

Decision for dispute CAC-UDRP-100848

Case number	CAC-UDRP-100848
Time of filing	2014-08-22 10:27:02
Domain names	arcelormittalvendas.com, arcelormittaldireto.com

Case administrator

Name	Kateřina Navrátilová
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Complainant

Organization	ArcelorMittal S.A.
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Complainant representative

Organization	Nameshield (Anne Morin)
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Respondent

Organization	HENDRIK VESBURG
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OTHER LEGAL PROCEEDINGS

None of which the Panel is aware.

IDENTIFICATION OF RIGHTS

The Complainant has submitted evidence which the Panel accepts of several trademark registrations for ARCELORMITTAL, including an international registration with the World Intellectual Property Organisation (Reg. No. 947686, registered August 3, 2008). The Respondent has not filed a Response and hence has not mounted any case against the Complainant having those rights. 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 background is drawn from material submitted in the Complaint.

The Complainant is a company specializing in steel throughout the world, and notably in Brazil. In fact, it 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 operations in more than 60 countries. It holds sizeable supplies of raw materials and operates extensive distribution networks.

The Complainant is the owner of several trademarks for ARCELORMITTAL. The Complainant has adduced evidence of those trademarks including the International trademark for ARCELORMITTAL, registered through the World Intellectual Property Organisation, registration number 947686 and registered on August 3, 2007 and also numerous Brazilian trademarks for ARCELORMITTAL (collectively "the ARCELORMITTAL trademark"). The Panel accepts this evidence as establishing the Complainant's trademark rights in ARCELORMITTAL. The Complainant also owns a number of domain names, including the same distinctive wording.

The disputed domain names <arcelormittalvendas.com> and <arcelormittaldireto.com> were registered respectively on July 25, 2014 with the Registrar NETWORK SOLUTIONS and June 25, 2014 with the Registrar UNIVERSO ONLINE S/A (UOL).

The Registration Agreements for the disputed domain names are in English for <arcelormittalvendas.com> and in Portuguese for <arcelormittaldireto.com>. Given the fact that at least one of both Registration Agreements is in English, the Complainant contends that the Respondent understands the English language. Thus, the Complainant requests, for the better understanding by both parties, that the Complaint should be filed in English.

Furthermore, the Registrant contact details are not strictly identical for both domain names. However, given the fact that the differences are insignificant (an "S" replaced by a "R" in VESBURG, a "9" replaced by a "4" in the number of the street, and the phone number), together with the fact that the email addresses are identical for both domain names (pk3k@live.com), the Complainant maintains that the Registrant identified by both names and contact information are the same person.

PARTIES CONTENTIONS

PARTIES' CONTENTIONS:

COMPLAINANT:

1. The disputed domain names are confusingly similar to the ARCELORMITTAL trademark as they each contain the trademark, together with in each case a generic expression, in the case of the <arcelormittalvendas.com> domain name the word "vendas" which in the English language means "sales" and in the case of <arcelormittaldireto.com> domain name the word "direto" which in the English language means "direct." The addition of those words is not sufficient to avoid the conclusion that the respective domain names are confusingly similar to the trademark. The reason why that is so is because the additional words describe activities of the Complainant and suggest that the domain names are related to the Complainant.
2. Moreover, the Respondent must have known of the Complainant's trademark ARCELORMITTAL because it appears on the website in relation with the disputed domain name <arcelormittalvendas.com>. The website to which that domain name resolves includes a portion of the Complainant's own website, including the Complainant's logo.
3. The Respondent does not have any rights or legitimate interest in the domain names. In that regard, it is now well established that the onus is on the Complainant to establish a prima facie case that the Respondent has no rights or legitimate interests in the disputed domain names and then the onus shifts to the Respondent to prove that it does have such rights or legitimate interests.
4. In the present case, the Complainant makes out its prima facie case by showing that the Respondent is not affiliated with it nor authorized by it in any way and nor is the Respondent related in any way to the Complainant's business. Moreover, the Complainant does not carry out any activity for, nor has any business with, the Respondent.
5. The Respondent is also not commonly known by either of the disputed domain names. The information regarding the Respondent, provided by the Whois of the disputed domain names <arcelormittalvendas.com> and <arcelormittaldireto.com>, is "Hendrik Vesburg", not the disputed domain names or either of them.
6. Moreover, the website in relation with the disputed domain name <arcelormittaldireto.com> has been inactive since its registration. However, it is used for email services, notably through the email address "vendas@arcelormittaldireto.com", as

indicated on the bottom of the website in relation with the domain name <arcelormittalvendas.com>. The website in relation with the disputed domain name <arcelormittalvendas.com> is active and provides information in relation with the Complainant and its trademark ARCELORMITTAL. As indicated on the website and in the disputed domain name itself, the Respondent offers for sale many products associated with the Complainant's activity. Furthermore, the Respondent reproduces the Complainant's figurative trademark on the front page of its website and also reproduces pictures and movies which belong to the Complainant.

