

ADMINISTRATIVE PANEL DECISION

JCDECAUX SA v. 黄文迪 (Huang Wen Di)

Case No. D2022-0444

1. The Parties

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

The Respondent is 黄文迪 (Huang Wen Di), China.

2. The Domain Name and Registrar

The disputed domain name <jcdecauxbus.top> is registered with Jiangsu Bangning Science & technology Co. Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on February 9, 2022. On February 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 10, 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.

On February 10, 2022, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On February 10, 2022, the Complainant submitted its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 in English and Chinese of the Complaint, and the proceedings commenced on February 16, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 8, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 9, 2022.

The Center appointed Deanna Wong Wai Man as the sole panelist in this matter on March 15, 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 is a company listed on the Euronext Paris stock exchange, and is headquartered in France, and is active in the advertising industry. The Complainant uses the JCDECAUX trademark for a wide range of its advertising services, particularly including the provision of advertising on street furniture, transport advertising, and billboards. The Complainant runs substantial international operations, providing evidence that it has over 10,230 employees worldwide, is present in more than 80 different countries and has generated revenues of EUR 2,312 million in 2020.

The Complainant owns a portfolio of trademark registrations for JCDECAUX, and provides evidence of registration for the word mark JCDECAUX, International trademark registration number 803987, registered on November 27, 2001, designating, *inter alia*, Turkey and Switzerland. The Complainant also owns a portfolio of official domain names, including <jcdecaux.com> registered on June 23, 1997. The relevant registered trademark adduced by the Complainant was successfully registered prior to the registration date of the disputed domain name, which is February 7, 2022.

The Complainant submits evidence proving that the disputed domain name resolved to an inactive website. However, on the date of this decision, the disputed domain name resolves to an active website seemingly offering the advertising services of a company referring to itself as “武汉市公共交通媒体” (“Wuhan public transport media”) offering advertising services on public transportation such as buses in Wuhan, China on its homepage in Chinese, and also offering other services such as filming, photo-processing, post-production, and modelling services on the other pages and on the English-language pages of such website.

5. Parties' Contentions

A. Complainant

The Complainant essentially contends that the disputed domain name is confusingly similar to its trademark for JCDECAUX, that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered, and is being used in bad faith.

The Complainant claims that its trademark is distinctive and famous, and submits a number of its marketing materials, online search engine results, and prior domain name decisions in which UDRP panels confirmed its rights in the mark JCDECAUX and in which such mark was accepted to constitute a well known trademark (see for instance *Jcdecaux SA v. Whois Privacy Protection Foundation / Anderson Paul*, WIPO Case No. [D2019-1143](#)). The Complainant particularly contends that the Respondent knew about the Complainant's trademark, which evidences its bad faith and that there are no justifications for the use of its trademark in the disputed domain name. The Complainant also contends that the Respondent is passively holding the disputed domain name and that it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate. The Complainant argues that such use of the disputed domain name does not confer rights or legitimate interests in the disputed domain name to the Respondent and constitutes registration and use in bad faith of the disputed domain name.

On the basis of the above arguments, the Complainant requests the transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

6.1. Preliminary Issue: Language of the Proceeding

Pursuant to paragraph 11(a) of the Rules, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

According to the Registrar's verification response, the language of the Registration Agreement for the disputed domain name is Chinese. Nevertheless, the Complainant filed its Complaint in English, and has requested that English be the language of the proceeding. The Panel notes that the Respondent did not comment on the language of the proceeding and did not submit any arguments on the merits of this proceeding.

The Panel has carefully considered all elements of this case in considering this request, and attaches particular relevance to the following elements: the Complainant's request that the language of the proceeding be English; the lack of comment on the language of the proceeding and the lack of response on the merits of this case by the Respondent (the Panel notes that the Respondent was timely invited by the Center in Chinese and English to provide its response in either English or Chinese, but chose not to do so); the fact that the disputed domain name is a combination of the Complainant's trademark with the word "bus" written in English rather than in Chinese; the fact that the website linked to the disputed domain name has various language versions, including a version in English, from which the Panel deduces that the Respondent understands and is capable of communicating in English; and the fact that Chinese as the language of the proceeding could lead to unwarranted delays and additional costs for the Complainant. In view of all these elements, the Panel grants the Complainant's request, and decides that the language of this administrative proceeding shall be English.

6.2. Discussion and Findings on the Merits

The Policy requires the Complainant to prove three elements:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (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.

Based on the evidence and arguments submitted, the Panel's findings are as follows:

A. Identical or Confusingly Similar

The Panel finds that the Complainant has provided sufficient evidence that it has valid rights in the mark JCDECAUX, based on its registration and use of the same as a trademark.

