Decision for dispute CAC-UDRP-100756

Case number	CAC-UDRP-100756
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Domain names	arcelorstaffing.com

Case administrator

Name	Lada Válková (Case admin)

Complainant

Organization	ARCELORMITTAL S.A.

Complainant representative

Organization	Nameshield (Anne Morin)

Respondent

Organization	Arcelor Staffing Solution

OTHER LEGAL PROCEEDINGS

The panel is not informed of other legal proceedings relating to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the proprietor of numerous trade mark registrations comprising the distinctive wording ARCELOR and has provided as annex a copy of the international trade mark ARCELOR registered on 25 February 2002 under number 77812 and the international trade mark ARCELORMITTAL registered on 3 August 2007 under number 947686.

The Complainant states that he also owns several domain names, which include arcelor.biz; arcelor.com; arcelor.info; arcelor.mobi; arcelor.net; arcelor.tel; arcelor-mittal.biz; arcelor-mittal.com; arcelor-mittal.info; arcelor-mittal.jobs; and many others.

This is not contested by the Respondent.

FACTUAL BACKGROUND

The Complainant, Arcelor Mittal SA was formed by a merger of leading steelmakers Arcelor and Mittal in 2006.

Arcerlor Mittal is the largest steel producing company in the world and is market leader in steel for use in the automotive, construction, household appliances and packaging industries, with operations in more than 60 countries. The company has

its registered office in Luxembourg, Grand Duchy of Luxembourg.

The Respondent registered the Domain Name “arcelorstaffing.com” on 22 January 2014, i.e. well after the registration of Complainant’s trade marks and domain names.

PARTIES CONTENTIONS

The parties' contentions

a. Complainant

The Complainant argues that:

- The disputed Domain Name “arcelorstaffing.com” is confusingly similar to his trade mark ARCELOR. He notes that the addition of the generic term “staffing” does not change the overall impression that the Domain Name is confusingly similar to his trademark. He stresses that linking the generic term “staffing” to ARCELOR directly refers to the extensive online recruitment services of the Complainant. This creates the conceptual similarity between the disputed Domain Name and the trade mark ARCELOR. The Complainant states that the addition of the gTLD string “.COM” is not sufficient to escape the finding that the Domain Name is confusingly similar to the trade mark ARCELOR. Finally, he states that the word ARCELOR is only known in relation to the Complainant, as it has no meaning whatsoever in English or any other language.

- The Respondent does not have any rights or legitimate interest in the Domain Name arcelorstaffing.com. The Respondent does not carry out any activity for, nor has any business with the Complainant. Furthermore, the Complainant argues that the Respondent is not affiliated to him nor authorised by him in any way. No licence or authorisation has ever been granted to the Respondent to make use, or apply for registration of the Domain Name.

The Complainant notes that the Domain Name has been used for a parking page since its registration.

- Bad faith registration and use. The Complainant states that given the distinctiveness and the reputation of his trade mark, it is reasonable to conclude that the Respondent has registered the Domain Name with full knowledge of the Complainant’s marks and uses it for the purpose of misleading and diverting internet traffic. Furthermore, the Complainant notes that the Respondent has also created social network pages, where the ARCELOR trademark is also being used. This shows that the Respondent tried to create a likelihood of confusion in order to mislead the internet users. This demonstrates his bad faith in creating and maintaining the disputed Domain Name registration. Finally, the Complainant notes that the website in relation to the Domain Name provides a parking page since its registration. He notes that WIPO UDRP panels consistently ruled that the incorporation of a famous trade mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration.

b. Respondent

The Respondent, called Arcelor Staffing Solution(s), states that this is a partnership firm, started on 15 January 2014, and refers in this regard to a partnership deed, as well as to its registration with the Indian Central Board of Excise and Customs and with the Income Tax Department of India and to the Bombay Shops & Establishment Act 1948. He states that he is proceeding towards registration of Arcelor Staffing Solutions with the Registrar of Firms.

The Respondent notes that he does not provide staffing services out of India, and that he is only working in Gandhidham and surrounding areas, where he uses Facebook and Twitter to share the local job openings. He stresses that he is not related to any kind of ArcelorMittal business or related to any kind of steel business. He also states that the logo of Arcelor Staffing Solutions is not similar to the ArcelorMittal logo, and consequently he does not create confusion.

He argues that he does not use arcelorstaffing.com in bad faith. He alleges that he did not generate any revenue with this firm and that he does not have any intention of making a commercial gain with the ARCELOR name. He holds that he purchased the Domain Name from Godaddy.com, and that at the time of registration, this Domain Name was available. He

alleges that he did not have any idea that ARCELOR is a registered trademark. He further notes that in the initial stage, he experienced funding issues and that due to this, the website has not been developed and therefore the Domain Name is used for a parking Page.

RIGHTS

In order to determine whether the trademark ARCELOR and the Domain Name arcelorstaffing.com are confusingly similar in the sense of paragraph 4 (a) (i) of the Policy, a comparison needs to be made and the likelihood of Internet user confusion should be determined.

