

Decision for dispute CAC-UDRP-105936

Case number CAC-UDRP-105936

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Domain names jcdecuex.com

Case administrator

Name Olga Dvořáková (Case admin)

Complainant

Organization JCDECAUX SE

Complainant representative

Organization NAMESHIELD S.A.S.

Respondent

Organization jcdecuax.com

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 holder of the International trademark JCDECAUX with registration No.803987, registered on 27 November 2001 for goods and services in International Classes 6, 9, 11, 19, 20, 35, 37, 38, 39, 41 and 42 (the "JCDECAUX trademark").

FACTUAL BACKGROUND

The Complainant was established in 1964. It is the worldwide number one in outdoor advertising and is the only group present in the three principal segments of outdoor advertising market: street furniture, transport advertising and billboard. The Complainant employs a total of 11 200 people and is present in approximately 80 countries and 3573 cities. It has more than 1 042 132 advertising panels in airports, rail and metro stations, shopping malls, on billboards and street furniture. The Complainant is listed on the Premier Marché of the Euronext Paris stock exchange and is part of Euronext 100 index, and has generated revenues of EUR 3317 million in 2021.

The Complainant's official website is located at the domain name <jcdecaux.com>, registered since 23 June 1997.

The disputed domain name was registered on 26 October 2023 and is inactive.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant states that the disputed domain name is confusingly similar to its JCDECAUX trademark. It represents an obvious misspelling of the trademark, which is not sufficient to avoid the likelihood of confusion with the trademark, and is an example of typosquatting.

The Complainant maintains that the Respondent has no right or legitimate interest in respect of the disputed domain name, because it is not commonly known by the disputed domain name and is not affiliated with the Complainant, and the Complainant has not authorized the Respondent to use the Complainant's JCDECAUX trademark. The Complainant adds that the Respondent has not used the disputed domain name and has no demonstrable plans to use it.

The Complainant contends that the disputed domain name was registered and is being used in bad faith. The disputed domain name is confusingly similar to the JCDECAUX trademark and given the distinctiveness of this trademark and its reputation, it is reasonable to infer that the Respondent has registered and used the disputed domain name with knowledge of the trademark. According to the Complainant, since the disputed domain name is a misspelling of the JCDECAUX trademark, it was intentionally designed to be confusingly similar with to it.

The Complainant further 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 it 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.

Finally, the Complainant notes that the disputed domain name has been set up with MX records. According to the Complainant, it is inconceivable that the Respondent may be able to make any good faith use of the disputed domain name as part of an e-mail address.

RESPONDENT:

The Respondent did not reply to the Complainant's contentions and did not submit any arguments or evidence in its defence.

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

Pursuant to the Policy, paragraph 4(a), a complainant must prove each of the following to justify the transfer of a domain name:

(i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;

(ii) the respondent has no rights or legitimate interests in respect of the domain name; and

(iii) the respondent has registered and is using the domain name in bad faith.

In this case, the Provider has employed the required measures to achieve actual notice of the Complaint to the Respondent, and the Respondent was given a fair opportunity to present its case.

By the Rules, paragraph 5(c)(i), it is expected of a respondent to: “[r]espond specifically to the statements and allegations contained in the complaint and include any and all bases for the Respondent (domain name holder) to retain registration and use of the disputed domain name ...”

In this proceeding, the Respondent has not used the opportunity provided to it under the Rules and has not submitted a substantive Response addressing the contentions of the Complainant and the evidence submitted by it.

Identical or confusingly similar

The Complainant has provided evidence and has thus established its rights in the JCDECAUX trademark.

The Panel notes that a common practice has emerged under the Policy to disregard in appropriate circumstances the general Top-Level Domain (“gTLD”) section of domain names for the purposes of the comparison under the Policy, paragraph 4(a)(i). The Panel sees no reason not to follow the same approach here, so it will disregard the “.com” gTLD section of the disputed domain name.