Moreover, as to confusing similarity of the disputed domain name with the Complainant's trademark, the disputed domain name consists of the combination of two elements, which are the Complainant's JCDECAUX trademark and the term "bus". According to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8, "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 confusing similarity under the first element." The Panel concludes that the disputed domain name contains the entirety of the

Complainant's trademark, as its sole distinctive and dominant feature, and that the addition of the term "bus" does not prevent a finding of confusing similarity. The Panel also finds that the applicable generic Top-Level Domain ("gTLD") (".top" in this proceeding) is viewed as a standard registration requirement, and may as such be disregarded by the Panel, see in this regard the [WIPO Overview 3.0](#), section 1.11.1.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark, and the Complainant has satisfied the requirements of the first element under the Policy.

B. Rights or Legitimate Interests

On the basis of the evidence and arguments submitted, the Panel finds that the Complainant makes out a *prima facie* case that the Respondent is not, and has never been, an authorized reseller, service provider, licensee, or distributor of the Complainant, is not a good faith provider of goods or services under the disputed domain name and is not making a legitimate noncommercial use or fair use of the disputed domain name. The Panel also notes that the Respondent is not commonly known by the disputed domain name. As such, the Panel finds that the burden of production regarding this element shifts to the Respondent (see [WIPO Overview 3.0](#), section 2.1). However, the Respondent did not provide any Response or evidence in this administrative proceeding.

The Panel notes that the Complainant contends that the disputed domain name resolved to an inactive website. However, upon review of the facts by the Panel, on the date of this decision, the disputed domain name resolves to an active website seemingly offering the advertising services of a company referring to itself as "武汉市公共交通媒体" ("Wuhan public transport media"), offering advertising services on public transportation such as buses on its homepage in Chinese and also offering other services such as filming, photo-processing, post-production, and modelling services on the other pages and on the English language pages of such website. The Panel also notes that such website does not accurately and prominently disclose the lack of relationship between the Complainant and the Respondent or contains any other elements pointing to the Respondent's good faith. Instead, the Panel finds that the Respondent is deliberately using the Complainant's trademark in the disputed domain name to divert Internet users to such website for the Respondent's commercial purposes (see [WIPO Overview 3.0](#), section 2.5.3). The Panel concludes that such use does not confer any rights or legitimate interests in the disputed domain name on the Respondent.

Furthermore, the Panel also finds that the nature of the disputed domain name, incorporating the Complainant's trademark JCDECAUX in its entirety, plus an additional term "bus" which is clearly related to the Complainant's core business of providing transport advertising services, carries a risk of implied affiliation and cannot constitute fair use, as it effectively impersonates the Complainant (see [WIPO Overview 3.0](#), section 2.5.1).

On the basis of the foregoing, the Panel considers that none of the circumstances of rights or legitimate interests envisaged by paragraph 4(c) of the Policy apply, and that the Complainant has satisfied the requirements of the second element under the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the registration of the disputed domain name was clearly intended to take unfair advantage of the Complainant's widely-known and intensively used trademark for JCDECAUX, by using such mark in its entirety in the disputed domain name to mislead and divert Internet users to the website hosted at the disputed domain name. The Panel considers the disputed domain name to be so closely linked and so obviously connected to the Complainant and its trademark that the Respondent's registration of the disputed domain name persuasively points toward the Respondent's bad faith. Moreover, given the fame of the Complainant's trademark for JCDECAUX, the Panel finds that the registration of the disputed domain name clearly targeted such trademark, and that the Respondent therefore knew, or at least should have known, of the existence of the Complainant's trademark. This has been reinforced by the fact that the addition of the term "bus" in the disputed domain name directly relates to the Complainant's core business of

providing transport advertising services. In the Panel's view, the preceding elements clearly establish the bad faith of the Respondent in registering the disputed domain name.

As to use of the disputed domain name in bad faith, the disputed domain name resolves to an active website seemingly offering the advertising services of a company referring to itself as “武汉市公共交通媒体” (“Wuhan public transport media”), offering advertising services on public transportation such as buses on its homepage in Chinese and also offering other services such as filming, photo-processing, post-production, and modelling services on the other pages and on the English-language pages of such website. The Panel therefore considers that the Respondent is using the Complainant's trademark in the disputed domain name to mislead Internet users and attract them to the website linked to the disputed domain name for commercial gain, enabling the Respondent to provide such Internet users with its own services. The Panel accepts that this constitutes direct evidence of bad faith under paragraph 4 (b)(iv) of the Policy. On the basis of the foregoing, the Panel finds that it has been demonstrated that the Respondent has used, and is using the disputed domain name in bad faith.

Finally, the Respondent has failed to provide any response or evidence to establish its good faith or absence of bad faith. The Panel therefore rules that the Complainant has satisfied the requirements of the third element under 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, <jcdecauxbus.top>, be transferred to the Complainant.

Deanna Wong Wai Man

Sole Panelist

Date: March 25, 2022