Decision for dispute CAC-UDRP-106148

Case number	CAC-UDRP-106148
Time of filing	2024-01-11 10:14:41
Domain names	jcdecauxin.com, jcdecaux-in.xyz, jcdecaux-ph.com, jcdecauxeph.top

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	JCDECAUX SE

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Organization	NameSilo, LLC

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 owner of International trademark (word) "JCDecaux" no. 803987, registered on 27 November 2001, duly renewed, in classes (Nice Classification) 6, 9, 11, 19, 20, 35, 37, 38, 39, 41, and 42.

It also owns multiple domain names, including <jcdecaux.com>, registered since 23 June 1997 and resolving to the Complainant's official website.

Finally, the Complainant conducts its business under the company or trade name "JCDecaux SE" (acronym that stands for Société Européenne).

The Complainant’s above-mentioned rights are hereinafter collectively referred to as the "JCDECAUX Trademark".

FACTUAL BACKGROUND

The following facts are asserted by the Complainant and not contested by the Respondent.

The Complainant is well-known worldwide for its outdoor advertising business, being the only present in three principal segments:

street furniture, transport advertising and billboard.

The Complainant has more than 1,042,132 advertising panels in airports, rail and metro stations, shopping malls, on billboards and street furniture. It is listed on the Premier Marché of the Euronext Paris stock exchange and is part of Euronext 100 index. Employing a total of 11,200 people, the Complainant is present in more than 80 different countries and 3,573 cities and has generated revenues of €3,317m in 2022.

The Complainant owns several trademarks and a large domain name portfolio, all of them characterized by the presence of the distinctive wording “JCDECAUX“.

The disputed domain names were registered on 6-7 January 2024 by using privacy or proxy service and are inactive.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant contends that the disputed domain names are confusingly similar to its trademark, since the JCDECAUX Trademark is incorporated in its entirety and the addition of the letters "in", "ph", or "eph" is not sufficient to escape the finding of likelihood of confusion between the disputed domain names and the Complainant's trademark.

The Complainant also contends that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Respondent is not known by the disputed domain names. The Complainant does not have any relationship with the Respondent. The Respondent is neither affiliated with, nor authorized by the Complainant in any way to make any use of the Complainant’s JCDECAUX Trademark or to register the disputed domain names. According to the Complainant the Respondent's non-use of the disputed domain names confirms that the Respondent has no demonstrable plan to use the disputed domain names.

Finally, the Complainant contends that, given the distinctiveness and reputation of the JCDECAUX Trademark, it is unlikely that the Respondent had no knowledge of the Complainant's mark when he had registered the disputed domain names confusingly similar to such mark. Furthermore, the disputed domain names redirect to a parking page. The Complainant argues that the Respondent has not demonstrated any activity in respect of the disputed domain names and it is not possible to conceive of any plausible actual or contemplated active good faith use of the disputed domain names by the Respondent.

The Complainant requests the transfer of the disputed domain names.

RESPONDENT:

No administratively compliant Response has been filed.

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).

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).

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).

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

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements to succeed in the administrative proceeding:
(i) the disputed domain names are 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 disputed domain names; and
(iii) the disputed domain names have been registered and are being used by the Respondent in bad faith.

I. RIGHTS AND IDENTITY OR CONFUSING SIMILARITY

In UDRP disputes the test for identity or confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. While each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing (paragraph 1.7 WIPO Overview 3.0).

UDRP panels have also consistently found that the adding, deleting, or substituting letters, numbers, punctuation, or other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) to the relevant trademark, recognizable within the disputed domain name, would not prevent a finding of confusing similarity under the first element (paragraph 1.8 of WIPO Overview 3.0).

UDRP panels also agree that the TLD is to be ignored for the purpose of determination of confusing similarity between the disputed domain name and the complainant's trademark, as it is a technical requirement of registration (paragraph 1.11.1 WIPO Overview 3.0).

The Complainant has established that it has rights in the JCDECAUX Trademark since 2001. The Complainant's mark, registered prior to the registration of the disputed domain names, is distinctive and well-known worldwide.

The disputed domain names incorporate the entirety of the Complainant's JCDECAUX Trademark and differ from such mark by merely adding a hyphen and/or letters "in", "ph" "eph", and the TLDs ".com", ".xyz", and ".top". The addition of the hyphen and/or letters to the Complainant's mark neither affects the attractive power of such trademark, nor is sufficient to distinguish the disputed domain names from the Complainant's mark.

