

ADMINISTRATIVE PANEL DECISION

JCDECAUX SA. v. Scott Bailey

Case No. D2022-3476

1. The Parties

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

The Respondent is Scott Bailey, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <decaux.xyz> is registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 20, 2022. On September 20, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 21, 2022, 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 verified that the 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 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 19, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 21, 2022.

The Center appointed Selma Ünlü as the sole panelist in this matter on October 25, 2022. 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 JCDECAUX SA is company operating in outdoor advertising and owns trademarks containing the term “decaux” such as the International trademark DECAUX no. 991341 registered since April 11, 2008. The Complainant is also the owner of domain names, including the trademark DECAUX, such as <decaux.com> registered since June 23, 1997.

The disputed domain name was registered on September 12, 2022, and redirects to a Dan.com where the disputed domain name is offered for sale

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is identical to the trademark DECAUX and the domain name includes the trademark in its entirety. The Complainant also contends that addition of the new generic Top-Level Domain (“gTLD”) “.xyz” does not change the overall impression of the designation as being connected to its trademark and does not differ them. Therefore, the Complainant asserts that the disputed domain name is confusingly similar to its prior trademark DECAUX.

The Complainant refers to the case *Croatia Airlines d .d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#), for the fact that 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.

The Complainant asserts that the Respondent is not known as the disputed domain name, but as “Scott Bailey”, based on past panels' decisions stating 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 has no rights or legitimate interests in respect of the disputed domain name and he is not related in any way to the Complainant. 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 DECAUX, or apply for registration of the disputed domain name by the Complainant.

The Complainant states that the disputed domain name points to a Dan.com page where the disputed domain name is offered for sale for USD 1,450, and this general offer to sell the disputed domain name demonstrates the Respondent's lack of rights or legitimate interests. Accordingly, the Complainant contends that the Respondent has no rights or legitimate interests to the disputed domain name.

The Complainant asserts that the disputed domain name is identical to the Complainant trademark DECAUX as mentioned above and refers to the past panels stating that the JCDECAUX trademark is well-known.

The Complainant also claims that all the results of searches of the terms “decaux” refer to the Complainant. Consequently, the Complainant contends that the Respondent knew about the Complainant's trademark, which evidences bad faith.

Moreover, it is claimed that the Respondent does not make any use of the disputed domain name and it resolves to a Dan.com page displaying a general offer to sell the disputed domain name. The Complainant claims that the Respondent fails to make an active use of the disputed domain name. The Complainant refers to past panels holding that failure to actively use a domain name is evidence of bad faith registration and use. Furthermore, the Complainant contends that the Respondent has registered the disputed domain

name only in order to sell it back for out-of-pockets costs, which shows bad faith registration and use. Consequently, the Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith.

B. Respondent

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

6. Discussion and Findings

The Complainant must prove that the three elements of paragraph 4(a) of the Policy have been met for the disputed domain name, namely:

(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.

Since the Respondent did not object to any of the contentions from the Complainant by not submitting a Response, the Panel will decide the Complaint in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable and on the basis of the Complaint and supporting Annexes.

A. Identical or Confusingly Similar

In light of the explanations and evidence provided by the Complainant, the Panel is satisfied that the Complainant has valid trademark rights in the DECAUX trademark, which is reproduced in its entirety in the disputed domain name.

Furthermore, the addition of the gTLD “.xyz” does not prevent a finding of confusing similarity, since it is merely a technical registration requirement to be disregarded typically.

Consequently, the Panel finds that the disputed domain name is identical to the Complainant's trademark and the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists non-exhaustively the relevant circumstances that could show the Respondent's rights or legitimate interests in a domain name, as follows:

“Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate [the respondent's] rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

(i) before any notice to [the respondent] of the dispute, [the respondent's] use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) [the respondent] (as an individual, business, or other organization) ha[s] been commonly known by the domain name, even if [the respondent] ha[s] acquired no trademark or service mark rights; or

(iii) [the respondent] is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

The Panel notes that the Respondent has not filed a Response, and therefore, neither denied the Complainant's claims, nor brought any information or evidence to prove any rights or legitimate interests.

The Complainant has made a *prima facie* showing that the Respondent does not have any rights or legitimate interests in the disputed domain name. In particular, the Complainant asserted that the Respondent has no trademarks with the word "decaux" and that it did not provide any license or authorization for the Respondent to use its trademark as part of the disputed domain name.

The Complainant states that the disputed domain name points to a Dan.com page where the disputed domain name is offered for sale for USD 1,450, and this general offer to sell the disputed domain name demonstrates the Respondent's lack of rights or legitimate interests.

Since the Complainant made out a *prima facie* case, the burden of production shifts to the Respondent to establish its rights or interests in the disputed domain name. The Respondent, however, has not sought to rebut that *prima facie* case.

In light of the Complainant's assertions and evidence, the Panel finds that the Complainant has met the requirement under the Policy of *prima facie* showing that the Respondent does not have any rights or legitimate interests in the disputed domain name. Accordingly, the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists certain relevant non-exhaustive circumstances, which can be considered as the registration and use of a domain name in bad faith, namely:

"(i) circumstances indicating that [the respondent has] registered or acquired [a disputed] 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 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 [the respondent's] website or other on-line 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."

Given the explanations in the Complaint and the evidence provided by the Complainant, the Panel finds that the disputed domain name was registered in bad faith.

The disputed domain name incorporates the exact distinctive DECAUX trademark of the Complainant, which cannot be considered as a coincidence. The Complainant has provided that the DECAUX trademark is well-known, therefore, the fact that the Respondent decided to register the disputed domain name including this term in its entirety strongly suggests that the Respondent taken the Complainant's well-known DECAUX trademark into account and targeted it specifically in order to gain unfair advantage. This is even more likely given the fact that the disputed domain name is on sale.

As follows, the disputed domain name resolves to a Dan.com page displaying a general offer to sell the disputed domain name. The Complainant claims that the Respondent fails to make an active use of the disputed domain name. Furthermore, the Complainant contends that the Respondent has registered the disputed domain name only to sell it back for out-of-pockets costs, which shows bad faith registration and use.

The Panel finds that the dispute in question is a typical case of bad faith provided in the Policy under UDRP paragraph 4(b) as one of the scenarios constituting evidence of the Respondent's bad faith, namely, the case that the Respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration probably in excess of the Respondent's out-of-pocket costs directly related to the domain name, considering that the disputed domain name reproduces entirely the distinctive well-known DECAUX trademark. See section 3.1.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition.

The Panel must decide by examining all relevant circumstances of each case in question. It is possible that cumulative conditions lead to the finding of bad faith, such as the Complainant's trademark being well-known, as well as no response to the Complaint.

See also, *Viceroy Cayman Ltd. v. Anthony Syrowatka*, WIPO Case No. [D2011-2118](#):

"Given that Respondent demanded USD 10,000 per domain name transfer to Complainant, the Panel concludes that Respondent registered the disputed domain names primarily for the purpose of selling their registrations to Complainant, who owns the VICEROY marks, for valuable consideration in excess of Respondent's documented out-of-pocket costs directly related to the disputed domain names, which is a circumstance of registration in bad faith pursuant to Policy paragraph 4(b)(i)."

Consequently, the Panel decides that the third requirement is also met and both the registration and the use of the disputed domain name are in bad faith.

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 name <decaux.xyz> be transferred to the Complainant.

/Selma Ünlü/

Selma Ünlü

Sole Panelist

Date: November 3, 2022