Decision for dispute CAC-UDRP-102535

Case number	CAC-UDRP-102535
Time of filing	2019-06-18 10:16:33
Domain names	canada-arcelormittal.com

Case administrator

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

Complainant

Organization	ARCELORMITTAL (SA)

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	Todd Peter

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

According to the Complainant, ARCELORMITTAL S.A. 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 states and provides evidence to support, that it is the owner of international trademark registration n° 947686 ARCELORMITTAL® (registered on August 3, 2007), predating the date of registration of the disputed domain name.

The Complainant further states that it 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.

FACTUAL BACKGROUND

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

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.

Please see for instance:

- WIPO Case No. D2000-1164, Boeing Co. v. Bressi (“the Respondent has advanced no basis on which he could conclude that it has a right or legitimate interest in the domain names”);

- NAF Case No. FA 1773444, Ashley Furniture Industries, Inc. v. Joannet Macket / JM Consultants (“The Panel finds that Respondent’s lack of content at the disputed domain shows the lack of a bona fide offering of goods or services or a legitimate noncommercial or fair use per Policy 4(c)(i) and (iii).”).

Past panels have confirmed the notoriety of the 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 (February 7, 2018) and is widely well-known.")

- CAC Case No. 101667, ARCELORMITTAL v. Robert Rudd ("The Panel is convinced that the Trademark is highly distinctive and well-established.")

Please see WIPO Case No. DCO2018-0005, ArcelorMittal SA v. Tina Campbell (“The Panel finds that the trademark ARCELORMITTAL is so well-known internationally for metals and steel production that it is inconceivable that the Respondent might have registered a domain name similar to or incorporating the mark without knowing of it.”).

Please see for instance:

- WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows;

- WIPO Case No. D2000-0400, CBS Broadcasting, Inc. v. Dennis Toeppen.

PARTIES’ CONTENTIONS:

COMPLAINANT:

• The disputed domain name is confusingly similar to the protected mark

According to the Complainant, the disputed domain name <canada-arcelormittal.com> is confusingly similar to its trademark ARCELORMITTAL®. The Complainant contends that the addition of the geographic term “CANADA” is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trademark ARCELORMITTAL®. The Complainant states that 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, its trademark and the domain names associated.

Since the Complainant is present in Canada, according to the Complainant, the addition of the term “CANADA” worsens the likelihood of confusion between the disputed domain name and the Complainant’s trademark ARCELORMITTAL®.

• Respondent does not have any rights or legitimate interest in the disputed domain name

The Complainant states that the Respondent has no rights or legitimate interests in respect of the domain name and it 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. In addition, the disputed domain name is currently inactive. Therefore, the Complainant contends that the 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 disputed domain name has been registered and is being used in bad faith

According to the Complainant, the Respondent has registered the disputed domain name and is using it in bad faith. The Complainant contends that the disputed domain name <canada-arcelormittal.com> is confusingly similar to its distinctive trademark ARCELORMITTAL® which is widely known. Past panels have confirmed the notoriety of the trademark ARCELORMITTAL® in the cases listed above. The Complainant states 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. In addition, the disputed domain name is inactive. The Complainant contends that the Respondent has not demonstrated any activity in respect of the disputed domain name, and it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law.

PARTIES CONTENTIONS

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

The UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (UDRP) of the Internet Corporation for Assigned Names and Numbers (ICANN) (the "Policy") provides that complainant must prove each of the following to obtain transfer or cancellation of the domain name:

1. that respondent's domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights; and

2. that respondent has no rights or legitimate interests in respect of the domain name; and

3. the domain name has been registered and is being used in bad faith.

1) The disputed domain name is confusingly similar to a trademark in which the Complainant has rights

The Complainant has provided evidence and proved to be the owner of international trademark ARCELORMITTAL®. Essentially, the Respondent has appropriated the trademark "ARCELORMITTAL®" by adding the geographic term “CANADA” to lead consumers to believe that it is affiliated with the Complainant. Since the Complainant is present in Canada, the Panel is convinced that the addition of the term “CANADA” worsens the likelihood of confusion between the disputed domain name and the Complainant’s trademark ARCELORMITTAL®.

