Decision for dispute CAC-UDRP-102153

Case number	CAC-UDRP-102153
Time of filing	2018-09-10 11:16:21
Domain names	arcelormittal-mexico.net

Case administrator

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

Complainant

Organization	ArcelorMittal (SA)

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	Arcelormittal Mexico

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other proceedings related to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the international trademark No 947686 ARCELORMITTAL registered on August 3rd, 2007. The Complainant also owns domain names including the same distinctive wording ARCELORMITTAL, such as the domain name <arcelormittal.com>, registered and used since January 27th, 2006. The disputed domain name <arcelormittal-mexico.net> was registered on August 22nd, 2018.

FACTUAL BACKGROUND

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

The Complainant contends that it is a company specialized in 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.

The Complainant states that the disputed domain name is confusingly similar to its prior trademark ARCELORMITTAL. A domain name that wholly incorporates a complainant's registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP (WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin). Indeed, the

addition of the geographical term “MEXICO” in the trademark is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark ARCELORMITTAL. On the contrary, it worsen the likelihood of confusion, as the Complainant had activities in Mexico. (WIPO Case No. D2018-0339, Charabot SA v. Name Redacted). Furthermore, the addition of the gTLD “.NET” does not change the overall impression of the designation as being connected to Complainant’s trademark. It does not prevent the likelihood of confusion between the disputed domain name and Complainant, its trademark and its domain names associated (WIPO Case No. D2006-0451, F. Hoffmann-La Roche AG v. Macalve e-dominios S.A.).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name 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 of the Complainant’s trademark ARCELORMITTAL or apply for registration of the disputed domain name by the Complainant. Furthermore, the disputed domain name points to an inactive website since its registration. Therefore, the Complainant contends that Respondent did not make any use of disputed domain name since its registration, and it confirms that Respondent has no demonstrable plan to use the disputed domain name. It demonstrates a lack of legitimate interests in respect of the disputed domain name.

The Complainant contends that the disputed domain name is confusingly similar to its distinctive and widely known trademark ARCELORMITTAL. The notoriety of the trademark ARCELORMITTAL has been confirmed in several UDRP proceedings (CAC Case No. 101908, ARCELORMITTAL v. China Capital; CAC Case No. 101667, ARCELORMITTAL v. Robert Rudd). Given the distinctiveness of the Complainant's trademark and reputation, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark. Furthermore, the website in connection with the disputed domain name is not used since its registration. The incorporation of a famous trademark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use (WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows; WIPO Case No. D2000-0400, CBS Broadcasting, Inc. v. Dennis Toeppen).

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

(i) The domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;

and

(ii) The respondent has no rights or legitimate interests in respect of the domain name; and

(iii) The domain name has been registered and is being used in bad faith.

I. Domain Name Is Identical or Confusingly Similar to a Trademark or Service Mark

The Complainant has established the fact that it has valid rights for the international trademark No 947686 ARCELORMITTAL registered on August 3rd, 2007, and that it owns domain names including the same distinctive wording ARCELORMITTAL and is active worldwide including Mexico. The disputed domain name has been registered on August 22nd, 2018, i.e. more than 10 years after the trademark registration, and wholly incorporates the Complainant's trademark and is therefore confusingly similar to it.

The geographical term "MEXICO" in the disputed domain name does not distinguish the disputed domain name from the Complainant's trademark. Moreover as the Complainant has activities in Mexico, the added term "MEXICO" strengthens the likelihood of confusion between the disputed domain name and Complainant's trademark. The addition of the geographical top level domain ".NET" does not change the overall impression of the designation as being connected to Complainant's trademark.

The Panel therefore considers the disputed domain name to be confusingly similar to the Complainant's trademark ARCELORMITTAL which the Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

II. Rights or Legitimate Interests

The Complainant has established a prima facie case (not challenged by the Respondent) that the Respondent has no rights or legitimate interests in the disputed domain name, since the Respondent is not related in any way with the Complainant. There is no website on the disputed domain name and the disputed domain name, therefore, does not constitute a bona fide offering of goods and services or a legitimate non-commercial fair use. The Respondent has no rights or legitimate interests in the disputed domain name, since there is no indication that the Respondent is commonly known by the term "ARCELORMITTAL" or its variations or that the Respondent is using the disputed domain name in connection with a bona fide offering of goods or services.

The Panel therefore considers that the Respondent has no rights or legitimate interests in respect of the disputed domain name within the meaning of paragraph 4(a)(ii) of the Policy.

III. Domain Name Registered and Used in Bad Faith

Given the distinctiveness of the Complainant's trademark and reputation (as confirmed in several UDRP proceedings in the past - CAC Case No. 101908, ARCELORMITTAL v. China Capital; CAC Case No. 101667, ARCELORMITTAL v. Robert Rudd) it is evident that the Respondent had the Complainant and its trademarks in mind when registering the disputed domain name. Furthermore, the website in connection with the disputed domain name is not used since its registration. The incorporation of a famous trademark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use.

Finally, the Panel ascertains that the identity of the Respondent was hidden through an identity protection service Whois Privacy Protection Service, Inc. (with contact e-mail qmklhxmq@whoisprivacyprotect.com) before the commencement of this proceedings. Such attempt to hide the identity may be the evidence of bad faith registration and use as well (CAC Case No. 101839, Franke Technology and Trademark Ltd v. Caner Tanaoba).

The Panel therefore considers that 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.

The Panel finally considers that the Complainant has shown that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights, the Respondent has no rights or legitimate interests in respect of the disputed domain name and the disputed domain name has been registered and is being used in bad faith. The Complainant has thus established all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ARCELORMITTAL-MEXICO.NET**: Transferred

PANELLISTS

Name	**JUDr. Petr Hostaš**

DATE OF PANEL DECISION 2018-10-18

Publish the Decision