Decision for dispute CAC-UDRP-106155

Case number	CAC-UDRP-106155
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Domain names	ipgdecaux.com

Case administrator

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

Complainant

Organization	JCDECAUX SE

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Organization	Ubiquity Solar

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 owner of the trademarks JCDECAUX and DECAUX by means of international trademark registrations, inter alia, Reg. No. 803987 registered on November 27, 2001 for JCDECAUX; Reg. No. 991341 registered on April 11, 2008 for DECAUX.

FACTUAL BACKGROUND

Since 1964, the Complainant JCDECAUX SE, is the worldwide number one in outdoor advertising. The Complainant provides solutions that combine urban development and the provision of public services in approximatively 80 countries. The Complainant is currently the only group present in the three principal segments of outdoor advertising market: street furniture, transport advertising and billboard advertising. All over the world, the digital transformation is gathering pace: The Complainant now has more than 1,042,132 advertising panels in Airports, Rail and Metro Stations, Shopping Malls, on Billboards and Street Furniture. The Group 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 Group is present in more than 80 different countries and 3,573 cities and has generated revenues of €3,317m in 2022. IGPDECAUX, the Complainant's subsidiary, is responsible for the communication in the transport network of 72 cities for a total of 160 thousand spaces and the street furniture of 19 cities for 12 thousand spaces. Furthermore, it has been entrusted with 5 airports (one thousand spaces), the undergrounds of 5 cities (35 thousand spaces) and the billboards of 10 cities (one thousand spaces). In the digital sector, 9 cities have entrusted it with a total of 570 spaces.

The disputed domain name was registered on January 8, 2024.

PARTIES CONTENTIONS

COMPLAINANT:

(i) The Complainant has rights in JCDECAUX and DECAUX marks as identified in “Identification of rights” above. The disputed domain name is confusingly similar to the Complainant's marks. The addition of the letters IPG is not sufficient to escape the finding that the disputed domain name is confusingly similar to the Complainant’s trademarks. The addition of the letters IPG cannot be coincidental, as it directly refers to the Complainant’s subsidiary IGPDECAUX.

(ii) The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not affiliated with nor authorized by the Complainant in any way. The Respondent has no rights or legitimate interests in respect of the disputed domain name, and he is not related in any way to its business. The Complainant does not carry out any activity for, nor has any business with the Respondent. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant’s trademark, or apply for registration of the disputed domain name by the Complainant. The Respondent has not used, nor prepared to use, the disputed domain name in connection with a bona fide offering of goods or services. Instead, the disputed domain name points to a parking page with commercial links.

(iii) The Respondent has registered and is using the disputed domain name in bad faith: i) given the distinctiveness of the Complainant's trademark and reputation, the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark; ii) the disputed domain name points to a parking page with commercial links, and thus the Respondent has attempted to attract Internet users for commercial gain to its own website thanks to the Complainant’s trademarks; and iii) the Respondent has configured the disputed domain name with multiple MX (mail exchange) records, which suggests that the disputed domain name may be actively used for email purposes.

RESPONDENT:

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).

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

Paragraph 15(a) of the Rules for the UDRP ('the Policy') instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable." Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

(1) the disputed domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and

(2) Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(3) the disputed domain name has been registered and is being used in bad faith.

In view of the Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of the Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. See Vertical Solutions Mgmt., Inc. v. webnet[1]marketing, inc., FA 95095 (FORUM July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); see also Talk City, Inc. v. Robertson, D2000-0009 (WIPO Feb. 29, 2000) ("In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.").

Rights

The Complainant contends that it is the owner of the registered trademarks JCDECAUX and DECAUX as identified in "Identification of rights" above. The Panel notes that an international trademark registration is sufficient to establish rights in that mark. As such, the Panel finds that the Complainant has established its rights in the marks JCDECAUX and DECAUX. The Complainant further contends that the disputed domain name **<ipgdecaux.com>** is confusingly similar to its mark DECAUX on the grounds that i) the disputed domain name incorporates entirely the Complainant's mark DECAUX with the addition of the letters IPG; ii) the addition of the letters IPG cannot be coincidental, as it directly refers to the Complainant's subsidiary IGPDECAUX; and iii) the addition of the gTLD ".com" does not add any distinctiveness to the disputed domain name. The Panel agrees with the Complainant and finds that the addition of '.com' gTLD and the letters IPG is disregarded in the assessment of the confusing similarity under paragraph 4(a)(i) of the Policy. Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark DECAUX.

