Decision for dispute CAC-UDRP-102291

Case number	CAC-UDRP-102291
Time of filing	2019-01-11 09:58:40
Domain names	arcelormltttal.com

Case administrator

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

Complainant

Organization	ArcelorMittal (SA)

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	Sanchez Juan Carlos

OTHER LEGAL PROCEEDINGS

The Panel is not aware of 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 the international trademark number 947686 'ARCELORMITTAL' registered on August 3, 2007. The Complainant also owns a portfolio of domain names, including the wording 'ARCELORMITTAL', such as the domain name <arcelormittal.com> registered on January 27, 2006.

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. The Complainant is one of the largest steel producing companies 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 is the owner of the international trademark number 947686 'ARCELORMITTAL' registered on August 3, 2007. The Complainant also owns a portfolio of domain names, including the wording 'ARCELORMITTAL', such as the

domain name <arcelormittal.com> registered on January 27, 2006.

The disputed domain name was registered on January 5, 2019. The disputed domain name resolves to an inactive website.

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

Rights and Confusingly Similar

The Complainant contends that it is the owner of the international trademark number 947686 ‘ARCELORMITTAL’ registered on August 3, 2007. The Panel notes that an international registration of a trademark is sufficient to establish rights in that trademark. As such, the Panel finds that the Complainant has established its rights in the trademark ‘ARCELORMITTAL.’

The Complainant contends that the disputed domain name is confusingly similar to its trademark ARCELORMITTAL by asserting that the substitution of the letter “I” by the letter “L” and the addition of the letter “T” is not sufficient to escape the finding that the disputed domain name is confusingly similar to the Complainant's trademark. Furthermore, the Complainant contends that the addition of the gTLD '.com.' does not change the overall impression of the designation as being connected to the Complainant’s trademark. The Panel agrees with the Complainant, and thus it finds that the disputed domain name is confusingly similar to the Complainant's trademark.

No rights or legitimate interests

Complainant must first make a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain name under paragraph 4(a)(ii) of the Policy, then the burden shifts to Respondent to show it does have rights or legitimate interests. See Croatia Airlines d. d. v. Modern Empire Internet Ltd., WIPO Case No. D2003-0455 (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 UDRP). See also Advanced International Marketing Corporation v. AA-1 Corp, FA 780200 (FORUM Nov. 2, 2011) (finding that a complainant must offer some evidence to make its prima facie case and satisfy paragraph 4(a)(ii) of the Policy.

The Complainant contends that the Respondent has no right or legitimate interest in respect of the disputed domain name. First of all, it asserts that the Respondent is not known by the disputed domain name. Where a response is lacking, WHOIS

information may be used to determine whether a respondent is commonly known by the disputed domain name under paragraph 4(c)(ii) of the Policy. See Amazon Technologies, Inc. v. LY Ta, FA 1789106 (FORUM June 21, 2018) (concluding a respondent has no rights or legitimate interests in a disputed domain name where the complainant asserted it did not authorize the respondent to use the mark, and the relevant WHOIS information indicated the respondent is not commonly known by the domain name). Additionally, lack of authorization to use a complainant's mark may indicate that the respondent is not commonly known by the disputed domain name. See Emerson Electric Co. v. golden humble / golden globals, FA 1787128 (FORUM June 11, 2018) ("lack of evidence in the record to indicate a respondent is authorized to use [the] complainant's mark may support a finding that [the] respondent does not have rights or legitimate interests in the disputed domain name per paragraph 4(c)(ii) of the Policy"). The WHOIS information for the disputed domain name lists the registrant as "Registration Private," and there is no other evidence to suggest that the Respondent was authorized to use the 'ARCELORMITTAL' mark. Therefore, the Panel finds that the Respondent is not commonly known by the disputed domain name per paragraph 4(c)(ii) of the Policy.

The Complainant further contends that the Respondent 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; the disputed domain name resolves to an inactive page; and the Respondent has no demonstrable plan to use the disputed domain name.

The Panel finds that the Complainant has made out a prima facie case that arises from the considerations above. All of these matters go to make out the prima facie case against the Respondent. As the Respondent has not filed a Response or attempted by any other means to rebut the prima facie case against it, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

Bad faith

The Complainant contends that the Respondent has registered the disputed domain name and is using it in bad faith. The Complainant contends that the disputed domain name is inactive since its registration; inactively holding a confusingly similar domain name shows bad faith under paragraph 4(a)(iii) of the Policy; and as prior WIPO UDRP panels have held, the incorporation of a famous trademark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use.

The Panel agrees that the passive holding of a domain name does not necessarily circumvent a finding that the domain name is being used in bad faith within the requirements of paragraph 4(a)(iii) of the Policy. See Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003 (finding that in considering whether the passive holding of a domain name, following a bad faith registration of it, satisfies the requirements of paragraph 4(a)(iii), the panel must give close attention to all the circumstances of the respondent's behavior, and a remedy can be obtained under the Policy only if those circumstances show that the respondent's passive holding amounts to acting in bad faith.)

The particular circumstances of this case that the Panel has considered are:

i) The Complainant is one of the largest steel producing companies 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. Past panels have confirmed the notoriety of the Complainant's trademark 'ARCELORMITTAL' in the following cases: CAC Case No. 101908, ARCELORMITTAL v. China Capital ("The Complainant has established that it has rights in the trademark "ArcelorMittal", at least since 2007. The Complainant's trademark was registered prior to the registration of the disputed domain name and is widely well-known."); and CAC Case No. 101667, ARCELORMITTAL v. Robert Rudd ("The Panel is convinced that the Trademark is highly distinctive and well-established."), and

ii) The Respondent has provided no evidence whatsoever of any actual or contemplated good faith use by it of the disputed domain name.

Taking into account all of the above, the Panel concludes that the Respondent's passive holding of the disputed domain

name constitutes bad faith under paragraph 4(a)(iii) of the Policy and that the Respondent is using the disputed domain name in bad faith.

Next, the Complainant contends that 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. The Panel infers due to the fame and notoriety of the Complainant's 'ARCELORMITTAL' mark that the Respondent had actual knowledge of Complainant's rights in the mark prior to registering the disputed domain name and finds that actual knowledge is adequate evidence of bad faith under paragraph 4(a)(iii) of the Policy. See Orbitz Worldwide, LLC v. Domain Librarian, FA 1535826 (FORUM Feb. 6, 2014) ("The Panel notes that although the UDRP does not recognize 'constructive notice' as sufficient grounds for finding paragraph 4(a)(iii) of the Policy bad faith, the Panel here finds actual knowledge through the name used for the domain and the use made of it.").

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ARCELORMLTTTAL.COM**: Transferred

PANELLISTS

Name	**Mr. Ho-Hyun Nahm, Esq.**

DATE OF PANEL DECISION 2019-02-09

Publish the Decision