

Decision for dispute CAC-UDRP-105576

Case number CAC-UDRP-105576

Time of filing 2023-06-27 09:31:24

Domain names jcdecauxnaa.com

Case administrator

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

Complainant

Organization JCDECAUX

Complainant representative

Organization NAMESHIELD S.A.S.

Respondent

Organization Buntai LTD

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 reputation of JCDECAUX trademark is well established. Complainant has provided evidence of its trademark registration consisting of the sign held by JCDECAUX in Europe:

- The International trademark JCDECAUX® n° 803987 registered since November 27, 2001, covering goods and services in classes 06, 09, 11, 19, 20, 35, 37, 38, 39, 41, 42, duly renewed.
- As part of its business activities, Complainant has registered several domain names incorporating the trademark JCDECAUX® including <jcdecaux.com> registered since June 23, 1997.

FACTUAL BACKGROUND

Since 1964, JCDECAUX is a leading figure of global outdoor advertising. JCDECAUX now has more than 957,706 advertising panels in Airports, Rail and Metro Stations, Shopping Malls, on Billboards and Street Furniture. The Group is present in more than 80 countries, and a total of 3,518 cities.

The disputed domain name <jcdecauxnaa.com> was registered on June 22, 2023 and resolves to a malware.

PARTIES CONTENTIONS

The Complainant contends 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).

The disputed domain name incorporates Complainant's "JCDECAUX" trademark in their entirety. The addition of the letters "NAA" does not prevent a finding of confusing similarity under policy, paragraph 4 (a)(i).

Moreover, the gTLD ".com" is not be taken into consideration when examining the identity or similarity between Complainant's registered trademark and the disputed domain name, as it is viewed as a standard registration requirement. (See for instance Fendi Srl v. Ren Fu Rong, WIPO Case No. D2021-2115).

For the aforementioned reasons, the Panel finds that the disputed domain name is confusingly similar to Complainant's "JCDECAUX" trademark under 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).

Respondent has no association with Complainant and has not been authorized to use and register any domain name that include the "JCDECAUX" trademark. Respondent cannot claim prior rights or legitimate interest in the disputed domain name as the registered trademark precedes the registration of the disputed domain name.

Finally, there is no evidence that Respondent has become commonly known by the terms "JCDECAUXNAA", in accordance with paragraph 4(c)(ii) of the Policy. As the disputed domain name is confusingly similar to Complainant's well-known registered trademark, Respondent cannot plausibly pretend he was intending to develop a legitimate activity through the disputed domain name.

Having considered the above circumstances, the Panel finds that Respondent has no rights or legitimate interests in respect of the disputed domain name and the requirement of paragraph 4(a)(ii) of the Policy is satisfied.

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).

To establish that the disputed domain name has been registered in bad faith, Complainant must show that Respondent "knew or should have known" about the Complainant and the trademark and nevertheless registered a domain name which he had no rights and legitimate interests (see for instance Research In Motion Limited v. Privacy Locked LLC/Nat Collicot, WIPO Case No. D2009-0320 and The Gap, Inc. v. Deng Youqian, WIPO Case No. D2009-0113).

Given Complainant's Worldwide presence and its trademark registrations, the Panel finds it strongly unlikely that Respondent was not aware of Complainant's rights in said trademark. The Panel considers that the trademark is well known and that with a simple Google search, Respondent could have known about the existence of Complainant.

Previous UDRP panels have also found that "the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith" (See section 3.1.4 of the WIPO Overview 3.0). The disputed domain name incorporates Complainant's trademark and adding the letters "NAA".

The Panel finds it implausible that Respondent was unaware of Complainant when it registered the disputed domain name.

As for the use of the disputed domain name, the Panel observes that it redirects to websites downloading malware onto its visitor's devices. This observation, combined with the previous finding that Respondent has fully incorporated Complainant's trademarks, leads to the conclusion that any plausible actual or contemplated active use of the disputed domain name by Respondent would not

be illegitimate.

In light of these factors, the Panel finds that the disputed domain name has been registered and is being used in bad faith under 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.

The complaint was filed with the Czech Arbitration Court (CAC) on June 23, 2023. On June 1, 2023, the CAC transmitted a request for registrar verification to the Registrar by e-mail. On the same day, the complaint was not admitted to proceed further in the Administrative Proceeding. Then, the complaint was filed with the CAC on June 27, 2023. The CAC sent a communication via e-mail to Complainant, on June 27, 2023, providing information disclosed by the Registrar. Complainant then filed an amendment to the complaint within the appointed deadline.

In accordance with the rules, the CAC formally notified Respondent, and the proceedings started on June 27, 2023. Respondent did not submit any response. Respondent's lack of answer was then notified on July 18, 2023.

The CAC appointed Nathalie Dreyfus as the sole panelist in this matter on July 19, 2023. The Panel found that it was properly constituted and thus submitted the Statement of Acceptance and Declaration of Impartiality and Independence.

PRINCIPAL REASONS FOR THE DECISION

1/ The Panel finds that the disputed domain name is confusingly similar to Complainant's trademark since it incorporates the Complainant's trademark in its entirety, adding only the letters "NAA".

2/ The Panel finds that Complainant successfully submitted evidence that Respondent lacks rights or legitimate interests in the disputed domain name, as he is unassociated with the Complainant, is unauthorized to use the "JCDECAUX " trademark, and is not commonly known by " jcdecauxnaa " .

3/ The Panel finds that Respondent knew Complainant's "JCDECAUX " trademark when he registered the disputed domain name. Finally, the Panel concludes that no use of the disputed domain name could be made in good faith.

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name, <jcdecauxnaa.com> be transferred to Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. jcdecauxnaa.com: Transferred

PANELLISTS

Name	Nathalie Dreyfus
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DATE OF PANEL DECISION 2023-07-28

Publish the Decision