Consequently, the Panel finds that the Complainant has proven the first element of the paragraph 4(a) of the Policy and the disputed domain names are confusingly similar to the Complainant's mark.

II. THE RESPONDENT'S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAMES

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain names. If 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 (see 2.1 WIPO Overview 3.0).

The Complainant contends to have no relationship whatsoever with the Respondent. The Respondent has never received any approval of the Complainant, expressed or implied, to use the Complainant's trademark or to register and use the disputed domain names.

No evidence is available that the Respondent has been commonly known by the disputed domain names or has acquired any rights in a trademark or trade name corresponding to the disputed domain names.

All disputed domain names incorporate the Complainant's trademark plus additional punctuation and/or letters, and, thus are confusingly similar to the JCDECAUX Trademark.

UDRP panels have found that domain names identical or confusingly similar to a complainant's trademark carry a high risk of implied affiliation. A domain name consisting of a trademark plus an additional term at the second- or top-level is seen as tending to suggest sponsorship or endorsement by the trademark owner. Thus, UDRP panels have largely held that such composition cannot constitute fair use.

Moreover, since the dispute domain names are inactive, there is no evidence that, before any notice to Respondent of the dispute, the Respondent used, or demonstrably prepared to use, the domain names or names corresponding to the domain names in connection with a bona fide offering of goods or services.

While the Complainant has established its prima facie case, the Respondent has not submitted a Response to the Complaint and, thus, has failed to invoke any of the circumstances, which could demonstrate any rights or legitimate interests in the disputed domain names.

Therefore, the Panel is satisfied that the Complainant has met the second requirement of the paragraph 4(a) of the Policy and finds that the Respondent lacks rights or legitimate interests to the disputed domain names.

III. REGISTRATION AND USE OF THE DISPUTED DOMAIN NAMES IN BAD FAITH

The disputed domain names have been registered and are being used in bad faith for the following cumulative reasons.

The Respondent has used a privacy or proxy service when registering the disputed domain names. Although the use of such service is not in and of itself an indication of bad faith, the circumstances and the manner in which such service is used may however impact the Panel's assessment of bad faith (see 3.6 WIPO Overview 3.0).

The disputed domain names are to be considered confusingly similar to the JCDECAUX Trademark, since they incorporate such mark in its entirety and differ from it merely by adding a hyphen and/or letters, and the TLD ".com", ".xyz", and ".top" (which are to be disregarded for the purpose of determination of confusing similarity between the disputed domain names and the trademarks of the Complainant).

UDRP panels have consistently 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 3.1.4 WIPO Overview 3.0).

Given the distinctiveness and the reputation of the Complainant's prior mark acquired over the years, it is inconceivable that the Respondent could have registered the disputed domain names confusingly similar to the Complainant's trademark for a mere chance without actual knowledge of the Complainant and its mark and the intention to exploit such reputation by diverting traffic away from the Complainant's website.

The disputed domain names do not resolve to any active website. UDRP panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding (see 3.3 WIPO Overview 3.0 and in particular Telstra Corporation Limited v. Nuclear Marshmallows WIPO Case No. D2000-0003).

The following factors were considered by the Panel when applying the passive holding doctrine in the present case:

(i) the degree of distinctiveness and/or reputation of the Complainant's trademark;
(ii) the failure of the Respondent(s) 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);
(iv) the implausibility of any good faith use to which the disputed domain names may be put.

Taken into account all circumstances of this case, the Panel finds that it is not possible to conceive of any plausible actual or contemplated active use of the domain names by the Respondent that would not be illegitimate, such as by being an infringement of the Complainant's trademark under trademark law, a passing off, or an infringement of consumer protection legislation.

The Complainant has, therefore, discharged the burden of proof to show that the disputed domain names have been registered and are being used in bad faith (paragraph 4(a)(iii) of the Policy).

The disputed domain names are to be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **jcdecauxin.com**: Transferred
2. **jcdecaux-in.xyz**: Transferred
3. **jcdecaux-ph.com**: Transferred
4. **jcdecauxeph.top**: Transferred

PANELLISTS

Name	**Ivett Paulovics**

DATE OF PANEL DECISION 2024-02-01

Publish the Decision