

Decision for dispute CAC-UDRP-100358

Case number	CAC-UDRP-100358
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Domain names	arcelormittal.biz , arcelormittal.info , arcelormittal.org

Case administrator

Name	Tereza Bartošková (Case admin)
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Complainant

Organization	ARCELORMITTAL
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Complainant representative

Organization	Teissonnière Sardain Chevé A.A.R.P.I.
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Respondent

Name	Yasser Choudhary
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OTHER LEGAL PROCEEDINGS

None

IDENTIFICATION OF RIGHTS

The Complainant is the proprietor of the trademark ARCELORMITTAL, registered as an international trademark no. 947686 and French trademark no. 3150239, and used as the principal name of its business which is the largest steelmaker in the world.

FACTUAL BACKGROUND

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

1. The domain names are identical to trademarks marks in which the Complainant has rights (Policy, Paragraph 4(a) (i); Rules, Paragraphs 3(b) (viii), (b) (ix) (1))

The disputed domain names are identical to the Complainant's above mentioned prior rights.

Firstly, it is undisputable that ArcelorMittal has rights in the above mentioned marks. The registration of a trademark is prima facie evidence of validity, which creates a rebuttable presumption that the trademark is inherently distinctive. Respondent has the burden of refuting this assumption (WIPO Case n° D2002-0201, Janus Interantional Holding Co. v. Scott Rademacher – Annex 14).

“ARCELORMITTAL” is a well-known trademark. Complainant has spent substantial time, effort and money advertising and promoting the trademark “ARCELORMITTAL” throughout the world. As a result, “ARCELORMITTAL” has become distinctive and well-known, and the company has developed an enormous amount of goodwill in the mark.

The trademarks “ARCELORMITTAL”, “ARCELOR” and “MITTAL” are entirely reproduced in both disputed domain names. Notably the trademark “ARCELORMITTAL” is easily recognisable as such within the disputed domain names and determines a clear likelihood of Internet user confusion. Thus, there is no question for purposes of paragraph 4(a)(i) that the disputed domain names are identical to the trademark “ARCELORMITTAL”, in which the Complainant asserts rights.

Furthermore the name of Complainant’s Company is ArcelorMittal and thus, the disputed domain names are identical to the trade name of the Complainant.

A question might rise in that the domain names www.arcelormittal.info and www.arcelormittal.biz have been registered in 2006, before the registration in 2007 of the trademark “ARCELORMITTAL”. This assertion is without relevance under paragraph 4(a)(i) of the Policy given that the Complainant is also the owner of the trademarks “ARCELOR” and “MITTAL”, registered well before the registration of the disputed domain name and entirely reproduced in the disputed domain name.

Moreover, panels agree that the registration of a domain name before a Complainant acquires trademark rights in a name does not prevent a finding of identity or confusing similarity. The Policy makes no specific reference to the date on which the holder of the trademark or service mark acquired rights. (WIPO Case No. D2006-0916, *Stoneygate 48 Limited and Wayne Mark Rooney v. Huw Marshall* – Annex 15, WIPO Case No. D2007-0856, *Esquire Innovations, Inc. v. Isclub.com c/o Whois Identity Shield and Vertical Axis, Inc, Domain Administrator* – Annex 16).

As for the applicable top level suffixes, namely “.biz”, “.info” and “.org”, there is consensus in that they are to be disregarded in the threshold assessment of risk of confusing similarity under the first element of the Policy. The addition of the gTLDs “.biz”, “.info” and “.org” is not of legal significance from the standpoint of comparing the disputed domain names to the trademark. Such use is required of domain name registrants and do not serve to identify a specific enterprise as a source of goods or services (WIPO Case No. D2001-0602, *SBC Communications v. Fred Bell aka Bell Internet* – Annex 17).

Thus, as the suffixes only indicate that the domain name are registered under the respective gTLD and are not distinctive, the Panel should find Respondent’s domain names to be identical with Complainant’s trademark “ARCELORMITTAL” (WIPO Case No. D2003-0598, *MADRID 2012, S.A. v. Scott Martin-MadridMan Websites* – Annex 18).

