Decision for dispute CAC-UDRP-102584

Case number	CAC-UDRP-102584
Time of filing	2019-07-23 09:44:24
Domain names	corporates-arcelormittal.com

Case administrator

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

Complainant

Organization	ARCELORMITTAL (SA)

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	Diane Rogers

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other proceedings, pending or decided, which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the following trademark no 947686 ARCELORMITTAL® registered on August 3, 2007 in the following classes of goods and services 06, 07, 09, 12, 19, 21, 39, 40, 41, 42 under the Nice Classification.

FACTUAL BACKGROUND

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

ARCELORMITTAL S.A. (the Complainant) is a company specialized in steel-producing in the world. Their website can be located 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 Complainant is the owner of the international trademark no 947686 ARCELORMITTAL® registered on August 3, 2007.

The Complainant 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.

The disputed domain name <corporates-arcelormittal.com> was registered on July 15, 2019, and it currently points to a page without content except for the message: “Forbidden You don't have permission to access / on this server.”

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

A. Introduction

This is a Mandatory Administrative Proceeding pursuant to paragraph 4 of the Uniform Domain Name Dispute Policy (Policy) of the Internet Corporation for Assigned Names and Numbers (ICANN), and the Procedural Rules for Uniform Domain Dispute Resolution (Rules) including the Czech Arbitration Centre (CAC) UDRP Supplementary Rules.

B. Administrative Deficiencies

By notification dated July 23, 2019 and in accordance with Paragraph 4(d) of the Rules, the CAC notified the Complainant that it was administratively deficient in that it had not sufficiently identified the Respondent.

The CAC directed the Complainant to have regard to the Registrar’s verification available in the online case file in the form of a non-standard communication regarding the appropriate identification of the domain name holder.

The CAC requested the Complainant correct the administrative deficiency and submit an Amended Complainant.
On July 23, 2019, the Complainant filed an Amended Complaint and the CAC determined that the Complaint could proceed by way of Administrative Proceeding.

The Panel considers that the administrative deficiency has now been corrected and this matter can proceed to be considered by the Panel in accordance with the Policy and the Rules.

C. Substantive Matters

The Complainant has filed a complaint with supporting evidence disputing the registration of the domain name <corporates-arcelormittal.com> (the disputed domain name) by the Respondent.

The disputed domain name was registered on July 15, 2019.

The Respondent has not filed any administratively compliant response or any materials in response to the Complaint in accordance with the deadline set out under the Rules.

Paragraph 15 of the Rules provides:

(a) A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

Accordingly, the Complainant carries the onus to prove its case.

Paragraph 4(a) of the Policy lists three elements that a complainant must prove to merit a finding that a domain name registered by a respondent shall be transferred to the complainant:

(i) The domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(ii) The respondent has no right or legitimate interests in respect of the domain name; and

(iii) The domain name has been registered and is being used in bad faith.

The Panel is satisfied that the Complainant has satisfied all three elements for the principal reasons set out below.

Taking each of these elements in turn:

RIGHTS IN AN IDENTICAL OR CONFUSINGLY SIMILAR TRADEMARK

To prove this element, the Complainant must have trademark rights and the disputed domain name must be identical or confusingly similar to the Complainant's trademark.

The Complainant has adduced evidence that:

(a) it is the owner of the international trademark no. 947686 ARCELORMITTAL (the Complainant's trademark) registered on August 3, 2007.

(b) It owns a domain name portfolio, which includes using the ARCELORMITTAL trademark, such as <arcelormittal.com> and registered since January 27, 2006.

The Panel notes that the Complainant's trademark and the disputed domain name referred to in the preceding paragraph predate the registration of the disputed domain name for at least a decade.

The disputed domain name, however, is not strictly identical to the Complainant's trademark or the Complainant's domain name as the disputed domain name incorporates a term 'corporates' hyphenated with 'arcelormittal' to make up the term 'corporates-arcelormittal'.

The Complainant contends that the addition of the generic term ‘corporates’ is not sufficient to escape the finding that the disputed domain name is confusingly similar to its trademark for the following reasons:

(a) It does not change the overall impression of the designation as being connected to the Complainant’s trademark.

(b) It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and the domain names associated with the Complainant.