The relevant part of the disputed domain name is therefore the sequence “jcdecuex”. As pointed out by the Complainant, it represents a mistyping of the JCDECAUX trademark, and the only difference is the replacement of the letters “au” by “ue” in the disputed domain name. The JCDECAUX trademark is easily recognized in the disputed domain name, and the different vowel letters do not preclude a finding of confusing similarity between the JCDECAUX trademark and the disputed domain name, since the disputed domain name contains sufficiently recognizable aspects of the trademark. See section 1.9 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”). The disputed domain name also appears as an intentional misspelling of the JCDECAUX trademark, taking into account that the name of the Respondent, “jcdecuax.com (LUK Wingle)” contains what appears as yet another misspelling of the same trademark.

Taking all the above into account, the Panel finds that the disputed domain name is confusingly similar to the JCDECAUX trademark in which the Complainant has rights.

Rights and legitimate interests

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often-impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name, because it is not commonly known by it, is not associated to the Complainant and has not been authorized by the Complainant to use the JCDECAUX trademark. According to the Complainant, the disputed domain name is a typo-squatted version of the JCDECAUX trademark and MX records have been configured for it, so it may be intended to confuse Internet users. Thus, the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name.

The Respondent has not submitted a Response and has not alleged that it has rights and legitimate interests in the disputed domain name; it has not disputed the Complainant’s allegations and evidence in this proceeding.

The disputed domain name is indeed confusingly similar to the Complainant’s JCDECAUX trademark, and in the absence of any plausible explanation by the Respondent why it has chosen and registered the disputed domain name, it can only be regarded as a typo-squatted version of the JCDECAUX trademark intended to confuse Internet users, more so given that the name of the Respondent itself contains a different misspelling of the same trademark. The fact that MX records have been configured for the disputed domain name shows that it is intended for email communications, which gives rise to an additional risk for confusion of the potential addressees of such communications.

The above leads the Panel to the conclusion that it is more likely than not that the Respondent, being aware of the goodwill of the Complainant and of the JCDECAUX trademark, has registered the disputed domain name in an attempt to exploit this trademark’s goodwill by confusing Internet and email users. In the Panel’s view, such activity is not legitimate and does not give rise to rights and legitimate interests in the disputed domain name.

Therefore, the Panel finds that the Respondent does not have rights or legitimate interests in the disputed domain name.

Bad faith

Paragraph 4(b) of the Policy lists four illustrative alternative circumstances that shall be evidence of the registration and use of a domain name in bad faith by a respondent, namely:

“(i) circumstances indicating that you have registered or you have 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 your documented out-of-pocket costs directly related to the domain name; or

(ii) you have 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 you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location."

As discussed above, the disputed domain name is confusingly similar to the JCDECAUX trademark and represents a typo-squatted version of it. There are MX records configured for it. In the absence of any plausible explanation by the Respondent why it has chosen and registered the disputed domain name, the Panel accepts as more likely that the Respondent has registered the disputed domain name with knowledge of the Complainant and targeting the JCDECAUX trademark in an attempt to mislead Internet users and recipients of email communications from email addresses at the disputed domain name that it is affiliated to the Complainant.

The disputed domain name has not been used. As discussed in section 3.3 of the WIPO Overview 3.0, from the inception of the UDRP, panelists have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine 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.

The Panel finds all of these factors are present here. The Complainant's JCDECAUX trademark has significant reputation, and the Respondent has failed to submit a Response or to provide any evidence of actual or contemplated good-faith use of the disputed domain name. It is likely that the Respondent has provided false contact details, given the name that it has indicated includes a misspelling of the JCDECAUX trademark and the name of a senior advertising consultant at the Complainant's company. Finally, the Panel is not aware of any good faith use to which the disputed domain name, representing a misspelling of the Complainant's trademark, may be put by the Respondent.

This satisfies the Panel that the Complainant has established that the Respondent has registered and used 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. **jcdecuex.com**: Transferred

PANELLISTS

Name
Assen Alexiev

DATE OF PANEL DECISION **2023-12-03**

Publish the Decision
