

Decision for dispute CAC-UDRP-104080

Case number CAC-UDRP-104080

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Domain names arcelomittalmx.com

Case administrator

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

Complainant

Organization ARCELORMITTAL (SA)

Complainant representative

Organization NAMESHIELD S.A.S.

Respondent

Name Roberto Villa

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

The Complainant also owns an important domain names portfolio, such as the domain name <arcelormittal.com> registered since January 27, 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 71.5 million tonnes of crude steel made in 2020.

It holds sizeable captive supplies of raw materials and operates extensive distribution networks. According to the information on its website at www.arcelormittal.com, it has steel manufacturing in 17 countries, with customers in 160 countries.

The disputed domain name <arcelomittalmx.com> was registered on October 9, 2021 and redirects to a copy of the Complainant's Mexican website.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain name is identical to 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.

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's trademark "ARCELORMITTAL" and its domain names associated.

It asserts that the deletion of the letter R and the addition of the abbreviation "MX", for Mexico and the gTLD ".com" is insufficient to distinguish the disputed domain name from the Complainant's trademark ARCELORMITTAL.

In support of its contention, the Complainant relies on previous similar cases involving the Complainant. See WIPO Case No. D2020-1174, ArcelorMittal (Société Anonyme) v. Avinash Maharaj, Avinash Maharaj <arcelomittalsa.com>; CAC Case No. 101989, ARCELORMITTAL S.A. v. Jeton Heta, <kryviy-arcelormittal.com>; CAC Case No. 101276, ARCELORMITTAL v. Whois Privacy Corp., <arcelormittal-us.com>; and CAC Case No. 101154, ARCELORMITTAL S.A. v. Gluyag Paul, <arcelormittaluk.com>.

When part of a domain name is identical to a well-known trademark, it increases the likelihood of confusion or association between the domain name holder and the trademark owner. It is, therefore, sufficient to establish identity or confusing similarity for the purposes of the Policy. See Oki Data Americas, Inc. v. ASD, Inc, WIPO Case No. D2001-0902; Dr. Ing. h.c. F. Porsche AG v Vasilij Terkin, WIPO Case No D2003-003-0888.

It is also a well-established principle in the domain name space that specific top-level domains such as ".COM", ".ORG" or ".NET" do not affect the domain name for the purpose of determining whether it is identical or confusingly similar. For example, WIPO Case No. D2006-0451, F. Hoffmann-La Roche AG v. Macalve e-dominios S.A; WIPO Overview 3.0 Section 1.11.1.

Applying the above well-established principle to the present case, the Panel finds as follows:

- (a) The disputed domain name is a misspelling of the term "ARCELORMITTAL" with the removal of the letter "R" from the letters "LOR" combined with the letters "MX", which is likely to be understood as an abbreviation of Mexico;
 - (b) Using an abbreviation of a geographical location is not sufficient to distinguish the disputed domain name from the trademark of the Complainant in the present case;
 - (c) The addition of ".COM" does not affect the determination of whether the disputed domain name is confusingly similar to the Complainant's trademark;
 - (d) The Complainant's trademark is a well-known registered trademark that has been used in connection with its business services and offerings for over a decade. Its trademark is clearly recognizable in the disputed domain name, and accordingly the disputed domain name is confusingly similar to the Complainant's trademark.
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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.

A complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests. Once such a prima facie case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. See WIPO Case No. D2003-0455, Croatia Airlines d.d. v. Modern Empire Internet Ltd.

The Complainant asserts that the Respondent is not known as the disputed domain name, but as "Roberto Villa". Here, the Respondent is not identified in the WHOIS database as the disputed domain name.

Where information in the WHOIS database is not similar to the disputed domain name, a respondent is not commonly known by the disputed domain name. For example, 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 Panel accepts this assertion, which is supported by the evidence from the WHOIS database adduced by the Complainant.

The Complainant also contends that the Respondent has no rights or legitimate interests in the disputed domain name, and that he is not related in any way with the Complainant. The Complainant states that it does not carry out any activity for, nor has any business with the Respondent. The Complainant further states that it has not licensed nor authorized the Respondent to make any use of the Complainant's trademark or apply for registration of the disputed domain name.

The Respondent has not filed any administrative compliant response to the Amended Complaint.

Accordingly, the Panel accepts these uncontradicted contentions.

Finally, the Complainant adduces evidence that the disputed domain name redirects to a copy of the Complainant's Mexican website. The Complainant contends that the owner of the disputed domain name is trying to pass himself off as an affiliate of the Complainant for his own commercial gain. The redirection of the disputed domain name to the Complainant's website clearly indicates a positive act on the Respondent's part that knowingly uses a legitimate website of the Complainant for his own commercial gain. The Complainant has already asserted, which the Panel accepts as uncontradicted, that any such use was not authorized.

