

Decision for dispute CAC-UDRP-105118

Case number	CAC-UDRP-105118
Time of filing	2023-01-11 10:41:46
Domain names	outokumpu-metal.com, outokumpu-steel.com, outokumpu-ss.com

Case administrator

Name	Olga Dvořáková (Case admin)
------	------------------------------------

Complainant

Organization	Outokumpu Oyj
--------------	----------------------

Complainant representative

Organization	Berggren Oy
--------------	--------------------

Respondent

Organization	zhuo yang gang tie shang hai you xian gong si (eng. Zhuoyang Steel Shanghai Co., Ltd.)
--------------	---

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 evidence is that the Complainant is the owner of trademark registrations for OUTOKUMPU in the EU and several countries including Australia, Bulgaria, Switzerland, China, Japan, South Korea and the USA, all of which were registered prior to the registration of the disputed domain names. The Complainant's company name "Outokumpu" dates back over 100 years.

FACTUAL BACKGROUND

The Complainant is a globally operating major stainless steel producer based in Finland and listed on the Helsinki Stock Exchange. The Complainant's market share in the global market is approximately 6%. In Europe, it is the market leader with some 30% market share and the clear number two in the Americas with a market share of approximately 22%. The Complainant employs some 9,000 professionals in more than 30 countries, with the headquarters in Helsinki, Finland.

The OUTOKUMPU trademark of the Complainant is well-known and enjoys significant reputation around the world due to its consistent and extensive use throughout the years especially related to stainless steel products.

The Respondent registered the disputed domain names on 24 November 2022.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown that the disputed domain names are confusingly similar to the OUTOKUMPU trademark or service mark in which the Complainant has established that it 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

I. No administratively compliant Response

As the Respondent did not file an administratively compliant Response, pursuant to paragraph 14(b) of the Rules, the Panel may draw such inferences therefrom as it considers appropriate. Thus, the Panel accepts the contentions of the Complainant as admitted by the Respondent.

II. Language of Proceedings

The Complainant requests the language of the proceedings to be changed to English. Paragraph 11 of the Rules provides that: "(a) Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding." Given the facts that the disputed domain names are in English, the websites, the disputed domain names and the links from it are also in English and the correspondence between a customer of the Complainant and the Respondent, as contended by the Complainant, were in English, the Panel finds that the Respondent is capable of understanding the Complaint and proceeding in English. Further, as the Respondent did not file an administratively compliant Response and, thus, did not object to the request for change of language, the Panel accepts the Complaint in English and the request of the Complainant and finds pursuant to Rule 11 (a) that it is procedurally more appropriate for the proceeding to be conducted in the English language.

III. The disputed domain names are confusingly similar to the OUTOKUMPU trademark of the Complainant.

The Complainant has, to the satisfaction of the Panel, shown that it has a valid trademark and company name rights in OUTOKUMPU.

The disputed domain names are similar to the Complainant's OUTOKUMPU trademark because they each contain the trademark and company name in their entirety. Further, the disputed domain names are confusingly similar to the trademarks, as the generic terms "-steel", "-metal" and "-ss" do not distinguish the disputed domain names from the trademark of the Complainant. The terms "-steel" and "-metal" are obviously descriptive in the steel business of both parties. The same applies to "-ss", which, as the Complainant submits is an abbreviation for "stainless steel", and recognised as such, being the main product in the Complainant's business. The addition of those terms therefore enhances the confusing similarity to the trademark. Also, the addition of the gTLD suffix ".com" is not sufficient to

escape the finding that the disputed domain names are confusingly similar to the Complainant's OUTOKUMPU trademark and company name and does not change the overall impression of the designation as being connected to the trademark and company name of the Complainant.

The Complainant has therefore established that the disputed domain names are confusingly similar to the OUTOKUMPU trademark.

IV. The Respondent has no rights or legitimate interests in respect of the disputed domain names within the meaning of the Policy.

Once the Complainant establishes a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names, the burden of production shifts to the Respondent to show that it has rights or legitimate interests in respect to the disputed domain names .

In the present case, the Complainant has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain names, since the Respondent is not a licensee of the Complainant nor has the Complainant granted any permission or consent to use its trademark or company name in a domain name.

Furthermore, the disputed domain names do not correspond to the name of the Respondent and there is no evidence that the Respondent is commonly known by the disputed domain names or as "Outokumpu".

The Respondent did not submit a Response in the present case and did not provide any explanation or evidence to show rights or legitimate interests in the disputed domain names which would be sufficient to rebut the Complainant's *prima facie* case.

The websites available through the disputed domain names display the information contained in them as if they were owned and run by the Complainant. At the very least, by doing so the Respondent takes advantage of the Complainant's renown in the field of steel manufacturing. The Panel is convinced that Respondent is intentionally trying to gain commercial monetary profit from the use and registration of the disputed domain names and is trying to benefit from and causing detriment and damage to the Complainant's well-known trademark and company name.

The Complainant has therefore established that the Respondent has no right or legitimate interest in the disputed domain names.

V. The disputed domain names have been registered and are being used in bad faith within the meaning of the Policy.

The evidence is that the Complainant's trademark and company name are well-known. Given the distinctiveness of the Complainant's rights and reputation, the Panel finds that the Respondent has registered and used the disputed domain names with full knowledge of the Complainant's trademark. This is apparent particularly as the Respondent is active in the same industry as the Complainant.

The Panel finds that the Respondent has intentionally attempted to attract, for commercial gain, Internet users and Complainant's potential customers by creating a likelihood of confusion with Complainant's registered and well-known trademark and company name as to the source, sponsorship, affiliation or endorsement of Respondent's website. The use of the trademark and company name in the disputed domain names and on the websites to which they resolve and the association of the descriptive terms "steel", "metal" and "ss" (=stainless steel) with the Complainant's trademark and company name are *inter alia* circumstances that must lead internet users to believe that Complainant is operating or is at least associated with the operation of the websites. Respondent's bad faith is evident from the use of the trademark and company name throughout all of the websites available via the disputed domain names. In addition, the Complainant has proven that the Respondent was trying to sell steel products via the websites by sending a concrete offer to a customer who clearly thought it was communicating with the Complainant. Further, text as well as pictures have been copied directly from the Complainant's website and have been used on Respondent's websites. When examining the related websites, the Panel has no doubt that the Respondent is engaged in a pattern of conduct consisting of registering domain names composed of company names and/or trademarks and generic words such as "metal".

As is evident from the above-stated, at the time of registration of the disputed domain names, the Respondent must have been well aware of the Complainant's trademark and company name and has intentionally registered and used the disputed domain names in order to benefit from the reputation and goodwill of the Complainant's well-known trademark and company name.

In addition, the Respondent did not submit a administratively compliant Response in this proceeding. Under the circumstances of this case, this is an additional indication of the Respondent's bad faith, which was considered by the Panel.

The Complainant has therefore established that the Respondent has registered and used the disputed domain names in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **outokumpu-metal.com**: Transferred
2. **outokumpu-steel.com**: Transferred
3. **outokumpu-ss.com**: Transferred

PANELLISTS

Name	Dominik Eickemeier
------	---------------------------

Name	Neil Brown
------	-------------------

Name	Jonathan Agmon
------	-----------------------

DATE OF PANEL DECISION	2023-02-23
------------------------	------------

Publish the Decision
