

Decision for dispute CAC-UDRP-105326

Case number	CAC-UDRP-105326
Time of filing	2023-04-20 10:58:51
Domain names	arcelormittal-com.com

Case administrator

Name	Olga Dvořáková (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	Jbrezy Inc
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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

In this proceeding the Complainant relies on the following trademark registration:

- The international trademark registration “ArcelorMittal” (word) No. 947686, registration date August 03, 2007 and effective *inter alia* in the US, Singapore, the European Union, Switzerland and China.

The Complainant also refers to various domain names owned by the Complainant that incorporate its “ArcelorMittal” trademark, including <arcelormittal.com>.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

THE DISPUTED DOMAIN NAME IS IDENTICAL OR CONFUSINGLY SIMILAR TO A TRADEMARK OR SERVICE MARK IN WHICH THE COMPLAINANT HAS RIGHTS

The Complainant is a steel manufacturing company.

The Complainant alleges that it is the largest steel producing company in the world and is the market leader in steel production for use in

automotive, construction, household appliances and packaging with 69.1 million tons crude steel made in 2021.

The Complainant is the owner of the “ArcelorMittal” trademark referred to above and also owns the domain name <arcelormittal.com> registered since January 27, 2006.

The disputed domain name is registered on March 27, 2023 and is currently not used for any active website.

The Complainant claims the disputed domain name is confusingly similar to the “ArcelorMittal” trademark since it includes the trademark of the Complainant in its entirety.

The Complainant asserts that the addition of the term “COM” is not sufficient to escape the finding that the disputed domain name is confusingly similar to the Complainant’s trademark and does not change the overall impression of the designation as being connected to the Complainant’s trademark.

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.

Therefore, the Complainant claims the disputed domain name is confusingly similar to its “ArcelorMittal” trademark.

THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTERESTS IN RESPECT OF THE DISPUTED DOMAIN NAME

The Complainant asserts that the Respondent is not identified in the “Whois” database as the disputed domain name.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name as he is not related in any way to 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, or apply for registration of the disputed domain name.

The disputed domain name is inactive and the Complainant contends that the Respondent did not use the disputed domain name since its creation, and it confirms that the Respondent has no demonstrable plan to use the disputed domain name.

Based on the above, the Complainant claims that the second element of the UDRP is evident and prima-facie requirement has been satisfied.

THE DISPUTED DOMAIN NAME WAS REGISTERED AND BEING USED IN BAD FAITH

The Complainant’s submissions on the bad faith element of the UDRP can be summarized as follows:

1. The Complainant claims that its “ArcelorMittal” trademark is well-known and refers to previous decisions of UDRP panels that confirm well-known character of the Complainant’s trademark.
2. The Complainant alleges that given the distinctiveness of the Complainant’s trademark the Respondent has registered the disputed domain name with full knowledge of the Complainant’s trademark.
3. The Complainant relies on the “Telstra” decision (WIPO Case No. D2000-0003, “Telstra Corporation Limited v. Nuclear Marshmallows”) and alleges that passive holding in the present case indicates bad faith of the Respondent since it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate.

Therefore, the Complainant claims the disputed domain name was registered and being used in bad faith.

PARTIES CONTENTIONS

The Complainant’s contentions are summarized in the Factual Background section above.

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

A. Identical or confusingly similar

The Complainant provides evidence of the international registration for the word mark “ArcelorMittal” that is protected in various jurisdictions.

As confirmed by the “WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition” (“WIPO Overview 3.0”): “where the complainant holds a nationally or regionally registered trademark or service mark, this prima facie satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case” (see par. 1.2.1).

The disputed domain name fully incorporates the word trademark of the Complainant with the addition of the “COM” term.

The confusing similarity test for the purpose of the first element assessment is rather straightforward, namely: “whether the mark is recognizable within the disputed domain name” and “where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark” (see par. 1.7 of the WIPO Overview 3.0).

It is also worth noting that “where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element” (par.1.8 of the WIPO Overview 3.0).

In the present case, the Complainant’s word trademark is clearly recognizable within the disputed domain name. The addition of the “COM” term to the Complainant’s mark in the disputed domain name does not eliminate confusing similarity.

The gTLD “.com” is to be disregarded under the confusing similarity test as it does nothing to eliminate confusion.

Therefore, the Panel finds that the first requirement of the Policy has been satisfied.

B. Rights or Legitimate Interests

The general rule is the following:

- (i) a complainant is required to make out a prima facie case that the respondent lacks rights or legitimate interests; and
- (ii) once such prima facie case is made, the burden shifts to the respondent who has to demonstrate his rights or legitimate interests in respect of the domain name under paragraph 4 (c) of the Policy.

If the respondent fails to do so, the second element of the Policy is satisfied, see “Julian Barnes v. Old Barn Studios”, WIPO Case No. D2001-0121; “Belupo d.d. v. WACHEM d.o.o.”, WIPO Case No. D2004-0110.

The disputed domain name was registered on March 27, 2023. It does not resolve to any active page.

The Respondent did not respond.

