

## **ADMINISTRATIVE PANEL DECISION**

JCDECAUX SE v. Artur Kezano

Case No. D2023-3203

### **1. The Parties**

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

The Respondent is Artur Kezano, Russian Federation.

### **2. The Domain Name and Registrar**

The disputed domain name <jcdecauxae.com> is registered with Registrar of Domain Names REG.RU LLC (the "Registrar").

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on July 25, 2023. On July 25, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 28, 2023, the Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Protection of Private Person) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 31, 2023, 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 August 1, 2023.

The Registrar also indicated that the language of the registration agreement is Russian. On July 31, 2023, the Center sent an email communication to the Parties in both Russian and English inviting the Complainant to submit satisfactory evidence of an agreement between the Complainant and the Respondent to the effect that the proceedings should be in English; or submit the Complaint translated into Russian; or submit a request for English to be the language of the administrative proceedings. On August 1, 2023, the Complainant filed a request for English to be the language of the proceedings. The Respondent did not comment on the language of the proceedings.

The Center verified that the Complaint together with the 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 in both Russian and English, and the proceedings commenced on August 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 3, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on September 13, 2023. On September 14 and September 21, 2023, the Respondent sent two informal email communications to the Center indicating that hosting of the disputed domain name would be suspended immediately.

On September 25, 2023, the proceeding was suspended upon the Complainant's request. On October 24, 2023, the proceeding was reinstated.

The Center appointed Alissia Shchichka as the sole panelist in this matter on November 1, 2023. 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 was established in 1964 and is specialized in outdoor advertising.

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 11,200 people, the Group is present in more than 80 different countries and 3,573 cities and has generated revenues of EUR 3,317 million in 2022.

The Complainant owns several trademarks containing the term JCDECAUX, amongst others:

- International trademark registration No. 803987, designating numerous countries including Russian Federation, registered on November 27, 2001, for the word mark JCDECAUX in classes 6, 9, 11, 19, 20, 35, 37, 38, 39, 41 and 42.

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

The Complainant contends that several previous panels have recognized its rights in the JCDECAUX trademarks.

The above trademarks and domain name were registered prior to the registration of the disputed domain name, which was registered on July 23, 2023.

The disputed domain name currently displays an inactive webpage. However, according to the evidence provided by the Complainant, the disputed domain name previously redirected visitors to the Complainant's official website "www.jcdecaux.com".

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant's contentions can be summarized as follows:

The Complainant submits that the Complainant's JCDECAUX trademark is clearly included and recognizable in the disputed domain name.

The addition of the letters "ae" (a two-letter country code for "United Arab Emirates") to the JCDECAUX trademark does not alter the overall impression that the disputed domain name is associated with the

Complainant's trademark or prevent the likelihood of confusion between the disputed domain name and the Complainant and its trademarks.

In respect of the generic Top-Level Domain ("gTLD") ".com", which forms part of the disputed domain name, the Complainant requests that the Panel disregard it under the first element as it is a standard registration requirement.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not commonly known by the disputed domain name, has not used or prepared to use the disputed domain name in connection with a *bona fide* offering of goods or services, and has not been authorized, licensed, or otherwise permitted by the Complainant to register and/or use the disputed domain name.

The Complainant further contends that the trademark JCDECAUX is well known and the Respondent knew about the Complainant's trademark, which evidences bad faith registration. Furthermore, the Complainant submits that the disputed domain name redirected visitors to the Complainant's official website and that this use cannot be considered a *bona fide* offering of goods or services.

Therefore, the Complainant alleges that the registration and use of the disputed domain name was, and currently is, in bad faith, contrary to the Policy and the Rules.

## **B. Respondent**

The Respondent did not substantively reply to the Complainant's contentions. The Respondent submitted two informal email communications in which he indicated: "I really do apologise for the inconvenience that may have arisen or caused by this misunderstanding. The domain name and hosting will be suspended immediately."

## **6. Discussion and Findings**

### **6.1 Language of the Proceedings**

The language of the Registration Agreement for the disputed domain name is Russian. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

The Complaint was submitted in English. The Complainant requested that English be the language of the proceedings for several reasons. These include the allegation that the Complainant would incur unreasonable effort and costs to provide the Complaint in Russian. Indeed, the disputed domain name is written in Latin script rather than Cyrillic script. Additionally, it used to redirect users to the official website of the Complainant in English.

The Center has sent all its communications to the Respondent in both English and Russian, and has invited the Respondent to express its views on the language of the proceeding. The Respondent has not submitted a response or any objections to the Complainants' request that the proceedings be conducted in English. Furthermore, the Respondent sent two informal email communications to the Center in English.

Having considered all the matters above, the Panel considers that the Respondent would not be disadvantaged if the language of the proceeding is English, and that using the English language in this proceeding would be fair and efficient. Therefore, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

## **6.2. Substantive Issues**

Under paragraph 4(a) of the Policy, the Complainant carries the burden of proving:

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

The Respondent's lack of substantive response in the case at hand does not automatically result in a decision in favor of the Complainant, however, paragraph 5(f) of the Rules provides that if the Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute solely based upon the Complaint.

Further, according to paragraph 14(b) of the Rules, the Panel may draw such inferences from the Respondent's failure to submit a formal response as it considers appropriate.

