Decision for dispute CAC-UDRP-100553

Case number	CAC-UDRP-100553
Time of filing	2013-02-07 12:30:50
Domain names	arcelormittalcement.com, arcelormittalindia.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	ArcelorMittal SA

Complainant representative

Organization	Nameshield (Laurent Becker)

Respondent

Organization	Arcelor Mittal Cement LTD

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

Complainant states that it is the owner of "several trademarks in word or in word/logo" and has provided as an annex documentation for Madrid Reg. No. 947686 for the mark ARCELORMITTAL; and U.S. Reg. No. 3,643,643 for the mark ARCELORMITTAL for use in connection with, inter alia, "[c]ommon metals and their alloys" (priority date May 25, 2007; registered on June 23, 2009).

FACTUAL BACKGROUND

Complainant has asserted the following facts (reproduced below as set forth verbatim in the Complaint) that have not been contested by the Respondent:

The Complainant is a company specialized in steel producing in the world.The Complainant is the largest steel producing company in the world and is the market leader in steel for use in automotive, construction,household appliances and packaging with operations in more than 60 countries.

It holds sizeable captive supplies of raw materials and operates extensive distribution networks. In 2011 the CNN Fortune Global 500 World’s Biggest Companies ranked the Complainant on the74th position in the world.

The Complainant owns and communicates on the Internet through various websites worldwide. The main one is “www.arcelormittal.com” (registered on 21/01/2006), but the Complainant has also registered domain names similar to trademark “ARCELORMITTAL” such as:

arcelor.com registered on 29/08/2001
arcelor.net registered on 03/09/2001
arcelormittal.net registered on 25/06/2006
arcelormittal.info registered on 25/06/2006
arcelormittal.org registered on 18/09/2011
arcelormittal.biz registered on 25/06/2006
arcelormittal.us registered on 22/12/2006
arcelormittal.in registered on 28/06/2006

...

Indeed, the Respondent created a company called « Arcelor Mittal Cement limited » on 31/07/2012 The Respondent has attempted to create a risk of confusion between the name of its company and the Complainant…. On the contrary, the Complainant contends that the Respondent registered « Arcelor Mittal Cement limited » in purpose of disrupting the Complainant’s business.

The Complainant contends that the domain names are confusingly similar to its trademarks “ARCELORMITTAL” .The Complainant confirms that the Respondent has no rights or legitimate interests in respect of the domain names and he is not related in any way with the Complainant. The Complainant does not carry out any activity for, nor has any business with the Respondent. Neither licence nor authorization has been granted to the Respondent to make any use, or apply for registration of the disputed domain names by the Complainant.

...

According the website (www.arcelormittalcement.com), the Respondent markets its products within the trademark « AMFORCE CEMENT »...

But the Complainant asserts that no trademark « AMFORCE CEMENT » has been registered by the Respondent.

...

The Complainant contends that the disputed domain names are confusingly similar to its trademark « ARCELORMITTAL » (which is incorporated in its entirety), and the addition of terms « cement » or « India » gives the impression that the domain names are related to the Complainant.

The Complainant contends that the Respondent registered the domain names only in purpose of using the notoriety of the Complainant to divert the Internet Users. Moreover, the Respondent explains that its company sells products « AMFORCE CEMENT » but no products (except the information from Respondent’s website) or trademark have been marketed.

Therefore, the Complainant contends that the Respondent registered the domain names in bad faith by using the domain name, the Respondent have intentionally attempted to attract, for commercial gain, Internet users to your 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 your website or location or of a product or service on your website or location.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Names are 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 Names (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 Names have been registered and are 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

Based upon the trademark registrations cited by Complainant and supported by relevant annexes, it is apparent that Complainant has rights in and to the trademark ARCELORMITTAL. As to whether the disputed domain names are identical or confusingly similar to the ARCELORMITTAL trademark, the relevant comparison to be made is with the second-level portion of the domain names only (i.e., “arcelormittalcement” and “arcelormittalindia”), as it is well-established that the top-level domain name (i.e., “.com”) should be disregarded for this purpose.