The disputed domain name consists of the same term "ARCELORMITTAL" preceded by a geographical term "CANADA". The disputed domain name is confusingly similar to the Complainant's trademarks "ARCELORMITTAL®" since it fully incorporates the Complainant’s trademark ARCELORMITTAL® despite the addition of the terms "CANADA" which the Panel finds does not eliminate any confusing similarity. This is especially true where, as here, the trademark is “the dominant portion of the domain name,” LEGO Juris A/S v. Domain Tech Enterprises, WIPO Case No. D2011-2286, or where the trademark in the domain name represents “the most prominent part of the disputed domain name[] which will attract consumers’ attention.” Kabushiki Kaisha Toshiba dba Toshiba Corporation v. WUFACAI, WIPO Case No. D2006-0768., and since the term "ARCELORMITTAL" is fully distinguishable with respect to the additional component of the domain name, either because it is placed at the beginning of the domain name, which is where consumers mainly focus their attention, or because the additional element of the domain name is deprived of a distinctive character.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark ARCELORMITTAL®.

2) The Respondent lacks rights or legitimate interests in the disputed domain name

Under the Policy, a 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 burden of production shifts to the respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such appropriate allegations or evidence, a complainant is generally deemed to have satisfied paragraph 4(a)(ii) of the UDRP (see WIPO Overview 2.0, paragraph 2.1).

The Panel finds that the Respondent does not have a legal right to use the term “ARCELORMITTAL” as part of its domain name. The Respondent is not in any way connected with the Complainant nor is it authorized to register the disputed domain name or use its intellectual property rights for its operations as a licensee or in any capacity. In addition, the disputed domain name is currently inactive and according to the Complainant, the Respondent did not make any use of the disputed domain name since its registration which allegedly confirms that the Respondent has no demonstrable plan to use the disputed domain name.

In a present case, the Respondent failed to file a Response in which it could have provided evidence in support of its rights or legitimate interests. Therefore, all these circumstances are sufficient to establish a prima facie case that the Respondent lacks rights and legitimate interests in the disputed domain name.

The Panel thus takes the view that the Respondent lacks rights or legitimate interests in the disputed domain name.

3) The disputed domain name has been registered and is being used in bad faith

The Panel finds that the disputed domain name <canada-arcelormittal.com> is confusingly similar to the Complainant's distinctive trademark ARCELORMITTAL® which is widely known and well-established. Given the distinctiveness of the Complainant's trademark and reputation, it is reasonable to infer that the Respondent has registered the domain name with full knowledge of the Complainant's trademark. Since the Complainant is present in Canada, the addition of the term “CANADA” worsens the likelihood of confusion between the disputed domain name and the Complainant’s trademark ARCELORMITTAL®. The Panel finds that such actions constitute bad faith pursuant to paragraph 4(b)(iv) of the Policy, which provides: "by using the domain name, respondent has intentionally attempted to attract, for commercial gain, Internet users to respondent's web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of respondent's web site or location or of a product or service on respondent's web site or location."

In addition, the Respondent is not using the disputed domain name. According to the Panel, the passive holding of the disputed domain name may amount to bad faith when it is difficult to imagine any plausible future active use of the disputed domain name by the Respondent that would be legitimate and not infringing the Complainant’s well-known mark or unfair competition and consumer protection legislation (See Inter-IKEA v Polanski, WIPO Case No. D2000 1614; Inter-IKEA Systems B.V. v. Hoon Huh, WIPO Case No. D2000 0438; Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003).

The fact that a complainant’s trademark has a strong reputation and is widely used and the absence of evidence whatsoever of any actual or contemplated good faith use are further circumstances that may evidence bad faith registration and use in the event of passive use of domain names (see section 3.3, WIPO Overview 3.0).

In the present case, the Panel is of the opinion that the Complainant’s ARCELORMITTAL trademark is distinctive and widely used, which makes it difficult to conceive any plausible legitimate future use of the disputed domain name by the Respondent.

For all reasons stated above, the Panel is satisfied that the Complainant has proven the third element of the Policy that is that the Respondent's registration and use of the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	**Mgr. Barbora Donathová, LL.M.**

DATE OF PANEL DECISION 2019-07-19

Publish the Decision