# Decision for dispute CAC-UDRP-100546

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| Case number | CAC-UDRP-100546 |
| Time of filing | 2012-12-27 10:26:54 |
| Domain names | ARCELORMITTALBUILDINGS.COM |

## Case administrator

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| Name | Lada Válková (Case admin) |

## Complainant

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| Organization | ArcelorMittal SA |

## Complainant representative

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| Organization | Nameshield (Laurent Becker) |

## Respondent

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| Name | Eric Widdifield |

OTHER LEGAL PROCEEDINGS

None of which the Panel is aware.

IDENTIFICATION OF RIGHTS

The Complainant has submitted evidence which the Panel accepts of numerous trademark registrations for ARCELORMITTAL, including registrations with the United States Patent and Trademark Office (Reg. No. 3643543, registered on June 23, 2009), and the World Intellectual Property Organisation (Reg. No. 947686, registered August 3, 2008) . The Respondent does not mount any case against the Complainant having those rights and, indeed, refers in the Response to “the protected mark”. The Panel notes that it is now well established that registered trademarks of the sort established by the Complainant satisfy the requirements of the Policy. The Panel therefore concludes that the Complainant has adequately demonstrated its rights in the ARCELORMITTAL mark pursuant to paragraph 4(a)(i) of the Policy.

FACTUAL BACKGROUND

The following statements on factual matters are taken from information provided in the Complainant and the Response.
COMPLAINANT
The Complainant is a Luxembourg company specialising in steel production and submits that it is the largest steel producing company in the world and the market leader in steel for use in automotive, construction, household appliances and packaging.
It also submits that it is engaged in operations in more than 60 countries. In 2011 the CNN Fortune Global 500 World’s

Biggest Companies ranked the Complainant on the 74th position in the world.
The Complainant owns several trademarks in the form of words and combined words and logos and copies of those trademarks are annexed to the Complaint.

The Complainant owns several domain names and uses them for websites on the internet to further its business. Its principal website is www.arcelormittal.com, the corresponding domain name for which was registered on January 1, 2006. The Complainant has also registered other domain names incorporating its trademark ARCELORMITTAL, such as:

arcelor.com registered on 29/08/2001
arcelor.net registered on 03/09/2001
arcelormittal.net registered on 25/06/2006
arcelormittal.info registered on 25/06/2006
arcelormittal.org registered on 18/09/2011
arcelormittal.biz registered on 25/06/2006
arcelormittal.us registered on 22/12/2006
arcelormittal.com.au registered on 04/06/2008

RESPONDENT

The only submissions by the Respondent on the facts are those referred to in the Respondent's general submissions which provide as follows :

1. The Complainant is a coal and iron ore mining company that manufactures steel. The Respondent is a high volume sales broker of prefabricated buildings. Clearly these are not the same industries.

2. The Respondent as Domain name holder owns protected rights in a corresponding name.

3. The respondent is a licensed and trademarked company in Florida, United States.

4. The Domain name is identical to the Respondent's trademarked company name.

5. Complainant and Respondent are not in the same industries.

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PARTIES CONTENTIONS

CONTENTIONS OF THE PARTIES

COMPLAINANT:

The Complainant contends that:

I. The disputed domain name is confusingly similar to its trademark ARCELORMITTAL because the domain name consists of the entirety of the trademark and the generic expression “buildings”. The disputed domain name also includes the generic Top Level Domain “.com” which is not sufficient to escape the finding that the domain name is confusingly similar to the trademark and does not change the overall impression of the designation as being connected to a trademark of the Complainant. The Complainant’s principal argument is that the addition of a generic word such as buildings does no more than suggest that the domain name is concerned with buildings supplied under the ARCELORMITTAL trademark, which is not true.

2. The Respondent does not have any rights or legitimate interests in the disputed domain name.
(a) Rights
In particular, the Complainant submits that a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests in the domain name. Once such prima facie case is made, respondent carries the burden of rebutting that case and demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a) (ii) of the UDRP.
The Complainant cites Croatia Airlines d.d. v. Modern Empire Internet Ltd., WIPO Case D2003-0455 in support of those propositions.

