Decision for dispute CAC-UDRP-102470

Case number	CAC-UDRP-102470
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Domain names	arcelormitalmexico.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	ARCELORMITTAL (SA)

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Organization	acero

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant has submitted evidence, which the Panel accepts, showing that it is the registered owner of the following:
- International trademark ARCELORMITTAL (registration n°947686) dated August 03, 2007.

Moreover, the Complainant is also the owner of the domain names bearing the sign “ARCELORMITTAL” such as the domain names arcelormittal.com registration since January 27, 2006 and arcelormittalmexico.com registration since October 12, 2017.

FACTUAL BACKGROUND

The Complainant is a company specialized in steel producing for use in automotive, construction, household appliances and packaging. The complainant operates in more than 60 countries and it holds sizeable captive supplies of raw materials and operates extensive distribution networks.

The Complainant holds the international trademark registration for “ARCELORMITTAL” (registration n°947686) dated August 03, 2007 and the Complainant also holds domain names bearing “ARCELORMITTAL”.

On April 24, 2019, the Respondent registered the disputed domain name <arcelormitalmexico.com>. The domain name is currently available on https://arcelormitalmexico.com/ and contains the Complainant‘s trademark ‘‘ARCELORMITTAL‘‘ and provides information regarding the Complainant and its activities.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

The Complainant is a company specialized in steel producing and is the leading company in its sector. The Complainant operates in more than 60 countries.

The Complainant holds international trademark registration for the trademark “ARCELORMITTAL” and also is the owner of the domain names bearing the sign “ARCELORMITTAL” namely <arcelormittal.com> and <arcelormittalmexico.com>.

1. THE DISPUTED DOMAIN NAME IS CONFUSINGLY SIMILAR TO THE COMPLAINANT’S TRADEMARK „ARCELORMITTAL“

The disputed domain name is confusingly similar to the Complainant’s trademarks “ARCELORMITTAL” as it bears the Complainant’s “ARCELORMITTAL” trademark with the deletion of the letter ‘‘T’’.

The Complainant alleges that the deletion of the letter ‘‘T’’ and the addition of the geographic term ‘‘MEXICO’’ are not sufficient to abolish the confusing similarity between the disputed domain name and the ‘‘ARCELORMITTAL’’ trademark. Furthermore, the addition of the ‘‘MEXICO’’ word even increase the likelihood of confusion since the Complainant is present in Mexico.

The Complainant also states that the addition of the gTLD ‘‘COM’’ does not change the overall impression of the designation as being connected to the Complainant’s trademark ‘‘ARCELORMITTAL’’.

Such attempts have been disapproved in various decisions e.g. WIPO Case No. D2006-0451, F. Hoffmann-La Roche AG v. Macalve e-dominios S.A., WIPO Case No. DMX2018-0024; ArcelorMittal (SA) v. Registration Private <arcelormittalmexico.mx>;
WIPO Case No. D2018-1974, Arcelormittal (SA) v. مسعود ثقفي <arcelormittaliran.com>;
WIPO Case No. D2018-1976, ArcelorMittal S.A. v. Ruben Gomez <arcelormittal-mexico.com>.

2. THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Complainant states that the Respondent has no rights on the disputed domain name as the Respondent is not known as the disputed domain name. The past panel decisions e.g. 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> ,FORUM Case No. FA 699652, The Braun Corporation v. Wayne Loney are precedents for the concrete case.

The Complainant also alleges that the Respondent has no rights to the disputed domain name since the Respondent has no relationship with Arcelormittal S.A. In fact, the Respondent and the Complainant do not carry out any activity or business together.

Moreover, the Complainant states that neither license nor authorization has been granted to the Respondent to use the Complainant’s trademark “ARCELORMITTAL”.

The Complainant states that the ‘‘ARCELORMITTAL’’ is a well-known trademark and its notoriety has been accepted within

the earlier decisions such as 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 (February 7, 2018) 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.").

3. THE DISPUTED DOMAIN NAME WAS REGISTERED AND IS USED IN BAD FAITH

The Complainant states that the ‘’ARCELORMITTAL’’ is a well-known trademark and its notoriety has been accepted within the earlier decisions such as 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 (February 7, 2018) 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.").

The Complainant asserts that the disputed domain name resolves to a website which contains the Complainant’s well-known trademark and further the Respondent presents itself as ‘’Arcelormittal Mexico‘‘. Therefore, the Complainant states that the Respondent knew about the Complainant and its rights before the registration of the disputed domain name.

