Decision for dispute CAC-UDRP-102598

Case number	CAC-UDRP-102598
Time of filing	2019-07-30 09:04:29
Domain names	essararcelormittal.com, essarmittal.com

Case administrator

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

Complainant

Organization	ARCELORMITTAL (SA)

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	Imran Syed

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings that relate to the disputed domain names.

IDENTIFICATION OF RIGHTS

The Complainant is the registrant of the international trademark registrations No. 947686, “ARCELORMITTAL”, registered on August 3, 2007, for goods and services in classes 6, 7, 9, 12, 19, 21, 39, 40, 41, 42, and No. 1198046, “MITTAL”, registered on December 5, 2013, for goods and services in classes 6 and 40.

The disputed domain names were registered by the Respondent on July 4, 2019.

FACTUAL BACKGROUND

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

The Complainant states that it is the largest steel company in the world and that it is present in more than 60 countries.

The Complainant adds that it supplies steel products in all major markets including automotive, construction, household appliances and packaging.

The Complainant points out that it is the owner of the international trademarks "ARCELORMITTAL" and "MITTAL", registered

before the registration of the disputed domain names.

The Complainant submits that it owns an important domain names portfolio, including the domain name <arcelormittal.com> registered since January 27, 2006.

The Complainant considers that the disputed domain names are confusingly similar to its distinctive trademarks "ARCELORMITTAL" and "MITTAL".

The Complainant observes that the disputed domain names have been registered on the same date using the same registrar.

The Complainant contends that the addition of the word “ESSAR” is not sufficient to avoid the finding that the disputed domain names are confusingly similar to the Complainant's trademarks. On the contrary, in the light of fact that the Complainant submitted a proposal for the acquisition of the company Essar Steel, the Complainant argues that the addition of the word "ESSAR" increases the likelihood of confusion between the disputed domain names and the Complainant's trademarks.

The Complainant submits that it is well established that a domain name that wholly incorporates a Complainant's registered trademark may be sufficient to establish confusing similarity for the purposes of the UDRP.

The Complainant notes that it is also well established that the top-level domain should be disregarded when assessing confusing similarity.

The Complainant adds that the Respondent has no rights or legitimate interests in respect of the disputed domain names and it is not related in any way with the Complainant.

The Complainant asserts that the Respondent is not known as the disputed domain names.

The Complainant clarifies that it does not carry out any activity for, nor has any business with the Respondent.

The Complainant underlines that neither license nor authorization has been granted to the Respondent to make any use of the Complainant’s trademarks "ARCELORMITTAL" and "MITTAL", or apply for registration of the disputed domain names.

The Complainant notes that the disputed domain names resolve to a parking page with commercial links, some of which are related to the Complainant, therefore it contends that the Respondent is not making a bona fide offering of goods or services by means of the disputed domain names, or a legitimate non-commercial or fair use of them.

The Complainant observes that past panels have confirmed the notoriety of the widely known trademarks "ARCELORMITTAL" and "MITTAL".

The Complainant points out that, given the distinctivness of the Complainant's trademarks and the Complainant's reputation, it is reasonable to infer that the Respondent has registered the disputed domain names with full knowledge of the Complainant's trademarks.

The Complainant adds that the Respondent uses the disputed domain names in parking pages with commercial links and this use has the deliberate purpose of creating confusion, mistake and deceiving as to the affiliation, connection or association of the Respondent with the Complainant.

Therefore, the Complainant considers that the Respondent has registered the disputed domain names and is using them in bad faith.

PARTIES CONTENTIONS

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 names have been registered and are 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

In accordance with paragraph 4(a) of the Policy, in order to obtain the transfer of a domain name, the complainant has to demonstrate that:

(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 rights or legitimate interests in respect of the domain name; and

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

IDENTICAL OR CONFUSINGLY SIMILAR

The first requirement that the Complainant must establish is that the disputed domain names are identical with, or confusingly similar to, the Complainant’s trademarks.

There are two elements of this test: for each domain name, the Complainant must demonstrate that it has rights in a trademark or service mark and, if so, the disputed domain names must be shown to be identical or confusingly similar to the trademark or service mark.

The Complainant has proven ownership of the registered trademarks "ARCELORMITTAL" and "MITTAL", identified in section "Identification of rights" above.

The Panel observes that the registration of the Complainant's trademarks predates the registration of the disputed domain names.

On the question of identity or confusing similarity, what is required is simply a comparison and assessment of the disputed domain names to the Complainant’s trademarks.

The disputed domain names differ from the Complainant’s trademarks "ARCELORMITTAL" and "MITTAL", only by the addition of the word "ESSAR" before each of the above-mentioned trademarks, and of the top-level domain ".COM". The Panel notes that the word "ESSAR" is the trademark of the company to which the Complainant submitted a proposal for

acquisition.

The Panel agrees with other panels' view that the fact that the disputed domain names incorporate two different trademarks is not enough to avoid confusion and is not sufficient to avoid confusing similarity with the Complainant’s trademarks (see, for example, WIPO Case No. D2016-0595).

The Panel observes that it is well established that the top-level domain may generally be disregarded in the confusing similarity test (see, for example, WIPO case No. D2016-2547).