Further, 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 nor does it prevent the likelihood of confusion between the disputed domain name and the Complainant’s trademark and the domain names associated with the Complainant.

The Panel considers that when a domain name wholly incorporates a complainant’s registered trademark, it is sufficient to establish identity or confusing similarity for the purposes of the Policy. See Oki Data Americas, Inc. v. ASD, Inc, WIPO Case No. D2001-0902; Dr. Ing. h.c. F. Porsche AG v Vasiliy Terkin, WIPO Case No D2003-003-0888.

Apart from being a registered trademark, on the evidence adduced by the Complainant the term ‘arcelormittal’ appears to be widely well-known, highly distinctive and well-established, or have notoriety.

The Complainant also refers to the following cases in support of previous findings made by other panels of its rights and established reputation. See Arcelormittal v. China Capital, CAC Case No. 101908; Arcelormittal v. Robert Rudd, CAC Case No. 101667; ArcelorMittal SA v. Tina Campbell, WIPO Case No. DCO2018-0005; Arcelormittal (SA) v. Flor Walden <arcelormittal-groupe.pw>, WIPO Case No. DPW2019-0002; Arcelormittal (SA) v. Admin Contact, PrivateName Services Inc. / Juan Jose <aceroarcelormittal.com>, WIPO Case NO. D2019-0145; ArcelorMittal (SA) v. Trplice Cultural <arcelormittalcultural.com>, CAC Case No. 102300.

Each case is necessarily different in respect of the factual matters that arise for determination by a panel. The cases referred to by the Complainant, however, deals specifically with its uncontroverted intellectual property rights. The Panel, therefore, considers that such uncontroverted matters accepted by other panels are highly persuasive for this Panel to consider and to give such weight as it deems appropriate.

The Panel, therefore, accepts that the Complainant has developed a reputation of its trademark in the marketplace by its extensive use. The Panel draws the inference that the Complainant assiduously takes appropriate legal steps to protect those rights when allegedly being infringed.

The Panel considers that the combination of the generic term ‘corporates’ and the Complainant’s trademark or a unique term ‘arcelormittal’ as a single hyphenated term will likely convey the impression of a connection with the Complainant’s trademark.

The Panel also considers that the top-level suffix ‘.com’ is generally irrelevant when assessing whether a domain name is identical or confusingly similar to a trademark. This is because gTLDs are only required for the functionality of a website. See Proactiva Medio Ambiente, S.A. v. Proactiva, WIPO Case No. D 2012-0182; F. Hoffman-La Roche AG v Macalve e-dominos S.A., WIPO Case No. D2006-0451.

The Panel accepts the Complainant’s contention that the addition of the ‘.com’ to the disputed domain name does not change the overall impression of the designation as being connected to the Complainant’s trademark nor does it prevent the likelihood of confusion between the disputed domain name and the Complainant’s trademark and its domain names.

The uncontroverted evidence adduced by the Complainant is 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 counties. It holds sizeable captive supplies of raw materials and operates extensive distribution networks.

The Panel also observes that on its website, the Complainant is stated to be listed on the stock exchanges in New York, Amsterdam, Paris, Luxembourg, Barcelona, Bilbao, Madrid, and Valencia.

Although no evidence of actual confusion has been provided by the Complainant, the Panel, having reviewed the evidence of reputation in support of the Complainant's case is satisfied that the disputed domain name is likely to cause confusion amongst Internet users given the nature and wide use of the Complainant's trademark in the classes of goods and services in which they are registered.

Accordingly, the Panel finds that the disputed domain name <corporates-arcelormittal.com> is confusingly similar to the Complainant's trademark and that paragraph 4(a)(i) of the Policy is satisfied.

NO RIGHTS OR LEGITIMATE INTERESTS

The burden of proof is on the Complainant to establish that the Respondent lacks rights or legitimate interests in the disputed domain name.

Under the Policy, if a prima facie case is established by a complainant, then the burden of production of evidence shifts to the respondent to demonstrate that it has rights or legitimate interests in a domain name.

See Document Technologies, Inc. v. International Electronic Communications Inc., WIPO Case No. D2000-0270; Belupo d.d. v. WACHEM d.o.o., WIPO Case No. D2004-0110; Croatia Airlines d. d. v. Modern Empire Internet Ltd, WIPO Case No. D2003-0455; Audi AG v. Dr. Alireza Fahimipour, WIPO Case No. DIR2006-0003.