Accordingly, the Panel views that the Respondent is not using the disputed domain name in connection with any bona fide offering of goods or services or a legitimate non-commercial or fair use. It is also no answer that traffic is being directed from the disputed domain name to the Complainant's website in Mexico. It is clear to the Panel that the disputed domain name is being used in a manner designed to allow the Respondent to pass himself off as the Complainant and/or in some way associated with the Complainant.

Accordingly, the Panel considers that the evidence adduced by the Complainant supports its contention that there is no bona fide offering of goods or services nor a legitimate non-commercial or fair use of the disputed domain name.

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.

There are two elements that must be satisfied – registration and use in bad faith.

Registration in bad faith

The evidence shows, and the Panel accepts, that the Complainant's trademark "ARCELORMITTAL" is widely known. The Complainant also refers to Past Panels' decision confirming the notoriety of its trademark. See CAC Case No. 101908, ARCELORMITTAL v. China Capital; CAC Case No. 101667, ARCELORMITTAL v. Robert Rudd.

The Complainant's trademark was clearly registered prior to the registration of the disputed domain name.

The Complainant contends that 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.

The Panel accepts that the Complainant's trademark is so well known internationally for metals and steel production. See WIPO Case No. DCO2018-0005, ArcelorMittal SA v. Tina Campbell

Given the distinctiveness of the Complainant's trademark, the well-known nature of the Complainant's trademark and its reputation, the inescapable inference that the Panel is prepared to draw is that the Respondent registered the disputed domain name with full knowledge of the Complainant's trademark. This is particularly so given that the disputed domain name redirects to a copy of the Complainant's Mexican website.

Accordingly, the Panel accepts that the disputed domain name was registered by the Respondent in bad faith.

Use in bad faith

The Panel has already referred to the uncontroverted facts set out in the Complaint and accepts the evidence and contention that the disputed domain name redirects to a copy of the Complainant's Mexican website.

The redirection of the disputed domain name to the Complainant's Mexican website is a positive act by the Respondent, which the Panel infers that it was done knowingly and without the authorization of the Complainant. The Respondent's conduct here, which remains uncontradicted, therefore clearly indicates his intention to use the Complainant's trademark and its reputation for his own commercial gain. Using the disputed domain name in this manner is clearly designed to allow the Respondent to pass himself off as the Complainant. This is use in bad faith. See Forum Case No. 1649982, DramaFever Corp. v. olxhost c/o olxhost; CAC Case No. 102654, ARCELORMITTAL S.A. v. Luis Patino.

The Panel, therefore, concludes that the Respondent's holding of the disputed domain name in this particular case satisfies the requirement that the disputed domain name is being used in bad faith by the Respondent.

Accordingly, the Panel finds that the registration of the disputed domain name and its use were in bad faith.

PROCEDURAL FACTORS

Notification of proceedings to the Respondent

When forwarding a Complaint, including any annexes, electronically to the Respondent, paragraph 2 of the Rules states that CAC shall employ reasonably available means calculated to achieve actual notice to the Respondent.

Paragraphs 2(a)(i) to (iii) set out the sort of measures to be employed to discharge CAC's responsibility to achieve actual notice to the Respondent.

On November 4, 2021 the CAC by its non-standard communication stated as follows (omitting irrelevant parts):

- That neither the written notice of the Complaint nor the advice of delivery thereof was returned to the Czech Arbitration Court;

- As far as the e-mail notice is concerned, the CAC received a confirmation that the e-mail sent to villababalucas001@gmail.com was successfully relayed;

- The e-mail notice sent to postmaster@arcelomittalmx.com was returned back undelivered as the e-mail address had permanent fatal errors.

No further e-mail address could be found on the disputed site. The Respondent never accessed the online platform.

Given the reasonable measures employed by CAC as set out in the above Nonstandard Communication, 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

The Complainant owns the international trademark "ARCELOMITTAL", and the domain name <arcelomittal.com> which are used in connection with its goods or services for over a decade.

The Respondent registered the disputed domain name <arcelomittalmx.com> on October 9, 2021 which redirects to a copy of the Complainant's Mexican website.

The Complainant challenges the Respondent's registration of the disputed domain name under paragraph 4(a)(i) of the Uniform Dispute Resolution Policy ("Policy") and seeks relief that the disputed domain name be transferred to the Complainant.

The Respondent failed to file any administratively compliant response.

For the reasons articulated in the Panel's reasons above, the Complainant has satisfied the Panel of the following:

- (a) The disputed domain name is confusingly similar to the Complainant's well-known trademark "ARCELOMITTAL";
- (b) The Respondent has no rights or legitimate interests in respect of the disputed domain name;
- (c) 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. ARCELOMITTALMX.COM: Transferred

PANELLISTS

Name	Adjunct Prof William Lye, OAM QC
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DATE OF PANEL DECISION 2021-11-13

Publish the Decision
