Decision for dispute CAC-UDRP-102256

Case number	CAC-UDRP-102256
Time of filing	2018-12-10 09:21:56
Domain names	arcelormittal-planta.com

Case administrator

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

Complainant

Organization	ArcelorMittal (SA)

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	Fernando Diaz Ramirez

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other pending or decided legal proceedings relating to the Disputed Domain Name.

IDENTIFICATION OF RIGHTS

Complainant is the owner of the international trademark n° 947686 ARCELORMITTAL registered on August 3, 2007.

FACTUAL BACKGROUND

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

The Complainant, is a company specialized in steel producing in the world. See website at www.arcelormittal.com.

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 Complainant also owns an important domain names portfolio, including the same distinctive wording ARCELORMITTAL, such as the domain name <arcelormittal.com> registered since January 27, 2006.

The Disputed Domain Name was registered on December 4, 2018.

The Complainant sent a cease and desist letter to the hosting provider of the website, which deleted the content of the website. However, before its intervention, the Disputed Domain Name resolved to a website displaying the Complainant's trademark and looking like the official website of the Complainant.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

1. The Disputed Domain Name is confusingly similar to the protected mark.

The Disputed Domain Name <arcelormittal-planta.com> is confusingly similar to the Complainant's trademark ARCELORMITTAL. The trademark ARCELORMITTAL is included in its entirety.

The Complainant contends that the addition of the term "PLANTA" is not sufficient to escape the finding that the Disputed Domain Name is confusingly similar to the trademark ARCELORMITTAL. It does not change the overall impression of the designation as being connected to the Complainant's trademark ARCELORMITTAL. It does not prevent the likelihood of confusion between the Disputed Domain Name and the Complainant.

On the contrary, the addition of the term "PLANTA", which means "PLANT" in Spanish, worsens the likelihood of confusion between the Disputed Domain Name and the Complainant's trademark ARCELORMITTAL, as the Complainant is a leader in steel industry.

It is well-established that "a domain name that wholly incorporates a Complainant's registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP". Moreover, the Complainant contends that the addition of the generic Top-Level Domain suffix ".COM" does not change the overall impression of the designation as being connected to the trademark ARCELORMITTAL. It does not prevent the likelihood of confusion between the Disputed Domain Name and the Complainant.

So the Disputed Domain Name is confusingly similar to Complainant's trademark ARCELORMITTAL.

2. The Respondent does not have any rights or legitimate interest in the Disputed 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 Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the Policy.

The Complainant asserts that the Respondent is not known as the Disputed Domain Name.

Past panels have held that a Respondent was not commonly known by a disputed domain name if the Whois information was not similar to the disputed domain name. Thus, the Respondent is not known as the Disputed Domain Name.

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 license 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.

Moreover, before the Complainant's intervention, the Disputed Domain Name resolved to a website which looked like the official website of the Complainant. Thus, the owner of the Disputed Domain Name obviously tries to pass itself off as an affiliate of the Complainant in Mexico for its commercial gain. Therefore, the Respondent is not using the Disputed Domain Name in connection with a bona fide offering of goods or services or a legitimate noncommercial or fair use.

Thus, in accordance with the foregoing, the Complainant contends that the Respondent has no right or legitimate interest in respect of the Disputed Domain Name.

3. The Disputed Domain Name has been registered and is being used in bad faith.

The Complainant contends that the Disputed Domain Name is confusingly similar to its distinctive trademark ARCELORMITTAL. The Complainant's trademark ARCELORMITTAL is widely known. Given the distinctiveness of the Complainant's trademarks and reputation, it is reasonable to infer that the Respondent has registered the Disputed Domain Name with full knowledge of the Complainant's trademark.

Moreover, before the Complainant's intervention, the Disputed Domain Name resolved to a website, which displayed the Complainant's trademark and looks like its official website. Therefore, the Complainant contends that by using the Disputed Domain Name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of the website.

Thus, Complainant contends that Respondent has registered the Disputed Domain Name and is using it in bad faith.

RESPONDENT:

No administratively compliant Response was 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

As contained under paragraph 4(a) of the Policy, for the Complaint to succeed in relation to the Disputed Domain Name, the Complainant must show the following:

(i) The Disputed 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 Disputed Domain Name; and

(iii) The Disputed Domain Name has been registered and is being used in bad faith.

