

Decision for dispute CAC-UDRP-105035

Case number CAC-UDRP-105035

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Domain names jcdecaux.com

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization JCDECAUX SA

Complainant representative

Organization NAMESHIELD S.A.S.

Respondent

Name Nadeem Kazmi

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 the registered trademark JCDECAUX as a word mark in numerous of countries all over the world, including the International word mark JCDECAUX, filed on November 27, 2001 under number 803987 for products and services of the classes 6, 9, 11, 19, 20, 35, 37, 39, 41 and 42.

FACTUAL BACKGROUND

According to the Complainant, it is a company active worldwide in outdoor advertising. For more than 50 years, the Complainant 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 billboards.

The Complainant is the owner of a large domain name portfolio, including the same distinctive wording JCDECAUX, such as <jcdecaux.com>, registered since June 23, 1997.

The disputed domain name <jcdecaux.com> was registered on November 24, 2022. The Complainant demonstrates that the website that is operated under the domain name resolves to an inactive page.

PARTIES CONTENTIONS

The Complainant submits that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.

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 disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights

According to the Complainant, the disputed domain name incorporates in full the Complainant's trademark JCDECAUX. The addition of the letter "C" does not distinguish the disputed domain name from the Complainant's JCDECAUX trademark. Furthermore, the additional "C" can be considered a common misspelling, a fact of which typosquatters normally take profit from by giving Internet users the impression that the disputed domain name belongs to the Complainant.

The Panel agrees with the Complainant that misspellings such as the addition of the letter "C" do not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark. As a typosquatting registration, it is designed to confuse (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.").

The generic Top-Level Domain extension of the disputed domain name, in this case ".com", is typically disregarded under the confusing similarity test, as it is a standard requirement for registration.

Therefore, the Complainant concludes and the Panel agrees that the disputed domain name is confusingly similar to the Complainant's trademark.

2. The Respondent has no rights or legitimate interests in respect of the disputed domain name

The Complainant states that the Respondent is not affiliated with nor authorized by the Complainant to make any use of the Complainant's trademark, or apply for registration of the disputed domain name. The Complainant states that it does not carry out any activity for, nor has any business with the Respondent.

In addition, the Complainant demonstrates that the Respondent is not identified in the WHOIS database as "JC DECCAUX", but as

“Nadeem Kazmi”. According to past panel decisions, a Respondent is not commonly known by the 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>: “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 further states that the disputed domain name resolves to an inactive page. The Complainant contends that the Respondent did not make any use of the disputed domain name nor that there is any plan to use the disputed domain name. Past panels concluded that a respondent’s failure to provide a product or service or develop a site in relation to the domain name demonstrates that the respondent has not established any rights or legitimate interests in the domain name (see WIPO Case No. D2000-0039, Ziegenfelder Co. v. VMH Enterprises, Inc.).

The Panel finds that the Complainant has shown that the Respondent has not made legitimate use of the disputed domain name for a bona fide offering of goods or services. In lack of any Response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

3. The disputed domain name is registered and is being used in bad faith

The Complainant refers to past panels that have held that the trademark JCDECAUX 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 JCDECAUX trademark when it registered the Domain Name.”).

Consequently, according to the Complainant, given the distinctiveness of the Complainant’s trademarks and its reputation, it is reasonable to infer that the Respondent has registered and used the domain name with full knowledge of the Complainant’s trademark.

Complainant contends that the Respondent has not demonstrated any activity in respect of the disputed domain name. Prior panels have held that 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).

Moreover, the Complainant also demonstrates that MX servers are configured to the domain name and suggests therefore that the disputed domain name may be actively used for email purposes. Past Panels have held that, if several active MX records connected to the disputed domain name but that there is no other use of the disputed domain name, it is inconceivable that the Respondent will be able to make any good faith use of the disputed domain name (cf. CAC Case No. 102827, JCDECAUX SA v. Handi Hariyono).

Furthermore, the Complainant states that the misspelling (the addition of the letter “C”) was intentionally designed to be confusingly similar with the Complainant’s trademark. The Complainant refers to past panels that have seen such actions as evidence of bad faith (see 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 trademark).

In lack of any Response from the Respondent, the Panel concludes that the Respondent has registered and is using the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **jcdecaux.com**: Transferred

PANELLISTS

Name	Tom Heremans
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DATE OF PANEL DECISION 2023-01-03

Publish the Decision
