Decision for dispute CAC-UDRP-106615

Case number	CAC-UDRP-106615
Time of filing	2024-06-17 10:46:47
Domain names	arcelormittal-backoffice.com, arcelormittal-service.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	ARCELORMITTAL

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Name	Eric Philipson

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 Complainant owns international trade mark registration No 947686 ARCELORMITTAL, first registered on 3 August 2007 in international classes 6, 7, 9, 12, 19, 21, 39, 40, 41, and 42. The Complainant's trade mark registration predates the registration of the disputed domain names.

Furthermore, the Complainant owns a portfolio of domain names consisting of the name ARCELORMITTAL, including the domain <arcelormittal.com>, registered on 27 January 2006, which is connected to the official website of the Complainant.

FACTUAL BACKGROUND

The Complainant is one of the largest steel producing companies in the world and is a market leader in steel for use in automotive, construction, household appliances and packaging with some 58 million tons of crude steel made in 2023. It operates an extensive international distribution network.

The disputed domain names <arcelormittal-backoffice.com> and <arcelormittal-service.com> were registered on 13 June 2024 and resolve to inactive pages. MX servers have been configured in relation to both domain names.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain names 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 names are identical or confusingly similar to a trade mark 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 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 notes that the amended complaint relates to two disputed domain names registered by the same Respondent, Eric Philipson, with the same registrar on the same date. The disputed domain names both resolve to inactive pages. The Panel considers it appropriate that the complaints against the disputed domain names are consolidated in a single UDRP proceeding for the following reasons: Paragraph 4(f) of the Policy provides that “[i]n the event of multiple disputes between [a respondent] and a complainant, either [the respondent] or the complainant may petition to consolidate the disputes before a single Administrative Panel….” This is allowed where it “promotes the shared interests of the parties in avoiding unnecessary duplication of time, effort and expense, reduces the potential for conflicting or inconsistent results arising from multiple proceedings, and generally furthers the fundamental objectives of the Policy.” (See, for example, WIPO Case No D2009-0985, MLB Advanced Media, The Phillies, Padres LP v. OreNet, Inc.). Furthermore, paragraph 3(c) of the Rules provides that “[t]he complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder”, as is the case here. Not only have the disputed domain names at issue in this proceeding been registered by the same Respondent, but they were also registered on the same date and neither of them resolves to an active website. The Panel therefore concludes that it would be equitable and procedurally efficient to permit the consolidation of the disputed domain names into this single case.

The Panel is satisfied that all other procedural requirements under UDRP were also met and that there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

With regard to the first UDRP element, the Panel finds that the disputed domain names are identical with the Complainant's trade mark ARCELORMITTAL. Indeed, the disputed domain names both incorporate the Complainant's trade mark in its entirety but add the hyphenated generic descriptive terms "backoffice" and “service” as suffixes to the Complainant's trade mark. The Panel follows in this respect the view established by numerous other decisions that a domain name which wholly incorporates a complainant's registered trade mark may be sufficient to establish confusing similarity for the purposes of the UDRP (see, for example, WIPO Case No. D2003-0888, Dr. Ing. h.c. F. Porsche AG v. Vasiliy Terkin <porsche-autoparts.com>). The Panel further considers it to be well established that the addition of a descriptive term does not allow a domain name to avoid confusing similarity with a trade mark (see, for example, WIPO Case No. D2019-2294, Qantas Airways Limited v. Quality Ads <qantaslink.com>; and CAC Case No. 102137, Novartis AG v. Black Roses <novartiscorp.com>). Other panels have previously found that “[W]here 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” (see WIPO Overview 3.0, section 1.8; and, for example, WIPO Case No. D2023-2542, Merryvale Limited v. tao tao <wwbetway.com>; and WIPO Case No. D2020-0528, Philip Morris Products S.A. v. Rich Ardtea <global-iqos.com>). Against this background, the Panel finds that the addition of the generic descriptive terms "backoffice" and “service” is not sufficient to alter the overall impression of the

designations as being connected with the Complainant's trade mark and does not prevent a likelihood of confusion between the disputed domain names and the Complainant, its trade mark and associated domain names. To the contrary, the disputed domain names rather add to the likelihood of confusion because the addition of the descriptive terms "backoffice" and “service”, in conjunction with the Complainant's trade mark ARCELORMITTAL, suggests that the disputed domain names link to an official website of the Complainant, and implies that they are linked to the Complainant and its business.

