

Decision for dispute CAC-UDRP-105184

Case number	CAC-UDRP-105184	
Time of filing	2023-02-09 09:20:45	
Domain names	arcelormittal-intl.com	

Case administrator

Name Olga Dvořáková (Case admin)

Complainant

Organization ARCELORMITTAL

Complainant representative

Organization NAMESHIELD S.A.S.

Respondent

Organization Unit GH Castlefields Industrial Estate

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 registration with number 947686 for the word mark "ARCELORMITTAL", registered on August 3, 2007 for goods and services in classes 6, 7, 9, 12, 19, 21, 39, 40, 41 and 42. The registration designates many countries worldwide

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 69.1 million tons crude steel made in 2021. It holds sizeable captive supplies of raw materials and operates extensive distribution networks.

On February2, 2023 the Respondent registered the disputed domain name <arcelormittal-intl.com>. The disputed domain name does not resolve to an active website and has been set up with MX records.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.

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

- 1. The Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark ARCELORMITTAL which was registered prior to the registration of the disputed domain name and should be regarded to having a reputation. The disputed domain name wholly incorporates the Complainant's trademark. The fact that the term "-int" is added does not eliminate the similarity between Complainant's trademark and the disputed domain name, as "int" can represent "international", which is a descriptive component of the disputed domain name. The Panel agrees with the Complainant that the disputed domain name gives the impression to be connected to Complainant's trademark.
- 2. The Panel finds that the Complainant successfully submitted evidence that the Respondent has made no use of, or demonstrable preparations to use the disputed domain name in connection with a bona fide offering of goods or services, neither did the Complainant grant the Respondent a license or authorization to make use of the Complainant's trademark ARCELORMITTAL or apply for registration of the disputed domain name, nor is the Respondent commonly known under the disputed domain name. The Complainant's allegations were not challenged by the Respondent.
- 3. In the absence of a Response, and given that ARCELORMITTAL is not a dictionary and/or commonly used term but rather a trademark with a reputation, the Panel infers that the Respondent must have had the Complainant's trademark in mind when registering the disputed domain name, which was therefore registered in bad faith. Further, the disputed domain name does not resolve to an active website. However, the consensus view amongst UDRP panelists is that the apparent lack of so-called active use of the domain name without any active attempt to sell or to contact the trademark holder does not as such prevent a finding of bad faith. The panel must examine all the circumstances of the case to determine whether the respondent is acting in bad faith. "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" (paragraph 3.4 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition). In this case, the Panel is satisfied that the overall circumstances of this case strongly suggest that the Respondent's non-use of the disputed domain name is in bad faith. This is further enhanced by the fact that the Complainant also alleged that Respondent set up Mail Exchange records ("MX records") to enable sending and receiving emails from the disputed domain name. In absence of a Response the Panel considers it likely that the disputed domain name may have

been used for unlawful purposes (e.g., BOLLORE SE v. Contact Privacy Inc. Customer 1247853759 / Angela Chaney, WIPO Case No. D2020-2050 and PrideStaff, Inc. v. Perfect Privacy, LLC / Marcheta Bowlin, Midwest Merchant Services, WIPO Case No. D2021-3165).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. arcelormittal-intl.com: Transferred

PANELLISTS

Name **Alfred Meijboom**

DATE OF PANEL DECISION 2023-03-14

Publish the Decision

disregarded for this purpose (see Playboy Enterprises International, Inc. v. John Taxiarchos, WIPO Case No. D2006-0561; Burberry Limited v. Carlos Lim, WIPO Case No. D2011-0344; Magnum Piercing, Inc. v. The Mudjackers and Garwood S. Wilson, Sr., WIPO Case No. D2000-1525). Therefore, only the part <wwwavg> of the disputed domain name has to be considered while evaluating confusing similarity or identity. In this respect the Panel notes that "avg" is identical to the Complainant's trademark "AVG" while "www", corresponds to the well-known acronym for "world wide web", and is an extremely common prefix (when succeeded by a period) to the domain name in a URL for a website on the Internet. The letters "www" thus have no distinguishing capacity in the context of domain names disputes (see Allianz SE v. Venkateshwara Distributor Private Limited/PrivacyProtect.org, WIPO Case No. D2010-0951). In fact, in the context of domain names, the letters "www" have the effect of focusing particular attention on the succeeding word, in this case the word "avg". This is because a casual reader of the domain name may wrongly think that there is a period between the "www" and the succeeding word, and so wrongly assume that the domain name is in fact comprised only of the succeeding word. In addition, the practical effect of preceding a trademark with the letters "www" in a domain name is so-called "typo-piracy" (see World Wrestling Federation Entertainment, Inc. v. Matthew Bessette, WIPO Case No. D2000-0256 and CSC Holdings, Inc. v. Elbridge Gagne WIPO Case No. D2003-0273) - that is, attracting to a different website the Internet user who mistakenly fails to insert a period after the letters "www" when typing the URL of the intended website. This situation of confusing similarity is even more evident in the present case since the official website of the Complainant is www.avg.com practically identical to the disputed domain name (the Complainant has registered the domain name <avg.com> in 1994). In consideration of both the visual similarity and the potential typo-piracy, the disputed domain name is confusingly similar to the Complainant's trademark "AVG" (see Volkswagen AG v. Privacy Protection Services, WIPO Case No. D2012-2066). Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B) The Respondent's rights or legitimate interests in the disputed domain name.