While failure to respond does not per se demonstrate that the Respondent does not have rights or legitimate interests, it allows the Panel to draw such inferences as it considers appropriate (see paragraph 14(b) of the Rules and CAC Case No. 101284: “A respondent is not obliged to participate in a proceeding under the Policy, but if it fails to do so, reasonable inferences may be drawn from the information provided by the complainant”).

The Complainant has made a prima facie case of Respondent’s lack of rights or legitimate interests.

The Respondent is not known by the disputed domain name and is identified as an individual with no connection to the Complainant’s business or the disputed domain name.

The Complainant has not granted any license or authorization to use its trademark to the Respondent and the Complainant is not doing any business with the Respondent.

The nature of the disputed domain name is such that it creates an association with the Complainant and its business, it includes the Complainant's trademark in its entirety coupled with a generic term "COM".

Passive holding of the disputed domain name in the circumstances of this case does not create any rights or legitimate interests of the Respondent.

Therefore, the Panel finds that the Complainant has satisfied the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy lists non-exhaustive circumstances indicating registration and use in bad faith. These circumstances are non-exhaustive and other factors can also be considered in deciding about the bad faith element.

It is well established that bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant's mark (see par. 3.1 of the WIPO Overview 3.0). Targeting is important in establishing bad faith under the UDRP.

The Panel finds that the Complainant provided sufficient evidence that the disputed domain name was registered and is being used in bad faith and facts of this dispute demonstrate bad faith of the Respondent.

The Panel's finding is based on the following:

1. The nature of the disputed domain name - the exact match of the Complainant's "ArcelorMittal" trademark coupled with a generic <COM> element and the timing of the registration of the disputed domain name – March 27, 2023, many years after the Complainant obtained protection for its trademark and became known under the "ArcelorMittal" mark and name. The nature of the disputed domain name indicates that the Respondent was aware of the Complainant and its trademark when he registered the disputed domain name.
2. The strength and reputation of the Complainant's trademark. The Complainant alleges that its "ArcelorMittal" mark is well-known and refers to previous UDRP decisions. The Panel notes that the Complainant provided only limited evidence of well-known character of the "ArcelorMittal" trademark (copies of webpages of the Complainant's Internet site with a description of its business and some facts and figures). Normally, more evidence is required to establish that a trademark is well-known/ has a strong reputation (e.g. evidence of awards, publications by independent sources, media reports, etc.). However, this is not fatal to the Complainant's case. The Panel indeed finds that the mark is widely known despite limited evidence provided by the Complainant. Panel's own independent research of publicly available sources also confirmed well-known character of the Complainant's trademark (exercising its powers under par. 10 of the UDRP rules) such as "Wikipedia" articles and publicly available publications about the Complainant and its activities in different countries. Besides, previous UDRP decisions relating to the "ArcelorMittal" trademark (including the ones cited by the Complainant in its complaint) could be an additional indication of popularity of the Complainant's trademark. While each UDRP case is unique and has its own set of facts and circumstances, previous decisions in Complainant's favor can demonstrate that the Complainant's mark was already targeted by cybersquatters and is popular (see e.g. CAC Case 105238: "The Panel concludes that the Complainant's 'ARCELORMITTAL' trademark is of distinctive character and is well-known" and CAC Case No. 101667: "The Panel is convinced that the Trademark is highly distinctive and well-established").
3. Passive holding of the disputed domain name in the circumstances of this case indicates both registration and use in bad faith. The WIPO Overview 3.0 states that "from the inception of the UDRP, panelists have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding" and the panelists "will look at the totality of the circumstances in each case" (par. 3.3). The Panel notes that passive holding per se does not indicate bad faith. However, the totality of the circumstances of this dispute proves bad faith of the Respondent, in particular: i) strength of the Complainant's mark and timing of registration of the disputed domain name, ii) failure of the Respondent to respond and take part in this proceeding and iii) the implausibility of any good faith use to which the domain name may be put – the Panel does not find any circumstances under which the Respondent could legitimately use the disputed domain name that is so closely associated with the Complainant and its trademark and virtually copying the Complainant's main domain name <arcelormittal.com>. Any possible explanation of a potential legitimate use is solely within the Respondent's knowledge and the Respondent failed to respond and provide any explanations.
4. The Panel finds that this is a case of targeting and an attempt to take unfair advantage of the Complainant's trademark and reputation by the Respondent. There are no any rights or legitimate interests of the Respondent taking into account evidence on the record and facts of this case and the only apparent reason for registration of the disputed domain name is an intent of the Respondent to take advantage of the Complainant's mark and business reputation.

Based on the above, the Panel finds that Respondent's behavior falls within, at least, par. 4 b (iv) of the Policy and the Respondent by

using the disputed domain name has intentionally attempted to attract, for commercial gain, Internet users to his web site, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement and that the Respondent takes unfair advantage of the Complainant's mark.

The Panel holds that the third requirement of the Policy has been satisfied.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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

PANELLISTS

Name	Igor Motsnyi
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DATE OF PANEL DECISION 2023-05-13

Publish the Decision