Decision for dispute CAC-UDRP-102660

Case number	CAC-UDRP-102660
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Domain names	arcelor-mittalmonterrey.com

Case administrator

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

Complainant

Organization	ARCELORMITTAL (SA)

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	Luis Patino

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other proceedings.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the registered international trade mark, number 947686, being the word mark, ARCELORMITTAL, registered on 3 August 2007 in classes 06,07,09,12,19,21,39,40,41,42, in 15 countries under the Madrid Protocol and another 30 countries under the Madrid Agreement. The Complainant is also the owner of a portfolio of national registered marks worldwide and has rights arising from use in trade in countries that recognize those rights. The mark is a well known mark or a mark with a reputation.

FACTUAL BACKGROUND

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

ARCELORMITTAL S.A., the Complainant, is a company specialized in steel production.

The Complainant is the largest steel producer 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 trade mark number 947686 for the word mark, ARCELORMITTAL, and many other national registered marks. The Complainant also owns a substantial domain name portfolio, including its main domain name <arcelormittal.com> registered on 27 January 2006. The website is at: that domain, www.arcelormittal.com.

The disputed domain name <arcelor-mittalmonterrey.com> was registered on 27 August 2019 and currently resolves to a website displaying the Complainant's trade mark and information regarding the Complainant and its activities.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

Rights

The Complainant says that the disputed domain name <arcelor-mittalmonterrey.com> is confusingly similar to its name and registered trade mark, the word mark, ARCELORMITTAL.

It says the addition of the geographical term "MONTERREY" and a hyphen to the trade mark, ARCELORMITTAL, is not sufficient to escape the finding that the disputed domain name is confusingly similar to the trade mark.

On the contrary, it says the addition of the term "MONTERREY" compounds the likelihood of confusion between the disputed domain name and the Complainant's trade mark as the Complainant is in fact present and doing business in Monterrey, Mexico.

Please see similar case CAC No. 102470, ARCELORMITTAL (SA) v. acero ("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.").

It is well established that the gTLD is viewed as a standard registration requirement and as such is disregarded for similarity. See the Forum Case No. FA 153545, Gardline Surveys Ltd v. Domain Finance Ltd. ("The addition of a top-level domain is irrelevant when establishing whether or not a mark is identical or confusingly similar, because top-level domains are a required element of every domain name.").

Consequently, the disputed domain name is confusingly similar to Complainant's trade mark.

Fair Use and Legitimate Interests

According to WIPO Case No. D2003-0455 Croatia Airlines d. d. v. Modern Empire Internet Ltd., the 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 Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the Policy.

The Complainant asserts that the Respondent is not known as the disputed domain name. Past panels have held that a Respondent was not commonly known by a disputed domain name if the WHOIS information was not similar to the disputed domain name. Thus, the Respondent is not known by the disputed domain name. See for instance the 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> ("Here, the WHOIS information of record identifies Respondent as "Chad Moston / Elite Media Group." The Panel therefore finds under Policy 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy 4(c)(ii).").

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name

and he is not related in any way to the Complainant. The Complainant does not carry out any activity for, nor has any business with, the Respondent. No license or authorization has been granted to the Respondent to make any use of the Complainant's trade mark or apply for registration of the disputed domain name.

Moreover, the disputed domain name resolves to a website which looked like the official website of the Complainant. Thus, the owner of the disputed domain name obviously tries to pass itself off as the Complainant or as an affiliate of the Complainant for its own commercial gain. Therefore, the Respondent is not using the disputed domain name in connection with a bona fide offering of goods or services or a legitimate non-commercial or fair use.

Please see the Forum Case No. 1649982, DramaFever Corp. v. olxhost c/o olxhost ("Using the domain name in a manner designed to allow Respondent to pass itself off as Complainant is neither a bona fide offering of goods or services under Policy 4(c)(i), nor a legitimate noncommercial or fair use under Policy 4(c)(iii).").

Thus, in accordance with the foregoing, the Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Bad Faith

The Complainant's trade mark is well known. Past panels have confirmed the notoriety of the trade mark in the following cases: See 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 see CAC Case No. 101667, ARCELORMITTAL v. Robert Rudd ("The Panel is convinced that the Trademark is highly distinctive and well-established.").

Moreover, the disputed domain name resolves to a website which displayed the Complainant's trade mark. This confirms that the Respondent knew about the Complainant and its rights. See CAC Case No. 102470, ARCELORMITTAL (SA) v. acero ("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.").

Given the distinctiveness of the Complainant's trade mark and reputation and the facts set out above, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trade mark.

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.").

Therefore, the Complainant contends that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant's trade mark as to the source, sponsorship, affiliation, or endorsement of the web site.

See similar case CAC No. 102470, ARCELORMITTAL (SA) v. acero ("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."). See also for instance the 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> ("Here, the WHOIS information of record identifies Respondent as "Chad Moston / Elite Media Group." The Panel therefore finds under Policy 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy 4(c)(ii)."). See also the Forum Case No. 1649982, DramaFever Corp. v. olxhost c/o olxhost ("Using the domain name in a manner designed to allow Respondent to pass itself off as Complainant is neither a bona fide offering of goods or services under Policy 4(c)(i), nor a legitimate noncommercial or fair use under Policy 4(c)(iii).").