The addition of certain words, as here (that is, “cement”), can “exacerbate [] the confusing similarity between the [Complainant’s] trademark and the Domain Name and increase [] the risk of confusion between the Domain Name and the… trademarks.” Costco Wholesale Corporation and Costco Wholesale Membership, Inc. v. Kenneth Terrill, WIPO Case No. D2010-2124 (citing Playboy Enterprises International, Inc. v. John Taxiarchos, WIPO Case No. D2006-0561 (citing Yellow Corporation v. MIC, WIPO Case No. D2003-0748 (“when a domain name is registered which is a well-known trademark in combination with another word, the nature of the other word will largely determine the confusing similarity”)).

Here, because the word “cement” is associated with the ARCELORMITTAL trademark, this word increases the confusing similarity between the disputed domain name <arcelormittalcement.com> and Complainant’s trademark. See, e.g., Gateway Inc. v. Domaincar, WIPO Case No. D2006-0604 (finding the domain name <gatewaycomputers.com> confusingly similar to the trademark GATEWAY because the domain name contained “the central element of the Complainant’s GATEWAY Marks, plus the descriptive word for the line of goods and services in which the Complainant conducts its business”); and Guccio Gucci S.p.A. v. Hainei Zhou, WIPO Case No. D2011-1017 (finding the domain name <gucci-jewelry.com> confusingly similar to the trademark GUCCI).

Further, many previous panels under the Policy have found that a geographic identifier in a domain name (as in the disputed domain name <arcelormittalindia.com>) “actually affirms the extent to which that domain name is confusingly similar to the Complainant’s Mark.” Six Continents Hotels, Inc. v. Sdf fdgg, WIPO Case No. D2004-0384.

Accordingly, the Complainant has, to the satisfaction of the Panel, shown the Domain Names are 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).

With respect to paragraph 4(a)(ii)of the Policy, Complainant has made out a prima facie case that the Respondent lacks rights or legitimate interests, and Respondent has failed to rebut this case. Under the UDRP, “a 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 burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations

or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP." WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition (available at <http://www.wipo.int/amc/en/domains/search/overview2.0/index.html>, paragraph 2.1 ("WIPO Overview 2.0").

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

Finally, in support of its argument that Respondent has registered and is using the disputed domain names in bad faith, Complainant has provided as annexes printouts of pages from a website using the disputed domain name <arcelormittalcement.com>. This printout shows that the domain name is being used in connection with a website offering "superior quality cement" in India, from a company that "commenced its operation on 31th July, 2012." Under circumstances of the type present here, numerous previous panels have found that such use constitutes bad faith under paragraph 4(b)(iv) of the UDRP, that is, Respondent "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 or of a product or service on [its] web site or location." See, e.g., The Dow Chemical Company v. dowaychemical eva_hwang@21cn.com +86.7508126859, WIPO Case No. D2008-1078 ("The Respondent was clearly specifically targeting the Complainant's trademark and attempting to divert Internet users searching for the Complainant's product to the Respondent's website").

Further, with respect to the disputed domain name <arcelormittalindia.com>, Complainant did not include printouts of pages from an associated website, and the Panel did not locate an active website. Nevertheless, as numerous panels have made clear, "passive holding… does not as such prevent a finding of bad faith." WIPO Overview 2.0, paragraph 3.2. See also Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003. Under the circumstances of this case, including especially the website associated with the disputed domain name <arcelormittalcement.com>, the Panel finds bad faith respect to the disputed domain name <arcelormittalindia.com> as well.

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

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ARCELORMITTALCEMENT.COM**: Transferred
2. **ARCELORMITTALINDIA.COM**: Transferred

PANELLISTS

Name	**Douglas M. Isenberg**

DATE OF PANEL DECISION 2013-03-26

Publish the Decision