

## Decision for dispute CAC-UDRP-103508

Case number	CAC-UDRP-103508
Time of filing	2021-01-14 09:15:45
Domain names	arcelormittalsmartersteels.com

### Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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### Complainant

Organization	ARCELORMITTAL S.A.
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### Complainant representative

Organization	Nameshield (Laurent Becker)
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### Respondent

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#### 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 relies on its rights as the owner and registered proprietor of the international trademark n°947686 ArcelorMittal registered on 3 August 2007 registered in over 32 countries and in classes 06,07,09,12,19,21,39,40,41 and 42.

Those countries include AU - BQ - CW - EM - GE - IS - JP - KR - NO - SG - SX - SY - TR - US - UZ and AL - AM - AZ - BA - BY - CH - CN - CU - DZ - EG - HR - IR - KE - KG - KP - KZ - LR - MA - MC - MD - ME - MK - MN - RS - RU - SD - SM - TJ - UA - VN and SG - US.

It also relies on its extensive use in trade internationally which makes it a well-known mark.

In common law jurisdictions it may have rights arising from use in trade.

The Complainant also owns a large domain name portfolio, including <arcelormittal.com> registered on 27 January 2006.

#### 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 tonnes crude steel made in 2019.

The disputed domain name was registered on 9 January 2021 and is currently inactive.

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#### PARTIES CONTENTIONS

#### PARTIES' CONTENTIONS:

##### COMPLAINANT:

The Complainant says the disputed domain name is confusingly similar to its trademark in which it is included in its entirety and the addition of terms "smarter steels" is not sufficient to avoid the likelihood of confusion with the Complainant, its trademarks and domain names. 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 trademark, see WIPO Overview 3.0, section 1.11. Consequently, the disputed domain name <arcelormittalsmartersteels.com> is confusingly similar to Complainant's trademark.

The Complainant says the Respondent does not have any rights or legitimate interest in the disputed domain name. 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 UDRP.

The Complainant asserts that the Respondent is not known as/by 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 it. Thus, the Respondent is not known as the disputed domain name. 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>. 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 with the Complainant. The Complainant does not carry out any activity for, nor has any business with the Respondent. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademark or apply for registration of the disputed domain name by the Complainant.

The disputed domain name is not used. The Complainant contends that Respondent did not make any use of disputed domain name since its registration, and it confirms that Respondent has no demonstrable plan to use the disputed domain name. It demonstrates a lack of legitimate interests in respect of the disputed domain name. Thus, in accordance with the foregoing, the Complainant contends that the Respondent has no right or legitimate interest in the disputed domain name.

The Complainant says the disputed domain name has been registered and is being used in bad faith. The Complainant's trademark is well known. Past panels have confirmed the notoriety of the trademark, 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 (7 February 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."). 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."). Given the distinctiveness of the Complainant's trademark and reputation, it is reasonable to infer that the Respondent has registered the domain name with full knowledge of the Complainant's trademark. Furthermore, the disputed domain name is currently inactive.

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 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. As prior WIPO UDRP panels have held, the incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use. Please see for instance: WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows and WIPO Case No. D2000-0400, CBS Broadcasting, Inc. v. Dennis Toeppen. Given the distinctiveness of the Complainant's trademark and reputation, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark. Please see WIPO Case No. DCO2018-0005, ArcelorMittal SA v. Tina Campbell. Thus, 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.

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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).

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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).

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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).

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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.

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PRINCIPAL REASONS FOR THE DECISION

There is no question as to Rights and the Complainant and its mark are well-known. 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 full trade mark is included with the laudatory words "smartersteels."

The use of the full mark in its entirety always implicates impersonation to some extent. Here the additional words are generic and/or descriptive. These words appear like a strapline and combined with the full mark, give the impression that the domain is official - that it is 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.

The many cases the content of the website in question will remove any doubt or compound it. Here there is only passive holding. It does not help. This places this case firmly in the impersonation zone. Therefore the Panel finds that as there is no use, the Respondent has no rights or legitimate interests in respect of the disputed domain name.

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. Here there can be no doubt the Respondent knew about the Complainant and its rights. 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.

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. **ARCELORMITTALSMARTERSTEELS.COM**: Transferred

## PANELLISTS

Name	Victoria McEvedy
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DATE OF PANEL DECISION 2021-02-18

Publish the Decision