

Decision for dispute CAC-UDRP-104154

Case number CAC-UDRP-104154

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Domain names mittalsteelgroup.com

Case administrator

Organization Denisa Bilík (CAC) (Case admin)

Complainant

Organization ARCELORMITTAL S.A.

Complainant representative

Organization NAMESHIELD S.A.S.

Respondent

Name qi bing Xue

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, ARCELORMITTAL S.A., is the largest steel producing company worldwide (www.arcelormittal.com). It is one of the market leaders in steel for use in automotive, construction, household appliances and packaging with operations in more than 60 countries and holds sizeable captive supplies of raw materials and operates extensive distribution networks. The Complainant is the owner of the following "MITTAL STEEL" registered trademark, European Trademark No. 4233301 for "MITTAL STEEL" registered on January 7, 2005.

The Complainant also owns the domain name <mittalsteel.com> which comprises of its MITTAL STEEL mark since January 2, 2003.

FACTUAL BACKGROUND

The Complainant contends that the disputed domain name is confusingly similar to its MITTAL STEEL mark on the basis that the disputed domain name includes the trademark in its entirety. The addition of the descriptive term "GROUP" and gTLD ".com" are insufficient to escape the finding that the disputed domain name is confusingly similar to its MITTAL STEEL mark.

The Complainant also argues that the Respondent does not have any rights or legitimate interest in the disputed domain name. The Respondent is not commonly known by the disputed domain name and is not authorized or licensed by the Complainant to make any use of the Complainant's MITTAL STEEL mark or register the disputed domain name. Further, the Respondent did not make any use of the disputed domain name since registration and has been passively holding the disputed domain name.

The Complainant further asserts that the domain name has been registered and is being used in bad faith as the Respondent should have known of the Complainant's MITTAL STEEL mark at the time of registration of the disputed domain name given the distinctiveness of its MITTAL STEEL mark and reputation. The disputed domain name is also passively held by the Respondent and resolved to an inactive webpage.

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.

Preliminary Issue: Language of Proceedings

Paragraph 11 of the Rules provides that:

“(a) Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.”

The language of the Registration Agreement for the disputed domain name <mittalsteelgroup.com> is Chinese.

The Complainant requested that the language of the proceeding be English for the following reasons:

- The disputed domain name consists of Roman characters (ASCII) and not in Chinese script; and
- The disputed domain name consists of the trademark "mittalsteel" and English term "group".

For these reasons, the Complainant contends that the Respondent has knowledge of the English language. The Respondent did not comment on the language of the proceeding.

The Panel cites the following with approval: “Thus, the general rule is that the parties may agree on the language of the administrative proceeding. In the absence of this agreement, the language of the Registration Agreement shall dictate the language of the proceeding.

However, the Panel has the discretion to decide otherwise having regard to the circumstances of the case. The Panel's

discretion must be exercised judicially in the spirit of fairness and justice to both parties taking into consideration matters such as command of the language, time and costs. It is important that the language finally decided by the Panel for the proceeding is not prejudicial to either one of the parties in his or her abilities to articulate the arguments for the case.” (See *Groupe Auchan v. xmxzl*, WIPO Case No. DCC2006 0004).

Having considered the above factors, the Panel determines that English be the language of the proceeding. The Panel agrees that the Respondent appear to be familiar with the English language, taking into account its selection of the English-language trademark and the domain name in dispute. In the absence of an objection by the Respondent, the Panel does not find it procedurally efficient to have the Complainant translate the Complaint and evidence into Chinese.

PRINCIPAL REASONS FOR THE DECISION

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a complainant to show that a domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. The Complainant has provided evidence that it owns the MITTAL STEEL trademark in the EU, but failed to comply with the Panel's administrative decision to provide evidence of a Chinese trademark registration, which the Complainant wished to rely on. While this failure would be crucial in some cases, in the present case, given that the Respondent did not respond, this failure is not fatal since a single registered trademark registration satisfies the requirements of the Policy in most cases. Complainant should take note that when it wishes to rely on a registered trademark, a copy of the certificate of registration should be provided to the Panel as part of its evidence.

The domain name wholly incorporates the Complainant's registered trademark, leading to a likelihood of establishing confusing similarity for purposes of the Policy. (see *Dr. Ing. H.c. F. Porsche AG v. Vasilij Terkin*, WIPO Case No. D2003-0888).

The differences between the disputed domain name and the Complainant's MITTAL STEEL trademark are the addition of the descriptive term "GROUP" and the gTLD ".COM". It is established that the addition of a descriptive term would not prevent a finding of confusing similarity under the first element (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 1.8).