With regard to the second UDRP element, there is no evidence before the Panel to suggest that the Respondent has made any use of, or demonstrable preparations to use, the disputed domain names in connection with a bona fide offering of goods or services. Neither is there any indication that the Respondent is making legitimate non-commercial or fair use of the disputed domain names. Indeed, the disputed domain names are not being used for any active website but resolve to an inactive error page. A lack of content at the disputed domain names has in itself been regarded by other panels as supporting a finding that the respondent lacked a bona fide offering of goods or services and did not make legitimate non-commercial or fair use of the disputed domain name (see, for example, Forum Case No. FA 1773444, Ashley Furniture Industries, Inc v. Joannet Macket/JM Consultants). The Panel further finds that the Respondent is not affiliated with or related to the Complainant in any way and is neither licensed nor otherwise authorised to make any use of the Complainant’s trade marks or to apply for or use the disputed domain names. Additionally, the Whois information for the disputed domain names does not suggest that the Respondent is commonly known by the disputed domain names. Past panels have 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, as is equally not the case here (see, for example, Forum Case No. FA 1781783, Skechers U.S.A., Inc. and Skechers U.S.A., Inc. II v. Chad Moston / Elite Media Group <bobsfromsketchers.com> (“Here, the WHOIS information of record identifies Respondent as “Chad Moston / Elite Media Group.” The Panel therefore finds under Policy ¶ 4(c)(ii) that Respondent is not commonly known by the disputed domain name under Policy ¶ 4(c)(ii).”)). Against this background, and absent any response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

With regard to the third UDRP element, it is reasonable to infer that the Respondent either knew, or should have known, that the disputed domain names would be identical or confusingly similar to the Complainant's trade mark, and that the Respondent registered the disputed domain names in full knowledge of the Complainant's trade mark. Indeed, if the Respondent had carried out a Google search for the term “Arcelormittal”, the search results would have yielded immediate results related to the Complainant, its websites, and its connected business and services. It is likely that the disputed domain names would not have been registered if it were not for the Complainant's trade mark (see, for example, WIPO Case No D2004-0673 Ferrari Spa v. American Entertainment Group Inc <ferrariowner.com>). Indeed, the Panel considers that the disputed domain names were intentionally designed to be either identical or confusingly similar with the Complainant’s trade mark. Furthermore, the disputed domain names resolve to an inactive error page. The Respondent has not demonstrated any activity in respect of the disputed domain names. First, it is difficult to conceive of any plausible actual or contemplated active use of the disputed domain names by the Respondent that would not be illegitimate on the grounds that it would constitute passing off, an infringement of consumer protection legislation, or an infringement of the Complainant’s rights under trade mark law under circumstances where the disputed domain names correspond to the Complainant’s trade mark and are similar to the Complainant’s genuine domain names currently used by the latter to promote its goods and services. Secondly, numerous other UDRP decisions have taken the view, which this Panel shares, that the passive holding of a domain name with knowledge that the domain name infringes another party’s trade mark rights may in itself be regarded as evidence of bad faith registration and use (see, for example, WIPO Case No. D2000-0003, Telstra Corporation Limited v. Nuclear Marshmallows; and WIPO Case No. D2004-0615, Comerica Inc. v. Horoshiy, Inc.). Finally, although the domain names appear to be unused, they have been set up with MX records which suggests that they may actively be used for e-mail purposes or that such use is contemplated. The Panel concludes that it is inconceivable that the Respondent will be able to make any good faith use of the disputed domain names as part of an e-mail address. Absent any response from the Respondent, or any other information indicating the contrary, the Panel therefore also accepts that the Respondent has registered and is using 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. **arcelormittal-backoffice.com**: Transferred
2. **arcelormittal-service.com**: Transferred

PANELLISTS

Name	**Gregor Kleinknecht LLM MCIArb**

DATE OF PANEL DECISION 2024-07-25

Publish the Decision