Metro Stations, Shopping Malls, on Billboards and Street Furniture. The Complainant's Group is listed on the Premier Marché of the Euronext Paris stock exchange and is part of Euronext 100 index. Employing a total of 13,030 people, the Group is present in more than 80 different countries and 4,030 cities and has generated revenues of €3,619m in 2018.

The Complainant states that the disputed domain name is identical to its trademarks. Besides, it is 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. Several UDRP panels confirmed the Complainant's rights over the term "JCDECAUX" (CAC Case No. 120169 <jicdecaux.com>, CAC Case No. 101990 <jcdeceux.com>, CAC Case No. 101961, <jcdiecaux.com>). Thus, the disputed domain name is confusingly similar to the Complainant's trademark.

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 (Forum Case No. FA 1781783 <bobsfromsketchers.com>). The Complainant contends that the Respondent is not affiliated with nor authorized by the Complainant 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 is not used. 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 disputed domain name is identical to the Complainant's trademark. 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). 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 (WIPO Cases No. D2000-0003 or D2000-0400). 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 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

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.

I. Identical or Confusingly Similar

The Complainant has established the fact that it has valid rights for the international trademark n° 803987 JCDECAUX registered on November 27, 2001 and that it owns domain name including the same distinctive wording JCDECAUX. The disputed domain name has been registered on January 13, 2022, i.e. more than 20 years after the JCDECAUX trademark registration, and wholly incorporates the Complainant's trademark JCDECAUX and is therefore identical to it.

The generic top level domain "VIP" should be disregarded in the assessment under the Policy when comparing disputed domain names and trademarks and does not change the overall impression of the designation as being connected to Complainant's trademark.

The Panel therefore considers the disputed domain name to be identical to the Complainant's trademark JCDECAUX which the Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

II. Rights or Legitimate Interests

The Complainant has established a prima facie case (not challenged by the Respondent who did not file any response to the complaint) that the Respondent has no rights or legitimate interests in the disputed domain name, since the Respondent is not related in any way with the Complainant. The disputed domain name is not used and, therefore, does not constitute a bona fide offering of goods and services or a legitimate noncommercial fair use. The Respondent has no rights or legitimate interests in the disputed domain name, since there is no indication that the Respondent is commonly known by the term "JCDECAUX" or its variations or that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services.

The Panel therefore considers that the Respondent has no rights or legitimate interests in respect of the disputed domain name within the meaning of paragraph 4(a)(ii) of the Policy.

III. Registered and Used in Bad Faith

Given the distinctiveness of the Complainant's trademark and reputation (as confirmed in other UDRP proceeding in the past – WIPO Case No. DCC2017-0003, JCDecaux SA v. Wang Xuesong, Wangxuesong) it is evident that the Respondent had the Complainant and its trademark in mind when registering the disputed domain name. Furthermore, the website in connection with the disputed domain name is not used since its registration. The incorporation of a famous trademark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use.

The Panel therefore considers that 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.

The Panel finally considers that the Complainant has shown that the disputed domain name is identical to a trademark in which the Complainant has rights, the Respondent has no rights or legitimate interests in respect of the disputed domain name and the disputed domain name has been registered and is being used in bad faith. The Complainant has thus established 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. JCDECAUX.VIP: Transferred

PANELLISTS

Name	JUDr. Petr Hostaš
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DATE OF PANEL DECISION	2021-12-12
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Publish the Decision