Decision for dispute CAC-UDRP-101688

Case number	CAC-UDRP-101688
Time of filing	2017-09-19 09:48:44
Domain names	arcelormitta1.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	ArcelorMittal SA

Complainant representative

Organization	Nameshield (Maxime Benoist)

Respondent

Organization	Cimpress Schweiz GmbH

OTHER LEGAL PROCEEDINGS

The Complainant has declared that there are no such proceedings. The Panel is not aware of any such proceedings.

IDENTIFICATION OF RIGHTS

The Complainant registered the international trademark ARCELORMITTAL, number 947686, on 03. August 2007 (i.e. after the merger noted below); the mark is a number of classes, including class 6 (common metals and their alloys), and class 42 (scientific and technological services). The mark was listed as due for renewal on 3 August 2017. Information had not been supplied on whether such renewal had taken place, although proceedings were commenced in September 2017. However, the Panel has consulted the ROMARIN database and confirmed that the mark was been renewed in the normal fashion (WIPO Gazette, 2017, issue 38, 5 October 2017) and so no further consideration is necessary.

FACTUAL BACKGROUND

Complainant ArcelorMittal SA, with its seat in Luxembourg, is a large manufacturer and distributor of steel, with operations across the world, including Europe, the Americas, Asia, and South Africa. It took its present form from a merger between two enterprises (Arcelor and Mittal) in 2006.

The disputed domain name <ARCELORMITTA1.COM> was registered on 4 September 2017. The Respondent, Cimpress Schweiz GmbH, has a postal address in Switzerland.

PARTIES CONTENTIONS

No administratively compliant response has been filed.

The Czech Arbitration Court has confirmed that written notice of the Complaint sent to the Respondent was delivered; e-mails sent to the WHOIS contacts did not result in an error message, while an e-mail sent to <postmaster@arcelormitta1.com> was returned undelivered as the e-mail address had permanent fatal errors. The Respondent never accessed the online platform.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed 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).

The Complainant argues that the disputed domain name <ARCELORMITTA1.COM> is confusingly similar to its trademark ARCELORMITTAL. In particular, it contents that the only difference between the strings (disregarding the TLD as is typical in UDRP analysis) is the replacement of the letter L with the number 1.

The Panel accepts this contention. The similarity is apparent, not least because the text ARCLORMITTAL is directly derived from the names of the two prior enterprises, and there is visual similarity between L and 1. The Panel notes similar cases of the 'typo-variant' type e.g. WIPO D2012-0212 <O1AYAN.COM> (also replacing the letter L in the mark OLAYAN with the number 1).

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 disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

The Complainant declares that the Respondent has no relationship with the Complainant's business and is not authorized or licensed to use the Complainant’s trademarks.

The Respondent has not participated in the proceedings. Moreover, there is no information available to the Panel to suggest that any rights or legitimate interests are engaged.

BAD FAITH

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

No content is found at the address at present; the Complainant has supplied a screenshot of an error page associated with the online service Vistaprint (which the Panel knows to be a brand of the Respondent, through consultation of the Cimpress website), although neither the Case Administrator nor the Panel have since been able to reach any page at the address. It appears to the Panel that one of the services offered by Vistaprint is web hosting in conjunction with domain name management; as such, it can be found that this is, in essence, a case of passive holding since registration in conjunction with the minimal difference between the disputed Domain Name and the registered trademark.

It can be difficult for a Panel to find use in bad faith where a Complaint is made immediately after registration, especially where nothing is known about the circumstances of the Respondent (e.g. a pattern of conduct) and there is no evidence of specific fraudulent or deceptive activity (e.g. emails using a domain name purporting to come from the Complainant). (While there are cases under the UDRP ostensibly relating to the Respondent or a member of its corporate family, these are of limited value to an assessment of conduct, given the Respondent's apparent business model as a provider of web services to a very wide range of its users).

It is however clear, in UDRP jurisprudence, that 'passive holding' can constitute use in bad faith, especially where a Panel cannot realistically identify a situation where use would be in good faith (see WIPO Jurisprudential Overview, para 3.2

including its summary of the 'Telstra' line of cases (D2000-0003 <TELSTRA.ORG>). As in, for example, CAC 101624 <BOEHRINNGER-INGELHEIM.COM>, the Panel notes that if the intention were, for instance, to provide a critical analysis of the Complainant, a good faith attempt to do so could use an aspect of the mark rather than a misspelling, and ensure that users were not confused through explanatory text on the website.

The Panel notes the need for bad faith to be established to its satisfaction. For instance, see CAC 101570 <KALMARPARTS.NET>, a passive holding case where use in bad faith was not made out to the satisfaction of the Panel, in particular due to the failure of the Complainant in that case to create a presumption that the Respondent must have been aware of the Complainant's rights when it registered the disputed domain names, in light of the nature of the business in question. In the present case, the combination of the passive holding with the substitution of a typo-variant character (in a way that makes no independent linguistic sense) means that the Panel is well able to be so satisfied.

The Panel acknowledges that the Complainant contends that the conduct of the Respondent disrupts the Complainant's business, by diverting consumers away from its legitimate website at <ARCELORMITTAL.COM>. There is no evidence of specific activity in this area; complaints under this aspect of the UDRP (paragraph 4(b)(iii)) are more usually based on the competitive relationship between the parties or a broader pattern of misuse. Nonetheless, the matters set out in paragraph 4(b) are non-exhaustive, and passive holding can fall within it, including but not limited to as an aspect of intentionally attempting to attract, for commercial gain, Internet users to the website through 'creating a likelihood of confusion' (paragraph 4(b)(iv)).The Respondent has taken no positive steps, to the knowledge of the Panel, to displace the possible likelihood of confusion. Moreover, the deliberate registration of a name combining a version of the name in which rights are held creates a clear presumption of knowledge and intention.

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.

The Panel notes that the Case Administrator at the CAC attempted to contact the Registrar (in order to receive verification and confirmation that the disputed domain name had been locked) on four occasions between 15 September 2017 and 27 September 2017, before notifying ICANN on the latter date, as no response had been received. Following ICANN's intervention on that date, the necessary steps were duly carried out and confirmed to the CAC.

PRINCIPAL REASONS FOR THE DECISION

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 <ARCELORMITTA1.COM>. On the other hand, it is clear that the Complainant has rights in respect of the trademark ARCELORMITTAL. In light of the evidence presented regarding the use of the disputed domain name by the Respondent, and the legal findings as set out above, the Panel can find that the disputed domain name is being operated in bad faith. The requirements for the acceptance of a Complaint under paragraph 4 of the UDRP have therefore been met.

The Panel has also noted recent decisions of differently constituted Panels within the CAC concerning similar Complaints from the same Complainant (such references provided by the Complainant, for which the Panel is grateful). See for instance CAC 101267 <ARCELORMILTAL.COM>.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ARCELORMITTA1.COM**: Transferred

PANELLISTS

Name	**Prof Daithi Mac Sithigh**

DATE OF PANEL DECISION 2017-11-01

Publish the Decision