

Decision for dispute CAC-UDRP-104811

Case number	CAC-UDRP-104811
Time of filing	2022-08-24 08:38:13
Domain names	arcelormittal-saudi.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)
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Complainant

Organization	ARCELORMITTAL (SA)
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Complainant representative

Organization	NAMESHIELD S.A.S.
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Respondent

Name	steve chill
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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 relies on its rights as the owner and registered proprietor of the international trademark n°947686 ArcelorMittal registered on 3 August 2007 registered in over 32 countries and in classes 06,07,09,12,19,21,39,40,41 and 42.

Those countries include AU - BQ - CW - EM - GE - IS - JP - KR - NO - SG - SX - SY - TR - US - UZ and AL - AM - AZ - BA - BY - CH - CN - CU - DZ - EG - HR - IR - KE - KG - KP - KZ - LR - MA - MC - MD - ME - MK - MN - RS - RU - SD - SM - TJ - UA - VN and SG - US.

It also relies on its extensive use in trade internationally, which makes it a well-known mark.

In common law jurisdictions it may have rights arising from use in trade.

The Complainant also owns a large domain name portfolio, including <arcelormittal.com> registered on 27 January 2006.

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 with 89.9 million tonnes crude steel made in 2019.

The disputed domain name was registered on 12 August 2022 and resolves to a parking page.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant says the addition of the geographic term "SAUDI" is not sufficient to escape the finding that the domain name is confusingly similar to the trademark and branded goods ARCELORMITTAL. It does not change the overall impression of the designation as being connected to the Complainant's trademark ARCELORMITTAL. It does not prevent the likelihood of confusion between the disputed domain name and the Complainant, its trademark and the domain name associated. It says 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" citing WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasily Terkin.

As the disputed domain name resolves to a parking page, the Complainant says this demonstrates a lack of legitimate interests in respect of the disputed domain name, citing: WIPO Case No. D2000-1164, Boeing Co. v. Bressi ("the Respondent has advanced no basis on which he could conclude that it has a right or legitimate interest in the domain names") and the Forum Case No. FA 1773444, Ashley Furniture Industries, Inc. v. Joannet Macket / JM Consultants ("The Panel finds that Respondent's lack of content at the disputed domain shows the lack of a bona fide offering of goods or services or a legitimate noncommercial or fair use per Policy ¶¶ 4(c)(i) and (iii).").

As to Bad Faith, the Complainant says given the distinctiveness of the Complainant's trademark and reputation, it is reasonable to infer that the Respondent has registered the domain name with full knowledge of the Complainant's trademark. Citing 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.").

RESPONDENT:

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.

PRINCIPAL REASONS FOR THE DECISION

There is no question as to Rights and the Complainant and its mark are well-known. See WIPO Case No. DCO2018-0005, ArcelorMittal SA v. Tina Campbell. In terms of the similarity analysis, identity is a strict standard and is not present, however the trade mark and the disputed domain name are clearly similar. The gTLD is disregarded in that comparison.

Here the full trade mark is included in the disputed domain name with the addition of the geographical term "saudi" for Saudi Arabia. The use of the full mark in its entirety can implicate impersonation. Here the additional words combined with the full mark, give the impression that the domain is official - that it is the Complainant in Saudi Arabia. The use of the .com also often indicates that the domain is official.

Fundamentally, use of a domain name will not be considered "fair" if it falsely suggests affiliation with the trade mark owner. Generally speaking, UDRP panels have found that domain names that are near identical to a complainant's trade mark carry a high risk of implied affiliation. Even where a domain name consists of a trade mark plus an additional term UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner.

Past panels have held that a Respondent was not commonly known by a disputed domain name if the WHOIS information was not similar to it, see for instance the 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>. There are no factors on the face of it that would support legitimate use and the Respondent has not come forward to assert any.

In many cases the content of the website in question will remove any doubt or compound it. Here there no use and the disputed domain name is parked. On that parking page there is a commercial message for a hosting service. Parking is not always indicative of lack of rights or bad faith. The prevailing view is that it is fact sensitive.

The WIPO overview says

"3.3. Can the "passive holding" or non-use of a domain name support a finding of bad faith? 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. While panellists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put."

Here, the Complainant says the non-use and parking demonstrates a lack of legitimate interests in respect of the disputed domain name, citing: WIPO Case No. D2000-1164, Boeing Co. v. Bressi ("the Respondent has advanced no basis on which he could conclude that it has a right or legitimate interest in the domain names") and the Forum Case No. FA 1773444, Ashley Furniture Industries, Inc. v. Joannet Macket / JM Consultants ("The Panel finds that Respondent's lack of content at the disputed domain shows the lack of a bona fide offering of goods or services or a legitimate non-commercial or fair use per Policy ¶¶ 4(c)(i) and (iii).").

There do not appear to have been Pay Per Click (PPC) links at the site, based on the evidence. However, the Complainant says the MX records for the disputed domain name had been configured. Evidence was submitted to support that assertion. That would suggest the Respondent used or intended to use the disputed domain for phishing or fraud. That can never be legitimate or fair.

When looking at bad faith - the focus is free-riding or taking unfair advantage of a Complainant's mark. This can be established by any of the factors from the Policy at paragraph 4(b) (although these are non-exclusive, and other scenarios may also arise). As noted, other panels that have found as the Complainant contends "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," see WIPO Case No. DCO2018-0005, ArcelorMittal SA v. Tina Campbell. The Complainant's trade mark is a distinctive well-known mark. Here there can be no doubt the Respondent knew about the Complainant and its rights. The Respondent has not come forward with an explanation for its selection or use of the Complainant's name and mark. Where a mark is famous and there is no obvious reason for its selection and the Respondent has not come forward to explain, it will often be reasonable to find bad faith. See WIPO case, Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003.

In this case, the configuration of MX records suggests the purpose may have been an illegal one. We cannot be certain of this. However, this case is firmly in the impersonation zone.

Therefore, the Panel finds that as there is no use, the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Panel finds the Respondent has registered the disputed domain name in bad faith and is using it in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **arcelormittal-saudi.com**: Transferred

PANELLISTS

Name **Victoria McEvedy**

DATE OF PANEL DECISION **2022-09-29**

Publish the Decision