In support of its prima facie case, the Complainant says that the Respondent 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 and has not granted a licence or authorization to the Respondent to make any use, or apply for registration of the disputed domain name.
Further, according to the WHOIS record the Registrant of the disputed domain name is Eric Widdifield.

Moreover, according to the evidence of EDGAR Search Results, annexed to the Complaint, no company with the name ARCELORMITTAL BUILDINGS seems to exist. Moreover, there is no content on the website to which the disputed domain name resolves that could inform Internet users about the Respondent.

(b) Legitimate interests

The Respondent uses the name of the Complainant Arcelormittal in order to profit from the notoriety of the Complainant. The risk of confusion is high, especially due to the fact that the Respondent uses on its website terms related to the business of the Complainant such as ”Arcelormittal”, “Metal”, ”building”, “construction” and “steel”, thus increasing the potential for confusion.

Therefore, the Complainant asserts that the Respondent’s use of the disputed domain name is neither a fair trademark use nor a bona fide offering of goods or services.
The Complainant submits that the Respondent’s activity under the disputed domain name is intended to disrupt the Complainant’s business and to derive an advantage from user confusion.
The Complainant asserts that such activity does not confer any rights or legitimate interests upon the Respondent.
3.The domain name has been registered and is being used in bad faith
The categories of issues involved that are highlighted by the Complainant on this issue are:
(i) Registration of a well-known/famous trade mark
(ii) Disrupting the business of a competitor
(iii) Attracting internet users for commercial gain by creating a likelihood of confusion with the Complainant.

The Complainant contends that the Respondent has registered the domain name in bad faith for the following reasons :
- According the whois, the Respondent is “ Eric Widdifield” and is not known in relation with the Complainant ;
- the domain name is confusingly similar to the trademark ARCELORMITTAL ;
- the website related to the domain name doesn’t give any clear information about the company Arcelormittal Buildings ;
- the domain name displays information regarding the steel construction market. The Respondent says that it is “America's leading steel building provider” and has built many buildings as indicated on the website. But on the website, a picture regarding a gymnasium, annexed to the Complaint, is the same picture as appears on another website of a competitor of the Complainant. Robertson Building Systems.
- Moreover, the postal address “7950 Executive Center Drive, Suite 337 Miami, FL 33166” corresponds to virtual office : “ Offix solutions “ .

On those facts, the Complainant submits that the Respondent has created a risk of confusion with the Complainant, especially with the content of the website ; this reinforces the impression that the Complainant is related to this domain name.

In support of its submissions, the Complainant relies on the decisions in

(a) ArcelorMittal SA
.v. BruceBruce Boggio
CAC case n° 100440 and

-(b) Al-Durra Food Products Company v. Aldurra Group, WIPO Case No. D2010-1226 .

RESPONDENT:

The Respondent contends that:

I. Domain name is neither identical nor confusingly similar to the protected mark for the following reasons:
a. Complainant’s failure to meet standard of proof.
b. Other:
The complainant is a coal and iron ore mining company that manufactures steel. The respondent is a high volume sales broker of prefabricated buildings. Clearly these are not the same industries.
ADDITIONAL EXPLANATIONS:
II. The Respondent has rights and/or legitimate interest in the domain name(s)
Categories of issues involved:
a. Use of, or demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services.
b. Domain name holder owns protected rights in a corresponding name.
c. Commonly known by the domain name.
d. Complainant’s failure to meet standard of proof.
e. Other:
The respondent is a licensed and trademarked company in Florida, United States.
ADDITIONAL EXPLANATIONS:
III. The domain name(s) has not been registered and used in bad faith
Categories of issues involved:
e. Complainant’s failure to meet standard of proof.
f. Other:
The complainant is a coal and iron ore mining company that manufactures steel. The respondent is a high volume sales broker of prefabricated buildings. Clearly these are not the same industries.
ADDITIONAL EXPLANATIONS:
Please explain your arguments in detail below.
- Respondent is a licensed and trademarked company in Florida, United States.
- Domain name is identical to the respondent's trademarked company name.
- Complainant and Respondent are not in the same industries.