Secondly, the risk of confusion between the Complainant’ trademarks and the contested domain names is all the more important in that the Complainant registered the domain name < arcelormittal.com >. The domain name is actively used and point to ARCELORMITTAL’s website www.arcelormittal.com (Annex 19).

Thirdly, the risk of confusion is also increased by the fact that the Complainant’s trademarks are well and widely known in the steel sector and are easily recognizable as such.

2. The Respondent has no rights or legitimate interests in respect of the domain name (Policy, Paragraph 4 (a) (ii); Rules, Paragraph 3 (b) (ix) (2))

The Complainant claims that the Respondent has no right or legitimate interests in respect of the contested domain names.

Preliminarily, although the Complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, panels have recognized that this could result in the often impossible task of proving a negative proposition, requiring information that is primarily if not exclusively within the knowledge of the Respondent. Thus, the consensus view is that paragraph 4(c) of the Policy shifts the burden to the Respondent to come forward with evidence of a right or legitimate interest in

the Domain Name, once the Complainant has made a prima facie showing indicating the absence of such rights or interests (WIPO Case No. D2000-0270, Document Technologies, Inc. v. International Electronic Communications Inc. – Annex 20)

In the case at hand there is no evidence that the Respondent used the domain names for anything but parking pages websites, which advertise various products and services. This effectively shifts the burden to the Respondent to demonstrate rights or legitimate interests in the domain names.

Subsequently, should the above argument not be considered, the following arguments shall be taken into consideration.

Firstly, the Respondent cannot prove any use of the disputed domain names in connection with a bona fide offering of goods or services.

The Respondent is using the disputed domain names for pay-per-click parking pages, attracting as many Internet users as possible to its websites (Annex 21 - Home page of www.arcelormittal.info, Annex 22 - Home page of www.arcelormittal.biz, Annex 23 - Home page of www.arcelormittal.org . The domain names are mere doors to other websites which have paid for advertisement and which in many cases are not connected in any manner to ArcelorMittal. When Internet users connect to the disputed domain names they are directed to parking pages showing advertising of different products and services, some of them being steel related. This is a definite diversion of potential Complainant's consumers and partners and cannot be considered a bona fide offering of goods and services.

Previous UDRP panels have held that Respondent's use of a domain name, which incorporates a third party's trademark in connection with an Internet web site that merely lists links to third party web sites is not a bona fide offering of services and is not a legitimate non-commercial or fair use of the disputed domain name (WIPO Case No. D2007-1499, E.J. McKernan Co. v. Texas International Property Associates – Annex 24, WIPO Case No. D2010-1437, Lardi Ltd v. Belize Domain WHOIS Service Lt Inc – Annex 25, WIPO Case No. D2007-1415, Asian World of Martial Arts Inc. v. Texas International Property Associates – Annex 26).

To sum up, Respondent's use of the domains, as a generic holding page, is in no way a bona fide offering of goods and services and this only emphasizes the fact that Respondent is not making a legitimate noncommercial or fair use of the disputed domain name.

Secondly, the Respondent has no registered trademark rights in the words "arcelormittal", "arcelor" or "mittal" and there is no evidence that the Respondent is commonly known by the disputed domain name. On the contrary, as herein already mentioned, it is the Complainant that has registered trademarks over "ARCELORMITTAL", "ARCELOR" and "MITTAL" and is commonly known as ArcelorMittal.

Thirdly, the Respondent has not been licensed or otherwise authorized to use any of the Complainant's trademarks or to apply for or use any domain name incorporating such trademarks. In similar circumstances, Panels considered that no bona fide or legitimate use of the disputed domain name could be claimed by the Respondent (WIPO Case D2000-0055, Guerlain SA v. Peikang – Annex 27, WIPO Case D2008-0488, BHP Billiton Innovation Pty Ltd. v. OS Domain Holdings IV LLC – Annex 28, WIPO Case D2009-0258, Mpire Corporation v. Michael Frey – Annex 29).