It is also established that a gTLD is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test (WIPO Overview 3.0, section 1.11). The addition of a gTLD to a disputed domain name does not avoid confusing similarity as the use of a TLD is technically required to operate a domain name (see *Accor v. Noldc Inc.*, WIPO Case No. D2005-0016; *F. Hoffmann-La Roche AG v. Macalve e-dominios S.A.*, WIPO Case No. D2006-0451; *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003; *L'Oréal v Tina Smith*, WIPO Case No. 2013-0820; *Titoni AG v Runxin Wang*, WIPO Case No. D2008-0820; and *Alstom v. Itete Peru S.A.*, WIPO Case No. D2009-0877).

The disputed domain name consists of the Complainant's MITTAL STEEL mark and the addition of the descriptive term "GROUP" and a gTLD ".com" which in the Panel's view does not avoid confusing similarity with the Complainant's trademark (see *Schneider Electric S.A. v. Domain Whois Protect Service / Cyber Domain Services Pvt. Ltd.*, WIPO Case No. D2015-2333; WIPO Overview 3.0, section 1.9). In this case, the addition of the gTLD ".COM" is a standard registration requirement and should be disregarded under the first element confusion similarity test (see WIPO Overview 3.0, section 1.11.1).

Therefore, the Panel finds that the disputed domain name is confusingly similar to the MITTAL STEEL mark and the element under paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Paragraph 4(a)(ii) of the Policy requires the complainant to show that the respondent has no rights or interests in respect of the domain name. Once the complainant establishes a prima facie case that the respondent lacks rights or legitimate interests in the domain name, the burden of production shifts to the respondent to show that it has rights or legitimate interests in respect to the domain name (see WIPO Overview 3.0, section 2.1).

In the present case, the Complainant has demonstrated prima facie that the Respondent lacks rights or legitimate interests in respect of the disputed domain name and the Respondent has failed to assert any such rights or legitimate interests.

The Complainant submitted evidence that the Respondent is not identified in the Whois database as the disputed domain name. The evidence shows that respondent is not commonly known by a disputed domain name if the WHOIS information is not similar to the disputed domain name (see Forum Case No. FA 1781783, Skeches U.S.A. Inc. and Skechers U.S.A., Inc. II v Chad Moston / Elite Media Group).

The Complainant also submitted evidence that the Respondent has no rights or legitimate interests in respect of the 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 inactive. The Complainant contends that the Respondent did not make any use of disputed domain name since its registration which is indicative in these circumstances that the Respondent has no demonstrable plan to use the disputed domain name which further demonstrates a lack of legitimate interests in respect of the disputed domain name.

The Respondent did not submit a response in the present case and did not provide any explanation or evidence to show rights or legitimate interests in the disputed domain name which is sufficient to rebut the Complainant's prima facie case. The Panel is therefore of the view that the Respondent has no rights or legitimate interests in respect of the disputed domain name and accordingly, paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

The complainant must show that the respondent registered and is using the domain name in bad faith (Policy, paragraph 4(a)(iii)). Paragraph 4(b) of the Policy provides circumstances that may evidence bad faith under paragraph 4(a)(iii) of the Policy.

In this case, the evidence shows that the Complainant's mark is sufficiently distinctive. The MITTAL STEEL mark indicates that the Complainant is the source for metals and steel production, and it is unlikely that Respondent has registered the disputed domain name without knowing of it (see ArcelorMittal SA v. Tina Campbell, WIPO Case No. DCO2018-0005).

The distinctive character of the Complainant's mark is evidence that the Respondent is unlikely to have registered the disputed domain name without sight and knowledge of the Complainant's marks and it is implausible that there is any good faith use to which the disputed domain name may be put to.

The domain name itself is also inactive. As is well established, passive holding will not prevent a panel from finding that there was bad faith registration and use of a disputed domain name. Panels would draw inferences having regard to the distinctive character of the Complainant's mark as well as the other circumstances of the case, including if a response was filed, concealment of the respondent's identity, fame of the complainant's mark, and so forth. In the present case, the incorporation of the Complainant's distinctive mark into the disputed domain name, in addition to the lack of response, concealment of the Respondent's identity, and the implausibility of any good faith use of the disputed domain name by Respondent, is taken by the Panel to be evidence of bad faith registration and use (see Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003; CBS Broadcasting, Inc. v. Dennis Toeppen, WIPO Case No. D2000-0400).

Based on all the particular circumstances of this case and the evidence presented to the Panel, including the confusing similarity between the disputed domain name, the distinctive nature of the Complainant's mark, and the fact that no Response was submitted by the Respondent to the Complaint, the Panel draws the inference that the disputed domain name was 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. MITTALSTEELGROUP.COM: Transferred
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PANELLISTS

Name	Mr. Jonathan Agmon
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DATE OF PANEL DECISION 2021-12-23

Publish the Decision
