

Decision for dispute CAC-UDRP-104517

Case number	CAC-UDRP-104517
Time of filing	2022-04-22 08:56:41
Domain names	arcelormittalro.com, globalarcelormittal.com

Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	ARCELORMITTAL S.A.
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Complainant representative

Organization	NAMESHIELD S.A.S.
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Respondent

Organization	Fastloc Inc
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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 names.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of the international trademark registration:

- registered international word mark "ArcelorMittal" No. 947686 for goods and services in Classes 6, 7, 9, 12, 19, 21, 39, 40, 41, 42, with the registration date on August 3, 2007.

The Complainant proved its ownership of the trademark registration in question by the submitted extract from the Register.

FACTUAL BACKGROUND

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. It holds sizeable captive supplies of raw materials and operates extensive distribution networks (Annex 1 to the Complaint).

The Complainant is the owner of the international trademark No. 947686 "ArcelorMittal" registered on August 3, 2007.

The Complainant owns an important domain names portfolio, including the same distinctive wording "ArcelorMittal", such as the domain name <arcelormittal.com> registered since January 27, 2006 (Annex 3 to the Complaint).

The disputed domain names <arcelormittalro.com> and <globalarcelormittal.com> (hereinafter "disputed domain names") were registered on April 13, 2022 (Annex 4 to the Complaint) and resolve to parking pages (Annex 5 to the Complaint).

According to the Registrar verification, the Respondent is 'Fastloc Inc'. The Respondent's provided address as being in Romania.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

A. The Complainant contends that the disputed domain names are confusingly similar to the Complainant's trademarks. The Complainant contends that the disputed domain names are confusingly similar to the Complainant's trademark. The disputed domain names include the Complainant's trademark in its entirety.

The Complainant asserts that the addition of the generic term "GLOBAL" or letters "RO" is not sufficient to escape the finding that the disputed domain names are confusingly similar to the trademark and branded goods. It does not change the overall impression of the designations as being connected to the Complainant's trademark. It does not prevent the likelihood of confusion between the disputed domain names and the Complainant, its trademark and the domain name associated. It is well established that "a domain name that wholly incorporates a Complainant's registered trademark may be sufficient to establish confusing similarity for purposes of the UDRP" (See WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin). The Complainant contends that the addition of the gTLD ".COM" does not change the overall impression of the designations as being connected to the Complainant's trademark. It does not prevent the likelihood of confusion between the disputed domain names and the Complainant, its trademark and its domain names associated. See WIPO Case No. D2006-0451, F. Hoffmann-La Roche AG v. Macalve e-dominios S.A. ("It is also well established that the specific top level of a domain name such as ".com", ".org" or ".net" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar.").

B. The Complainant states that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Complainant asserts that the Respondent is not known as the disputed domain names. Past Panels have held that a Respondent was not commonly known by a disputed domain name if the Whois information was not similar to the disputed domain name. Thus, the Respondent is not known as the disputed domain names (for instance: Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com> ("Here, the WHOIS information of record identifies Respondent as "Chad Moston / Elite Media Group." The Panel therefore finds under Paragraph 4(c)(ii) of the Policy that Respondent is not commonly known by the disputed domain name under Paragraph 4(c)(ii) of the Policy.") or Forum Case No. FA 699652, The Braun Corporation v. Wayne Loney).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain names and it 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 names by the Complainant.

Moreover, the disputed domain names resolve to parking page. The Complainant contends that Respondent did not use the disputed domain names, and it confirms that Respondent has no demonstrable plan to use the disputed domain names.

C. The Complainant contends that the domain names have been registered and are being used in bad faith.

The Complainant's trademark is widely known. Past Panels have confirmed the notoriety of the trademark "ArcelorMittal" in the following cases:

- CAC Case No. 101908, ArcelorMittal v. China Capital ("The Complainant has established that it has rights in the trademark "ArcelorMittal", at least since 2007. The Complainant's trademark was registered prior to the registration of the disputed domain name (February 7, 2018) and is widely well-known.")
- CAC Case No. 101667, ArcelorMittal v. Robert Rudd ("The Panel is convinced that the Trademark is highly distinctive and well-established.")

