

Decision for dispute CAC-UDRP-103739

Case number	CAC-UDRP-103739
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Time of filing	2021-04-19 09:37:45
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Domain names	arcelor-steel.com
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Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	ARCELORMITTAL (SA)
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Complainant representative

Organization	Nameshield (Enora Millocheau)
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Respondent

Name	IT DEPART
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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

International Registration No. 778212 ARCELOR for various goods and services in classes 1, 6, 7, 9, 12, 37, 40 and 42 (including steels) designating numerous countries such as Australian Trade Mark Registration No. 969925.

FACTUAL BACKGROUND

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

The Complainant, ArcelorMittal (SA), is a company that specializes in steel producing. It is the largest steel manufacturer in the Americas, Africa and Europe. It manufactures steel in 18 countries and has over 190,000 employees. In the year 2019 it made 89.8 million tonnes in crude steel.

The Complainant is the owner of International Registration No. 778212 ARCELOR for various goods and services in classes 1, 6, 7, 9, 12, 37, 40 and 42 (including steels) designating numerous countries such as Australian Trade Mark Registration No. 969925 (which has a registration date of 31 August 2001). It is also the registrant of the domain name <arcelor.com>.

The Respondent registered the disputed domain name on 10 April 2021. Its name is listed as IT DEPART and it provided an address in Lagos, Nigeria.

The disputed domain name resolves to a parking page containing various links, none of which appear to obviously refer to either party or the steel industry.

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 lists three elements that the Complainant must prove to merit a finding that the disputed domain name registered by the Respondent be transferred to the Complainant:

- 1) the disputed domain name is identical or confusingly similar to a trademark or service mark ("mark") in which the Complainant has rights; and
- 2) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- 3) the disputed domain name has been registered and is being used in bad faith.

The Panel is satisfied that the Complainant has satisfied all three elements for the principal reasons set out below.

RIGHTS IN AN IDENTICAL OR CONFUSINGLY SIMILAR TRADEMARK

As mentioned above the Complainant claims registered rights over the trade mark ARCELOR through the designation of a number of jurisdictions in an international application. Such designation includes the establishment of registered rights in relation to "steels" which predated the registration of the disputed domain name by over 15 years.

To satisfy paragraph 4(a)(i) of the Policy it is enough that the Panel is satisfied that the Complainant has registered rights in a single trademark in a single jurisdiction that predates the registration of the disputed domain name (even if that single jurisdiction is not one in which the Respondent resides or operates) (Koninklijke KPN N.V. v. Telepathy, Inc D2001-0217 (WIPO May 7, 2001); see also WIPO Case Nos. D2012-0141 and D2011-1436).

Prior registered rights in ARCELOR are clearly established here.

The next question is whether the disputed domain name, <arcelor-steel.com>, is confusingly similar to ARCELOR.

The Complainant asserts that the addition of the word "steel" in the disputed domain actually "worsens the likelihood of confusion" between it and the ARCELOR trade mark. The ARCELOR trade mark is registered for "steels" and it is a well-known mark in relation to steel production.

The Panel accepts this argument. It is clear on the evidence that the ARCELOR trade mark is well-known in relation to steel production. In particular, it is used by the Complainant in relation to the largest steel manufacturing business in Africa.

The Panel is therefore satisfied that <arcelor-steel.com> is confusingly similar to a trademark in which the Complainant has rights.

NO RIGHTS OR LEGITIMATE INTERESTS

The Respondent's name bears no resemblance to the disputed domain name. Further, the disputed domain name does not resolve to a website that in anyway indicates any such rights or interests.

There is simply no basis to conclude that the Respondent has rights or interests in the disputed domain name.

BAD FAITH

The Complainant asserts that bad faith is established by the incorporation of its well-known trade mark coupled with the lack of any arguable legitimate use of the domain name, which currently redirects to a parking page.

The Panel accepts this argument for the reasons set out below. However, as a preliminary matter the Panel seeks to make clear that it does not find that the use of the domain name to resolve to a parking page suffices in this matter to support a finding of bad faith.

Failing to redirect a domain name to an active website or merely directing the domain name to a basic parking page that contains links to other websites can be legitimate conduct. It is commonly referred to as 'passive holding'. Whilst it is true that the passive holding of a domain name may, in appropriate circumstances, be indicative of bad faith. It will only be so indicative when all the circumstances of the Respondent's behaviour indicates he or she is acting in bad faith (Telstra Corporation Ltd v. Nuclear Marshmallows D2000-0003 (WIPO February 18, 2000)). There is no law or rule that a domain name cannot be parked or that it must be used to redirect to an active website within a specific period of time.

In the present proceeding the fact that the disputed domain name redirects web-users to a parking page adds nothing to an allegation of bad faith. Nothing on that parking page indicates any attempt to use the domain name for an unlawful or confusing purpose. If anything, it simply shows the Complainant has not yet decided to direct the disputed domain name to any active website and it has therefore just merely elected to park the domain name with a parking service. This passive action is of no concern to the Panel whatsoever. The disputed domain name was only registered three days before the ADR proceeding was commenced by the Complainant.

In the Panel's view one ought not be harshly judging a registrant's mere passive holding of a domain name over such a short period of time. It is prudent to consider what a reasonably minded bona fide registrant may intend by the same behaviour. And it is entirely possible that such a hypothetical person may first register a domain name they wish to use and then take weeks or even months to develop a web page for which they wish to use it. It is equally possible that such a hypothetical person may use the domain name for an e-mail service only. These legitimate foreseeable possibilities must be considered when determining if an allegation of passive holding amounts to, or contributes to, a finding of bad faith.

However, what is of great concern to the Panel in this present proceeding is that:

- (a). ARCELOR is a well-known trade mark; and
(b). ARCELOR is used in relation to the largest steel manufacturing business in the Respondent's home continent, being Africa.

It is entirely unforeseeable that a reasonable person residing in Africa could register a domain name consisting of the word elements ARCELOR and STEEL without knowledge of the Complainant's rights.

The Panel finds that the Respondent had such prior knowledge at the time of registering the disputed domain name and therefore its only purpose in registering the disputed domain name was to opportunistically profit from confusing similarity. The Respondent clearly targeted the Complainant's well-known domain name for this purpose.

Therefore, in consideration of all the circumstances the disputed domain name has been registered and is being used 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-STEEL.COM**: Transferred

PANELLISTS

Name	Mr Andrew Norman Sykes
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DATE OF PANEL DECISION	2021-05-24
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Publish the Decision