Decision for dispute CAC-UDRP-100361

Case number	**CAC-UDRP-100361**
Time of filing	**2012-02-22 12:29:36**
Domain names	**arcelormittal.pro**

Case administrator

Name	**Tereza Bartošková (Case admin)**

Complainant

Organization	**ArcelorMittal**

Complainant representative

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

Respondent

Organization	**Pro Trade Consult**

FACTUAL BACKGROUND

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

1. Protected rights relied on by the Complainant

This Complaint is hereby submitted for decision in accordance with the Uniform Domain Name Dispute Resolution Policy (the Policy), approved by the Internet Corporation for Assigned Names and Numbers (ICANN) on October 24, 1999, and the Rules for Uniform Domain Name Dispute Resolution Policy (the Rules), approved by ICANN on October 30, 2009.

To the best of the Complainant's knowledge, the language of the Domain Registrant Agreement is English, a copy of which is provided as Annex 1 to this Complaint. The Complaint has been submitted in English.

This dispute is properly within the scope of the Policy and the Administrative Panel has jurisdiction to decide the dispute. The Domain Registrant Agreement, pursuant to which the domain name that is the subject of this Complaint is registered, incorporates the Policy. A true and correct copy of the domain name dispute policy that applies to the domain name in question is provided as Annex 2 to this Complaint and can be found at http://www.icann.org/en/udrp/udrp-policy-24oct99.htm.

According to the WhoIs database, the Respondent in this Administrative Proceeding is Pro Trade Consult, 24, ul. Borba, Plovdiv, 4000, Bulgaria. Copies of the printout of the database search conducted on February 03, 2011 are provided as

Annex 3.

The Complainant in this Administrative Proceeding is ArcelorMittal, a public limited company, with a capital of 6 836 805 991,80 euros, headquartered 19 avenue de la Liberté, L-2930 Luxembourg, LU, registered under the number B 82454 at the Luxembourg Commercial and Companies Register since the 21st June 2001 (Annex 4).

ArcelorMittal is the largest steel producing company in the world (Annex 5 – Top 30 largest steel producers in the world according to the World Steel Association) 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.

In 2011 the CNN Fortune Global 500 World's Biggest Companies ranked ArcelorMittal on the 74th position in the world (Annex 6 – extract of 2011 CNN Fortune Global 500 World's Biggest Companies).

Firstly, according to the Rules, para 3(b) (viii), the present Complaint is based on the following trademarks of the Complainant, which are widely-known and have a strong international reputation:

• The word international trademark "ArcelorMittal" filed on March 8th, 2007 under number 947686 in classes 6, 7, 9, 12, 19, 21, 39, 40, 41 and 42 (Annex 7).

• The word trademark "ARCELOR" filed on February 26th, 2002, registered in France under number 3150239 in classes 6, 7 and 12. Such trademark, which was initially filed by ARCELOR S.A, was assigned to ARCELORMITTAL on May 31th, 2010 (Annex 8).

• The word community trademark "ARCELOR" filed on February 25th 2002, under number 2601987 in classes 1, 6, 7, 9, 12, 37, 40 and 42 (Annex 9).

• The word international trademark "ARCELOR" filed on February 25th 2002, under number 778212 in classes 1, 6, 7, 9, 12, 37, 40 and 42 (Annex 10).

• The word community trademark "MITTAL" filed on August 16th, 2005, under number 4592382 in class 39 (Annex 11).

• The word community trademark "MITTAL" filed on August 9th, 2004, under number 3975786 in classes 6 and 40 (Annex 12).

All the above trademarks have been predominantly registered in connection with ArcelorMittal's activities on the steel market.

"ArcelorMittal" is a well-known trademark, easily recognizable as such, notably with regard to the recent sponsoring with an amount of 16 million pounds of Britain's largest piece of art called ArcelorMittal Orbit, an observation tower placed in the Olympic Park in Stratford, London (Annex 13). ArcelorMillat's position as the largest steelmaker in the world has been recently recognized by means of a decision issued the Czech Arbitration Court in the case no. 100358 (Annex 14).

With regard to ArcelorMittal's trademark infringements, the company has been engaged in several domain name dispute resolutions, all of them being positively resolved in that the Complainant was granted the transfer of the domain names in question. Such cases are: WIPO D2011-1154, WIPO D2011-0326, WIPO D2011-0322, WIPO D2010-2049, WIPO D2010-1417, WIPO D2010-0899, WIPO DME2010-0006.