3. The domain names have been registered and are being used in bad faith (Policy, paragraphs 4 (a) (iii), 4(b); Rules, paragraph 3 (b) (ix) (3))

The disputed domain names have been registered and are being used by the Respondent in bad faith.

As to bad faith registration, when registering the disputed domain names, the Respondent was necessarily aware of the Complainant's well-known business and widespread reputation in its "ARCELORMITTAL", "ARCELOR" and "MITTAL" trademarks.

Clearly, such maneuver would not have been generated if the Respondent did not know the Complainant's activities (WIPO Case D2010-1290, Meilleurtaux v. Domain Manager of Bondi Junction – Annex 30).

The registration of the domain names www.arcelormittal.info and www.arcelormittal.biz was clearly in bad faith considering the 2006 merger process between Mittal Steel and Arcelor that lead to the creation of today's ArcelorMittal, the Complainant in this administrative procedure.

On June 25, 2006 The Board of Directors of Arcelor unanimously recommended accepting the offer proposed by Mittal and the proposed creation of "Arcelor Mittal". On the same day Arcelor publicly accepted Mittal Steel's takeover and the two companies merged into a new company, today's ArcelorMittal (article "Arcelor accepts Mittal Merger offer" dated June 25, 2006 published on www.forbes.com – Annex 31, article "Arcelor agrees to Mittal takeover" dated June 25, 2006 published on www.nytimes.com – Annex 32).

The Respondent registered the domain name www.arcelormittal.info and www.arcelormittal.biz (and also www.arcelormittal.co.uk - (Annex 42 – whois www.arcelormittal.co.uk) precisely on June 25, 2006 which is the very day of the public merger agreement.

The Respondent has timed its registration of the domain names to coincide with the date that the Complainants had announced their intention to merge Mittal Steel with Arcelor and operate under the name "Arcelor Mittal". The merger was bruited for some time before it was formally announced on 25 June 2006. The fact that the infringing domain name was registered on the day of the official announcement and subsequent news articles regarding the merger, strongly indicates that the Respondent acted opportunistically with a view to making a profit from the Complainants.

This is a clear proof of registration in bad faith and the obvious envisaged goal is to benefit from the reputation of the newly created ArcelorMittal. In similar cases other panels concluded that the registration of a domain name is obviously in bad faith particularly when the domain name registration is affected shortly after the merger of two companies had been commenced (WIPO Case D2000-0446, Pharmacia & Upjohn AB vs. Monsanto-pharmacia.com Inc. – Annex 33).

A first logical explanation about why the Respondent registered the domain names combining the trademarks "ARCELOR" and "MITTAL" precisely on the day of the public merger between Arcelor and Mittal Steel is that his intention was to register the domain name primarily for the purposes of selling, renting or otherwise transferring the domain name to the Complainant or to a competitor of the Complainant for valuable consideration in excess of the documented out-of-pocket costs directly associated with acquiring or using the domain name. This hypothesis is confirmed by the 2006 negotiations between the parties that failed to conclude the transfer. In this regard, please find attached the e-mail correspondence dated November 06, 2006 (Annex 40) and November 14, 2006 (Annex 41) proving that the parties have been involved in transfer negotiations for the infringing domain name.

A second logical explanation about why the Respondent registered the domain names combining the trademarks "ARCELOR" and "MITTAL" precisely on the day of the public merger between Arcelor and Mittal Steel is that his intention was to register the domain name as a blocking registration against the combination between the trademarks ARCELOR and MITTAL into the trademark ARCELORMITTAL resulting from the merger process. This hypothesis is confirmed by the fact that on the same day, namely June 25 2006, the Respondent also registered the domain name www.arcelormittalco.uk (Annex 42 – whois www.arcelormittal.co.uk). Moreover, the Respondent registered on November 18, 2011 the domain name www.arcelormittal.org also. This results in a clear registration of the domain name as a blocking registration against the trademark "ARCELORMITTAL" in which the Complainant has proved legitimate rights. The Complainant have filed this complaint to put a stop to the adverse impact the infringing domain name is having and will continue to have on the Complainants' business and to allow the Complainants to acquire the ownership of the infringing domain name which has previously been blocked by the Respondent's registration.