### **A. Identical or Confusingly Similar**

Ownership of a trademark registration is generally sufficient evidence that a complainant has the requisite rights in a trademark for purposes of paragraph 4(a)(i) of the Policy (see [WIPO Overview 3.0](#), section 1.2.1).

The Complainant has provided evidence of its rights in the JCDECAUX trademark, as noted above. The Complainant has therefore proven that it has the requisite rights in the JCDECAUX trademark.

With the Complainant's rights in the JCDECAUX trademark established, the remaining question under the first element of the Policy is whether the disputed domain name, typically disregarding the TLD in which it is registered (in this case, ".com"), is identical or confusingly similar to the Complainant's trademark.

The JCDECAUX trademark is recognizable in the disputed domain name. The addition of a two-letter country code "ae" for "United Arab Emirates" does not prevent a finding of confusing similarity. Numerous UDRP panels have considered 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 confusingly similarity under the first element (see [WIPO Overview 3.0](#), section 1.8).

Thus, the Panel finds that the Complainant has satisfied the first element of the Policy.

### **B. Rights or Legitimate Interests**

The Complainant must show that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent may establish a right or legitimate interest in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

- (i) "before any notice to you of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are 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.”

In the case at hand, the Panel finds that the Complainant has made a *prima facie* case and that the Respondent, by not having submitted a formal Response, has failed to demonstrate rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy for the following reasons.

The Panel notes that there is no relation, disclosed to the Panel or otherwise apparent from the record, between the Respondent and the Complainant. The Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant’s trademarks. Moreover, there is no element from which the Panel could infer a Respondent’s right over the disputed domain name, or that the Respondent might be commonly known by the disputed domain name.

In addition, Respondent has not used the disputed domain name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use.

Currently, the disputed domain name merely resolves to inactive page. Before, as the Complainant has demonstrated on record, the disputed domain name redirected users to the Complainant’s official website. None of such use constitutes a *bona fide* offering of goods or services or a legitimate noncommercial or fair use and cannot under the circumstances confer on Respondent any rights or legitimate interests in the domain name. See, e.g. *Capitec Bank Limited v. Rakesh Gajjar*, WIPO Case No. [D2019-0609](#).

Moreover, the Panel also notes that the composition of the disputed domain name, carries a risk of implied affiliation or suggests sponsorship and/or endorsement by the trademark owner (see [WIPO Overview 3.0](#), section 2.5.1).

Accordingly, the Complainant has provided evidence supporting its *prima facie* claim that Respondent lacks any rights or legitimate interests in the disputed domain name. The Respondent has failed to produce countervailing evidence of any rights or legitimate interests in the disputed domain name.

Therefore, the Panel concludes that the Respondent does not have any rights or legitimate interests in the disputed domain name and the Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

### **C. Registered and Used in Bad Faith**

The third element of paragraph 4(a) of the Policy requires that the Complainant demonstrate that the Respondent registered and is using the disputed domain name in bad faith.

On the issue of registration, the Panel observes that the Complainant’s JCDECAUX trademarks significantly predate the Respondent’s registration of the disputed domain name. The Complainant is also well-established and widely recognized. In fact, given the Complainant’s global presence and its trademark registrations, the Panel deems it highly unlikely that the Respondent was unaware of the Complainant’s rights in the said trademarks. The Panel considers that with a simple Google search, the Respondent could have easily discovered the existence of the Complainant. Therefore, the Respondent knew or should have known the Complainant’s trademarks at the time of registering the disputed domain name (see [WIPO Overview 3.0](#), section 3.2.2).

Further, the mere registration of the domain name that is confusingly similar to the Complainant’s famous or widely-known trademarks by the Respondent, who is unaffiliated with the Complainant, can by itself create a presumption of bad faith (see [WIPO Overview 3.0](#), section 3.1.4). Panels have moreover found that the

redirecting the domain name to the complainant's website can establish bad faith insofar as the Respondent retains control over the redirection thus creating a real or implied ongoing threat to the complainant.

Moreover, the disputed domain name had been used to redirect users to the Complainant's official website.

Panels have found that under paragraph 4(b)(iv) of the Policy, this circumstance shall be evidence of the registration and use of a domain name in bad faith (see [WIPO Overview 3.0](#), section 3.1.4).

Therefore, in the Panel's view, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of its website or of the products on its website.

On the issue of use, the disputed domain name is currently inactive and unconnected with any *bona fide* supply of services by the Respondent. Previous UDRP panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding (see [WIPO Overview 3.0](#), section 3.3).

The Panel finds that passive holding of the disputed domain name does not, in the circumstances of this case, prevent a finding of bad faith, given: (i) the degree of distinctiveness or reputation of the Complainant's mark, (ii) the failure of the Respondent to submit a formal response or to provide any evidence of actual or contemplated good-faith use, and (iii) the prior use and implausibility of any good faith use to which the disputed domain name may be put.

In the absence of any evidence to contend against the Complainant's evidence and claims, this Panel accepts the Complainant's evidence and finds that the Respondent has registered and used the disputed domain name, without the Complainant's consent or authorization, for the likely purpose of capitalizing on the reputation of the Complainant's trademarks to target the Complainant's rights.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(iii) 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 name, <jcdecauxae.com>, be transferred to the Complainant.

*/Alissia Shchichka/*

**Alissia Shchichka**

Sole Panelist

Date: November 9, 2023