

ADMINISTRATIVE PANEL DECISION

JCDECAUX SE v. Brentford Brentford, jcdecaux co
Case No. D2024-3565

1. The Parties

The Complainant is JCDECAUX SE, France, represented by Nameshield, France.

The Respondent is Brentford Brentford, jcdecaux co, United Kingdom.

2. The Domain Names and Registrar

The disputed domain names are <jcdecauxco.com> and <jcdecauxco.vip> are registered with Gname.com Pte. Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 3, 2024. On September 4, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On September 5, 2024, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Center sent an email communication to the Complainant on September 12, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on the same day.

The Center verified that the Complaint together with amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on September 18, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 8, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 9, 2024.

The Center appointed Anna Carabelli as the sole panelist in this matter on October 14, 2024. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a global outdoor advertising company established in 1964. It offers solutions combining urban development and the provision of public services and is currently the only group present in the three principal segments of the outdoor advertising market: street furniture, transport advertising and billboard.

The Complainant 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 Complainant is present in more than 80 different countries and 3,918 cities and generated revenues of EUR 3,570 million in 2023.

The Complainant is the owner of the International trademark No. 803987 JCDECAUX registered on November 27, 2001, designating various jurisdictions.

The Complainant also owns the domain name <jcdecaux.com> which was created in 1997 and resolves to the Complainant's official website.

The disputed domain names were registered on August 19, 2024. As per the evidence submitted with the Complaint, they resolved to a website prominently displaying the Complainant's trademark and containing a login page. At the time of this Decision, the disputed domain names resolve to an inactive webpage stating "Unable to reach site".

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

Notably, the Complainant contends that:

- The Complainant's JCDECAUX trademark is well-known worldwide, as recognized in previous UDRP decisions;
- The disputed domain names are confusingly similar to the Complainant's trademark, since they consist of the Complainant's exact mark. The addition of the letters "co" (short form "company") does not prevent the confusing similarity with the Complainant's trademark;
- The Respondent has no rights or legitimate interests in the disputed domain names since: (i) the Complainant has not authorized or somehow given consent to the Respondent to register and use the disputed domain names, (ii) the Respondent is not commonly known by the disputed domain names, and (iii) the Respondent's use of the disputed domain names is neither a bona fide offering of goods or services nor a legitimate noncommercial or fair use. Indeed, the disputed domain names resolve to a webpage displaying the Complainant's trademark and redirecting to a login page which could be used to collect personal information of the Internet users;
- The disputed domain names were registered and are being used in bad faith. The structure of the disputed domain names shows that the Respondent registered them having in mind the Complainant's JCDECAUX mark, and reflect the Respondent's clear intention to create an association with and take advantage of the Complainant's trademark.

Based on the above the Complainant requests the disputed domain names be transferred to the Complainant.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the panel to decide the complaint based on the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Under paragraph 4(a) of the Policy, the complainant must prove each of the following:

- (i) the disputed 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 disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

Paragraph 4(b) of the Policy sets out four illustrative circumstances, which for the purposes of paragraph 4(a)(iii) of the Policy, shall be evidence of registration and use of a domain name in bad faith.

Paragraph 4(c) of the Policy sets out three illustrative circumstances any one of which, if proved by the respondent, shall be evidence of the respondent's rights to or legitimate interests in a disputed domain name for the purpose of paragraph 4(a)(ii) of the Policy above.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain names. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced and recognizable within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. The addition of the generic Top-Level Domains such as ".com" and ".vip" is viewed as a standard registration requirement and as such is typically disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

The addition of the letters "co", does not avoid a finding of a confusing similarity on the present case. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

Moreover, as noted in Section 6.A above, the disputed domain names incorporate the Complainant’s JCDECAUX mark in its entirety together with the additional letters “co”, which carries a risk of implied affiliation with the Complainant. [WIPO Overview 3.0](#), section 2.5.1.

The Panel further notes that the Respondent has indeed used the disputed domain names to deliberately cause confusion among Internet users, as the disputed domain names linked to a website prominently displaying the Complainant’s trademark and containing a login page. This page could be used for collecting personal information of the Complainant’s clients and such use of the disputed domain names cannot constitute fair use.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, given the well-known character of the Complainant’s trademark (also recognized in *JCDecaux SE v. cesar padal*, WIPO Case No. [D2023-4013](#); *JCDecaux S.A. v. Whois Agent, Domain Protection Services, Inc / Jennifer Smith*, WIPO Case No. [DCO2017-0026](#)) it is difficult to believe that the Respondent did not have in mind the Complainant’s trademark when registering the disputed domain names. Prior panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith ([WIPO Overview 3.0](#), section 3.1.4).

Furthermore, the uncontested evidence submitted by the Complainant shows that the Respondent has used the disputed domain names following registration, to resolve to a webpage prominently featuring the Complainant’s JCDECAUX mark. In the Panel’s view this establishes both the Respondent’s actual knowledge of the Complainant’s rights as at the date of registration of the disputed domain names and the Respondent’s intention to take unfair advantage of those rights.

Indeed, the Respondent has used the disputed domain names to capitalize on the goodwill of the Complainant’s JCDECAUX trademark and has intentionally attempted to create a false impression of an association with the Complainant, and to mislead Internet users into believing the disputed domain names as official domain names of the Complainant.

The above conduct constitutes bad faith registration and use of the disputed domain names under the Policy.

The fact that the disputed domain names currently connect to an inactive webpage stating that the site can't be reached, does not prevent a finding of bad faith under the passive holding doctrine given the totality of the circumstances in the present case. [WIPO Overview 3.0](#), section 3.3.

The Panel finds that the Complainant has established the third element of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain names <jcdecauxco.com> and <jcdecauxco.vip> be transferred to the Complainant.

/Anna Carabelli/

Anna Carabelli

Sole Panelist

Date: October 28, 2024