Secondly, the Complainant has rights in several "ArcelorMittal" domain names notably, the generic top level domain name www.arcelormittal.com, registered on January 27, 2006 (Annex 15). Additionally, related to the .pro extension, ARCELOR SA registered on June 24, 2004 and assigned to the Complainant following the 2006 merger between ARCELOR SA and Mittal Steel the domain name www.arcelor.pro (Annex 16) that points to the domain name www.arcelormittal.com. For information

purposes only we mention that on June 25, 2006 ARCELOR SA 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 17, article "Arcelor agrees to Mittal takeover" dated June 25, 2006 published on www.nytimes.com – Annex 18).

Thirdly, the Complainant has rights in the company name ArcelorMittal which is a public limited company, with a capital of 6 836 805 991,80 euros, headquartered 19 avenue de la Liberté, L-2930 Luxembourg, LU, registered under the number B 82454 at the Luxembourg Commercial and Companies Register since the June 21, 2001 (Annex 4)

2. The domain name is identical to the protected marks (Policy, Paragraph 4(a) (i); Rules, Paragraphs 3(b) (viii), (b) (ix) (1))

The disputed domain name is 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 19).

"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 the disputed domain name. Notably the trademark "ArcelorMittal" is easily recognisable as such within the disputed domain name and determines a clear likelihood of Internet user confusion. Thus, there is no question for the purposes of paragraph 4(a)(i) that the disputed domain name is 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 name is identical to the trade name of the Complainant.

As for the applicable top level suffixe, namely ".pro", there is consensus in that it is to be disregarded in the threshold assessment of risk of confusing similarity under the first element of the Policy. The addition of the gTLDs ".pro", is not of legal significance from the standpoint of comparing the disputed domain name 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 20). Thus, as the suffixes only indicate that the domain name is registered under the respective gTLD and are not distinctive, the Panel should find Respondent's domain name to be identical with Complainant's trademark "ArcelorMittal" (WIPO Case No. D2003-0598, MADRID 2012, S.A. v. Scott Martin-MadridMan Websites – Annex 21).

In a similar case the Czech Arbitration Court found the domain names www.arcelormittal.info, www.arcelormittal.biz and www.arcelormittal.org to be identical to the trademark "ArcelorMittal" (Annex 14).

Secondly, the risk of confusion between the Complainant' trademarks and the contested domain name is all the more important in that the Complainant registered the domain name < arcelormittal.com >. The domain name is actively used and points to ArcelorMittal's website www.arcelormittal.com (Annex 22).

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.

3. The Respondent does not have any rights or legitimate interest in 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 name.

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 23)

In the case at hand there is no evidence that the Respondent used the domain name but for a mere registration. This effectively shifts the burden to the Respondent to demonstrate rights or legitimate interests in the Domain Name.

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 name in connection with a bona fide offering of goods or services. In fact, the domain name has been merely registered as a blocking registration of the trademark “ArcelorMittal” in the corresponding domain name and there is no corresponding offering of goods or services

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 the Complainant that has registered trademarks over “ArcelorMittal”, “ARCELOR” and “MITTAL” and is commonly known as ArcelorMittal in its trademarks and company name.

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. Additionally, there is no affiliation between the Complainant and the Respondent to justify the use of the Complainant's mark by the Respondent. 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 24, WIPO Case D2009-0258, Mpire Corporation v. Michael Frey – Annex 25).

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

The disputed domain name has been registered and is being used by the Respondent in bad faith.

As to bad faith registration, when registering the disputed domain name, the Respondent was necessarily aware of the Complainant’s well-known business and widespread reputation in its “ArcelorMittal”, “ARCELOR” and “MITTAL” trademarks.

In similar cases panels have stated that the fact that Complainant's name and trade mark is so well and widely known makes it inevitable that Respondent registered the domain name in full knowledge of Complainant's rights and interests (WIPO Case No. D2000-0574, Jupiters Limited v. Aaron Hall – Annex 26).

In this context, it is not possible to conceive of a plausible circumstance in which the Respondent could legitimately use the disputed domain name. It is also not possible to conceive of a plausible situation in which the Respondent would have been unaware of this fact at the time of registration. These assertions, together with the assertions that the Respondent has no rights or interests in the domain name, lead the conclusion that the disputed domain name has been registered by the Respondent in bad faith (WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows – Annex 27).

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 28). The disputed domain name has been opportunistically registered in order to prevent the owner of the trademark from reflecting the mark in the corresponding domain names.

As to bad faith use, The Policy indicates that certain circumstances may, "in particular but without limitation", be evidence of bad faith.

There is no evidence that a web site or other on-line presence is in the process of being established which will use the domain name. Apparently the respondent does not conduct any legitimate commercial or non-commercial business activity in Bulgaria.