Disputed Domain Name was registered and is being used in bad faith. The Complainant alleges that, as is stated before, the disputed domain name resolves to a website which displays the Complainant’s trademark and where the Respondent identifies itself as ‘’Arcelormittal Mexico’’ and accordingly the Respondent has an intention to attract the users for commercial gain and the Respondent creates an impression as there exists a sponsorship, affiliation or endorsement between the Respondent and the Complainant.

RESPONDENT:

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

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In this context, the Panel also notes that the burden of proof is on the Complainant to make out its case and past UDRP panels have consistently said that a Complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

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

A. The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and

B. The Respondent has no rights or legitimate interests in respect of the disputed domain name; and

C. The disputed domain name has been registered and is being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.

A. IDENTICAL OR CONFUSINGLY SIMILAR

The Policy simply requires the Complainant to demonstrate that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The Panel is satisfied that the Complainant is the owner of registration of the “ARCELORMITTAL” trademark.

The Panel finds that the disputed domain name is nearly identical with the Complainant’s “ARCELORMITTAL” trademark since the deletion of the letter ‘T’ is not sufficient to vanish the similarity.

In particular, this case represents a clear example of typo-squatting, where the disputed domain name is one letter less than the Complainant's mark where the additional letter in the mark is the repetition of the previous one.

Further, the addition of the ‘‘MEXICO‘‘ word is not enough to abolish the similarity as it is a geographic term and moreover, it increases the confusion since the Complainant Arcelormittal S.A. operates in Mexico.

The Panel is of the opinion that the internet users will easily fall into false impression that the disputed domain name is an official domain name of the Complainant. The Panel recognizes the Complainant's rights and concludes that the disputed domain name is confusingly similar with the Complainant's trademarks. Therefore, the Panel concludes that the requirements of paragraph 4(a)(i) of the Policy is provided.

B. NO RIGHTS OR LEGITIMATE INTERESTS

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

It is open to a Respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

(i) before any notice to the respondent of the dispute, the use or making demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) the respondent of the dispute (as an individual, business, or other organization) has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

(iii) the respondent of the dispute is making a legitimate non-commercial or fair use of the domain name, without an intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Thus, if the Respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the disputed domain name, the Complainant will have failed to discharge its burden of proof and the Complaint will fail. The burden is on the Complainant to demonstrate a prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain name. Once the Complainant has made out a prima facie case, then the

Respondent may, inter alia, by showing one of the above circumstances, demonstrate rights or legitimate interests in the disputed domain name.

The Complainant contends that the Respondent has nothing to do with the Complaint and any use of the trademark ARCELORMITTAL has to be authorized by the Complainant and there is no such authorization. Moreover, the disputed domain name has no relation with the Respondent and the Respondent is not commonly known as the disputed domain name. Finally, there is no fair or non-commercial uses of the disputed domain name found as well.

In the absence of a response, the Panel accepts the Complainant's allegations that the Respondent has no authorization to use the Complainant's trademarks in the disputed domain name as true. Hence, as the Complainant has made out its prima facie case, and as the Respondent has not demonstrated any rights or legitimate interests as illustrated under paragraph 4(c) of the Policy, nor has the Panel found any other basis for finding any rights or legitimate interests of the Respondent in the disputed domain name, the Panel concludes that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. BAD FAITH

The Panel concludes that the Complainant's "ARCELORMITTAL" trademark has a significant reputation and is of distinctive character. Therefore, the Panel is of the opinion that due to the earlier rights of the Complainant in the "ARCELORMITTAL" trademark and the associated domain names, the Respondent, was aware of the Complainant and its trademark at the time of registration of the disputed domain name (see e.g., Ebay Inc. v. Wangming, WIPO Case No. D2006-1107). Referring to Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net, WIPO Case No. D2000-0226, the Panel believes that the awareness of the Complainant's trademark at the time of the registration of the disputed domain name is to be considered an inference of bad faith registration.

Moreover the https://arcelormitalmexico.com/ link contains images of the Complainant's trademark and creates the false impression as the disputed domain name is the official domain name of the Complainant.

Therefore, in light of the above-mentioned circumstances in the present case, the Panel finds that the disputed domain name has been registered and is being used in bad faith and that the Complainant has established the third element under paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ARCELORMITALMEXICO.COM**: Transferred

PANELLISTS

Name	**Mrs Selma Ünlü**

DATE OF PANEL DECISION 2019-07-04

Publish the Decision