

Decision for dispute CAC-UDRP-104815

Case number	CAC-UDRP-104815
Time of filing	2022-08-26 09:30:14
Domain names	arcelormittalemployees.com

Case administrator

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

Organization	ARCELORMITTAL
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Complainant representative

Organization	NAMESHIELD S.A.S.
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Respondent

Organization	Clearer Technology
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Respondent representative

Organization	Envisage Law
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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 is the owner of the international trademark n° 947686 ARCELORMITTAL® registered on August 3, 2007.

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. The disputed domain name <arcelormittalemployees.com> was registered on

August 8, 2022 and redirects to a website under construction. Respondent's landing page is automatically forwarding to <STEELEMPLOYEES.COM>. This website (titled "THISS WEBSITE IS NOT ASSOCIATED WITH NOR ENDORSED BY ARCELOR MITTAL") contains a number of allegations and questions regarding the LGBTQ and corona policy of the Complainant.

PARTIES' CONTENTIONS

The Complainant asserts that the addition of the term "employees" is not sufficient to escape the finding that the domain name is confusingly similar to the trademark and branded goods ARCELORMITTAL®. Furthermore, the Complainant contends that the addition of the gTLD ".COM" does not change the overall impression of the designation as being connected to the Complainant's trademark. The Complainant contends that the Respondent has no rights or legitimate interests in respect of the domain name and he 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 ARCELORMITTAL®, or apply for registration of the disputed domain name by the Complainant.

The Respondent held: He is located in the United States, registered the disputed domain name in the United States using the Complainant's business name plus the dictionary word "employees" for the purpose of commenting on the corresponding policies of the business and to inform and elicit information regarding employment discrimination, and to inquire if employees of certain companies are interested in forming a union as allowed under the National Labor Relations Act, 29 U.S.C. §§141 *et seq.* Respondent's registration and use of the disputed domain name is a fair use and a legitimate and protected free speech practice on the internet.

Furthermore, the Respondent held: Although it is the case that the disputed domain name contains Complainant's marks in its entirety, the disputed domain name will not cause confusion, and should not be deemed confusingly similar. Complainant applies a test of confusing similarity that is confined merely to a comparison of the disputed domain name and the Complainant's marks. Given that both parties have business operations in the United States, it is appropriate to apply United States' legal principals and law to this proceeding. The current landing page of the disputed domain name provides information to Complainant's employees and does not appear in any way to be affiliated with Complainant.

Respondent intends to use the disputed domain name for the purpose of educating Complainant's employees and the general public of their civil rights and of their unionization rights under United States law. Additionally, Respondent intends to use the disputed domain name to provide information to Complainant's employees regarding Complainant's policies, and for the purpose of collecting information regarding whether and to what extent Complainant has abused the rights of its employees and/or discriminated against them. Finally, Respondent intends to develop ArcelorMittalEmployees.com to include details and information about Arcelor Mittal's messaging with its employees and especially with its customers in America and Worldwide regarding Environmental, Social and Governance issues. Respondent's use of Complainant's marks in the disputed domain name is a nominative fair use to identify the company that is the subject of the site.

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). The disputed domain name <arcelormittalemployees.com> is confusingly similar to the trademark ARCELORMITTAL®. The addition of the term "employees" 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 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. Vasily Terkin). The addition of the gTLD ".COM" does not change the overall impression of the designation as being connected to the Complainant's trademark. It does not prevent the likelihood of confusion between the disputed domain name 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.").

The likelihood of confusion is also not eliminated by the fact that the homepage in dispute indicates that the website has nothing to do with the Complainant. Such general statements do not change the fact that users mistakenly attribute the site to the Complainant when they call it up on the basis of the domain name.

NO RIGHTS OR LEGITIMATE INTERESTS

The burden of proving rights and legitimate interests with respect to the disputed domain name generally lies with the Complainant. Nonetheless, if the Complainant makes out a prima facie case concerning the lack of such rights and interests, the burden of proof shifts to the Respondent (see e.g. Dow Jones & Company and Dow Jones LP v. The Hephzibah Intro-Net Project Limited, WIPO Case No. D2000-0704). Because proving the negative, i.e. a lack of interests, is more difficult than proving the positive, the burden of proof on this element can be light. (see e.g. Croatia Airlines d. d. v. Modern Empire Internet Ltd., WIPO Case No. D2003-0455, De Agostini S.p.A. v.

Here, the Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests with respect to the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy). The Respondent is not known by the disputed domain name. The Respondent intends to address Complainant's employees to make them aware of Complainant's policies and uses a domain name confusingly similar to the Complainant's domain name for the mere purpose of reaching more Complainant's employees. Past panels have also 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 (see *The Braun Corporation v. Wayne Loney*, NAF Case No. FA 699652). Here, the WHOIS information does not correspond to the disputed domain name. Moreover, 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. Neither license nor authorization has been granted to the Respondent to make any use of the Complainant's trademark ARCELORMITTAL®, or apply for registration of the disputed domain name by the Complainant. These factors suffice to find *prima facie* that the Respondent has no rights or legitimate interests in the domain name.

