Decision for dispute CAC-UDRP-101910

Case number	CAC-UDRP-101910
Time of filing	2018-03-09 09:00:16
Domain names	mittalsteels.com

Case administrator

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

Complainant

Organization	ArcelorMittal (SA)

Complainant representative

Organization	Nameshield (Laurent Becker)

Respondent

Name	SHRUTI MITTAL

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant is the owner of several trademarks. In particular, ArcelorMittal owns the European Union Trademark no. 4233301 "MITTAL STEEL" filed on January 7, 2005, registered on March 27, 2006 and duly renewed.

FACTUAL BACKGROUND

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

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.

The disputed domain name was registered on February 11, 2018.

The Complainant states that the disputed domain name is confusingly similar to its trademark "MITTAL STEEL". The addition of the letter S is not sufficient to escape the finding that the disputed domain name is confusingly similar to the

trademark "MITTAL STEEL".

The Complainant also proved to be the owner of an important domain names portfolio, including the same distinctive wording MITTAL STEEL, such as the domain name <mittalsteel.com> registered since January 3, 2003.

The Complainant states that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant also argues that the Respondent has no relationship with Complainant's business and is not authorized or licensed to use the trademark "MITTAL STEEL".

The Complainant points out that currently the disputed domain name does not resolve to a website. However the disputed domain name previously redirected to a web page dedicated to the business of a company named “Hemkunt Iron & Steel (P) Ltd" which is a Complainant’s competitor in the field of steel. Therefore, the Complainant contends that the Respondent was aware of the Complainant when registering and subsequently using the disputed domain name and also that Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the Complainant's mark.

PARTIES CONTENTIONS

The Response was received by the CAC after the deadline. The Panel notes that, according to the CAC, the Response is not admitted to proceed further in the Administrative Proceeding since it does not annex any documentary or other evidence upon which the Respondent relies, together with a schedule indexing such documents. The CAC noted that the Respondent has not specified any factual and/or legal grounds in its Response and that accordingly it is not compliant with the UDRP Rules.

The Panel wishes to outline that the Response consists on a mere declaration that the Respondent is not more interested in using the disputed domain name. The Panel also notes that the CAC informed the parties that, in order to negotiate a settlement, each of them may submit a written notice to request a suspension of the proceeding for a limited period of time that is no longer than 14 days. After said communication no request of suspension was transmitted to CAC. Due to the above and having duly considered that the Response does not appear to contain any material which would justify a rejection of the Complaint, the Panel will proceed to a decision on the basis of the Complaint.

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).

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).

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).

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

Paragraph 4(a) of the Policy provides that to obtain the transfer of the disputed domain name, the Complainant must prove that each of the following elements is present:

(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.

1) The Complainant has established that he has rights in the trademark "MITTAL STEEL" at least since January 2005. The Complainant's trademark is registered well before with respect to the registration of the disputed domain name (February 11, 2018). The Panel finds that the disputed domain name is confusingly similar to "MITTAL STEEL" as the disputed domain name differs from the Complainant's trademark only by the use of letter "s" at the end of the word, and of the top-level domain ".com". The mere addition of the common plural signifier "s" does not avoid the confusing similarity between the disputed domain name and the mark (see, for example, SeeHalcyon Yarn, Inc. v. Henry Chan - WIPO Case No. D2004-0336; Dr. Ing. h.c. F. Porsche Aktiengesellschaft v. John Smith - WIPO Case No. D2014-1859; Bollore v. Tom Fey, CAC Case No. 101790). Furthermore, in accordance with the consensus view of past UDRP panels, the Panel finds that the Top-Level domain ".com" is not sufficient to exclude the likelihood of confusion. The Complainant therefore succeeds on the first element of the Policy.

2) The Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain name as it is not commonly known under the disputed domain name and was never authorized to use it by the Complainant. The Panel outlines that while WHOIS information for <mittalsteels.com> shows that the Respondent's name includes "Mittal" (possibly a surname) corresponding to a portion of the Complainant's trademark, there is nothing else in the WHOIS records, or in the content of the current or past associated websites, which relates the Respondent to the disputed domain name. The Respondent, in the absence of any substantial response, has not shown any facts or element to justify prior rights or legitimate interests in the disputed domain name. The Complainant therefore succeeds also on the second element of the Policy.

3) As to the registration of the disputed domain name in bad faith, the distinctive character of the Complainant's trademark and its reputation is such that, in the Panel's view, the Respondent could not ignore the trademark MITTAL STEEL at the time of the registration of <mittalsteels.com>. Furthermore, the Complainant argues that the Respondent's actions constitute bad faith use of the Domain Name pursuant to the UDRP, paragraph 4(b)(iv) because the Respondent intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website by creating likelihood of confusion with the Complainant's mark as to the affiliation or endorsement of either the Respondent or its website. In this respect it must be considered that currently the disputed domain name not resolve to an active website; however, the evidence on file shows that the disputed domain name was likely used to redirect to a website dedicated to the business of a Complainant's competitor in the field of steel. It is well-established that passive holding does not prevent a finding of bad faith. In particular, in Intel Corporation v. The Pentium Group, WIPO Case No. D2009-0273 and in Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003 panels concluded that passive holding of a domain name can be bad faith when complainant's mark has a strong reputation and respondent has provided no evidence of whatsoever of any actual or contemplated good faith use by it of the domain name. In addition, as established in Conair Corp. v. Pan Pin, Hong Kong Shunda International Co. Limited, WIPO Case No. D2014-1564, "the presence of the Domain Name in the hands of the Respondent represents, in the view of the Panel, an abusive threat hanging over the head of the Complainant (i.e., an abuse capable of being triggered by the Respondent at any time) and therefore a continuing abusive use". This is especially true in this case because the Respondent had used the disputed domain name in dispute, which is very similar to the Complainant's <mittalsteel.com> domain name to redirect to a website showing competing services.

Thus, the Panel holds that the Respondent's current passive holding of the disputed domain name amounts to bad faith use.

In consideration of the above the Complainant succeeds on the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **MITTALSTEELS.COM**: Transferred

PANELLISTS

Name	**Avv. Guido Maffei**

DATE OF PANEL DECISION 2018-04-20

Publish the Decision