The Complainant has long standing rights in the mark "AVG". The Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain name as it is not commonly known under the disputed domain name and as the Respondent was never authorized or licensed or otherwise permitted by the Complainant to use the disputed domain name. The Respondent, in the absence of any response, has not shown any facts or elements to justify legitimate rights or interests in the disputed domain name. Therefore, on the basis of the evidences submitted and in the absence of a response, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name. The fact that the domain name in dispute was registered in 2004 and therefore before the filing dates of the Complainant's mark is totally irrelevant in assessing possible legitimate interests of the Respondent in the term "AVG". This because (i) the Complainant uses the unregistered trademark "AVG" since 1991 (ii) the Complainant has registered the <avg.com> domain name from November 1, 1994 and since then it has extensively used said domain name in order to run a website (www.avg.com) fully dedicated to the promotion and distribution of the antivirus products marked "AVG" and (iii) the domain name in dispute was never used for an independent business activity of the Respondent not linked to the Complainant since the only use of the domain name in dispute shown to the Panel consists of the redirection of internet traffic to Complainant's official website. Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C) Registration and use in bad faith.

The Panel has duly considered that, according to the current Whois records and to the domain report made available by Complainant, the disputed domain name was registered in 2004, but the ownership of the disputed domain name has (apparently) changed between February and April 2018. The Panel also knows that according to section 3.9 of the WIPO Overview 3.0, "the transfer of a domain name registration from a third party to the respondent is not a renewal and the date on which the current registrant acquired the domain name is the date a panel will consider in assessing bad faith".

Now, according to the domain report, it results that in the period February/April 2018 the ownership of <www.avg.com> passed from Mr. David Webb to a domain privacy service used to conceal the owner identity named PRIVACYDOTLINK CUSTOMER 3542472. Anyway, by the Registrar Verification made on April 13, 2021 it results that the current owner of the disputed domain name concealed under PRIVACYDOTLINK CUSTOMER 3542472 is Mr. Webb from the city of Wylie located in Texas which corresponds to the previous owner of <wwwavg.com>. In consideration of the above the Panel is not convinced that a transfer of the domain name in dispute, with the meaning of section 3.9 of the WIPO Overview 3.0, effectively took place as stated by the Complainant. On the contrary, in the Panel's view, in the period February/April 2018 the owner of the domain name in dispute simply decided to use a domain privacy service in order to conceal its identity. In order to correctly address the issue of bad faith registration it must be considered that at the time of the registration of the disputed domain name by the Respondent, the Complainant had already extensively used the unregistered mark "AVG" since it has been used to contradistinguish the Complainant's antivirus since 1991 and in consideration of the fact that (i) it was created a website dedicated to the "AVG" products linked to the domain name <avg.com> registered since November 1, 1994 and (ii) since 1997 licences on the "AVG" products have been sold across Europe and United States of America allowing the use of "AVG" identifier across many territories of the word. The Panel is definitively convinced that the Complainant's unregistered mark "AVG" was distinctive and sufficiently well-known at the time of the disputed domain name registration due to the fact that the Respondent uses the domain name in dispute only to redirect users to Complainant websites which incontrovertibly demonstrates that the Respondent was perfectly aware of Complainant's rights on "AVG" when it decided to register (clearly in bad faith) the domain name <wwwavg.com> which fully includes the Complainant's trademark (being the only distinctive part of the domain name in dispute).

As seen before, the Respondent uses the domain name in dispute to redirect users to Complainant websites. According to the Panel, the use of the domain name in dispute to redirect the traffic to the Complainant's own website implies bad faith as there is a risk that the Respondent may at any time cause Internet traffic to redirect to a website that is not that of, or associated with, the Complainant (see MySpace, Inc. v. Mari Gomez, WIPO Case No. D2007-1231) and as it may increase customer confusion that the domain name in dispute is somehow licensed or controlled by the Complainant (see PayPal Inc. v. Jon Shanks, WIPO Case No. D2014-0888). Furthermore, the Panel draws an adverse inference from the Respondent's use of a privacy protection service to conceal its identity. Whilst privacy shields may be legitimate in certain cases, it is difficult to see why the Respondent in this case needs to protect its identity "except to frustrate the purposes of the Policy or make it difficult for a brand owner to protect its trade marks against infringement, dilution and cybersquatting" (see Ustream.TV, Inc. v. Vertical Axis, Inc, WIPO Case No. D2008-0598). Finally, the Panel also finds that the Respondent's failure to take part in the present proceedings constitutes an additional indication of its bad faith. Accordingly, the Panel finds that the Complainant has satisfied also 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. WWWAVG.COM: Transferred

PANELLISTS

Name Avv. Guido Maffei

Date of Panel Decision 2021-05-10 Publish the Decision