Decision for dispute CAC-UDRP-102953

Case number	CAC-UDRP-102953
Time of filing	2020-03-05 09:28:06
Domain names	acerlormittalsa.com

Case administrator

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

Complainant

Organization	ARCELORMITTAL (SA)

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	Domain Resellers

OTHER LEGAL PROCEEDINGS

None of which the Panel is aware.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of International trademark No.947686 for ARCELORMITTAL registered on August 3, 2007 (hereinafter referred to as "the ARCELORMITTAL trademark").

The Respondent registered the disputed domain name <acerlormittalsa.com> on February 26, 2020.

FACTUAL BACKGROUND

The Complainant, ARCELORMITTAL, is a company incorporated in Luxembourg and engaged in steel production. It is the largest steel producing company in the world.

The Complainant is the owner of the international trademark No. 947686 ARCELORMITTAL registered on August 3, 2007.

The Complainant also owns numerous domain names including <arcelormittal.com> which it uses in its business.

The disputed domain name <acerlormittalsa.com> was registered on February 26, 2020. The website to which the disputed domain name resolves currently displays a “Coming Soon” message.

The Complainant is concerned that the disputed domain name damages its trademark and diminishes its high public reputation built up over many years and consequently it wishes to have the disputed domain name transferred to itself.

The Respondent did not file a Response to the proceeding.

PARTIES CONTENTIONS

CONTENTIONS OF THE PARTIES

COMPLAINANT:

The Complainant made the following contentions.

1. CONFUSING SIMILARITY BETWEEN THE DISPUTED DOMAIN NAME AND THE TRADEMARK

The Complainant submits that the disputed domain name <acerlormittalsa.com> which was registered by the Respondent on February 26, 2020 is confusingly similar to its trademark ARCELORMITTAL.

That is so because the domain name incorporates the entirety of the ARCELORMITTAL trademark in the domain name.

Making minor spelling alterations to the trademark as the Respondent has done in this case do not avoid a finding of confusing similarity to a trademark. Nor does the addition in this case of the letters 'sa' at the end of the disputed domain name which stand for societe anonyme and which merely indicate that the subject of the disputed domain name is a company.

It is well established that TLDs may typically be disregarded in the assessment under paragraph 4(a)(i) of the Policy when comparing disputed domain names and trademarks.

Past panels have already confirmed the Complainant’s rights in the ARCELORMITTAL mark, especially in cases of typosquatting.

Consequently, the disputed domain name <acerlormittalsa.com> is confusingly similar to Complainant’s trademark ARCELORMITTAL.

2. RIGHTS AND LEGITIMATE INTERESTS

The Respondent does not have any rights or legitimate interests in the disputed domain name.

The Complainant is obliged only to make out a prima facie case and then the onus of proof moves to the Respondent to disprove it.

In support thereof, the Complainant contends that the Respondent is not commonly known by the disputed domain name.

The Respondent is not related in any way to the Complainant, nor does it carry out any activity for, or have any business association with the Complainant.

Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademark ARCELORMITTAL, or to apply for registration of the disputed domain name by the Respondent.

The website to which the domain name resolves displays only a "Coming Soon" message.

Respondent has not made any use of disputed domain name since its registration, and Respondent has no demonstrable plan to use the disputed domain name. This demonstrates a lack of legitimate interests in respect of the disputed domain name.

3. REGISTRATION AND USE IN BAD FAITH

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

The Complainant contends that the disputed domain name <acerlormittalsa.com> is confusingly similar to its distinctive trademark ARCELORMITTAL. Moreover, the Complainant's trademark ARCELORMITTAL is widely known and past UDRP panels have confirmed its notoriety. Besides, the Respondent chose to add the abbreviation "SA", for "Société Anonyme" (i.e. the Complainant's corporate form) to the term ACERLORMITTAL, a typo-squatted version of the Complainant's trademark.

It is therefore reasonable to infer that the Respondent registered the disputed domain name with full knowledge of the Complainant's trademark.

Furthermore, the website to which the disputed domain name resolves is currently inactive and MX servers are configured. 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 disputed 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. Indeed, the disputed domain name is configured with MX records that allow it to be used to send e-mails that Internet users could well assume were sent by the Complainant.

Thus, Respondent has registered and is using the disputed domain name in bad faith.

RESPONDENT:

The Respondent did not file a Response in this proceeding.

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

Findings and Discussion of the Issues

This is a mandatory administrative proceeding pursuant to Paragraph 4 of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”) of the Internet Corporation for Assigned Names and Numbers (“ICANN”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the CAC Supplemental Rules.

A. Administrative deficiency

By notification dated March 5, 2020 and in accordance with paragraph 4 (b) of the Rules, the CAC notified the Complainant that the Complaint was administratively deficient regarding the appropriate identification of the domain name holder.

The notification invited the Complainant to have regard to the Registrar’s Verification available in the online case file in the form of a Nonstandard Communication regarding the appropriate identification of the domain name holder. On March 5, 2020, the Complainant filed an Amended Complaint and the CAC determined that the Complaint should be admitted to proceed further in the Administrative Proceeding.

