

Decision for dispute CAC-UDRP-104231

Case number	CAC-UDRP-104231
Time of filing	2021-12-10 09:36:35
Domain names	arcelormittalvarilla.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	ARCELOMITTAL S.A.
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Complainant representative

Organization	NAMESHIELD S.A.S.
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Respondent

Name	fernando sierra
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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 is the owner of several trademarks. In particular, ARCELOMITTAL S.A. owns the International Registration No. 947686 ARCELOMITTAL registered on August 3, 2007 for classes 6, 7, 9, 12, 19, 21, 39, 40, 41 and 42, duly renewed. The above trademark is protected in numerous countries.

FACTUAL BACKGROUND

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

PRELIMINARY REQUEST FOR ENGLISH TO BE THE LANGUAGE OF THIS PROCEEDING

As requested by the CAC, the Complainant filed preliminary request in order to require English to be the language of the administrative proceeding at issue for the following grounds:

- The English language is the language most widely used in international relations.

- In order to proceed in Spanish (the language of the registration agreement) the Complainant would have had to retain specialized translation services at a cost very likely to be higher than the overall cost of these proceedings. The use of Spanish in this case would therefore impose a burden on the Complainant which must be deemed significant in view of the low cost of these proceedings.

Therefore, in accordance with the instructions submitted by the CAC, for the reasons described above, the Complainant requested the Panel to maintain English as the proceedings language.

ON THE MERIT

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 operations in more than 60 countries. It holds sizeable captive supplies of raw materials and operates extensive distribution networks.

The disputed domain name <arcelormittalvarilla.com> was registered on December 2, 2021.

The Complainant states that the disputed domain name <arcelormittalvarilla.com> is confusingly similar to its trademark ARCELOMITTAL. Actually, in the Complainant's view, the addition of the term "varilla" is not sufficient to escape the finding that the domain name is confusingly similar to the trademark "ARCELOMITTAL". This, also considering that the word "varilla" refers to the Complainant business.

The Complainant states that the Respondent is not affiliated with him nor authorized by him in any way. The Complainant states that the Respondent has no right nor legitimate interest in the disputed domain name and it is not related in any way to its business. The Complainant does not carry out any activity for, nor has any business with the Respondent. The Respondent is not commonly known by <arcelormittalvarilla.com> or by other names similar to the disputed domain name.

The Complainant also notes that the domain name <arcelormittalvanilla.com> is not used and that, given the distinctiveness of the Complainant's trademark and reputation, it is reasonable to infer that the Respondent has registered the domain name with the full knowledge of the Complainant's trademarks. It is the Complainant's view that the incorporation of a famous mark into a domain name, coupled with an inactive website, is evidence that the Respondent has registered the disputed domain name and is using it in bad faith.

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.

As regards to the Complainant's request for the language of the proceedings to be in English, notwithstanding the fact that, as evidenced by the Domain Registrar's Verification, Spanish is the language of the registration agreement of the disputed domain name, under Paragraph 11 of the Rules, the Panel is free to deviate from the language of the registration agreement depending on the particular circumstances of each case. Here, the Respondent has clearly decided to avoid any communication after the filing of the Complaint maintaining an obvious passive attitude during this proceedings. Also, the disputed domain name is not registered under a country-code top level domain, but rather under the most common generic top-level domain ".com" which is most often used in an international context and that may justify the use of English being the language most widely used in international relations as outlined by the Complainant. Again, in this proceedings we are dealing with a case in which the Respondent deliberately registered a domain name which fully includes a well-known registered trademark legitimately owned and used by the Complainant from several years all around the world. Therefore, as correctly pointed out by the Complainant, it will be unreasonable to force a complainant to bear the high costs of specialized translation services in cases where the abuse is particularly evident and the proceedings may be held in a language widely and commonly used as English. Against this background, the Panel is willing to accept to lead this proceeding in English, given that the Respondent obviously has no disadvantages arising from doing so and is still treated equally and fair within the scope of Paragraph 10 of the Rules (see, between many others, *Intesa Sanpaolo S.p.A. vs. Marco Fabrone*, CAC Case No. 102689).

The disputed domain name <arcelormittalvarilla.com> combines three elements: (1) the wording "arcelormittal" (2) the term "varilla" and (3) the top-level domain name ".com". The relevant comparison to be made is with the portion of the domain name "arcelormittalvarilla". Actually, it is well established that the top-level domain name (i.e., ".com") should be disregarded for this purpose (see, between many others, *Playboy Enterprises International, Inc. v. John Taxiarchos*, WIPO Case No. D2006 - 0561). Furthermore, the term "varilla" does not distinguish the disputed domain name from Complainant's "ARCELORMITTAL" mark. As explained by the Complainant, "varilla" must be considered as a generic term having regard to the Complainant's business since the "varilla de acero" meaning "steel edge rod" is a product which makes part of the Complainant's business. In general, when a distinctive mark is combined with less distinctive terms, the combination will typically be found to be confusingly similar to the distinctive mark. Therefore, in the case at hand, the combination does not prevent the likelihood of confusion between the disputed domain name and the Complainant's trademark (*Arcelormittal S.A. v. Name Francois Dumontier*, CAC Case. No. 100855). Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark "ARCELORMITTAL".

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 licenced 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.

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 (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 <arcelormittalvarilla.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 (between many others, *Incipio Technologies, inc. v. Starfield Services Ltd*, WIPO Case No. D2011-0418). In consideration of the above, the Panel deems that the domain name in dispute was registered and used in bad faith.

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **ARCELOMITTALVARILLA.COM**: Transferred

PANELLISTS

Name	Avv. Guido Maffei
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DATE OF PANEL DECISION	2022-01-11
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Publish the Decision