Decision for dispute CAC-UDRP-100367

Case number	CAC-UDRP-100367
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Domain names	ARCELORMITTAL-EGYPT.COM

Case administrator

Name	Tereza Bartošková (Case admin)

Complainant

Organization	ArcelorMittal

Complainant representative

Organization	Teissonnière Sardain Chevé A.A.R.P.I.

Respondent

Organization	Easy Tech

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The complainant is the owner of trademarks currently valid and in force for ArcelorMittal in Egypt and other countries since at least 2007.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The domain name is confusingly similar to trademarks and domain names in which the Complainant has rights (Policy, Paragraph 4(a) (i); Rules, Paragraphs 3(b) (viii), (b) (ix) (1))

The disputed domain name is confusingly similar or identical to Complainant’s above mentioned prior rights.

Firstly, it is undisputable that ArcelorMittal has rights in the mentioned marks. The registration of a mark is prima facie evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive. Respondent has the burden of refuting this assumption (WIPO Case n° D2002-0201, Janus Interantional Holding Co. v. Scott Rademacher).

“ArcelorMittal” is a well-known trademark. Complainant has spent substantial time, effort and money advertising and promoting “ArcelorMittal” throughout the world. As a result, “ArcelorMittal” has become distinctive and well-known and the company has developed an enormous amount of goodwill in the mark.

The trademarks “ArcelorMittal”, “ARCELOR” and “MITTAL” are entirely reproduced in the disputed domain name.

The disputed domain name consists of the “ArcelorMittal” trademark plus the addition of the country name Egypt. Because the Domain Name incorporates the identical “ArcelorMittal” trademark, a consumer or user of the Internet viewing a website located at the "www.arcelormittal-egypt.com" domain address would be likely to assume that the website or operator is somehow sponsored by or affiliated with ArcelorMittal, when it is not.

ArcelorMittal owns other domain names that employ the “ArcelorMittal” trademark in conjunction with a country/continent name and uses such domain names to promote its services in other countries. For example, ArcelorMittal has registered through its various entities across the world corresponding domain names as for example "arcelormittalna.com" to promote its services in North America or “arcelormittalinoxbrasil.com.br” for Brazil.

By adopting a domain name that incorporates the identical “ArcelorMittal” trademark and simply adding the name of a country, Respondent is attempting to capitalize on the "ArcelorMittal" name. Registrant clearly is hoping to mislead consumers to believe that the disputed domain name is affiliated with ArcelorMittal to attract Internet users to Respondent’s website for Respondent’s commercial gain.

Panels considering similar cases where registrants simply added a country name to a registered trademark have found such domain names to be confusingly similar to the relevant marks. For example:

a. In the WIPO Case No. D2000-0553, AT&T Corp. v. WorldclassMedia.com ("attmexico.com", "att-latinamerica.com"), transfer has been ordered where domain names incorporating the AT&T trademark plus a country or place name were found to be confusingly similar to the AT&T trademarks;

b. In the WIPO No. D2000-0713, America Online, Inc. v. Dolphin@Heart ("aolfrance.com", "aolgermany.com", "aolireland.com", "aolspain.com"), transfer has been ordered where domain names were confusingly similar because the "addition of a place name generally does not alter the underlying mark to which it is added.";

c. In the WIPO Case No. D2000-0150, Wal-Mart Stores, Inc. v. Walmarket Canada ("walmartcanada.com"), transfer has been ordered where "walmartcanada.com" domain name was found to be confusingly similar to complainant’s WAL-MART trademark;

d. In the WIPO Case No. D2000-0028, Cellular One Group v. Paul Brien (cellularonechina.com), transfer has been ordered where "cellularonechina.com" domain name was found to be identical or confusingly similar to the CELLULARONE trademark.

e. In the WIPO Case No. D2000-1633, eBay Inc. v. Sunho Hong (ebaykoreea.com), transfer has been ordered where "ebaykoreea.com" domain name was found to be identical or confusingly similar to the EBAY trademark.

Secondly, the risk of confusion between the Complainant’ trademarks and the contested domain name is all the more important in that the Complainant registered the domain name < arcelormittal.com >. The domain name is actively used and points to ArcelorMittal’s website www.arcelormittal.com.