The Panel has reviewed all of the above matters and makes a finding that within the meaning of paragraph 4(b) of the Rules, the administrative deficiencies have been corrected and that this matter has proceeded properly to the Panel in accordance with the Policy and the Rules.

B. Substantive matters

Paragraph 15 of the Rules provides that the Panel is to decide the complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In that regard, the Panel also notes that the onus is on the Complainant to make out its case and past UDRP panels have consistently said that a complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

The Panel therefore turns to discuss the various issues that arise for decision on the facts as they are known.

For the complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, 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.

The Panel will therefore deal with each of these requirements in turn.

A. Identical or Confusingly Similar

The Complainant has adduced evidence that the Panel accepts that it is the registered owner of the ARCELORMITTAL trademark and as such has rights in that trademark.

The Panel next finds that the disputed domain name is confusingly similar to the ARCELORMITTAL trademark for the following reasons:

First, the disputed domain name includes the entirety of the ARCELORMITTAL trademark and that word is by far the dominant part of the disputed domain name. Accordingly, the attention of the internet user would naturally be drawn to that part of the disputed domain name and would inculcate in the mind of the user the idea that the disputed domain name was an official domain name of the Complainant which has the same name.

Secondly, the Respondent has made some minor spelling alterations to the trademark before constructing the domain name, by way moving the letter “r” after the letter “e”. It is well established that making minor spelling alterations of that sort does not negate confusing similarity that is otherwise present, as it is in the present case.

Thirdly, the disputed domain name includes some letters that have been added to the amended spelling of the word ARCELORMITTAL, namely “sa“. Those letters are widely understood to signify Societe Anonyme, or company and the Complainant is a company. This must strengthen in the mind of the internet user the notion that the disputed domain name is an official domain name of the famous Arcelormittal Complainant which is a company.

Fourthly, taken as a whole, the disputed domain name would convey to the objective bystander that it related to the activities of the Complainant, giving rise to inevitable confusion.

It is also now well established that the addition of a generic top level domain, such as “.com” in the present case, cannot negate confusing similarity that is otherwise present, as it is in the present case.

The Complainant cites a number of prior UDRP decisions to support its contentions. The Panel accepts that the decisions are relevant and that they show that the conclusions the Complainant draws from them are correct.

Accordingly, the disputed domain name is confusingly similar to the Complainant’s trademark and the Complainant has thus shown the first of the three elements that it must establish.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

But by virtue of paragraph 4(c) of the Policy, it is open to the respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

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

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

(iii) you [respondent] are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Thus, if a respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the domain name, the complainant will have failed to discharge its onus and the complaint will fail.

It is also well-established that a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests and that when such a prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent cannot do so, a complainant is deemed to have satisfied

paragraph 4(a)(ii) of the Policy.

The Panel, after considering all of the evidence in the Complaint, finds that the Complainant has made out a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain name.

That prima facie case is made out from the following considerations.

The evidence of the Complainant is to the effect that the Respondent is not related in any way to the Complainant's business, is not affiliated with the Complainant or authorized by it in any way to use the ARCELORMITTAL trademark and does not carry out any activity for, nor has any business with, the Complainant. The Panel accepts that evidence.

It is also clear from the evidence that the Respondent is not commonly known by the disputed domain name under paragraph 4(c)(ii) of the Policy.

The Complainant also relies on the fact that the website to which the domain name resolves displays a "Coming Soon" message. This indicates that the Respondent is not using the disputed domain name for a legitimate purpose.

The Panel accepts this evidence and the conclusions the Complainant seeks to draw from it.
These facts and the conclusions drawn from them give rise to the prima facie case made out by the Complainant.

The Complainant cites a number of prior UDRP decisions to support its contentions and the Panel accepts that the decisions are relevant and that they show that the conclusions the Complainant draws from them are correct.

The Respondent has not filed a Response or made any other answer to the claims of the Complainant and is in default. Accordingly, the prima facie case has not been rebutted and the Complainant has made out the second of the three elements that it must establish.

C. Registered and Used in Bad Faith

The Complainant must prove on the balance of probabilities both that the disputed domain name was registered in bad faith and that it is being used in bad faith: Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003.

Paragraph 4(b) of the Policy sets out four circumstances, any one of which is evidence of the registration and use of a domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive. The four specified circumstances are:

(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 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 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 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 the respondent's website or location or of a product or service on the site or location.

The Panel finds that the Complainant has shown that the Respondent registered and used the disputed domain name in bad faith both in general and in particular because the Respondent's conduct puts the case squarely within paragraphs 4(b) (iii) and (iv) of the Policy and probably within the provisions of paragraph 4(b)(i) of the Policy.