7. The domain name(s) has been registered and is being used in bad faith.

8. The disputed domain names <arcelormittalvendas.com> and <arcelormittaldireto.com> are confusingly similar to its trademarks and branded goods provided under the ARCELORMITTAL trademark. Indeed, the domain names contain the Complainant's trademark in its entirety.

9. 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 marks and uses it for the purpose of misleading and diverting Internet traffic. Indeed, the Respondent must be necessarily aware of the Complainant's trademark ARCELORMITTAL because it appears on the website in relation to the disputed domain name <arcelormittalvendas.com>. Thus, it is inconceivable that the choice of the Respondent's domain name was made independently of knowledge of the Complainant's trademarks.

10. Furthermore, the website in relation with the disputed domain name <arcelormittaldireto.com> is and has been inactive since its registration. However, it is used for email services (notably through the email address "vendas@arcelormittaldireto.com"), as indicated on the bottom of the website in relation with the domain name <arcelormittalvendas.com>.

11. The website in relation with the disputed domain name <arcelormittalvendas.com> is active and provides information in relation to the Complainant and its trademark ARCELORMITTAL. As indicated on the website and in the disputed domain name itself, the Respondent offers for sale many products associated with the Complainant's activity.

12. Furthermore, the Respondent reproduces the Complainant's figurative trademark on the front page of its website. It also reproduces pictures and movies which belong to the Complainant.

13. Thus, the Complainant contends that the Respondent has registered and is using the disputed domain names in order:

1/ To deprive the Complainant of its intellectual property rights on the trademark ARCELORMITTAL, notably in Brazil and therefore to block the registration of the disputed domain names by the Complainant;

2/ To send fraudulent emails (or to answer to emails in a fraudulent way) to the Complainant's potential consumers through the email address vendas@arcelormittaldireto.com;

3/ To attract Internet users in order to generate profits by attempting to sell them various products, pretending that these products are being sold by the Complainant.

RESPONDENT: The Respondent did not file a Response in this matter.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the Domain Name 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 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 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

Reasons

Preliminary issues

1. For the reasons advanced by the Complainant and appearing in this decision under the heading Factual Background the Panel finds that the Complaint should be filed in the English language and that the proceeding should be conducted in the English language.
2. For the reasons advanced by the Complainant and appearing in this decision under the heading Factual Background, the Panel finds that the Registrant of each of the two disputed domain names is the same person and that accordingly the Complainant has provided the name of the Respondent, defined in the Rules as the domain -name holder, with respect to each of the two disputed domain names.

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 show rights in a trademark or service mark. The Complainant has submitted evidence which the Panel accepts of numerous trademark registrations for ARCELORMITTAL, including an international registration with the World Intellectual Property Organisation (Reg. No. 947686, registered August 3, 2008) and several Brazilian registrations also for ARCELORMITTAL (collectively "the ARCELORMITTAL trademark"). 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 disputed domain names are confusingly similar to Complainant's ARCELORMITTAL mark due to the presence of the trademark in the domain name and in each case the addition of a generic word, in the case of the <arcelormittalvendas.com> domain name the Portuguese word "vendas" which in the English language means "sales" and in the case of <arcelormittaldireto.com> domain name the Portuguese word "direto" which in the English language means "direct." The addition of those words is not sufficient to avoid the conclusion that the respective domain names are confusingly similar to the trademark. The reason why that is so is that the additional words describe activities of the Complainant and suggest that the domain names are related to the Complainant which they are not. The Panel finds that by using Complainant's ARCELORMITTAL mark and adding the respective words referred to, the domain names are confusingly similar to Complainant's ARCELORMITTAL mark because the objective internet user would naturally conclude that the domain names related to the activities of the Complainant. 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.