Therefore, the Panel considers that the disputed domain names are confusingly similar to the Complainant's trademarks.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

The second requirement that the Complainant must prove is that the Respondent has no rights or legitimate interests in each of the disputed domain names.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the respondent has rights or legitimate interests in a domain name:

(i) before any notice to [the Respondent] of the dispute, [the Respondent’s] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a bona fide offering of goods or services; or

(ii) [the Respondent] (as an individual, business, or other organization) [has] been commonly known by the [disputed] domain name, even if [the Respondent] [has] acquired no trademark or service mark rights; or

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

This is a non-exhaustive list of circumstances in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement falls on the Complainant. UDRP panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”.

Accordingly, it is usually sufficient for a complainant to raise a prima facie case against the respondent and the burden of proof on this requirement shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in a domain name.

The Panel finds that the Complainant has made out a prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain names.

In particular, the Complainant states that:

- the Respondent is not known as the disputed domain names;

- the Respondent is not related in any way with the Complainant;

- the Complainant does not carry out any activity for the Respondent;

- the Complainant does not have any business with the Respondent;

- the Complainant has not granted any license nor any authorisation to the Respondent to make any use of the Complainant's trademarks or apply for registration of the disputed domain names;

- the disputed domain names redirect to parking pages with commercial links.

In the absence of a Response, there is no indication in the present case that the Respondent is commonly known by the disputed domain names.

Furthermore, the Respondent has failed to demonstrate any of the other non-exclusive circumstances evidencing rights or legitimate interests under paragraph 4(c) of the Policy or other evidence of rights or legitimate interests in the disputed domain names.

The Respondent does not appear to make any legitimate non-commercial or fair use of the disputed domain names, nor any use in connection with a bona fide offering of goods or services. Indeed, the websites in relation with the disputed domain names consist in parking pages containing commercial links, some of which are related to the Complainant.

The Panel considers that, on the balance of probability, the Respondent knew of the reputation and goodwill that the Complainant had established in the trademarks "ARCELORMITTAL" and "MITTAL" and registered the disputed domain names with knowledge of the Complainant's rights and reputation. Indeed, it is not conceivable that the Respondent did not have the Complainant's trademarks in mind, when registering and using the disputed domain names. Under these circumstances, it cannot be concluded that the Respondent is making a "fair" use of the disputed domain names.

Taking into account that the Respondent is not commonly known as the disputed domain names, that the Respondent has no connection or business relationship with the Complainant, that the Complainant has not authorized the Respondent to apply for registration of the disputed domain names or to use the Complainant's trademarks, that the disputed domain names are used by parking pages containing commercial links and not for any other legitimate purpose, the Panel cannot imagine any possible legitimate justification for this use, and the Respondent has not come forward with any explanation that demonstrates any rights or legitimate interests in the disputed domain names.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

REGISTERED AND USED IN BAD FAITH

Under the third requirement of the Policy, the Complainant must establish that the disputed domain names have been both registered and used in bad faith by the Respondent.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, including:

(i) circumstances indicating that [the Respondent] [has] registered or [has] acquired the [disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the [disputed] 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 Respondent's] documented out-of-pocket costs directly related to the [disputed] domain name; or

(ii) [the Respondent] [has] registered the [disputed] 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 Respondent] [has] engaged in a pattern of

such conduct; or

(iii) [the Respondent] [has] registered the [disputed] domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the [disputed] domain name, [the Respondent] [has] intentionally attempted to attract, for commercial gain, Internet users to [the 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 [the Respondent's] web site or location or of a product or service on [the Respondent's] web site or location.

The Panel, on the basis of the evidence presented, agrees with the Complainant's contentions that the disputed domain names were registered in bad faith and that they have been used in bad faith.

Taking into account the distinctiveness and reputation of the trademarks “ARCELORMITTAL” and "MITTAL" also recognized by other panels, the Panel agrees that it is inconceivable that the Respondent was not aware of the Complainant's rights in the Complainant's trademarks when registering the disputed domain names.

Other panels considered that knowledge of a corresponding mark at the time of the domain name’s registration can suggest bad faith (see, for example, WIPO Case No. D2017-0100) and that the registration of a domain name composed by trademarks of well-known companies after the announcement of an acquisition or merger concerning these companies suggests opportunistic bad faith (see, for example, WIPO Case No. D2000-0446). The Panel shares these views.

The Panel agrees also that directing Internet users to a web page containing some commercial links in relation to the Complainant, like in the present case, is evidence of use in bad faith (see, for example, WIPO case No. D2017-0890).

The Panel observes that if the Respondent had legitimate purposes in registering and using the disputed domain names it would have filed a Response in this proceeding.

The Panel, having taken into account the Respondent's knowledge of the Complainant's trademarks at the time of the disputed domain names’ registration, that no response to the complaint has been filed and the use of the disputed domain names in a website containing some commercial links in relation to the Complainant, considers that the disputed domain names were registered and are being used in bad faith.

Accordingly, the Panel finds that the disputed domain names were registered and are being used in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ESSARARCELORMITTAL.COM**: Transferred
2. **ESSARMITTAL.COM**: Transferred

PANELLISTS

Name	**Michele Antonini**

DATE OF PANEL DECISION 2019-09-05

Publish the Decision