The relevant issue is not whether the Respondent is undertaking a positive action in bad faith in relation to the domain name, but instead whether, in all the circumstances of the case, it can be said that the Respondent is acting in bad faith. The distinction between undertaking a positive action in bad faith and acting in bad faith may seem a rather fine distinction, but it is an important one. The significance of the distinction is that the concept of a domain name "being used in bad faith" is not limited to positive action; inaction is within the concept. That is to say, it is possible, in certain circumstances, for inactivity by the Respondent to amount to the domain name being used in bad faith (WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows – Annex 27).

Under the circumstances of the present case, the Panel should state that the passive holding constitutes a bad faith use of the disputed domain name.

To conclude that the passive holding constitutes bad faith registration in the present case, the Panel should additionally consider that the Respondent did not only register the disputed domain name, namely <arcelormittal.pro> but also the domain name <boeing.pro> (Annex 29). Similarly, the domain name <boeing.pro> has no web site or other on-line associated presence being also passively hold by the Registrant. Thus, it appears that the registration of the domain name <arcelormittal.pro> is not a singular case and that another well-known trademark, namely Boeing, has been registered under the .pro TLD by the Registrant. This is a proof of opportunistic bad faith suggesting a pattern of conduct.

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 both by e-mail (Annex 30) and by hard copy (Annex 31). The electronic correspondence has been apparently delivered (Annex 32) but no reply has been received so far. The paper version of the letter has been returned as unclaimed (Annex 33).

To sum up, we take the view that in the circumstances of this particular Complaint, the passive holding of the domain name by the Respondent amounts to the Respondent acting in bad faith. The particular circumstances of this case which lead to this conclusion are:

(i) the Complainant's trademark has a strong reputation and is widely known, as evidenced by its substantial use all over the world;

(ii) the Respondent has provided, so far, no evidence whatsoever of any actual or contemplated good faith use by it of the domain name;

(iii) the Respondent has did not reply to the cease and decease letter and it is unclear whether the contact details provided in the Whois database are real or not;

(iv) the respondent also registered and passively holds the domain name <boeing.pro>;

(v) taking into account all of the above, it is not possible to conceive of any plausible actual or contemplated active use of

the domain name by the Respondent that would not be illegitimate.

In similar cases, panellists have stated that passive holding might be qualified as bad faith under the Policy in contexts suggesting opportunistic manoeuvres (WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows – Annex 27, WIPO Case No. D 2002-0131, Ladbroke Group Plc v. Sonoma International LDC – Annex 33).

Moreover, the disputed domain name is to be qualified as doppelganger domain 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> 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.

PARTIES CONTENTIONS

Procedure

The Complainant has been filed in the name of ArcelorMittal, a French company domiciled 5 rue Luigi Cherubini 93212 La Plaine Saint Denis in France, whereas the opposed trademarks are in the name of ArcelorMittal, a public limited company, headquartered 19 avenue de la Liberté, L-2930 Luxembourg, LU, registered under the number B 82454 with the Luxembourg Commercial and Companies Register.
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On April 2, 2012, the Panel requested the Complainant to precise whether the Luxembourg company ArcelorMittal, domiciled in Luxembourg was meant to join the procedure.

Pursuant to the response sent on April 6, 2012, this latter company joined the procedure and requested the transfer to his benefit.

A deadline of 8 days, expiring on April 20, 2012, has been given to the Respondent, to submit any statement or comment. The Respondent did not react.

No administrative response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the 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 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 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

Rights

The Complainant has, to the satisfaction of the Panel, shown the Domain Name is identical or confusingly similar to a trademark or service mark in which the complainant has rights, to its principal name, “ARCELORMITTAL”, and to its domain names which include the terms “ARCELOR”, “MITTAL” or “ARCELORMITTAL” (within the meaning of paragraph 4 (a) (i) of the Policy).

No right or legitimate interests

The Respondent passively holds the Domain Name. This does not constitute a bona fide use for the purposes of the UDRP. The Respondent is obviously not commonly known by the Domain Name and he is not making legitimate non-commercial or fair use of them. There appears to be no other basis on which the Respondent could claim any 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 Domain Name (within the meaning of paragraph 4 (a) (ii) of the Policy).

Bad faith

Complainant's name and trademark is so well and widely known that it is inevitable that Respondent registered the domain name in full knowledge of Complainant's rights and interests.

Moreover, the Respondent also holds passively the domain name <boeing.pro>.

These circumstances show that the registration of the domain name <arcelormittal.pro> is not a singular case and show an opportunistic bad faith.
For the foregoing reasons, the Panel finds that the Complainants have also established the finding of bad faith registration and use within the meaning of paragraph 4(a)(iii) of the Policy.

Procedural Factors

For all the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name, <arcelormittal.pro> be transferred to the Luxembourg company ArcelorMittal.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ARCELORMITTAL.PRO**: Transferred

PANELLISTS

Name	**Marie Emmanuelle Haas**

DATE OF PANEL DECISION 2012-04-26

Publish the Decision