The Complainant adds that it is reasonable to infer that the Respondent has registered the disputed domain names with full knowledge of the Complainant's trademark. See WIPO Case No. DCO2018-0005, ArcelorMittal SA v. Tina Campbell ("The Panel finds that the trademark ARCELORMITTAL is so well-known internationally for metals and steel production that it is inconceivable that the Respondent might have registered a domain name similar to or incorporating the mark without knowing of it.").

Besides, the disputed domain names are not used. The Complainant contends that the Respondent has not demonstrated any

activity in respect of the disputed domain names, and it is not possible to conceive of any plausible actual or contemplated active use of the domain names by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law. As prior Panels have held, the incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use (for instance: WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows; or WIPO Case No. D2000-0400, CBS Broadcasting, Inc. v. Dennis Toeppen).

RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 names have been registered and are 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

In the present case, the Respondent has not submitted any Response and consequently has not contested any of the contentions made by the Complainant. The Panel proceeds therefore to decide only on the basis of the Complainant's factual statements and the documentary evidence provided in support of them (Paragraph 5(f) of The Rules).

I. CONFUSING SIMILARITY

The Panel finds that the disputed domain names are confusingly similar to the Complainant's trademark "ArcelorMittal". The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (hereinafter referred to as "The WIPO Overview 3.0") in Paragraph 1.7 states: "[...] in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing."

The WIPO Overview 3.0 in Paragraph 1.8 states: "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements."

In the WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin, the Panel stated that: "In numerous cases, it has been held that a domain name that wholly incorporates a Complainant's registered mark may be sufficient to establish confusing similarity for purposes of the UDRP."

The Complainant has established that owns registered international word mark "ArcelorMittal" designated for the classes in connection with steel production (proved by the Annex 2 of the Complaint).

The Complainant's trademark is incorporated in its entirety and clearly recognizable in the disputed domain names <arcelormittalro.com> and <globalarcelormittal.com>. In the first disputed domain name are added letters "RO", Letters "RO" suggest geographical indication in connection with the Respondent's seat in Romania – "RO" is the international abbreviation for Romania, and it is a ccTLD <.ro> too. In the second disputed domain name, there is an addition of the generic term "GLOBAL".

Both additions do not change the overall impression of the disputed domain names. As stated in the WIPO Overview 3.0 in

Paragraphs 1.7 and 1.8 where a domain name incorporates the entirety of a trademark, the domain will normally be considered confusingly similar and the addition of other terms would not prevent finding of confusing similarity.

Therefore, the disputed domain names <arcelormittalro.com> and <globalarcelormittal.com> as they reproduce “ArcelorMittal” trademark in its entirety, with the addition of the generic term and letter “RO” are considered to be confusingly similar to the relevant trademark.

As a result, the Panel finds that the Complainant has satisfied Paragraph 4(a)(i) of the Policy.

II. THE RESPONDENT’S LACK OF RIGHTS OR LEGITIMATE INTERESTS IN THE DOMAIN NAMES

The Panel finds that the Respondent lacks rights or legitimate interests in the disputed domain names.

According to Paragraph 4(a)(ii) of the Policy, the Complainant shall make case that the Respondent lacks rights and legitimate interests in the disputed domain name. If the Complainant fulfils this demand the burden of proof shifts to the Respondent and so the Respondent shall demonstrate rights or legitimate interests in the disputed domain name. If the Respondent fails to prove its rights or legitimate interests, it is assumed that the Complainant satisfied the element of Paragraph 4(a)(ii) of the Policy (see CAC Case No. 102430, Lesaffre et Compagnie v. Tims Dozman). Moreover, past Panels were of the view that it is difficult or sometimes impossible to prove negative facts, i.e., absence of rights or legitimate interest on the part of the Respondent. In this respect, past panels referred to the WIPO Case No. D2000-1769, Neusiedler Aktiengesellschaft v. Vinayak Kulkarni. Within the meaning of Paragraph 4(a)(ii) of the Policy, once the complainant has made something credible (prima facie evidence), the burden of proof shifts to the Respondent to show that he has rights or legitimate interests in the domain name at issue by providing concrete evidence.

