Decision for dispute CAC-UDRP-106583

Case number	CAC-UDRP-106583
Time of filing	2024-06-04 08:49:36
Domain names	jcdeaux.com

Case administrator

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

Complainant

Organization	JCDECAUX SE

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Organization	markert

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 international trademark registration JCDECAUX no 803987 registered since November 27, 2001, and the US trademark JCDECAUX no 88290330 registered since June 8, 2021.

The Complainant is also the owner of the domain name <jcdecaux.com> registered since June 23, 1997.

The disputed domain name <jcdeaux.com> was registered on May 30, 2024.

PARTIES CONTENTIONS

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

Since 1964, the Complainant is the worldwide number one in outdoor advertising. Throughout the world, the company's success is driven by meeting the needs of local authorities and advertisers by a constant focus on innovation. For 60 years JCDECAUX has been offering solutions that combine urban development and the provision of public services in approximatively 80 countries, in particular the United States. The Complainant is currently the only group present in the three principal segments of outdoor advertising market: street furniture, transport advertising and billboard.

The Complainant now has more than 1,056,833 advertising panels in Airports, Rail and Metro Stations, Shopping Malls, on Billboards and Street Furniture. The Complainant's Group is listed on the Premier Marché of the Euronext Paris stock exchange and is part of Euronext 100 index. Employing a total of 11,650 people, the Group is present in more than 80 different countries and 3,918 cities and has generated revenues of €3,570m in 2023.

JCDECAUX owns several trademarks "JCDECAUX" such as the international trademark registration JCDECAUX® no 803987 registered since November 27, 2001, and the US trademark JCDECAUX® no 88290330 registered since June 8, 2021.

JCDECAUX is also the owner of a large domain names portfolio, including the same distinctive wording JCDECAUX ®, such as <jcdecaux.com> registered since June 23, 1997.

The disputed domain name <jcdeaux.com> was registered on May 30, 2024 and points to a parking page with commercial links. Besides, MX servers are configured.

The Complainant states that the disputed domain name is confusingly similar to its trademark JCDECAUX. The misspelling in the domain name (i.e. the deletion of the letter "C") is not sufficient to escape the finding that the domain name is confusingly similar to the trademark JCDECAUX. This is a clear case of typosquatting, as the disputed domain name contains an obvious misspelling of the Complainant's trademark. It is well established that the slight spelling variations does not prevent a disputed domain name from being confusing similar to the Complainant's trademark. Besides, it is well established that TLDs may typically be disregarded in the assessment under paragraph 4(a)(i) of the Policy when comparing disputed domain names and trademarks. Several UDRP panels confirmed the Complainant's rights over the term "JCDECAUX" (CAC Case No. 120169 <jicdecaux.com>, CAC Case No. 101990 <jcdeceux.com>, CAC Case No. 101961, <jcdiecaux.com>).

The Complainant asserts that the Respondent is not identified in the WHOIS database as the disputed domain name, but as "markert". Past panels have held that a Respondent was not commonly known by a disputed domain name if the Whois information was not similar to the disputed domain name. Thus, the Respondent is not known as the disputed domain name. The Complainant contends that the Respondent is not affiliated with nor authorized by the Complainant in any way. The Complainant contends that 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 licence 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. Furthermore, the disputed domain name points to a parking page with commercial links. Past panels have found it is not a bona fide offering of goods or services or legitimate non-commercial or fair use.

The disputed domain name is confusingly similar to the Complainant's trademark. The Complainant asserts that its trademark JCDECAUX was already known for decades and protected in several countries at the time of the registration. The Complainant is doing business in more than 80 countries worldwide, especially in the United States, where the Respondent is located and is listed at the Euronext Paris stock exchange. Besides, past panels have held that the JCDECAUX trademark is well-known (WIPO Case No. DCC2017-0003). Thus, given the distinctiveness of the Complainant's trademark and reputation, the Complainant can state that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark, and therefore could not ignore the Complainant. The Complainant states that the misspelling was intentionally designed to be confusingly similar with the Complainant's trademark. Previous UDRP panels have seen such actions as evidence of bad faith. Furthermore, the disputed domain name points to a parking page with commercial links. The Complainant contends the Respondent has attempt to attract Internet users for commercial gain to his own website thanks to the Complainant's trademarks for its own commercial gain, which is an evidence of bad faith. Finally, the disputed domain name has been set up with MX records, which suggests that it may be actively used for e-mail purposes.

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is 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

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

(i) The domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
(ii) The respondent has no rights or legitimate interests in respect of the domain name; and
(iii) The domain name has been registered and is being used in bad faith.

I. Identical or Confusingly Similar

The Complainant has established the fact that it has valid rights for the international trademark no. 803987 JCDECAUX registered on November 27, 2001, the US trademark JCDECAUX no. 88290330 registered since June 8, 2021 and that it owns domain name including the same distinctive wording JCDECAUX. The disputed domain name has been registered on May 30, 2024, i.e. more than 20 years after the JCDECAUX international trademark registration.

The disputed domain name is almost identical to the Complainant's trademark with the only difference – the second letter "C" is missing. Such obvious misspelling of the Complainant's trademark is characteristic of a typosquatting practice intended to create confusing similarity between the Complainant's trademark and the disputed domain name. The deletion of one letter therefore does not prevent the disputed domain name from being confusingly similar to the Complainant's trademark.

The generic top-level domain "COM" should be disregarded in the assessment under the Policy when comparing disputed domain names and trademarks and does not change the overall impression of the designation as being connected to Complainant's trademark.

The Panel therefore considers the disputed domain name to be confusingly similar to the Complainant's trademark JCDECAUX in which the Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

II. Rights or Legitimate Interests

The Complainant has established a prima facie case (not challenged by the Respondent who did not file any response to the complaint) that the Respondent has no rights or legitimate interests in the disputed domain name, since the Respondent is not related in any way with the Complainant. The disputed domain name is used for the parking page with the commercial links only and, therefore, does not constitute a bona fide offering of goods and services or a legitimate noncommercial fair use. The Respondent has no rights or legitimate interests in the disputed domain name, since there is no indication that the Respondent is commonly known by the term "JCDECAUX" or its variations or that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services.

The Panel therefore considers that the Respondent has no rights or legitimate interests in respect of the disputed domain name within the meaning of paragraph 4(a)(ii) of the Policy.

III. Registered and Used in Bad Faith

Given the distinctiveness of the Complainant's trademark and reputation (as confirmed in other UDRP proceeding in the past – WIPO Case No. DCC2017-0003, JCDecaux SA v. Wang Xuesong, Wangxuesong) it is evident that the Respondent had the Complainant and its trademark in mind when registering the disputed domain name. Furthermore, the website in connection with the disputed domain name is used for the parking page with the commercial links only since its registration. The incorporation of a famous trademark into a domain name, coupled with parking page website, may be evidence of bad faith registration and use.

Moreover, there are active MX records connected to the disputed domain names and the disputed domain name is or could be used for the e-mail purposes. It is difficult to imagine that the Respondent would be able to use the disputed domain name in good faith as part of an e-mail address in this case.

The Panel therefore considers that 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.

The Panel finally considers that the Complainant has shown that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights, the Respondent has no rights or legitimate interests in respect of the disputed domain name and the disputed domain name has been registered and is being used in bad faith. The Complainant has thus established all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **jcdeaux.com**: Transferred

PANELLISTS

Name	**Petr Hostaš**

DATE OF PANEL DECISION 2024-07-02

Publish the Decision