Thirdly, the risk of confusion is also increased by the fact that the Complainant’s trademarks are well and widely known in the steel sector and are easily recognizable as such.

The Respondent has no rights or legitimate interests in respect of the domain names (Policy, Paragraph 4 (a) (ii); Rules,

Paragraph 3 (b) (ix) (2))

The Complainant claims that the Respondent has no right or legitimate interests in respect of the contested domain name.

Preliminarily, although the Complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, Panels have recognized that this could result in the often impossible task of proving a negative proposition, requiring information that is primarily if not exclusively within the knowledge of the Respondent. Thus, the consensus view is that paragraph 4(c) of the Policy shifts the burden to the Respondent to come forward with evidence of a right or legitimate interest in the Domain Name, once the Complainant has made a prima facie showing indicating the absence of such rights or interests (WIPO Case No. D2000-0270, Document Technologies, Inc. v. International Electronic Communications Inc.)

In the case at hand there is no evidence that the Respondent used the domain name but for a parking page website. This effectively shifts the burden to the Respondent to demonstrate rights or legitimate interests in the Domain Name.

Subsequently, should the above argument not be considered, the following arguments shall be taken into consideration.

Firstly, the Respondent cannot prove any use of the disputed domain name in connection with a bona fide offering of goods or services.

The Respondent is using the disputed domain name as a pay-per-click parking page. The domain name is merely a door to other websites which have paid for advertisement. When Internet users connect to the disputed domain names they are directed to a parking page showing advertising of different products and services. This is a definite diversion of potential Complainant's consumers and it cannot be considered a bona fide offering of goods and services.

UDRP panels have previously held that Respondent's use of a domain name, which incorporates a third party's trademark in connection with an Internet web site that merely lists links to third party web sites is not a bona fide offering of services and is not a legitimate non-commercial or fair use of the disputed domain name (WIPO Case No. D2007-1499, E.J. McKernan Co. v. Texas International Property Associates, WIPO Case No. D2010-1437, Lardi Ltd v. Belize Domain WHOIS Service Lt Inc, WIPO Case No. D2007-1415, Asian World of Martial Arts Inc. v. Texas International Property Associates).

Furthermore, ArcelorMittal was awarded the transfer of other landing pages in cases CAC 100358 and CAC 100359 and panels considered that no rights or legitimate interests could exist under the Policy in such cases.

To sum up, Respondent's use of the domain name as generic holding page is in no way a bona fide offering of goods and services and this only emphasizes the fact that Respondent is not making a legitimate non-commercial or fair use of the disputed domain name.

Secondly, the Respondent has no registered trademark rights in the word "arcelormittal", "arcelor" or "mittal" and there is no evidence that the Respondent is commonly known by the disputed domain name.

Thirdly, the Respondent has not been licensed or otherwise authorized to use any of the Complainant's trademarks or to apply for or use any domain name incorporating such trademarks. In similar circumstances, Panels considered that no bona fide or legitimate use of the disputed domain names could be claimed by the Respondent (WIPO Case D2000-0055, Guerlain SA v. Peikang, WIPO Case D2008-0488, BHP Billiton Innovation Pty Ltd. v. OS Domain Holdings IV LLC, WIPO Case D2009-0258, Mpire Corporation v. Michael Frey).

The domain names were registered and are being used in bad faith (Policy, paragraphs 4 (a) (iii), 4(b); Rules, paragraph 3 (b) (ix) (3))

The disputed domain name has been registered and is being used by the Respondent in bad faith.

With regard to the bad faith registration, when registering the disputed domain name, the Respondent was necessary aware of the Complainant's well-known business and widespread reputation in its notorious trademarks. Clearly, such maneuver would not have been generated if the Respondent did not know the Complainant's activities or its official website (WIPO Case D2010-1290, Meilleurtaux v. Domain Manager of Bondi Junction).

Furthermore, the disputed domain name has been registered after the registration of the relevant above mentioned trademarks. Given the international reputation of the Complainant, by choosing to register and use the domain names which is confusingly similar to the Complainant's widely known and distinctive trademark "ArcelorMittal", "ARCELOR" and "MITTAL", the Respondent intended to ride on the goodwill of the Complainant's prior rights in an attempt to exploit Internet traffic destined for the Complainant.

