Decision for dispute CAC-UDRP-102294

Case number	CAC-UDRP-102294
Time of filing	2019-01-11 10:00:11
Domain names	mittalmetal.com, mittal-metals.com, mittalmetalsltd.com

Case administrator

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

Complainant

Organization	ArcelorMittal (SA)

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Organization	ANKIT ENTERPRISES

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any legal proceedings pending or decided which relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

Complainant is the owner of the international trademark n° 1198046 MITTAL® registered on December 5, 2013.

Complainant also owns a domain names portfolio, including MITTAL®, such as the domain name <mittalsteel.com> registered since January 3, 2003.

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 (please see their 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 disputed domain names were registered on January 5, 2018 and currently resolve to a registrar parking page.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

COMPLAINANT'S CONTENTIONS:

The disputed domain names are confusingly similar to the Complainant's trademark MITTAL®. Indeed, the trademark MITTAL® is included in its entirety.

The Complainant contends that the addition of the term "METAL", "METALS" and "LTD" is not sufficient to escape the finding that the disputed domain names are confusingly similar to the trademark MITTAL®. It does not change the overall impression of the designations as being connected to the Complainant's trademark MITTAL®. It does not prevent the likelihood of confusion between the disputed domain names and the Complainant, its trademark and the domain name associated.

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". Please see WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin.

On the contrary, the addition of the term "METAL", in singular or plural form, worsens the likelihood of confusion between the disputed domain names and the Complainant's trademark MITTAL®. Indeed, this term is related to the Complainant's activities and the trademark MITTAL is registered in class 6 for several products, including "Common metals".

Prior panels have held that the addition of words can worsen the confusing similarity between a trademark and a domain name.

Please see for instance WIPO Case No. D2010-2124, Costco Wholesale Corporation and Costco Wholesale Membership, Inc. v. Kenneth Terrill: "The addition of certain words, as here, can "exacerbate […] the confusing similarity between the [Complainant's] trademark and the Domain Name and increase […] the risk of confusion between the Domain Name and the […] trademarks."

Moreover, the Complainant contends that the addition of the generic Top-Level Domain suffix ".COM" does not change the overall impression of the designations as being connected to the trademark MITTAL®. It does not prevent the likelihood of confusion between the disputed domain names and the Complainant, its trademark and its domain name associated.

Please see WIPO Case No. D2006-0451, F. Hoffmann-La Roche AG v. Macalve e-dominios S.A. ("It is also well established that the specific top level of a domain name such as ".com", ".org" or ".net" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar.").

Finally, many UDRP decisions have confirmed the Complainant's rights such as:

- WIPO Case No. Case No. D2018-1086, ArcelorMittal S.A. v. Registrant of lakshmimittal.org, c/o WHOIStrustee.com Limited / Zeus Holding Market Ltd., <lakshmimittal.org>;

- WIPO Case No. D2016-0449, Arcelormittal S.A. v. Ram Mittal, <mittal-investment.com>;

- WIPO Case No. D2014-1677, Arcelormittal S.A. v. Navin Mandla, <lakshmimittal.london>.

Consequently, the disputed domain names are confusingly similar to Complainant's trademark MITTAL®.

The Respondent does not have any rights or legitimate interest in the disputed domain names.

According to WIPO Case No. D2003-0455 Croatia Airlines d. d. v. Modern Empire Internet Ltd., 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 names but as “ANKIT ENTERPRISES”.

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 names. Please see for instance:

- FORUM Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com> (“Here, the WHOIS information of record identifies Respondent as “Chad Moston / Elite Media Group.” The Panel therefore finds under Policy 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy 4(c)(ii).”).

- FORUM Case No. FA 699652, The Braun Corporation v. Wayne Loney.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain names 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 MITTAL®, or apply for registration of the disputed domain names by the Complainant.

Moreover, the disputed domain names resolve to a parking page. The Complainant contends that Respondent did not make any use of disputed domain names since their registration, and it confirms that Respondent has no demonstrable plan to use the disputed domain names. It demonstrates a lack of legitimate interests in respect of the disputed domain names.

Please see FORUM Case No. 1785596, King Ranch IP, LLC v. E Miller (“Additionally, Respondent makes no material demonstrable preparations to use the <kingranchbbq.com> domain name. The domain name simply links to a parking page. Holding a confusingly similar domain name inactively, as does Respondent, is not indicative of any bona fide offering of goods or services under Policy 4(c)(i), nor of a non-commercial or fair use under Policy 4(c)(iii).”).

