Decision for dispute CAC-UDRP-103225

Case number	CAC-UDRP-103225
Time of filing	2020-08-13 10:57:19
Domain names	arcelormittal1.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	ARCELORMITTAL (SA)

Complainant representative

Organization	Nameshield (Enora Millocheau)

Respondent

Name	PHISH PHISH

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name

IDENTIFICATION OF RIGHTS

The Complainant owns the International Trademark no. 947686, registered on August 3, 2007 and claiming protection for numerous countries of the world.

FACTUAL BACKGROUND

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

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 89.9 million tones crude steal made in 2019. 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 and of the domain name <arcelormittal.com> registered since January 27, 2006

The disputed domain name <arcelormittal1.com> was registered on August 5, 2020.

The Complainant states that the disputed domain name <arcelormittal1.com> is confusingly similar to its trademark ARCELORMITTAL. The addition of the number "1" is not sufficient to escape the finding that the domain name is confusingly similar to the trademark ARCELORMITTAL.

The Complainant states that the Respondent has no right nor legitimate interest in the disputed domain name and that it is not related in any way to its business. Furthermore, the Complainant informs that ARCELORMITTAL (SA) does not carry out any activity for, nor has any business with the Respondent and observes that the Respondent is not commonly known by <arcelormittal1.com> or by other names similar to the disputed domain name.

The website corresponding to <arcelormittal1.com> is inactive and is configured with MX records that allow it to be used to send emails. Given the distinctiveness and reputation of the trademark ARCELORMITTAL it is reasonable, in the Complainant's view, to infer that the Respondent has registered the domain name with the full knowledge of the Complainant's trademarks and with the purpose to send emails that Internet users could assume were sent by the Complainant

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

Paragraph 4(a) of the Policy provides that to obtain the transfer of the disputed domain name, the Complainant must prove that each of the following elements is present:

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

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

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

1) The disputed domain name <arcelormittal1.com> reproduces the Complainant's ARCELORMITTAL trademark in its entirety with the addition of the number “1” after the wording ARCELORMITTAL, thus the disputed domain name is

undoubtedly confusingly similar to the trademark ARCELORMITTAL in which the Complainant has rights. Actually, this Panel agrees with the Complainant's opinion and previous UDRP decisions, affirming that confusing similarity is generally established when the domain name incorporates the complainant's trademark in its entirety merely adding a descriptive suffix. This, in consideration of the fact that the addition of a descriptive suffix, which has a very limited weight in the comparison between the signs to be analyzed, is not able to avoid confusing similarity between the older mark and the contested domain name (see Experian Information Solution, Inc v. Credit Research, Inc., WIPO Case. No. D2002-0095 and Hang Seng Bank Limited v. Websen Inc., WIPO Case No. D2000-0651). The addition of a number after the wording corresponding to the Complainant's trademark is nothing more than adding a descriptive and generic suffix to the Complainant's mark; actually, as indicated in the decision for Inter IKEA Systems B.V. v. New Ventures Services, Corp, CAC Case No. 102433 “Such addition of the number “90” after word “ikea” does not reduce the high degree of similarity between the disputed domain name and the Complainant’s trademark" (in the same direction Academy of Motion Picture Arts and Sciences v. 007 Promotions, WIPO Case No. D2009-1523; LEGO Juris A/S v. huangderong. WIPO Case No. D2009-1325 and Sanofi. v. Alexander M Kowalsky, WIPO Case No. D2012-1123). Finally, the top level “.com” is merely instrumental to the use in Internet - as found in accordance with all previous UDRP decisions - and is absolutely not able to affect the confusing similarity of the disputed domain name to the Complainant’s trademark. Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark ARCELORMITTAL and consequently finds that paragraph 4(a)(i) of the Policy has been established.

2) The Complainant has long standing rights in the mark ARCELORMITTAL. The Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain name as it is not commonly known under the disputed domain name and as the Respondent was never authorized to use the domain name by the Complainant. The Respondent, in the absence of any response, has not shown any facts or element to justify prior rights or legitimate interests in the disputed domain name. The Complainant has not licensed or otherwise permitted the Respondent to use the Complainant's marks in the disputed domain name. On the basis of the evidences submitted and in the absence of a response the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name. Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

3) The disputed domain name is inactive. This circumstance does not prevent a finding of bad faith use. Previous Panels have held that the passive holding of a domain name can be considered as use in bad faith (see, between many others, Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003 and Cleveland Browns Football Company LLC v. Andrea Denise Dinoia, WIPO Case No. D2011-0421). Furthermore it is the Panel's view that the disputed domain name has been registered in bad faith because the Respondent was or must have been perfectly aware of the existence of ARCELORMITTAL trademark, which is highly distinctive and unique for the registered goods and services, when the same Respondent registered the domain name <arcelormittal1.com>. When considering this, in conjunction with the fact that the Respondent has been passively holding the disputed domain name and has not submitted any evidence suggesting that the domain name was selected for a legitimate use or purpose, an inference of bad faith registration and use is made by the Panel (see, between many others, Incipio Technologies, inc. v. Starfield Services Ltd, WIPO Case No. D2011-0418). Finally, the Complainant has provided evidence that the Respondent has set up “MX-records” for the disputed domain name. This entails that the Respondent can send e-mails through the e-mail address “@arcelormittal1.com”. The Respondent can therefore use the disputed domain name to send fraudulent e-mails such as messages containing spam and/or phishing attempts that Internet users could well assume were sent by the Complainant. (See also Conféderation Nationale du Crédit Mutuel, Crédit Industriel et Commercial v. Khodor Dimassi, WIPO Case No. D2016-1980; Paris Saint-Germain Football v. MHP Private, WIPO Case No. D2019-0036). Albeit that there are no concrete examples of such use, it seems inconceivable that the Respondent will be able to make any good faith use of the disputed domain name as part of an e-mail address. The Panel finds that the mere conduct of making preparation for sending emails which are very likely to confuse the recipient of such e-mails as to their origin, is without justification and is inconsistent with the Complainant’s exclusive rights in the ARCELORMITTAL trademark (see Accenture Global Services Limited v. Registration Private, Domains by Proxy, LLC / Richa Sharma, Name Redacted, WIPO Case No. D2019-2453). In consideration of the above, the Panel deems that the domain name in dispute was registered and used in bad faith and accordingly that the Complainant has satisfied also 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. **ARCELORMITTAL1.COM**: Transferred

PANELLISTS

Name	**Avv. Guido Maffei**

DATE OF PANEL DECISION 2020-09-11

Publish the Decision