A third logical explanation about why the Respondent registered the domain name combining the trademarks "ARCELOR" and "MITTAL" precisely on the day of the public merger between Arcelor and Mittal Steel is that his intention was to disrupt the business of the Complainant. In fact, the unfair disrupt of Complainant's business consists in that when looking for ArcelorMittal

in the United Kingdom Internet users are directed to the infringing domain names instead of the official website www.arcelormittal.com. This causes ArcelorMittal commercial detriment notably in terms of consumer confusion and the loss of the general ability to communicate with existing and potential clients or partners.

The domain name www.arcelormittal.org was also registered in bad faith. Respondent proved constancy and registered more than five years after the registration of the domain names www.arcelormittal.info, www.arcelormittal.biz and www.arcelormittal.co.uk, a fourth TLD reproducing the trademark ArcelorMittal, namely www.arcelormittal.org. Respondent intentionally registered the domain name www.arcelormittal.org being absolutely aware of the trademark "ARCELORMITTAL" created following the fusion between Arcelor and Mittal Steel.

Thus it is clear that the disputed domain names have been registered in order to prevent the owner of the trademark from reflecting the mark in the corresponding domain names and that such pattern results form a conscious policy on the part of the Respondent.

As to bad faith use, The Policy indicates that certain circumstances may, "in particular but without limitation", be evidence of bad faith the fact that a respondent "by using the domain name, ... [has] intentionally attempted to attract, for commercial gain, Internet users to [its] web site 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 [respondent's] web site or location of a product or service on [its] web site or location" (id., paragraph 4(b)(iv)).

In the case at hand Respondent has intentionally sought to use Complainant's marks in the disputed domain names to attract Internet users to websites and other on-line locations for commercial gain by confusing consumers as to sponsorship of the website. This constitutes bad faith within the meaning of paragraph 4(b)(iv) of the Policy. (WIPO Case No. D2000-1495, *America Online, Inc. v. John Zuccarini*, also known as *Cupcake Message*, *Cupcake Messenger*, *The Cupcake Secret*, *Cupcake Patrol*, *Cupcake City*, and *The Cupcake Incident* – Annex 34)

Moreover, the disputed domain names are to be qualified as doppelganger domains considering that web addresses can be easily created in order to capture data which is sent to misspelt email addresses. Additionally one should bear in mind that the domain name [arcelormittal.com](http://www.arcelormittal.com) is frequently used in e-mail addresses of various employees for professional correspondence (e.g. Complainant's contact e-mail details in this administrative procedure are ml.pied@arcelormittal.com). Therefore, there is remarkable high risk of sensitive data capture which might be sent to misspelt email addresses.

In previous attempts to cease the illegitimate use of the domain names, a warning letter dated November 23, 2011 notifying Complainant's prior rights in the disputed domain names and requesting the domain names to be transferred has been sent to the Respondent (Annex 35) who, although has received it by e-mail never replied to it.

The domain name is so obviously connected with the Complainant's trademark and its services that their very use by someone with no connection with the Complainant suggests "opportunistic bad faith" (WIPO Case No. D2000-0226, *Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net* - Annex 36, WIPO Case No. D2000-0163, *Veuve Cliquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co., net* - Annex 37, WIPO Case No. D2001-0781, *Fortuneo v. Johann Guinebert* - Annex 38)

Thus, the Respondent knowingly and intentionally attempted to divert the traffic intended for the Complainant's website to its own websites. Consequently, the Respondent has through the use of identical domain names, created a likelihood of confusion with the Complainant's prior rights, which constitutes a misrepresentation to the public who might think that the disputed domain name belongs or is connected to the Complainant (WIPO Case D2007-0424, *Alstom v. Yulei* Annex 39).

PARTIES CONTENTIONS

No administratively compliant response has been filed.

RIGHTS

