

Decision for dispute CAC-UDRP-105071

Case number	CAC-UDRP-105071
Time of filing	2022-12-20 09:42:03
Domain names	jcdecaux-marketing.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	Jianfeng Wu Juming
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OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings, either pending or decided, which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of international trademark registration JCDECAUX n° 803987, of 27 November 2001, covering goods and services in classes 6, 9, 11, 19, 20, 35, 37, 38, 39, 41 and 41, and designating various countries.

The Complainant is also the owner of the domain name <jcdecaux.com>, registered on 23 June 1997.

FACTUAL BACKGROUND

The Complainant is a French company operating worldwide in the field of outdoor advertising, which comprises street furniture, transport advertising, and billboard. The Complainant has more than 957,700 advertising panels in airports, rail and metro stations, shopping malls, on billboards and street furniture. The Complainant is listed on the Paris Stock Exchange and is part of the Euronext 100 index. With more than 10,700 employees, the Complainant's group is present in over 80 countries and had a turnover of 2,745 million Euros in 2021.

The disputed domain name was registered on 13 December 2022 and resolves to an inactive webpage.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

According to the Complainant, the disputed domain name is confusingly similar to its JCDECAUX mark, as the addition of the term "marketing", cannot prevent a finding of confusing similarity. It is in fact a well-established principle that a domain name that fully incorporates a Complainant's trademark may be sufficient to establish confusing similarity for the purpose of the UDRP if such trademark is recognizable within the disputed domain name.

The Complainant maintains that the Respondent does not have rights or legitimate interests in the disputed domain name. The Complainant does not appear to be commonly known by the disputed domain name. The Respondent is not affiliated with the Complainant. The Complainant has no business or other relation with the Respondent, and never licensed its JCDECAUX trademark to the Respondent, nor authorised the Respondent to make use of its trademark, or register a domain name containing this mark.

Furthermore, the disputed domain name does not resolve to an active website and, to the best of the Complainant's knowledge, the Respondent did not make any use of the disputed domain name since its registration, and does not have demonstrable plans to use the disputed domain name in the future.

Lastly, the Complainant contends that the disputed domain name was registered and has been used in bad faith. The Complainant asserts that its trademark JCDECAUX is well known, and has been known for decades and protected in several countries at the time of the registration of the disputed domain name. Besides, the addition of the term "marketing" to the Complainant's mark cannot be coincidental, as it refers to the Complainant's activities. A search made on Google(r) with the keywords "jcdecaux marketing" only refers to the Complainant and to its activities.

Hence, it is clear that the Complainant registered the disputed domain name with full knowledge of the Complainant's trademark.

In relation to the use of the disputed domain name in bad faith, the Complainant underlines that the disputed domain name does not lead to an active webpage and that it is not possible to conceive any plausible actual or contemplated active use of the disputed domain name that would not be illegitimate such as being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under the trademark law. As already found by previous Panels, the Complainant maintains 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.

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. Confusing similarity

The Panel agrees with the Complainant that the disputed domain name is confusingly similar to the Complainant's trademark JCDECAUX as it includes it entirely followed by the term "marketing", which can be associated to the Complainant's activity.

Previous UDRP Panels have generally found that where the relevant trademark is recognizable within a disputed domain name, the addition of other terms would not prevent a finding of confusing similarity under the first element. This general principle also applies in this case, where the Complainant's trademark is fully distinctive and recognizable within the disputed domain name, despite the addition of the word "marketing".

In light of the above, the Panel is satisfied that the first condition under the Policy is met.

2. No rights or legitimate Interests

As also confirmed in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), a 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 burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

The Complainant states that it does not undertake any kind of relationship with the Respondent and that it never licensed its JCDECAUX trademark to the Respondent, nor authorised the Respondent to include its trademark in a domain name. Furthermore, the Respondent does not appear to have been commonly known by the disputed domain name. The disputed domain name does not resolve to an active website but to an inactive website. The Panel therefore finds that the Respondent is making neither a bona fide offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain name.

In light of the above, the Panel concludes that the Complainant has successfully established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. As the Respondent failed to file a Response, the Panel is satisfied that also the second condition under the Policy is met.

3. Bad Faith

In relation to bad faith, the Panel agrees with the Complainant that the Respondent was well aware of the Complainant's mark and activity at the time of the registration of the disputed domain name. Indeed, the Complainant's trademark is highly distinctive and enjoys reputation, as also confirmed in several other UDRP decisions. The Respondent added the term "marketing" to the Complainant's trademark to make direct reference to the Complainant's activity. This clearly shows that the Respondent had full knowledge of the Complainant and of its trademark and activity when it registered the disputed domain name.

With respect to use in bad faith, the disputed domain name was not resolving to an active website at the time of filing. However, the consensus view amongst WIPO panellists is that the apparent lack of so-called active use (e.g., to resolve to a website) of the domain name without any active attempt to sell or to contact the trade mark holder (passive holding), does not as such prevent a finding of bad faith. The panel must examine all the circumstances of the case to determine whether the respondent is acting in bad faith. Examples of what may be cumulative circumstances found to be indicative of bad faith include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.

In the instant case, the disputed domain name is highly distinctive and well known in its field. Furthermore, the Respondent failed to submit a response and therefore to prove an actual or contemplated good-faith use of the disputed domain name. Considering that the JCDECAUX trademark univocally belongs to the Complainant, and that the term "marketing" can be associated makes direct reference to the Complainant's activity, any possible use that the Respondent could make of the disputed domain name would not be in good faith.

In view of the above and given any absence of a reply from the Respondent, the Panel concludes that the Complainant has duly proved that the Respondent registered and is being using the disputed domain name in bad faith. Hence, also the third and last requirement under the Policy is met.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. jcdecaux-marketing.com: Transferred

PANELLISTS

Name	Angelica Lodigiani
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DATE OF PANEL DECISION 2023-01-29