With regard to the bad faith use, the Policy indicates that may, "in particular but without limitation", be evidence of bad faith the fact that a respondent "by using the domain name, … [has] intentionally attempted to attract, for commercial gain, Internet users to [its] web site 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 [respondent's] web site or location of a product or service on [its] web site or location" (id., paragraph 4(b)(iv)).

In the case at hand Respondent has intentionally sought to use Complainant's marks in the disputed domain name to attract Internet users to websites and other on-line locations for commercial gain by confusing consumers as to sponsorship of the websites. This constitutes bad faith within the meaning of paragraph 4(b)(iv) of the Policy (WIPO Case No. D2000-1495, America Online, Inc. v. John Zuccarini, also known as Cupcake Message, Cupcake Messenger, The Cupcake Secret, Cupcake Patrol, Cupcake City, and The Cupcake Incident).

Consequently, the Respondent has through the use of a confusingly similar domain names, created a likelihood of confusion with the Complainant's prior rights, which constitutes a misrepresentation to the public who might think that the disputed domain names belong or are connected to the Complainant (WIPO Case D2007-0424, Alstom v. Yulei. Thus the Respondent knowingly and intentionally attempted to divert the traffic intended for the Complainant's website to its own websites.

The disputed domain name being almost identical the trademark "ArcelorMittal" it is very likely for Internet users to believe that the domain name is registered to, operated or authorised by or otherwise connected with the Complainant. The obvious envisaged result of the practice is to benefit of the strong reputation of the Complainant through misrepresentations that are likely to confuse the Internet users or business partners to the identity of the entity behind the domain name. This causes ArcelorMittal commercial detriment notably in terms of consumer confusion and the loss of the general ability to communicate with existing and potential clients or partners.

In very similar cases, Panels have been satisfied by the above mentioned arguments and assessed that domain names redirecting to parking pages have been registered and are being used in bad faith (CAC 100358 and CAC 100359).

Moreover, the disputed domain name may easily be qualified as doppelganger domain considering that web addresses can be created in order to capture data which is sent to misspelled email addresses. Additionally please note that the domain name < arcelormittal.com > is frequently used in e-mail addresses of various employees for professional correspondence (e.g. Complainant's contact e-mail details in this administrative procedure are ml.pied@arcelormittal.com). Therefore, there is remarkable high risk of sensitive data capture which might be sent to misspelled email addresses.

In our previous attempts to cease the illegitimate use of the domain name, a warning letter dated May 09, 2012 notifying Complainant's prior rights in the disputed domain name and requesting the domain name to be transferred has been sent to the Respondent. Although the Respondent has received it he never replied.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Name is identical or confusingly similar to a trademark or service mark in which the complainant has rights (within the meaning of paragraph 4(a)(i)of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the Domain Name (within the meaning of paragraph 4(a)(ii)of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the Domain Name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii)of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

1. The Panel finds that the disputed domain name <arcelormittal-egypt.com> is confusingly similar to the Complainant's earlier trade mark "ArcelorMittal". The Panel considers that the addition of a country name (in this case, "Egypt") does not alter this conclusion.

2.
Respondent cannot prove any use of the disputed domain name in connection with a bona fide offering of goods or services. UDRP panels have previously held that Respondent's use of a domain name, which incorporates a third party's trademark in connection with an Internet web site that merely lists links to third party web sites is not a bona fide offering of services. The Respondent is obviously not commonly known by the domain name and he is not making legitimate non-commercial or fair use of them. There appears to be no other basis on which the Respondent could claim any rights or legitimate interests.

In the absence of any Response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

3.
The Respondent is currently using the domain name as a pay-per-click parking page. The Complainant proved to the satisfaction of the Panel that the Respondent registered and used a domain name that is confusingly similar to Complainant's mark to attract, for commercial gain, Internet users to its web site, by creating a likelihood of confusion with Complainants' marks as to the source, sponsorship, affiliation or endorsement of its website and the services offered at such websites. UDRP 4(b)(iv).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **ARCELORMITTAL-EGYPT.COM**: Transferred

PANELLISTS

Name	**Jose Checa**

DATE OF PANEL DECISION 2012-08-28

Publish the Decision