

## Decision for dispute CAC-UDRP-104280

Case number	<b>CAC-UDRP-104280</b>
Time of filing	<b>2022-01-24 09:03:06</b>
Domain names	<b>jcdecauxtoday.xyz, jcdecauxvip.xyz</b>

### Case administrator

Name	<b>Iveta Špiclová (Case admin)</b>
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### Complainant

Organization	<b>JCDECAUX SA</b>
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### Complainant representative

Organization	<b>NAMESHIELD S.A.S.</b>
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### Respondent

Organization	<b>yi feng</b>
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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 names.

#### IDENTIFICATION OF RIGHTS

The Complainant is the owner of several trademarks consisting of the term "JCDECAUX" in particular the international trademark JCDECAUX® n° 803987 registered since 27 November 2001 in classes 06, 09, 11, 19, 20, 35, 37, 38, 39, 41 and 42. Further, the Complainant owns domain names consisting of the term "JCDECAUX", such as <jcdecaux.com>, created on 23 June 1997.

#### FACTUAL BACKGROUND

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

The Complainant was established in 1964 and is the worldwide number one in outdoor advertising. The Complainant's group employs around 10,230 people with presence in more than 80 countries and 3,670 cities. In 2020, the Complainant's group generated revenues of €2,312.

The Complainant owns several trademarks and domain names, characterised by the presence of the distinctive term "JCDECAUX". The Complainant contends that several previous panels have recognized its rights in the trademark

"JCDECAUX".

On 18 January 2022, the Respondent yi feng, an individual located in China, registered the disputed domain names <JCDECAUXTODAY.XYZ> and <JCDECAUXVIP.XYZ>.

The disputed domain names resolve to a page displaying a login box asking for a password/ mobile phone number, and displaying Complainant's trademark and logo.

According to the information on the case file, the Registrar confirmed that the Respondent is the current registrant of the disputed domain names and that the language of the registration agreement is English.

The facts asserted by the Complainant are not contested by the Respondent because no Response was filed.

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#### PARTIES CONTENTIONS

**NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.**

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#### RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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).

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#### 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 names (within the meaning of paragraph 4(a)(ii) of the Policy).

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#### BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names have been registered and are being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

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#### 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.

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#### PRINCIPAL REASONS FOR THE DECISION

**THREE ELEMENTS COMPLAINANT MUST ESTABLISH UNDER THE POLICY**

According to Paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to obtain an order that a disputed domain names should be transferred or cancelled:

- (i) the disputed domain names are 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 disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

The Panel has examined the evidence available to it and has come to the following conclusions concerning the satisfaction of the three elements of paragraph 4(a) of the Policy in these proceedings:

**(A) THE COMPLAINANT'S RIGHTS AND CONFUSING SIMILARITY OF THE DISPUTED DOMAIN NAMES TO THE**

## COMPLAINANT'S RIGHTS

Sufficient evidence has been submitted by the Complainant of its trademark rights in the term JCDECAUX for outdoor advertising and related products and services. Further, the Complainant is the owner of domain names that incorporate its trademark including <JCDECAUX.COM>. All of the above were created and registered well prior to 18 January 2022, the creation date of the disputed domain names. It is well established that a nationally or regionally registered trademark confers on its owner sufficient rights to satisfy the requirement of having trademark rights for the purposes of standing to file a UDRP case. As such, the Panel finds that the Complainant possesses rights in its JCDECAUX trademark.

UDRP panels have held that where the asserted trademark is recognizable within a disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under paragraph 4(a)(i) of the Policy. See, e.g., LEGO Juris A/S v. DBA David Inc/ DomainsByProxy.com, Case No. D2011-1290 (WIPO, September 20, 2011) (“the mere addition of the words ‚Ninjago‘ and ‚Kai‘ is not sufficient to exclude the likelihood of confusion between the disputed domain name and the Complainant’s trademark.”).

In the present case, the disputed domain names consist of the JCDECAUX trademark followed by the terms “TODAY” and “VIP”. In assessing confusing similarity, the Panel finds the disputed domain names are confusingly similar to the Complainant’s trademark, as they incorporate the entirety of the JCDECAUX trademark, and differ from such mark merely by respectively adding the descriptive terms “TODAY” and “VIP”.

UDRP panels agree that the TLD may usually be ignored for the purpose of determination of identity or confusing similarity between a domain name and the Complainant’s trademark as it is technical requirement of registration (see paragraph 1.11.1 WIPO Overview 3.0).

Therefore, the Panel concludes that the Complainant has satisfied the requirement under paragraph 4(a)(i) of the Policy and the disputed domain names are confusingly similar to Complainant’s mark.