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

Reasons
Identical and/or Confusingly Similar

The first question that arises is whether Complainant has rights in a trademark or service mark. Complainant alleges that it has multiple trademark registrations that grant it rights in the ARCELORMITTAL mark and thus satisfy the requirement of paragraph 4(a) (i) of the Policy that it must shows rights in a trademark or service mark. The Complainant has submitted evidence which the Panel accepts of numerous trademark registrations for ARCELORMITTAL, including registrations with the United States Patent and Trademark Office (Reg. No. 3643543, registered on June 23, 2009), and the World Intellectual Property Organisation (Reg. No. 947686, registered August 3, 2008) . The Respondent does not mount any case against the Complainant having those rights and, indeed, refers in the Response to “the protected mark”. However, as the Panel is required to satisfy itself that all elements are proved by evidence, it notes that it is now well established that registered trademarks of the sort established by the Complainant satisfy the requirements of the Policy. The Panel therefore concludes that the Complainant has adequately demonstrated its rights in the ARCELORMITTAL mark pursuant to paragraph 4(a)(i) of the Policy.

The second question that arises is whether the disputed domain name is identical or confusingly similar to Complainant’s ARCELORMITTAL mark. The Complainant submits that the domain name <arcelormittalbuildings.com> is confusingly similar to Complainant’s ARCELOMITTAL mark due to the presence of the trademark in the domain name and the generic term “buildings” being added to the trademark to make up the disputed domain name and the addition also of the generic top-level domain (“gTLD”) “.com.” The Panel finds that by using Complainant’s ARCELOMITTAL mark and adding the word “buildings” the domain name is confusingly similar to Complainant’s mark because the objective internet user would naturally conclude that the domain name related to buildings supplied under the Complainant’s ARCELOMITTAL mark and as part of its business, which is not so. It is also now clear beyond any doubt that the addition of gTLDs does not negate a finding of confusing similarity that is otherwise established, as it is in the present case.

To this the Respondent says that the disputed domain name is neither identical nor confusingly similar to the trademark because of “Complainant’s failure to meet standard of proof …” and because “The complainant is a coal and iron ore mining company that manufactures steel. The respondent is a high volume sales broker of prefabricated buildings. Clearly these are not the same industries.” The Panel does not accept either of those arguments. In the first place, the Panel finds that the Complainant has clearly proved the matters required to be proved under paragraph 4( a)(i) of the Policy and proved them beyond doubt. Secondly, it has now been well established in many prior UDRP decisions that in making the comparison between the domain name and the trademark, extraneous matters such as the nature of the businesses of the complainant and the respondent are not to be taken into account, but that a straight comparison is to be made between the wording of the domain name and the trademark. Having made the comparison, the Panel finds that it is clear that the objective bystander would conclude that the domain name is similar to the trademark, because the entirety of the trademark has been incorporated in the domain name and that it is confusingly so, because the internet user would assume that the domain name related to buildings supplied by the Complainant and that it would lead to a website dealing with the same subject, neither of which is true.
Complainant has thus made out the first of the three elements that it must establish.

Rights or Legitimate Interests

It is now well established, as the Complainant has submitted, that the Complainant must first make a prima facie case that Respondent lacks rights and legitimate interests in the disputed domain name under paragraph 4(a)(ii) of the Policy. The

burden of proof than shifts to Respondent to show it does have rights or legitimate interests. There are many prior UDRP decisions to that effect, for example, the case cited by the Complainant, Croatia Airlines d.d. v. Modern Empire Internet Ltd. WIPO Case no. D2003-0455.

The Panel finds that Complainant has made out a prima facie case that arises from the following considerations:

(a) Respondent has chosen to take the Complainant's trademark and to use it in its domain name, adding only the generic word "buildings", thus implying that the domain name is an official domain name of Complainant leading to an official website of Complainant dealing with buildings supplied under the trademark;

(b) Respondent has then used the domain name to resolve to a website dealing with goods and services allegedly provided by the Respondent and which are the same or similar goods and services provided by the Complainant;

(c) Respondent has engaged in these activities without the consent or approval of Complainant;