The 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 then 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) the Respondent has chosen to take the Complainant's trademark and to use it in its domain names, adding only the two generic words referred to, thus implying that the domain names are official domain names of Complainant leading to an official website of Complainant dealing with products supplied under the trademark, both products sold and products dealt with by the Complainant directly;
- (b) The Complainant has also established from information contained in the WHOIS that the Registrant is Hendrick Vesburg 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;
- (c) The Complainant also submits that the Respondent's activity under the disputed domain names 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.
- (d) The evidence is that the Respondent is not affiliated with it nor authorized by it in any way and nor is the Respondent related in any way to the Complainant's business. Moreover, the Complainant does not carry out any activity for, nor has any business with, the Respondent.
- (e) The website in relation with the disputed domain name <arcelormittaldireto.com> has been inactive since its registration. However, it is used for email services, notably through the email address "vendas@arcelormittaldireto.com", as indicated on the bottom of the website in relation with the domain name <arcelormittalvendas.com>. The website in relation with the disputed domain name <arcelormittalvendas.com> is active and provides information in relation to the Complainant and its trademark ARCELOMITTAL. As indicated on the website and in the disputed domain name itself, the Respondent offers for sale many products associated with the Complainant's activity. Furthermore, the Respondent reproduces the Complainant's figurative trademark on the front page of its website and also reproduces pictures and movies which belong to the Complainant.
- (f) The Respondent has engaged in these activities without the consent or approval of the Complainant.

All of these matters go to make out the prima facie case against the 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 the Respondent has no rights or legitimate interests in the disputed domain name.

As the Respondent has not filed a Response or sought by any other means to show a right or legitimate interest in the disputed domain names, the Panel finds that the Respondent has no rights or legitimate interest in either of the disputed domain names.

Registered and used in bad faith

To establish bad faith for the purposes of the Policy, the Complainant must show that the disputed domain names were registered in bad faith and have been used in bad faith. It is also clear that the criteria set out in paragraph 4(b) of the Policy 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 names were registered and used in bad faith. That is so for the following reasons.

The Complainant relies on several grounds. First, that both domain names <arcelormittalvendas.com> and <arcelormittaldireto.com> are confusingly similar to the Complainant's trademarks and branded goods provided under the ARCELORMITTAL trademark and that the domain names contain the Complainant's trademark in its entirety. The Panel accepts that argument and adds that the very fact that the Respondent has taken and used the famous ARCELORMITTAL trademark without permission shows that the Respondent was motivated by bad faith from the beginning.

The Complainant then says that 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 marks and uses it for the purpose of misleading and diverting Internet traffic. Indeed, the Respondent must be necessarily aware of the Complainant's trademark ARCELORMITTAL® because it appears on the website in relation to the disputed domain name <arcelormittalvendas.com>. Thus, it is inconceivable that the choice of the Respondent's domain name was made independently of knowledge of the Complainant's trademarks. The Panel accepts that argument and the reasoning on which it is based. The only conclusion open is that the Respondent intended to trade on the good name of the Complainant and turn it to his advantage by giving the impression that the domain names were official domain names of the Complainant, leading to official websites and that they could be used for conducting business with the Complainant, which was misleading and fraudulent. The Panel finds that these matters establish bad faith registration and use by the Respondent.

The Complainant also argues that the website in relation with the disputed domain name <arcelormittaldireto.com> is and has been inactive since its registration. However, it is used for email services (notably through the email address "vendas@arcelormittaldireto.com"), as indicated on the bottom of the website in relation with the domain name <arcelormittalvendas.com>. The website in relation with the disputed domain name <arcelormittalvendas.com> is active and provides information in relation to the Complainant and its trademark ARCELORMITTAL®. As indicated on the website and in the disputed domain name itself, the Respondent offers for sale many products associated with the Complainant's activity. Furthermore, the Respondent reproduces the Complainant's figurative trademark on the front page of its website. It also reproduces pictures and movies which belong to the Complainant. From these matters it is very clear that the intention of the Respondent from the time of registration has been to use the disputed domain names to deprive the Complainant of its intellectual property rights on the trademark ARCELORMITTAL®, notably in Brazil and therefore to block the registration of the disputed domain names by the Complainant; to send fraudulent emails (or to answer to emails in a fraudulent way) to the Complainant's potential consumers through the email address vendas@arcelormittaldireto.com; and to attract Internet users in order to generate profits by attempting to sell them various products, pretending that these products are being sold by the Complainant the related company ARCELORMITTAL. All of this is clearly bad faith both with respect to registration and use of the domain names and probably fraudulent.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. ARCELORMITTALVENDAS.COM: Transferred
2. ARCELORMITTALDIRETO.COM: Transferred

PANELLISTS