Past panels have confirmed the notoriety of the trade mark, 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.”).

The Complainant contends that Respondent has registered the disputed domain name in bad faith and is using it in bad faith.

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 trade mark 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

Rights

The Complainant states that the disputed domain name is confusingly similar to its name and registered trade mark, the word mark, arcelormittal.

Indeed, the only differences are firstly, the addition of one character, a hyphen, between the two words in the name and mark and secondly, the new word at the end, the place name or geographical term “MONTERREY.” The Complainant says the place name “MONTERREY” here compounds the likelihood of confusion between the disputed domain name and the Complainant’s trade mark as the Complainant is in fact present and doing business in Monterrey, Mexico.

So the addition of that term suggests that the Respondent/its site is the Complainant’s business in Monterrey. This was the finding in the similar case CAC No. 102470, Arcelormittal (SA) v. acero. The Panel accepts this submission.

In terms of the similarity analysis, identity is a strict standard and is not present, however the trade mark and the disputed domain name are clearly similar. The gTLD is disregarded. The hyphen can be disregarded also. Consequently, the disputed domain name is confusingly similar to Complainant’s trade mark, the word mark, Arcelormittal.

Fair Use and Legitimate Interests

According to WIPO Case No. D2003-0455 Croatia Airlines d. d. v. Modern Empire Internet Ltd., the 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 Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the Policy.

The Complainant asserts that the Respondent is not known by the disputed domain name. This is accepted and is clear from the WHOIS information. It is not related in any way to the Complainant and does not carry out any activity for it, nor has any business with it. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trade mark. The Respondent has no fair use or legitimate interests in respect of the disputed domain name on the face of the case and is not, for example, using the mark in a nominative sense to talk about the Complainant.

Further, the disputed domain name resolves to a website which looks like an official website of the Complainant. Thus, the Respondent impersonates or passes itself off as the Complainant or an affiliate of the Complainant and this cannot be a bona fide offering of goods or services or a legitimate non-commercial or fair use. See the Forum Case No. 1649982, DramaFever Corp. v. olxhost c/o olxhost. The Panel notes that the contact details given on the site to which the disputed domain name resolves are or purport to be those of the Complainant.

Fundamentally, use of a domain name will not be considered "fair" if it falsely suggests affiliation with the trade mark owner. Generally speaking, UDRP panels have found that domain names that are near identical to a complainant's trade mark carry a high risk of implied affiliation. Even where a domain name consists of a trade mark plus an additional term UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. At the offending end of the spectrum are use with geographic terms (e.g., <trade mark-usa.com>, or <trade mark.nyc>), or terms with an "inherent Internet connotation" (e.g., <e-trademark.com>, <buy-trademark.com>, or <trademark.online>) as these are seen as tending to suggest sponsorship or endorsement by the trade mark owner. This is such a case. The content of the website in question removes any margin for error and places this case firmly in the impersonation zone. Therefore the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Bad Faith

The Complainant contends that the disputed domain name was registered in bad faith and is used in bad faith.

When looking at bad faith - the focus is free-riding or taking unfair advantage of a complainant's mark. This can be established by any of the below factors from the Policy at paragraph 4(b) (although these are non-exclusive, and other scenarios may also arise):

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name 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 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 the respondent has 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 its 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 the respondent's website or location or of a product or service on the respondent's website or location.

The Complainant cites and relies on (iv) but all are potentially applicable in this case. The Complainant's trade mark is

distinctive and is a well-known mark. Other panels have made the same finding, see CAC Case No. 101908, Arcelormittal v. China Capital (above) and CAC Case No. 101667, Arcelormittal v. Robert Rudd (above). See also CAC Case No. 102470, Arcelormittal (sa) v. Acero and WIPO Case No. DCO2018-0005, ArcelorMittal SA v. Tina Campbell.

Here the disputed domain name resolves to a website which displayed the Complainant's trade mark. Therefore, there can be no doubt here the Respondent knew about the Complainant and its rights. Even if this was not so, given the distinctiveness of the Complainant's trade mark and the extent of its reputation, it would be clear the Respondent had registered the disputed domain name with full knowledge of the Complainant's trade mark.

The Respondent has not come forward with an explanation for its selection or use of the Complainant's name and mark. Where a mark is famous and there is no obvious reason for its selection and the Respondent has not come forward to explain, it will often be reasonable to find bad faith. See WIPO case, Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003. Here as the disputed domain name resolves to a website which displays the Complainant's trade mark and misrepresents that it is the Complainant or is connected to it, bad faith is clear.

The Panel accepts that this creates a likelihood of confusion with the Complainant's trade mark and the source, sponsorship, affiliation, or endorsement of the web site.

The Panel finds the Respondent has registered the disputed domain name in bad faith and is using it in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ARCELOR-MITTALMONTERREY.COM**: Transferred

PANELLISTS

Name	**Victoria McEvedy**

DATE OF PANEL DECISION 2019-10-14

Publish the Decision