The Complainant advances four contentions in support of this ground:

(a) The Respondent is not known in the WHOIS database as the disputed domain name.

(b) There Respondent is not related in any way with the Complainant.

(c) The Respondents does not carry out any activity for, nor has any business with the Respondent.

(d) The Complainant has not granted a licence nor authorisation to the Respondent to make any use of the Complainant's trademark or apply for registration of the disputed domain name.

The Panel accepts on its face the Complainant's assertion that the Respondent is not commonly known in the WHOIS database as the disputed domain name as provided under paragraph 4(c)(ii) of the Policy.

The Respondent did not submit any administratively compliant response or attempt to demonstrate any rights or legitimate interests in the disputed domain name. Accordingly, the Panel can draw an adverse inference from the Respondent's failure to respond, in accordance with paragraph 14(b) of the Rules.

The Complainant's evidence suggests that the disputed domain name has not been used by the Respondent in connection with bona fide offerings of goods or services. The disputed domain name currently redirects to an inactive web page with the message 'Forbidden You don't have permission to access / on this server'. The Complainant also asserts that the web page has never been used. These assertions remain unchallenged by the Respondent.

In any event, the Panel considers that it cannot be inferred that the disputed domain name is for use in a fair or legitimate manner, as the disputed domain name pertains to the business, products or services created by the Complainant.

The Complainant contends that neither a licence nor authorisation has been granted to the Respondent to make any use of the Complainant's trademark or apply for registration of the disputed domain name.

The Panel is satisfied that use of the disputed domain name cannot be connected to the Complainant or its business, products or services to which the Complainant's trademark applies.

Accordingly, the Panel is satisfied that there is no actual or contemplated active use by the Respondent of the disputed domain name that is legitimate.

On the contrary, given the priority date of the Complainant's trademark and registered domain name <arcelormittal.com>, any such use by the Respondent, to which no evidence to the contrary has been submitted, of the disputed domain name will likely mislead and direct customers or businesses away from the Complainant's legitimate website.

By the lack of any administratively compliant response from the Respondent, or any other information indicating the contrary, the Panel finds that the Respondent has no rights or legitimate interests in respect of <corporates-arcelormittal.com> and that paragraph 4(a)(ii) of the Policy is satisfied.

BAD FAITH

For the purposes of paragraph 4(a)(iii), paragraph 4(b) of the Policy states that any of the following circumstances shall be considered evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that the respondent has registered or 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 to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent 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 you have engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's website 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 your website or location or of a product or service on the respondent's website or location.

The Complainant advances two contentions in support of this ground:

(a) Registration of a well-known/famous trademark.

(b) Non-use of the disputed domain name.

The Complainant has generally dealt with the circumstances set out in paragraph 4(b) of the Policy.

The Panel has accepted, as stated above, that the Complainant's trademark is well-known, highly distinctive and well-established, or have notoriety.

Given the world wide nature of the Complainant's business and the fact that it is listed on several Stock Exchanges including in the USA where the Registrar is located, the Panel considers that it is inconceivable that the Respondent might have registered the disputed domain name joining the terms 'corporates' and 'arcelormittal' without knowing of the Complainant's trademark and/or domain name.

Accordingly, the Panel is satisfied that the Respondent will have had or likely to have had knowledge of the Complainant's trademark given the high degree of the Complainant's reputation in its field at the time of registration of the disputed domain name. An inference can, therefore, be drawn that the acquisition of the disputed domain name by the Respondent is for commercial reasons as set out in paragraph 4(b)(i) of the Policy.

The Panel has accepted, as stated above, that the disputed domain name currently redirects to an inactive web page.
The incorporation of a well-known mark into a domain name coupled with an inactive website, as in the present case, may be evidence of bad faith registration and use. See Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003; CBS Broadcasting, Inc. v. Dennis Toeppen, WIPO Case No. D2000-0400.

Accordingly, the Panel finds that the Complainant has satisfied its burden of showing bad faith registration and use of the disputed domain name 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. **CORPORATES-ARCELORMITTAL.COM**: Transferred

PANELLISTS

Name	**Professor William Lye, OAM QC**

DATE OF PANEL DECISION 2019-08-20

Publish the Decision