That is so for the following reasons:

First, the Complainant submits that Respondent was aware of Complainant and its well-known ARCELORMITTAL trademark at the time of registration of the disputed domain name. The Panel agrees. Because of the fame and strong reputation of the trademark, the Respondent must have been aware of the existence of the Complainant and its reputation when it registered the disputed domain name. In particular, the Respondent could not have made randomly the association of the ARCELORMITTAL trademark and the popular initials,"sa", used to describe its corporate status, Sociaet Anonyme. The Panel accepts the Complainant's submission that it is highly likely that the Respondent chose such combination of words to invoke the concept of the Complainant and its activities. By that means the Respondent, in registering the disputed domain name deceptively and without any authority to do so, must be taken to have created a likelihood of confusion, with the intention of attracting current and potential customers of the Complainant looking for its services and doing so in this misleading manner. Those considerations bring the case within paragraphs 4(b) (iii) and (iv) of the Policy. Accordingly, the disputed domain name was registered in bad faith.

Secondly, the website currently resolves to an Error message. The Panel accepts the Complainant's evidence to that effect. The Panel concludes that the Respondent must have registered the disputed domain name to impersonate the Complainant and probably to induce it to buy the domain name from the Respondent primarily for the purpose of disrupting the business of Complainant whom it saw as a competitor, bringing the case within paragraph 4(b) (iii) of the Policy.

Thirdly, that evidence leads to the conclusion that the Respondent registered the disputed domain name to attract, for commercial gain, internet users to its website and that it would probably have pursued this intention had the Complainant not brought the present proceeding. These facts bring the case squarely within paragraph 4(b)(iv) of the Policy, i.e. "by using the domain name, (the Respondent) ... intentionally attempted to attract, for commercial gain, Internet users to (its) 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 (its) web site or location or of a product or service on (its) web site or location".

Fourthly, in addition and having regard to the totality of the evidence, the Panel finds that, in view of Respondent's registration of the disputed domain name using the ARCELORMITTAL trademark and in view of the conduct that Respondent has engaged in when using the disputed domain name, Respondent registered and used it in bad faith within the generally accepted meaning of that expression.

The Complainant cites a number of prior UDRP decisions to support its contentions and the Panel accepts that the decisions are relevant and that they show that the conclusions the Complainant draws from them are correct.

Accordingly, the Complainant has shown the third of the three elements that it must establish.

Principal Reasons for the Decision

The onus is on the complainant to make out its case and show that all three elements of the Policy have been made out, as follows.

(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.

A. Identical or Confusingly Similar

The Complainant is a prominent steel manufacturing company and the registered owner of the ARCELORMITTAL trademark. As such, it has rights in that trademark. The disputed domain name is confusingly similar to the ARCELORMITTAL trademark because the disputed domain name includes the entirety of the ARCELORMITTAL trademark with the spelling of the trademark altered in a minor way and the letters "sa" standing for Societe Anonyme or company being added. This must strengthen in the mind of the internet user the notion that the disputed domain name is an official domain name of the famous Arcelormittal corporate Complainant. The result is that the disputed domain name would convey to the objective bystander that it related to the Complainant and its activities, giving rise to inevitable confusion.

B. Rights or Legitimate Interests

The Respondent has no rights or legitimate interests in the disputed domain name. The Complainant has to make out a prima facie case to that effect after which the Respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name.

In the present case the prima facie case was made out from the facts that the Respondent has taken the Complainant's trademark and used it without permission in his domain name making only minor spelling alterations. Also, the respondent is not affiliated with the Complainant or authorized by it in any way to use the ARCELORMITTAL trademark and does not carry out any activity for, nor has any business with, the Complainant. Nor is it commonly known by the disputed domain name.

These facts make out the prima facie case and the Respondent has not sought to rebut it as it has not filed a Response.

C. Bad Faith

The Respondent registered and used the disputed domain name in bad faith both in general and in particular.

That is because Respondent had actual notice of Complainant and its well-known ARCELORMITTAL trademark at the time of registration of the disputed domain name. The Respondent thus had actual notice of the Complainant's trademark which was famous and had a strong reputation.

Secondly, the website currently resolves to an Error message, suggesting that the Respondent registered the disputed domain name to impersonate the Complainant and probably to induce it to buy the disputed domain name from the Respondent and thus primarily for the purpose of disrupting the business of Complainant whom it saw as a competitor, bringing the case within paragraph 4(b) (iii) of the Policy.

Thirdly, the Respondent probably registered the disputed domain name to attract, for commercial gain, internet users to its website and that it would probably have pursued this intention had the Complainant not brought the present proceeding. These facts bring the case squarely within paragraph 4(b)(iv) of the Policy, i.e. “by using the domain name, (the Respondent) ... intentionally attempted to attract, for commercial gain, Internet users to (its) 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 (its) web site or location or of a product or service on (its) web site or location”.

Fourthly, in view of Respondent’s registration of the disputed domain name using the ARCELORMITTAL trademark and in view of the conduct that Respondent has engaged in when using the disputed domain name, Respondent registered and used it in bad faith within the generally accepted meaning of that expression.

The Respondent did not reply to the Complainant's claims.

Accordingly, the Complainant has shown all three elements under the Policy that it had to establish.

For the reasons set out in the Decision, the Complaint was accepted and the disputed domain name was ordered to be transferred to the Complainant.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ACERLORMITTALSA.COM**: Transferred

PANELLISTS

Name	**The Hon. Neil Brown, QC**

DATE OF PANEL DECISION 2020-04-03

Publish the Decision