(d) The Complainant has asserted that the Respondent is not related in any way to the Complainant, that the Complainant does not carry out any activity for, nor has any business with the Respondent. The Complainant also submits that neither a licence nor authorization has been granted by the Complainant to the Respondent to make any use of, or apply for registration of the disputed domain name .The Complainant also relies on information contained in the WHOIS to show that the Registrant is Eric Widdifield and that consequently the Respondent is not commonly known by the domain name. The Panel accepts these submissions and the evidence and inferences from the evidence on which they are based;

(e) The Complainant also submits that the Respondent uses the name of the Complainant to take profit of the notoriety of the Complainant, that the risk of confusion is high, especially because the Respondent uses terms related to the business of the Complainant, namely " Arcelormittal ", " Metal ", " building ", " construction and "steel ".Therefore, the Complainant asserts that the Respondent's use of the disputed domain name is neither a fair trademark use nor a bona fide offering of goods or services. The Panel accepts these submissions and the evidence and inferences from the evidence on which they are based;

(f) The Complainant also submits that the Respondent's activity under the disputed domain name is intended to disrupt the Complainant's business and to derive an advantage from user confusion. The Complainant asserts that such activity does not confer any rights or legitimate interests upon the Respondent. The Panel accepts these submissions and the evidence and inferences from the evidence on which they are based.

All of these matters go to make out the prima facie case against Respondent. The Panel accepts the evidence and submissions of the Complainant on these matters and finds therefore that the Complainant has made out a prima facie case that Respondent has no rights or legitimate interests in the disputed domain name.

It is then a matter to examine the case of the Respondent to see if it has rebutted the prima facie case against it.

The first thing that must be said against the Respondent's case is that it is remarkable sparse on the facts. As has already been seen, the Respondent's entire case on this issue is as follows:

"Respondent has rights and/or legitimate interest in the domain name(s)

Categories of issues involved:

a.Use of, or demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services.

b.Domain name holder owns protected rights in a corresponding name.

c. Commonly known by the domain name.

d. Complainant's failure to meet standard of proof.

Other:

The respondent is a licensed and trademarked company in Florida, United States."

Point (a) may be quickly disposed of because the Panel is not satisfied on the meagre nature of the evidence tendered by the Respondent, that its use of the domain name was for a bona fide offering of goods and services. Indeed, from the evidence tendered by the Complainant of its website and the website of the Respondent, being the website to which the disputed domain name resolves, the Panel's view is that the offering of goods and services of the Respondent was far from bona fide and seems if anything to be an attempt by the Respondent to cash in on or trade on the established name of the Complainant. This is particularly so with respect to one of the buildings on the Respondent's website that the Respondent claims that it built, when the Complainant has suggested that it is a building built by a competitor of the Complainant. "Robertson Building Systems". The Respondent could have replied to this allegation if it wished and if the allegation were untrue and, indeed, there is an obligation on a party to these proceedings to assist the Panel by replying to untrue allegations and to put in its own evidence to establish its points. But the Respondent has not done this, leaving the Panel in the position that the only evidence on the subject is from the Complainant.

Points (c) and (d) have no substance and have not been made out on the evidence or submissions.
As to point (b) that the domain name holder owns protected rights in a corresponding name and the point made under "Other", that "The respondent is a licensed and trademarked company in Florida, United States", the Panel does not accept the Respondent's arguments in that regard. The Respondent has given no particulars of the alleged licence or trademark or of their effect although that evidence must be available to the Respondent and the meagre submissions on those issues, for they are submissions and not evidence, are certainly not enough to rebut the prima facie case established by the Complainant. As the evidence stands at the present, the Panel has seen no evidence that the Respondent has been incorporated as a company.
As to the trademark relied on, the Respondent gives no particulars of this and has not annexed a copy of the trademark. As the Respondent has raised the issue and as it is pivotal to the outcome of this case, the Panel has conducted its own search on the internet of the records of the State of Florida, Department of State, Division of Corporations that show that a trademark has been filed in the name of a company named Arcelormittal Buildings Inc at the address of the Respondent referred to above. However, that trademark was filed, not registered and the date of filing was January 23, 2013, which is shortly after the Complaint in this matter was issued, which was on December 18, 2012. This suggests that the application for the trademark was filed because the Complaint was issued and that prior to the filing there may not have been a trademark application on foot at all. Moreover, the record of the actual application shows that a fee of $87.50 was paid on the application being made on December 20, 2012, only 2 days after the Complaint was filed. The application for filing of the trademark is available for inspection at the website of the Department of State. The status of trademarks issued by the State authorities in the USA, rather than the Federal body, USPTO, has often given rise to debate, as at least some State trademark applications are not examined and in any event if the records show only applications rather than actual registrations, they may well be of limited effect. The trademark presently under consideration is not a registration and hence must be of limited value. Again it must be said that the onus is on the Respondent o produce its evidence and if there were a valid registered trademark in existence the Respondent must know of it and should produce it as evidence, which it has not done.
Accordingly, the Panel is not satisfied that the Respondent has produced any evidence to rebut the prima facie case against it and concludes that the bare submissions of the Respondent do not rebut that prima facie case.
Complainant has thus made out the second of the three elements that it must establish.

