Decision for dispute CAC-UDRP-106247

Case number	CAC-UDRP-106247
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Domain names	jcdin.com, jcdin.top, jcdph.com, jcdin.net, jcdph.net, jcdph.top

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	JCDECAUX SE

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Organization	zhang san

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 the following trademarks:-

- European Union trademark registration no. 002238038 for JCDECAUX, registered on 26 February 2003;
- International trademark registration no. 803987 for JCDECAUX, registered on 27 November 2001;
- International trademark registration no. 972204 for JCDECAUX, registered on 19 June 2009; and
- International trademark registration no. 1469432 for JCDECAUX, registered on 31 December 2018.

The Complainant is the owner of various domain names which incorporate “JCD”, including:-

- <jcdecaux.com> registered on 23 June 1997;
- <jcd-careers.com> registered on 22 March 2022; and
- <jcd-genz.com> registered since 11 May 2023.

FACTUAL BACKGROUND

The Complainant, JCDECAUX SE, was founded in 1964, and is of the leading outdoor advertisers in the world. The Complainant

offers solutions that combine urban development and the provision of public services in around 80 countries. The Complainant is the only group present in the three principal segments of the outdoor advertising market. The Complainant has over 1,042,132 advertising panels throughout the world, and employs 11,200 people worldwide. It generated €3.317 billion of revenue in 2022.

PARTIES CONTENTIONS

The Complainant´s contentions in regard to the first element of the Policy are summarised below.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has not, 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 Panel did not assess the second element of the Policy (paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Panel did not assess the third element of the Policy (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

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a complainant to show that a domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. The Complainant has provided evidence that it owns the trademark registration of the JCDECAUX mark.

The disputed domains names all contain the first 3 letters “jcd” with the addition of one of two suffixes: “in” or “ph”. It is well-established that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The disputed domain names, however, do not comprise the JCDECAUX mark. The disputed domain names are therefore not identical.

The Complainant argues that the disputed domain names comprising the terms “jcdin” and “jcdph” and the Complainant’s JCDECAUX mark are confusingly similar. The Complainant argues that the letters “in” refer to the country India and the letters “ph” refer to the country Philippines and that these are meant to convey a country-code meaning. The Panel accepts that this is a possibility and absent a Response the Panel proceeds on this basis.

To support its claim that the disputed domain names comprising the letters “jcd” are confusing similar with the JCDECAUX mark the Complainant argued and provided evidence that the letters JCD refer to the initials of the founder of the Complainant, Jean-Claude Decaux. The Complainant also argued that (1) the letters “jcd” are an abbreviation of its JCDECAUX mark, (2) that “jcd” is capitalised in its JCDECAUX trademark, and (3) the Complainant has developed activities around the term “jcd”, such as operating some of its websites incorporating “jcd” in their respective domain names.

The Complainant, however, did not provide evidence in support of the first and second arguments.

In relation to the third argument the Complainant provided screenshots of two web pages, one for Complainant's <jcd-genz.com> and the other for <jcd-careers.com>. However, apart from using the letters "jcd" as part of domain names, the letters "jcd" or "JCD" are not used within these web pages independently to denote the JCDECAUX mark. The Complainant has not provided sufficient evidence of use of the JCD letters as an indication of origin apart from its JCDECAUX mark and has not provided any evidence to show that it has been using the JCD mark instead of its JCDECAUX mark. Within these web pages, the Complainant emphasises the name "JCDecaux", even writing a short paragraph on the correct pronunciation of "JCDecaux" but there is no mention that the mark is abbreviated or should be used as JCD. It is therefore difficult for the Panel to accept that the Complainant is known as "jcd" or "JCD" based on the evidence submitted. This is also the case in light of the fact that the Complainant itself has allowed its previous registered trademarks for "JCD" to lapse:-

- International trademark registration no. 3316618 for JCD, expired on 1 October 2014;
- International trademark registration no. 1527730 for JCD, expired on 3 February 2018; and
- International trademark registration no. 1077985 for JCD.

