Decision for dispute CAC-UDRP-102529

Case number	CAC-UDRP-102529
Time of filing	2019-06-11 09:55:31
Domain names	arcelormittalprijedor.net

Case administrator

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

Complainant

Organization	ARCELORMITTAL (SA)

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	Yun Zao

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

Complainant states, and provides evidence to support, that it is the owner of certain trademark registrations that consist of or contain the mark ARCELORMITTAL (the "ARCELORMITTAL Trademark"), including Int'l Reg. No. 947,686 for the mark ARCELORMITTAL (registered August 3, 2007).

FACTUAL BACKGROUND

Complainant states that it 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."

The Disputed Domain Name was created on May 24, 2019, and is being used in connection with a website that, as described by Complainant, is "written in Indonesian and related to natural medicine."

Paragraph 4(a)(i): Complainant states, inter alia, that the Disputed Domain Name is confusingly similar to the ARCELORMITTAL Trademark because it contains the ARCELORMITTAL Trademark in its entirety; that "the addition of the geographic term 'PRIJEDOR' … does not change the overall impression of the designation as being connected to the

Complainant's trademark"; and that "the addition of the term 'PRIJEDOR' worsens the likelihood of confusion between the disputed domain name and the Complainant's trademark" because "the Complainant is present in Prijedor, Bosnia and Herzegovina."

Paragraph 4(a)(ii): Complainant states, inter alia, that Respondent "is not known as the disputed domain name"; that Respondent "is not related in any way with the Complainant"; that "Complainant does not carry out any activity for, nor has any business with the Respondent"; that "[n]either license nor authorization has been granted to the Respondent to make any use of the Complainant's trademark… or apply for registration of the disputed domain name by the Complainant"; and that "Respondent['s] use[] [of] the domain name to promote various natural medicine for heart diseases… does not represent a bona fide offering of goods or services or a legitimate use."

Paragraph 4(a)(iii): Complainant states that the Disputed Domain Name was registered and is being used in bad faith because, inter alia, the ARCELORMITTAL Trademark is "widely known"; by including the city name "Prijedor" in the Disputed Domain Name – "the name of a city located in the northwest of Bosnia and Herzegovina, where the Complainant is present" – "it confirms that the Respondent knew about the Complainant and its rights"; and "[g]iven the distinctiveness of the Complainant's trademark and reputation and the facts exposed above, it is reasonable to infer that the Respondent has registered the domain name with full knowledge of the Complainant's trademark."

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 the Policy were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

Identical or Confusingly Similar

Based upon the trademark registrations cited by Complainant, it is apparent that Complainant has rights in and to the ARCELORMITTAL Trademark.

As to whether the Disputed Domain Name is identical or confusingly similar to the ARCELORMITTAL Trademark, the relevant comparison to be made is with the second-level portion of the Disputed Domain Name only (i.e., "arcelormittalprijedor") because "[t]he applicable Top Level Domain ('TLD') in a domain name (e.g., '.com', '.club', '.nyc') is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test." WIPO Overview of WIPO Overview 3.0, section 1.11.1.

Here, the Disputed Domain Name contains the ARCELORMITTAL Trademark in its entirety. As set forth in section 1.7 of

WIPO Overview 3.0, “in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.” Further, section 1.8 of WIPO Overview 3.0 states: “Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.”

Accordingly, the Panel finds that Complainant has proven the first element of the Policy.

Rights or Legitimate Interests

Complainant states, inter alia, that Respondent “is not known as the disputed domain name”; that Respondent “is not related in any way with the Complainant”; that “Complainant does not carry out any activity for, nor has any business with the Respondent”; that “[n]either license nor authorization has been granted to the Respondent to make any use of the Complainant’s trademark… or apply for registration of the disputed domain name by the Complainant”; and that “Respondent[’s] use[] [of] the domain name to promote various natural medicine for heart diseases… does not represent a bona fide offering of goods or services or a legitimate use.”

WIPO Overview 3.0, section 2.1, states: “While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of ‘proving a negative’, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.”

The Panel finds that Complainant has established its prima facie case and without any evidence from Respondent to the contrary, the Panel is satisfied that Complainant has satisfied the second element of the Policy.

Registered and Used in Bad Faith

Whether a domain name is registered and used in bad faith for purposes of the Policy may be determined by evaluating four (non-exhaustive) factors set forth in paragraph 4(b) of the Policy: (i) circumstances indicating that the registrant has registered or the registrant has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the registrant’s documented out-of-pocket costs directly related to the domain name; or (ii) the registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the registrant has engaged in a pattern of such conduct; or (iii) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or (iv) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, Internet users to the registrant’s website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the registrant’s website or location or of a product or service on the registrant’s website or location.

As set forth in section 3.2.1 of WIPO Overview 3.0, “a widely-known mark, or a domain name incorporating the complainant’s mark plus an additional term such as a descriptive or geographic term” is relevant to bad faith. In a previous proceeding under the Policy also involving the ARCELORMITTAL Trademark, a panel found “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.” ArcelorMittal SA v. Tina Campbell, WIPO Case No. DCO2018-000.

Accordingly, the Panel finds that Complainant has proven the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ARCELORMITTALPRIJEDOR.NET**: Transferred

PANELLISTS

Name	**Douglas M. Isenberg**

DATE OF PANEL DECISION 2019-07-23

Publish the Decision