Against this burden of proof, the Respondent brings forward certain arguments to the contrary. The Respondent invokes fair use on the basis of providing information and genuinely criticizing the Complainant's social policies with noncommercial intentions. He claims that he wants to use the domain in question to comment on the company's policies in the area of labor law in the USA and to disseminate information on discrimination in the workplace. He also wants to find out whether employees are interested in forming a union. In doing so, he relies on decisions that affirm Respondents' legitimate interest to criticize the Complainants. Indeed, fair use and freedom of speech can be considered as an exceptional justifying reason for the registration of a certain domain name (see, e.g., *TMI Inc. v. Maxell*, 368 F.3d 433, 440; *Wal-Mart Stores, Inc. v. walmartcanadasucks.com*, WIPO Case No. D2000-1104; *Bridgestone Firestone, Inc. v. Jack Myers*, WIPO Case No. D2000-0190).

However, it is necessary to differentiate more precisely in order to prevent pretextual references to an alleged justification for a domain. Otherwise, anyone could justify any domain simply because he wants to use it to exercise his freedom of speech.

While the Respondent tries to place his right to freedom of speech on First Amendment grounds by referring to the United States' legal principles as the applicable law in the present dispute, this argument can hardly be upheld. Previous arbitration courts have found rather than national laws, a single set of principles should govern the UDRP (see e.g. *Covance, Inc. and Convince Laboratories Ltd., v. The Covance Campaign*, WIPO Case No. D2004-0206). Thus, the farther-reaching First Amendment considerations cannot be raised in the present case. Additionally, even the European addresses of residence of both parties do not support the application of US law.

Therefore, previous arbitration courts have only ever accepted an appeal to fair use if a considerable group of existing addresses use the domain name for the concrete exercise of freedom of speech in a specific case (see e.g. *Leidos, Inc. v. Gabriel Joseph/Clearer Technology*, FA2207002005102 (FORUM Sept. 8, 2022)).

Registering or using a confusingly similar domain name can oppose the invocation of the fair use defense. On the one hand, panels have denied fair use in cases where a domain name identical to a trademark was used, due to a risk of user confusion (see e.g. *Sermo, Inc. v. CatalystMD, LLC*, WIPO Case No. 2008-0647). On the other hand, if the domain name comprises a derogatory term in addition to the trademark, a legitimate interest can more easily be established (see e.g. *Amylin Pharmaceuticals, Inc. v. Watts Guerra Craft LLP*, WIPO Case No. D2012-0486). The present domain name, although not completely identical, is more similar to the former than to the latter case. In addition, the other factors shall be considered to determine whether fair use can be invoked.

In a number of UDRP decisions where a respondent argues that its domain name is being used for free speech purposes the panels have found this to be primarily a pretext for cybersquatting, commercial activity, or tarnishment (see e.g. *Northwestel Inc. v. John Steins*, WIPO Case No. D2015-0447, <northwestel.com>; *De Beers Intangibles Limited v. Domain Admin, Whois Privacy Corp.*, WIPO Case No. D2016-1465, <debeers.feedback>). Thus, fair use cannot be invoked if the respondent has an intent to misleadingly divert consumers or to tarnish the Complainant's trade mark. Redirecting consumers from the disputed domain name to the Respondent's landing page shows a clear intent to deflect. In addition, the apparent criticism on the Respondent's landing page may suffice to tarnish the Complainant's trade mark. In addition, Commercial use is also to be considered in the finding of fair use. Commercial gain may include the respondent gaining or seeking reputational advantage, even where such advantage may not be readily quantified. By intending to reach the Complainant's employees and to address Complainant's policy issues, the Respondent seeks to have such an advantage.

Whether the Respondent has engaged in a pattern of trademark-abusive domain name registrations is also to be considered as a factor that does not support a claim to rights or legitimate interests. The present case is not the only one where the Respondent Clearer Technology has added the term "employees" to the Complainant's domain name and used it for his own purposes (see also *Leidos, Inc. v. Gabriel Joseph/Clearer Technology*, FA 2207002005102 (FORUM Sept. 8, 2022)).

Moreover, for fair use to serve as a justification for the Respondent's use of the domain name, it is necessary that the Respondents criticism must be genuine. In the absence of any evidence that may serve as proof, previous panels have found that the use is not genuine (see e.g. *De Beers Intangibles Limited v. Domain Admin, Whois Privacy Corp.*, WIPO Case No. D2016-1465). In this case, the allegations stated on the Respondent's landing page are not in any way substantiated by references or other kinds of evidence.

Under these circumstances, the Complainant has established a clear *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has not succeeded in rebutting that *prima facie* case. Accordingly, the Panel finds the Complainant has established the second requirement under the Policy.

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). Given the distinctiveness of the Complainant's trademark and reputation, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark. The Respondent registered and uses the disputed domain name in bad faith to create confusion with Complainant's marks for by attempting to pass off as Complainant in order to disrupt Complainant's business.

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

The disputed domain name <arcelormittalemployees.com> is confusingly similar to the trademark ARCELORMITTAL®. Merely having the intention to use the domain politically at some point in the future cannot constitute fair use. The Respondent has only referred to a mere declaration of intent and to the fact that in the future he would like to address any current or future employees of the Complainant. Such a vague declaration of intent is in no way sufficient to justify fair use.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **arcelormittalemployees.com**: Transferred

PANELLISTS

Name	Thomas Hoeren
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DATE OF PANEL DECISION	2022-10-22
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Publish the Decision