No rights or legitimate interests

Complainant must first make a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy paragraph 4(a)(ii), then the burden shifts to Respondent to show it does have rights or legitimate interests. See Croatia Airlines d. d. v. Modern Empire Internet Ltd., WIPO Case No. D2003-0455 (the 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 Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the UDRP). See also Advanced International Marketing Corporation v. AA-1 Corp, FA 780200 (FORUM Nov. 2, 2011) (finding that a complainant must offer some evidence to make its prima facie case and satisfy Policy paragraph 4(a)(ii).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not related in any way to the Complainant's business. The Complainant does not carry out any activity for, nor has any business with the Respondent. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademarks, or apply for registration of the disputed domain name by the Complainant. The Panel finds that nothing in the records suggests that the Respondent is commonly known by the disputed domain name or authorized to use the Complainant's marks.

The Complainant further contends that the Respondent has not used, nor prepared to use, the disputed domain name in connection with a bona fide offering of goods or services. Instead, the disputed domain name points to a parking page with commercial links. The Complainant provides a screenshot of the disputed domain name's resolving website. The Panel finds that the disputed domain name's resolving website features multiple third-party links in connection with advertisement services, which are the Complainant's business. The Panel finds that presumably, Respondent receives pay-per-click fees from the linked websites. Such a use of the disputed domain name is generally not considered to be a bona fide offering of goods of services nor a legitimate noncommercial or fair use. See Morgan Stanley v. Domain Administrator, FA1998681 (Forum July 6, 2022) (Respondent has previously used the disputed domain name as a parking website which hosts third-party links to competitors of Complainant. Such a use is generally not considered to be a bona fide offering of goods of services nor a legitimate noncommercial or fair use.). Therefore, the Panel finds that the Respondent failed to make a bona fide offering of goods or services or legitimate noncommercial or fair use per Policy paragraph 4(c)(i) or (iii).

The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

Bad faith

Paragraph 4(b) of the Policy provides a non-exclusive list of circumstances that evidence registration and use of a domain name in bad faith. Any one of the following is sufficient to support a finding of bad faith:

(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 the 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 its 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 the respondent's website or location or of a product or service on the respondent's website or location.

The Complainant contends that the Respondent has registered and is using the disputed domain name in bad faith because the disputed domain name points to a parking page with commercial links, and thus the Respondent has attempted to attract Internet users for commercial gain to its own website thanks to the Complainant's trademarks. The Panel recalls that the Complainant provides a screenshot of the disputed domain name's resolving website. The Panel finds that the disputed domain name's resolving website features multiple third-party links in connection with advertisement services, which are the Complainant's business. The Panel finds that presumably, Respondent receives pay-per-click fees from the linked websites. Hosting hyperlinks that compete with a complainant may be evidence of bad faith under Policy paragraph 4(b)(iv). See Morgan Stanley v. Domain Administrator, FA1998681 (Forum July 6, 2022) (Hosting hyperlinks that compete with a complainant may be evidence of bad faith under Policy paragraph 4(b)(iv).). Therefore, the Panel finds that the Respondent registered and uses the disputed domain name in bad faith under Policy paragraph 4(b)(iv).

Next, the Complainant contends that given the distinctiveness of the Complainant's trademark and reputation, the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark. While constructive knowledge is insufficient for a finding of bad faith, per Policy paragraph 4(a)(iii), registration of a disputed domain name with actual knowledge of another's trademark rights is sufficient to establish bad faith, and can be shown by the notoriety of the mark and the use the Respondent makes of the disputed domain name. See Orbitz Worldwide, LLC v. Domain Librarian, FA 1535826 (Forum February 6, 2014) ("The Panel notes that although the UDRP does not recognize 'constructive notice' as sufficient grounds for finding Policy paragraph 4(a)(iii) bad faith, the Panel here finds actual knowledge through the name used for the domain and the use made of it."); see also AutoZone Parts, Inc. v. Ken Belden, FA 1815011 (Forum December 24, 2018) ("Complainant contends that Respondent's knowledge can be presumed in light of the substantial fame and notoriety of the AUTOZONE mark, as well as the fact that Complainant is the largest retailer in the field. The Panel here finds that Respondent did have actual knowledge of Complainant's mark, demonstrating bad faith registration and use under Policy paragraph 4(a)(iii)."). The Panel finds that the Complainant's trademarks JCDECAUX and DECAUX are well known in connection with the advertisement business given the fact as identified in "Factual Ground" above. The Respondent has resolved the disputed domain name to a website hosting multiple third-party links, which relate to the Complainant's advertisement business. Furthermore, the addition of the letters IPG in configurating the disputed domain name cannot be coincidental, as it directly refers to the Complainant's subsidiary IGPDECAUX. Therefore, the Panel infers that the Respondent had actual knowledge of the Complainant's rights in its marks JCDECAUX and DECAUX at the time of registering the disputed domain name, and thus the Panel finds the bad faith registration of the disputed domain name.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ipgdecaux.com**: Transferred

PANELLISTS

Name	**Mr. Ho-Hyun Nahm Esq.**

DATE OF PANEL DECISION 2024-02-09

Publish the Decision