In this case, the Respondent failed to produce a Response, therefore, the Panel may treat as uncontested the assertions put forth by the Complainant. Now, the Panel will turn to review each of these elements.

A. Identical or Confusingly Similar

The Complainant, through evidence on record, has established its rights in the trademark ARCELORMITTAL, since 2007. Additionally, the Complainant submitted evidence showing the trademark has achieved recognition through its use and is widely-known.

The second step under this element requires the Panel to determine if the Disputed Domain Name is confusingly similar to the Complainant's trademarks. As part of this analysis, the Panel notes that the Disputed Domain Name incorporates the entirety of the trademark, namely "ARCELORMITTAL", with the addition of the text "planta", using a hyphen to separate the trademark and the word. This additional text appears to be in Spanish and it roughly translates to "plant" or "factory", both of which can be synonymous. If the Panel acknowledges the meaning to be "factory" and/or the synonymous acceptation of "plant", it would signify that it is meant to reference a commonly used term in relation to one of the main activities of the Complainant, namely steel production. This fact reinforces the conclusion that the additional text is of secondary importance to the main element of the Disputed Domain Name, namely "ARCELORMITTAL" and has been included in order to enhance the likelihood of confusion between the Disputed Domain Name and the trademark, but the Panel will delve into this under the subsequent elements.

Based on this, and as per the evidence on record, the Panel finds that the Disputed Domain Name contains the totality of the trademark, which is clearly identified and the additional text does not dispel the confusing similarity between the Disputed Domain Name and the Complainant's trademark, as elucidated under paragraph 1.8 of WIPO Overview 3.0.

The Panel therefore finds that the Complaint has satisfied the first element set under paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

The Complainant alleges that the Respondent is not commonly known as the Disputed Domain Name, does not carry out any activity for, nor has any business relations with the Respondent. Furthermore, the Respondent is not beneficiary of a license or authorization granted by the Complainant. Based on these allegations, and the guidance contained under paragraph 2.1 of WIPO 3.0 Overview, it is the view of the Panel that this is enough to establish a prima facie case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name.

Additionally, as per the evidence on record, the Respondent, in the website that resolves from the Disputed Domain Name, utilized the Complainant's trademark and reproduced the look and feel of one of the Complainant's websites, giving the appearance that the Disputed Domain Name is directly related to the Complainant. This is further supported by the use of the generic term "planta" in the Disputed Domain Name, which is meant to further cement the misrepresentation, which in the view of the Panel amounts to impersonation/passing off in the terms described under paragraph 2.13.1 of WIPO Overview 3.0. This passing off, under no circumstances, can confer rights or legitimate interests on the Respondent and there is no available evidence on record that would otherwise allow the Panel to find any rights or legitimate interests for the Respondent in the Disputed Domain Name.

Hence, the Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Name and therefore the Complainant has fulfilled the second requirement set under paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

In relation to the third element, and as per the evidence on record, namely the content of the website resolving from the Disputed Domain Name – which replicates the Complainant's trademark and the look and feel of one of the main websites of the Complainant – it is more than likely that the Respondent was aware of the Complainant and targeted the

Complainant's trademarks when registering the Disputed Domain Name for commercial gain by benefiting from the likelihood of confusion. This fact creates a presumption of bad faith, being that the Complainant's trademark is widely-known, as per paragraph 3.1.4 of WIPO Overview 3.0. The Panel therefore finds that the registration and use of the Disputed Domain Name has been in bad faith, as it encompasses the breadth of the conducts contained in the indicative list under paragraph 4(b)(iv) of the Policy.

The Panel consequently finds that the Complainant has satisfied the third and final element required under paragraph 4(a)(iii) of the Policy.

D. Decision

For the preceding reasons and in conformity with the provisions contained under Paragraph 4(i) of the Policy and Paragraph 15 of the Rules, the Panel orders the transfer of the Disputed Domain Name to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ARCELORMITTAL-PLANTA.COM**: Transferred

PANELLISTS

Name	**Rodolfo Carlos Rivas Rea**

DATE OF PANEL DECISION 2019-01-08

Publish the Decision