The Complainant has also submitted arguments that the use of the abbreviated term "jcd" does not distinguish the disputed domain names from the Complainant's JCDECAUX trademark in view of the following cases: -

- ZB, N.A., dba Zions First National Bank and ZB, N.A., dba Amegy Bank v. Cameron David Jackson, Case No. D2016-1452 ("Zions First National")
- Express Messenger Systems, Inc. v. Golden State Overnight, Case No. D2001-0063 ("Express Messenger")
- Dow Jones & Company, Inc. & Dow Jones LP v. T.S.E. Parts, Case No. D 2001-0381 ("Dow Jones")
- Philip Morris USA Inc. v. Steven Scully, J&S Auto Repair, Case No. D2015-1001 ("Philip Morris")

In Zions First National, it was held that the disputed domain name <zbnationalassociation.xyz> was confusingly similar to the complainant's corporate name, "ZB NA", and its ZION BANK trademark on the grounds that the disputed domain name was comprised of an abbreviated form of the trademark ZIONS BANK together with the terms "national association". The complainant in that case had been name "Zions Bank National Association" but had since been renamed and truncated its name to "ZB NA". The Panel therefore found that the "disputed domain name <zbnationalassociation.xyz> reflects the Complainant's corporate name ZB NA which the Complainant has used in relation to its business since January 2016." This case is not helpful to Complainant since the Complainant has not been using the letter JCD instead of JCDECAUX as its name.

In Express Messenger, it was held that the disputed domain name <calovernight.com> was confusingly similar to the complainant's CALFORNIA OVERNIGHT trademark. It was held that "cal" was a common abbreviation for "California". In Dow Jones, it was held that the letters "st" a standard English abbreviation for the word "street".

In Philip Morris, it was held that the disputed domain name <pmcannabis.com> was found to be confusingly similar to the complainant's PHILIP MORRIS trademark as (1) it was an abbreviation of the complainant's PHILIP MORRIS trademark, and (2) that the addition of the generic term "cannabis" was an attempt to associate the disputed domain name with the complainant's business in the tobacco industry. The case specifically states that "the Panel finds that the Complainant has provided uncontested evidence to establish that it is the owner of and has common law rights in and to the Complainant's Marks, its trade name and the abbreviation thereof." (Emphasis added.)

The Complainant has not provided evidence to show that the term "jcd" is commonly used or is commonly known as an abbreviation of JCDECAUX. While the trigram "jcd" may be stylised capitalistically in the Complainant's JCDECAUX trademark, it is insufficient, on its own, to show that the Complainant is known by the abbreviation "jcd". Moreover, the claiming and showing of common law rights poses an evidentiary bar, which requires the Complainant to show that the name "JCD" has become a distinctive identifier associated with the Complainant or its goods and services. Relevant evidence of such "secondary meaning" includes length and amount of sales under the mark, the nature and extent of advertising, consumer surveys and media recognition. The fact that the secondary meaning may only exist in a small geographic area does not limit Complainant's rights in a common law trademark. (see WIPO overview 3.0, section 1.7). The Complainant has not satisfied this bar.

Failing to show that the letters JCD are an abbreviation of the JCDECAUX mark and that the Complainant has common law rights in the JCD mark, and while the Panel notes that "jcd" term are the initials of the founder of the Complainant, and that the Complainant operates at least two websites which contain "jcd" in their domain names, the Panel finds that the Complainant has not shown the disputed domain names are confusingly similar to the JCDECAUX mark. See Group Kaitu, LLC , Darkside Productions, Inc. v. NetDirect, WIPO Case No. D2011-0220.

In summary, the Complainant has not shown that the disputed domain names are identical or confusingly similar to a trademark, registered or otherwise, or service mark in which the Complainant has rights.

Accordingly, and having failed to establish the first element, it is not necessary for the Panel to decide the second and third elements.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **jcdin.com**: Remaining with the Respondent
2. **jcdin.top**: Remaining with the Respondent
3. **jcdph.com**: Remaining with the Respondent
4. **jcdin.net**: Remaining with the Respondent
5. **jcdph.net**: Remaining with the Respondent
6. **jcdph.top**: Remaining with the Respondent

PANELLISTS

Name	**Jonathan Agmon**

DATE OF PANEL DECISION 2024-03-19

Publish the Decision