In the CAC Case No. 102279, FileHippo s.r.o. v. whois agent, the Panel stated that “[i]n the absence of a response, the Panel accepts the Complainant’s allegations as true that the Respondent has no authorization to use the Complainant’s trademarks in the disputed domain name. Hence, as the Complainant has made out its prima facie case, and as the Respondent has not demonstrated any rights or legitimate interests as illustrated under Paragraph 4(c) of the Policy, nor has the Panel found any other basis for finding any rights or legitimate interests of the Respondent in the disputed domain name, the Panel concludes that the Complainant has satisfied the requirements of Paragraph 4(a)(ii) of the Policy.”

In the Forum Case No. FA 1781783, Skechers U.S.A. Inc. v. Chad Moston / Elite Media Group, the Panel stated that: “where a response is lacking, WHOIS information can support a finding that the respondent is not commonly known by the disputed domain name”.

In the present case, the Complainant asserts that the Respondent is not identified in the Whois database as the disputed domain names’ holder (evidenced by the Annex to the Complaint 4).

The Complainant adds that the Respondent is not related in any way with the Complainant and the Complainant had never granted any license nor authorization to the Respondent to use the Complainant’s trademark or apply for registration of the disputed domain names.

Furthermore, the disputed domain names resolve to the parking page (proved by the Annex 5 of the Complaint). Therefore, this Panel agrees with the Complainant’s contention that the Respondent has no demonstrable plan to use the disputed domain names.

The Respondent did not reply to the Complaint and so failed to demonstrate its rights or legitimate interests in the disputed domain names.

Therefore, the Panel finds that the Complainant has satisfied Paragraph 4(a)(ii) of the Policy.

III. THE REGISTRATION AND USE OF THE DISPUTED DOMAIN NAMES IN BAD FAITH

The Panel finds that the Respondent registered and used the disputed domain names in bad faith.

The WIPO Overview 3.0 in Paragraph 3.1.4 states: “Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith.”

The WIPO Overview 3.0 in Paragraph 3.3 states: “From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding.”

In the WIPO Case No. D2006-1440, National Football League v. Thomas Trainer, the Panel stated: “when a registrant, such as the Respondent here, obtains a domain name that is confusingly similar to a famous mark, with no apparent rights or legitimate interests in the name, and then fails to respond to infringement claims and a UDRP Complaint, an inference of bad faith is warranted.”

In the WIPO Case No. D2015-1167, Valero Energy Corporation and Valero Marketing and Supply Company v. Sharad Bhat, the Panel stated that: “In accordance with previous UDRP decisions, inactive or passive holding of a domain name, under the

circumstances does not prevent a finding of bad faith use.”

In the present case, the Complainant owns registered international trademark “ArcelorMittal” (evidenced by the Annex 2 to the Complaint). Past Panels have decided that the “ArcelorMittal” trademark is well-known (see the CAC Case No. 101908, ArcelorMittal v. China Capital) and has a distinctive nature (see the CAC Case No. 101667, ArcelorMittal v. Robert Rudd). Moreover, the Complainant has certain reputation in the area of steel production while having customers in 160 countries (proved by the Annex 1 to the Complaint).

Furthermore, in the WIPO Case No. DCO2018-0005, ArcelorMittal SA v. Tina Campbell, the Panel found that the Complainant’s trademark is so well-known internationally for steel production that it is inconceivable that the Respondent might have registered a domain name similar to the Complainant’s trademark without knowing of it.

Therefore, this Panel assumes that the Respondent must have been aware of the Complainant’s trademark and its reputation before the registration of the disputed domain names on April 13, 2022.

Additionally, the disputed domain names resolve to an inactive parking website (proved by the Annex 5 to the Complaint). By that, the Respondent is passively holding the disputed domain names with no demonstrable plan to use the disputed domain names. Past Panels have stated that the incorporation of a well-known mark into a domain name, coupled with an inactive parking website, may be evidence of bad faith. (see the WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows; or the WIPO Case No. D2000-0400, CBS Broadcasting, Inc. v. Dennis Toeppen; or the WIPO Case No. D2000-0574, Jupiters Limited v. Aaron Hall).

Following the above mentioned, the Panel finds that the Complainant has satisfied Paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **ARCELORMITTALRO.COM**: Transferred
2. **GLOBALARCELORMITTAL.COM**: Transferred

PANELLISTS

Name	JUDr. Radim Charvát, Ph.D., LL.M.
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DATE OF PANEL DECISION 2022-05-23

Publish the Decision