Registration and Use in Bad Faith

To establish bad faith for the purposes of the Policy, Complainant must show that the disputed domain name was registered in bad faith and has been used in bad faith. It is also clear that the criteria set out in Policy ¶ 4(b) for establishing bad faith are not exclusive, but that Complainants in UDRP proceedings may also rely on conduct that is bad faith within the generally accepted meaning of that expression.
Having regard to those principles, the Panel finds that the disputed domain name was registered and used in bad faith. That is so for the following reasons.
The Complainant essentially relies on paragraphs 4 (b) (iii), that the Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor, namely the Complainant and paragraph 4 (b) (iii), that the Respondent has created a likelihood of confusion with the Complainant's mark. The Panel finds that the Complainant has made out both of those grounds. The Panel has already commented on the paucity of the Respondent's case and the total absence of evidence to support its defence and this lack of contribution weighs heavily against making a finding in favour of the Respondent. In contrast, the Complainant has produced a case such that the conclusion on the evidence is overhelmingly in favour of the Complainant. The Respondent has taken the Complainant's trademark, created a domain name that is confusingly similar to the Complainant's trademark, has not given any explanation as to why it chose a name with such an unusual spelling, has provided no information about itself or its history or any facts going to show that it is "America's leading steel building provider", has not answered any of the serious allegations made against it by the Complainant or even the specific allegation that one of the buildings it has claimed to have built is in fact a building of a competitor of the Complainant and has got up a website that is similar to that of the Complainant .
To this, the Respondent has relied, first, on its argument concerning the "Complainant's failure to meet standard of proof", an argument that the Panel rejects, as the Complainant has certainly met the standard of proof required. Secondly, the Respondent says: "The complainant is a coal and iron ore mining company that manufactures steel. The respondent is a high volume sales broker of prefabricated buildings. Clearly these are not the same industries."The Panel has no reason to doubt the Complainant's description of itself, but has doubts as to whether the Respondent has been engaged in the industry

as it claims and, in any event, the paucity of the material adduced by the Respondent is not enough in the opinion of the Panel for it to say on the balance of probabilities that the Respondent did not register or use the domain name in bad faith when, as has been explained, the evidence shows that it did register and use the domain name in bad faith. The Respondent then relies on its other arguments that have already been referred to namely that “Respondent is a licensed and trademarked company in Florida, United States”, “Domain name is identical to the respondent's trademarked company name” and “Complainant and Respondent are not in the same industries.”
The Panel has doubts concerning the Respondent’s trademark that have already been explained, it has expressed its reservations about the Respondent’s alleged “trademarked company name” and it is irrelevant under the UDRP whether the Complainant and Respondent are in the same industry.
For all of these reasons the Panel finds that the Respondent registered and has used the disputed domain name in bad faith.
In addition and having regard to the totality of the evidence, the Panel finds that, in view of Respondent’s registration of the disputed domain name using the ARCELORMITTAL mark and in view of the conduct that Respondent engaged in when using it, Respondent registered and used the disputed domain name in bad faith within the generally accepted meaning of that expression.
Complainant has thus made out the third of the three elements that it must establish.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ARCELORMITTALBUILDINGS.COM**: Transferred

## PANELLISTS

| Name | **The Hon. Neil Brown, QC** |
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DATE OF PANEL DECISION 2013-02-11

Publish the Decision