When comparing ARCELOR with the Domain Name, it should be taken into account that ARCELOR is a distinctive, well-known trade mark, where “staffing” is a generic term, lacking distinctive character in relation to staffing services. Consequently, the combination between the generic word “staffing”, with the well-known trade mark ARCELOR is insufficient to prevent Internet user confusion. In this context, the Panel refers the well-established case law under the Policy, where it is generally found that when a trademark constitutes the dominant or principal component of the domain name, the addition of a descriptive word to a trademark is generally insufficient to avoid confusing similarity in the sense of paragraph 4 (a) (i) of the Policy (BHP Billton Innovation Pty Ltd, BMA Alliance Coal Operations Pty Ltd. V. Cameron Jackson, WIPO D2008-1338; MasterCard International Incorporated v. Michael J Yanda, Indy Web Productions, WIPO D2007-1140).

Even more, it needs to be emphasized that the addition of the generic word “staffing” with the trade mark ARCELOR might increase Internet user confusion, in the sense that the Internet user could have the impression that there is a real connection between the Respondent’s Domain Name and the Complainant, in the sense that it could be perceived as a recruitment portal to apply for job openings with the Complainant.

Consequently, 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

In order to determine whether the Respondent has rights or legitimate interests in the Domain Name, the 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 proof shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in respect of the Domain Name (Accor v. Eren Atesmen, WIPO D2009-0701; Malayan Banking Berhad v. Beauty, Success & Truth International, WIPO D2008-1393).

The Complainant argues that the Respondent is not affiliated with him nor authorised by him in any way, and he notes that the Domain Name has been used for a parking page since it registration. Based on these findings, it prima facie appears that the Respondent lacks rights or legitimate interests.

Paragraph 4(c) of the Policy provides that the following circumstances can demonstrate rights or legitimate interests in the Domain Name for the purpose of paragraph 4(a)(ii):
(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 organisation) 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 non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or tarnish the trademark or service mark at issue.
The Panel is of the opinion that these conditions have not been met in the present case.

Firstly, it should be noted that the Respondent incorporated the company Arcelorstaffingsolutions on 15 January 2014. Contrary to the statements of the Respondent, the Domain Name “arcelorstaffing.com” does not match its business name. Neither does the Respondent hold any trade mark right in the sign “arcelorstaffing”. The mere allegation that it experienced

funding issues and that due to this, the website has not been developed, is not sufficient to establish use or preparation of use in good faith.

Secondly, the Respondent does not show that he is commonly known by the Domain Name by third parties before the domain name was registered (see in that sense Laurence St. Ives v. Orgatech Ltd, WIPO D.2000-1588).

Thirdly, the fact that the website has been put on a parking page does not of itself confer rights or legitimate interests arising from a bona fide offering of goods or services or from legitimate non-commercial or fair use of the Domain Name (Paris Hilton v. Deepak Kumar, WIPO D2010-1364). The fact that the trade mark of the Complainant is linked with the word "staffing" could give the impression to Internet users that it serves as a web portal in the context of recruiting activities carried out by the Complainant.

Fourthly, the fact that the Respondent alleges that he did not generate any revenue with his firm and that he does not have any intention of other commercial gain with using the Complainant's trade mark is not sufficient to establish a legitimate non-commercial or fair use of the Domain Name.

In conclusion, the Panel finds that 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 mere statement of the Respondent that at the time of registration, the Domain Name was available and that it was matching his business name does not show that he did not register the Domain Name in bad faith. Nor does the fact that the Respondent alleges that he did not have the intention of making a commercial gain with the trade mark of Complainant. The statement of the Respondent that he did not have any idea that ARCELOR is a registered trademark cannot be accepted given the fact that ARCELOR is a very well-known trade mark, also in India. The Respondent's lack of knowing the trademark is therefore highly improbable. This is supported by the fact that the Facebook page and Twitter page of the Respondent refer to a logo which is very similar to, and clearly alludes to the logo of the Complainant. This clearly proves that the Respondent knew the Complainant's trade mark.

The incorporation of a well-known trade mark into a domain name by a registrant having no plausible explanation for doing so may be, in and of itself, an indication of bad faith (General Electric Company v. CPIC NET and Hussain Syed, WIPO D2001-0087). The word "ARCELOR" is meaningless and it is clear that whoever selected the name, selected it with the Complainant's trade mark in mind. Consequently, it is reasonable to infer that the Respondent has registered the Domain nname with full knowledge of the Complainant's mark and uses it for the purpose of misleading and diverting Internet traffic (Ferrari S.p.A v. American Entertainment Group. Inc, WIPO D2004-0673).

Moreover, it has been held in UDRP decisions that the passive holding of a domain name which incorporates a well-known trademark, without obvious use for legitimate purpose, can constitute evidence bad faith (Telstra Corporation Limited v. Nuclear Marshmallows, WIPO D2000-0003). Bad faith can be established when a domain name has been registered because the trade mark is well-known, where any possible use after registration would constitute bad faith (America Online Inc. v. Chinese ICQ Network, WIPO D2000-0808). It is clear that if the Domain Name were used, it would create confusion, in the sense that Internet users could perceive the Domain Name as a portal for job offers associated with the Complainant, which would result in an illegitimate diversion of Internet traffic.

Accordingly, for the reasons discussed above, 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

The Respondent has registered and used a domain name that is confusingly similar to the Complainant's trade mark and in respect of which the Respondent has no rights or legitimate interest and which is registered and used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ARCELORSTAFFING.COM**: Transferred

PANELLISTS

Name	**Tom Heremans**

DATE OF PANEL DECISION 2014-03-23

Publish the Decision