Thus, in accordance with the foregoing, the Complainant contends that the Respondent has no right or legitimate interest in respect of the disputed domain names.

The disputed domain names have been registered and are being used in bad faith.

The Complainant contends that the disputed domain names are confusingly similar to its distinctive trademark MITTAL®.

The Complainant’s trademark MITTAL® is widely known. Past panels have confirmed the notoriety of the trademark MITTAL® in the following cases:

- WIPO Case No. D2018-1086, ArcelorMittal S.A. v. Registrant of lakshmimittal.org, c/o WHOIStrustee.com Limited / Zeus Holding Market Ltd. ("The Domain Name wholly incorporates a well-known mark [MITTAL]”)

- WIPO Case No. D2010-2049, Arcelormittal v. Mesotek Software Solutions Pvt. Ltd. (“the Complainant’s marks MITTAL and MITTAL STEEL have been widely used and are well-known.”)

Given the distinctiveness of the Complainant's trademarks and reputation, it is reasonable to infer that the Respondent has registered the domain names with full knowledge of the Complainant's trademark.

Moreover, this disputed domain names resolve to a registrar parking page. The Complainant contends that the Respondent fails to make an active use of the disputed domain names. Failure to make an active use of a domain name is evidence of bad faith.

Please see FORUM Case No. FA 1786533, Guess? IP Holder L.P. and Guess?, Inc. v. xi long chen ("As noted previously, Complainant offers screenshots of the resolving webpage for the disputed domain name. The Panel finds that Respondent's inactive use of the disputed domain name indicates bad faith registration and use per Policy 4(a)(iii).").

Thus, Complainant contends that Respondent has registered the disputed domain names and is using them in bad faith.

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

The disputed domain names registered in 2019 are confusingly similar to the Complainant's MITTAL trade mark (registered as an international trade mark for metals as of 2013) adding only the generic words metal or metals, a hyphen and/or the generic term 'ltd' and the gTLD .com. 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". Please see WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin.

The Respondent is not commonly known by the disputed domain names but by the name Ankit Enterprises.

Please see for instance:

- FORUM Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com> ("Here, the WHOIS information of record identifies Respondent as "Chad Moston / Elite Media Group." The Panel therefore finds under Policy 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy 4(c)(ii).")

The Respondent has not been authorised to use the disputed domain names by the Complainant.

The disputed domain names have been pointed to parking pages which are not a bona fide offering of goods or services or a non-commercial legitimate or fair use where a domain name has been registered containing a well-known mark.

Please see FORUM Case No. 1785596, King Ranch IP, LLC v. E Miller ("Additionally, Respondent makes no material demonstrable preparations to use the <kingranchbbq.com> domain name. The domain name simply links to a parking page. Holding a confusingly similar domain name inactively, as does Respondent, is not indicative of any bona fide offering of goods or services under Policy 4(c)(i), nor of a non-commercial or fair use under Policy 4(c)(iii).")

Accordingly the Panel is persuaded that the Respondent has no rights or legitimate interests in the disputed domain names.

Past panels have confirmed the notoriety of the trademark MITTAL® in the following cases:

- WIPO Case No. D2018-1086, ArcelorMittal S.A. v. Registrant of lakshmimittal.org, c/o WHOIStrustee.com Limited / Zeus Holding Market Ltd. ("The Domain Name wholly incorporates a well-known mark [MITTAL]")

- WIPO Case No. D2010-2049, Arcelormittal v. Mesotek Software Solutions Pvt. Ltd. ("the Complainant's marks MITTAL and MITTAL STEEL have been widely used and are well-known.")

The Respondent has not answered this Complaint or indicated why he should be allowed to register domain names containing the Complainant's well-known mark with the word 'metal' or 'metals' which indicates a connection with the Complainant and shows the Respondent is aware of the Complainant and its rights. Accordingly the Panel is persuaded the disputed domain names are cybersquatting registration which are being passively held and that the names have been registered and used in bad faith under the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **MITTALMETAL.COM**: Transferred
2. **MITTAL-METALS.COM**: Transferred
3. **MITTALMETALSLTD.COM**: Transferred

PANELLISTS

Name	**Dawn Osborne**

DATE OF PANEL DECISION 2019-02-06

Publish the Decision