

## **ADMINISTRATIVE PANEL DECISION**

JCDECAUX v. TERRY JIM

Case No. D2024-4649

### **1. The Parties**

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

The Respondent is TERRY JIM, United States of America ("United States").

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

The disputed domain name <jcdecaux.fun> ("Disputed Domain Name") is registered with West263 International Limited (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 12, 2024. On November 13, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On November 14, 2024, 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 (Unknown) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 14, 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 November 14, 2024.

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, and the proceedings commenced on November 22, 2024. In accordance with the Rules, paragraph 5, the due date for Response was December 5, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 6, 2024.

The Center appointed Christos A. Theodoulou as the sole panelist in this matter on December 11, 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 company focusing on outdoor advertising. According to the Complainant, the company's success is driven by meeting the needs of local authorities and advertisers by a constant focus on innovation. According to the Complainant, for 60 years the company has been offering solutions that combine urban development and the provision of public services in more than 80 countries. The Complainant states that their company is currently the only group present in the three principal segments of outdoor advertising market: street furniture, transport advertising, and billboard advertising.

According to the information provided by the Complainant and not refuted by the Respondent, the Complainant now has more than 1,056,833 advertising panels in airports, rail and metro stations, shopping malls, on billboards, and Street Furniture. It is claimed by the Complainant, that the Complainant's group is listed on the Premier Marché of the Euronext Paris stock exchange and is part of Euronext 100 index. It is further supported by the Complainant, that the group is present in more than 80 different countries and 3,918 cities, and has generated revenues of EUR 3,570 million in 2023, and also employs a total of 11,650 people.

The Complainant claims to be the owner of several trademarks for JCDECAUX.

The Complainant's trademarks include:

- (i) International Trademark Registration No. 803987, JCDECAUX, registered on November 27, 2001.

Furthermore, the Complainant also owns and uses the domain names consisting of or incorporating the trademark JCDECAUX. The Complainant claims that is the owner of a large domain names portfolio, including the same distinctive wording JCDECAUX, such as the domain name <jcdecaux.com>, registered since June 23, 1997.

As it can be inferred from the case record, the Disputed Domain Name was registered on November 8, 2024, by the Respondent, and does not resolve to an active webpage.

#### **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 Name.

Notably, the Complainant contends that the Disputed Domain Name is identical to its prior trademark in which the Complainant has rights, that the Respondent lacks any rights or legitimate interests in respect of the Disputed Domain Name, and that the Respondent must have known of the Complainant's trademark and has registered and used the Disputed Domain Name in bad faith.

The Complainant states that the addition of the generic Top-Level Domain ("gTLD") ".fun" must be disregarded for the comparison. Moreover, the Complainant alleges that the Respondent has no rights or legitimate interests in the Disputed Domain Name, as the Respondent has never been known by the Disputed Domain Name; that the Respondent has no relation to the Complainant in any way; that the Complainant does not carry out any activity for, nor has any business with the Respondent. The Complainant further alleges that the Respondent was neither licensed nor authorized to make any use of the Complainant's trademark JCDECAUX, or applied for registration of the Disputed Domain Name by the Complainant.

The Complainant further asserts that given the distinctiveness of the Complainant's trademarks and reputation; it is inconceivable that the Respondent could have registered the Disputed Domain Name without actual knowledge of the Complainant's rights in the trademark, which is evidence of bad faith.

The Complainant contends that the Disputed Domain Name is inactive and that the Respondent did not use and/or has not demonstrated any activity in respect of the Disputed Domain Name, and it is not possible to conceive of any plausible actual or contemplated active use of the Domain Name by the Respondent that would not be illegitimate, such as being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law.

Lastly, according to the Complainant, the incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use.

## **B. Respondent**

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

## **6. Discussion and Findings**

The Panel shall now proceed to the analysis of the evidence in this case, and shall decide if the Complainant has satisfied the three elements of paragraph 4(a) of the Policy.

### **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 Name. 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 within the Disputed Domain Name. Accordingly, the Disputed Domain Name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel finds the mark is recognizable within the Disputed Domain Name. Accordingly, the Disputed Domain Name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. The gTLD ".fun" in the Disputed Domain Name is viewed as a standard registration requirement as such is disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.

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 Name. 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 Name such as those enumerated in the Policy or otherwise.

In particular, the Panel finds that the Respondent has not used the Disputed Domain Name with a bona fide offering; that the Respondent is not commonly known by the Disputed Domain Name; and that the Respondent has not made a legitimate noncommercial or fair use of the Disputed Domain Name.

Moreover, it is to be noted that the Respondent did not present evidence of any license or permission by the Complainant, with whom there seems to exist no relationship whatsoever.

In addition, the Panel notes that the Disputed Domain Name is identical to the Complainant's distinctive trademark and carries a high risk of implied affiliation. [WIPO Overview 3.0](#), section 2.5.1.

As a conclusion on this point, the Panel finds the second element of the Policy has been established and that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

### **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, the Panel notes that the Respondent's Disputed Domain Name has only been registered since November 8, 2024, whereas the Complainant's trademarks are registered since at least 2001. From the case record at hand, the Panel finds that the Respondent, when registering the identical Disputed Domain Name was aware of the Complainant's trademarks. Therefore, the Respondent's awareness of the Complainant's trademark rights at the time of registration suggests bad faith (See *Nintendo of America Inc v. Marco Beijen, Beijen Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite*, WIPO Case No. [D2001-1070](#), *BellSouth Intellectual Property Corporation v. Serena, Axel*, WIPO Case No. [D2006-0007](#), *Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. [D2011-2209](#)).

Panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness and reputation of the Complainant's trademark, and the composition of the Disputed Domain Name, and finds that in the circumstances of this case the passive holding of the Disputed Domain Name does not prevent a finding of bad faith under the Policy.

As a consequence of the above, 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 Name <jcdecaux.fun> be transferred to the Complainant.

*/Christos A. Theodoulou/*

**Christos A. Theodoulou**

Sole Panelist

Date: December 23, 2024