## (B) RESPONDENT’S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DISPUTED DOMAIN NAMES

The second element of the Policy requires that the Complainant establish that the Respondent has no rights or legitimate interests in the disputed domain names. The generally adopted approach by UDRP panels, when considering the second element, is that if a complainant makes out a prima facie case, the burden of proof shifts to the respondent to rebut it; see, for example, CAC Case No. 102333, Amedei S.r.l. v sun xin. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy (see e.g. WIPO case no. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.).

However, the burden of proof still remains with the Complainant to make out its prima facie case on a balance of probabilities; see, for example, CAC Case No. 102263, Intesa Sanpaolo S.p.A. v Ida Ekkert. Moreover, the wording of paragraph 4(a)(ii) of the Policy requires a complainant to establish that the respondent has no rights or legitimate interests in the domain name in issue. Simply establishing that the complainant also has rights in the domain name in issue is insufficient.

In the present case, the Complainant asserts that the Respondent is not commonly known by the disputed domain names, is not in any way related to the Complainant, nor has the Respondent been granted an authorization or license to use the disputed domain names by the Complainant. This has not been contested by the Respondent. Instead, the Respondent has not responded in any form and thus has failed to provide any information and evidence whatsoever that could have shown that it has relevant rights or legitimate interests in respect of the disputed domain names (within the meaning of paragraph 4(a) (ii) of the Policy).

Therefore, the Panel concludes that neither the Respondent nor the evidence establishes that the Respondent has any right or legitimate interest to the disputed domain names. The Complainant has therefore also satisfied the requirement under paragraph 4(a)(ii) of the Policy.

## (C) BAD FAITH REGISTRATION AND USE OF THE DISPUTED DOMAIN NAMES

The third element requires Complainant to show that the disputed domain names have been registered and used in bad faith under paragraph 4(a)(iii) of the Policy. *Hallmark Licensing, LLC v. EWebMall, Inc.*, Case No. D2015-2202 (WIPO, February 12, 2016) (“The standard of proof under the Policy is often expressed as the “balance of the probabilities” or “preponderance of the evidence” standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true.”).

Further, Paragraph 4(b) of the Policy sets out four circumstances, in particular but without limitation, any one of which may be evidence of the registration and use of a domain name in bad faith. The four specified circumstances are:

- (i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent’s documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent’s website or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the respondent’s website or location or of a product or service on the site or location.

The Panel finds that the Complainant has shown that the Respondent registered and used the disputed domain names in bad faith both in general (ie under paragraph 4(a)(iii) of the Policy) and in particular because the Respondent’s conduct puts the case within paragraph 4(b) of the Policy for the following reasons:

1. The Complainant’s trademark is distinctive and enjoys considerable reputation (as confirmed by several other UDRP decisions including WIPO Case No. DCC2017-0003, *JCDecauz SA v. Wang Xuesong, Wangxuesong*). Accordingly, it is therefore reasonable to infer that the Respondent either knew, or should have known, that the disputed domain names would be identical, or confusingly similar to, the Complainant’s trademarks and that they registered the disputed domain names with knowledge of the Complainant’s trademarks.
2. It follows that the Respondent had actual notice of the Complainant’s trademark. It has regularly been held that to copy a trademark in a domain name, or use it with a slight variation, knowing that the disputed domain name is based on the trademark of another party, constitutes bad faith registration and use of the disputed domain name. The Panel makes that finding in the present case.
3. The Respondent is not commonly known by the disputed domain names and Complainant asserts that the Respondent has never been authorized or licensed by the Complainant to use the Complainant’s trademark(s) and/or register the disputed domain names, nor is there any business or other association between the Complainant and the Respondent.
4. The disputed domain names resolved to identical pages showing a login box asking for the submission of a password/ mobile number and displaying the Complainant’s trademark and logo. The pages submitted as evidence do not appear to contain any information about the Respondent and thus a visitor to the sites may incorrectly assume they belong to Complainant. Such login pages may be used to improperly harvest personal information from site visitors, and the Panel finds no legitimate purpose may

be inferred from such unauthorized use. Further, the content of the web pages - including the unauthorized use of the Complainant's trademark – supports a finding that the disputed domain names were registered for a bad faith purpose.

5. By using the disputed domain names in the manner noted above, the Respondent is clearly intending to attract internet users, which would generate confusion as to the legitimacy of any site to which the disputed domain names resolve. That brings the case within the provisions of paragraph 4(b) (iv) of the Policy.

In light of the above analysis, the Panel concludes that the Complainant has made out its case that the disputed domain names were registered and are being used in bad faith, and thus has satisfied the requirement under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **JCDECAUXTODAY.XYZ**: Transferred
2. **JCDECAUXVIP.XYZ**: Transferred

## PANELLISTS

Name **Stefania-Despoina Efstathiou, LL.M. mult.**

DATE OF PANEL DECISION 2022-03-03

Publish the Decision