Decision for dispute CAC-UDRP-106737

Case number	CAC-UDRP-106737
Time of filing	2024-07-23 09:05:45
Domain names	arcelor-kiswire.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	ARCELORMITTAL

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Name	Guy Phoenix

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 has submitted evidence, which the Panel accepts, showing that it is the registered owner of the IR trademark “ARCELOR” (registration n° 778212) dated February 25, 2002.

The Complainant is also the owner of the domain name <arcelor.com>, which bears the sign “ARCELOR“ and has been registered since August 29, 2001.

FACTUAL BACKGROUND

The Complainant ARCELORMITTAL is specialized in producing steel worldwide and is the market leader company in steel for use in automotive, construction, household appliances and packaging with 58.1 million tonnes crude steel made in 2023.

The Complainant is the owner of the international trademark n° 778212 “ARCELOR” and domain name <arcelor.com>.

The disputed domain name <arcelor-kiswire.com> was registered on July 11, 2024 and resolves to an inactive page.

PARTIES CONTENTIONS

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COMPLAINANT:

THE DISPUTED DOMAIN NAME IS CONFUSINGLY SIMILAR

The Complainant states that the disputed domain name is confusingly similar to the Complainant's trademark "ARCELOR". It only has an addition of the term "KISWIRE", which does not alter the overall impression and does not prevent likelihood of confusion, because the disputed domain name fully includes the Complainant's trademark.

The Complainant also states that the top level ".com" does not change the overall impression and does not prevent likelihood of confusion.

Consequently, the Complainant asserts that the disputed domain name is confusingly similar to the Complainant's trademark.

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

The Complainant states that the Respondent has no rights or legitimate interests in the disputed domain name since the Respondent is not known as the disputed domain name and not identified in the WHOIS database.

The Complainant also states that the Respondent is neither related to the Complainant in any way nor has any business with the Complainant. There is not any license nor authorization granted to the Respondent to use the Complainant's trademark "ARCELOR", or to apply for registration of the disputed domain name by the Complainant.

Since the disputed domain name resolves to an inactive page, the Complainant states that the Respondent did not use the disputed domain name since its registration, and it confirms that the Respondent has no demonstrable plan to use the disputed domain name. It shows lack of legitimate interests on the disputed domain name.

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

The Complainant indicates that the disputed domain name is confusingly similar to the Complainant's distinctive trademark ARCELOR and the Complainant's trademark ARCELOR is widely known.

- WIPO Case No. DME2018-0005, Arcelormittal (SA) v. floyd martins ("The trademark ARCELOR is well-known and past UDRP decisions confirmed such circumstance (see, for instance, Arcelormittal v. PrivacyProtect.org / Mr. Singh (tajgroup@avipl.com), Taj Pharmaceuticals Ltd., Taj Group of Companies, WIPO Case No. D2010-0899). A quick search on Google for ARCELOR would have revealed to the Respondent that all the results retrieved are strictly related to the Complainant and its trademark.")
- CAC Case No. 100756, ARCELORMITTAL S.A. v. Arcelor Staffing Solution ("The statement of the Respondent that he did not have any idea that ARCELOR is a registered trademark cannot be accepted given the fact that ARCELOR is a very well-known trade mark […]").

The Complainant also states that, given the distinctiveness of the Complainant's trademark and its reputation, it is reasonable to infer that the Respondent registered the domain name with full knowledge of the Complainant's trademark.

Besides, the Complainant has asserted that the addition of the term "KISWIRE" to the trademark "ARCELOR" cannot be coincidental, as it refers to a hearing for representatives of Kiswire Group & ArcelorMittal that took place a few weeks prior to the registration of the disputed domain name.

Since the disputed domain name resolves to an inactive page, the Complainant states that the Respondent has not demonstrated any activity in respect of the disputed domain name, and it is not possible to ascertain any reasonable actual or planned active use of the domain name by the Respondent that would not be illegitimate, such as passing off, infringement of consumer protection or trademark law. Besides, the Complainant also states that incorporating a well-known trademark into a domain name may be evidence of bad faith registration and use.

Lastly, the Complainant claims that MX servers are configured suggesting that the disputed domain name may be actively used for e-mail purposes, which cannot be in good faith.

Accordingly, the Complainant alleges that the disputed domain name was registered and is being used in bad faith.

RESPONDENT:

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

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

In this context, the Panel also notes that the burden of proof is on the Complainant to make out its case and past UDRP panels have consistently said that a Complainant must show that all three elements of the Policy have been made out before any order can be made to transfer a domain name.

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

- the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;

- the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

- the disputed domain name has been registered and is being used in bad faith.

The Panel will therefore deal with each of these requirements in turn.

1. IDENTICAL OR CONFUSINGLY SIMILAR

The Policy simply requires the Complainant to demonstrate that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The Panel is satisfied that the Complainant is the owner of registration of “ARCELOR” trademark.

The Panel finds that the disputed domain name is confusingly similar to the Complainant’s “ARCELOR” trademark and the addition of the term “KISWIRE” is not sufficient to vanish the similarity.

The Panel is aware that another company's trademark, "KISWIRE", also is contained in the disputed domain name and that company is not a party to this proceeding. However, the Panel finds the Respondent's domain name, <arcelor-kiswire.com> is confusingly similar to the Complainant's “ARCELOR” trademark.

Prior panels have reached similar conclusions where two unrelated trademarks were combined to form a domain name.
See, e.g., Chevron Corporation v. Young Wook, WIPO Case No. D2001-1142, (finding the domain name <chevron-texaco.com> confusingly similar to the trademark “Chevron”)

Moreover, the addition of the gTLD “.COM” is not enough to abolish the similarity.

The Panel is of the opinion that the Internet users will easily fall into false impression that the disputed domain name is an official domain name of the Complainant. The Panel recognizes the Complainant's rights and concludes that the disputed domain name is confusingly similar with the Complainant's trademark. Therefore, the Panel concludes that the requirements of paragraph 4(a)(i) of the Policy is provided.

2. NO RIGHTS OR LEGITIMATE INTERESTS

Under paragraph 4(a)(ii) of the Policy, the complainant has the burden of establishing that the respondent has no rights or legitimate interests in respect of the domain name.

It is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

(i) before any notice to the respondent of the dispute, the use or making demonstrable preparations to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) the respondent of the dispute (as an individual, business, or other organization) has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

(iii) the respondent of the dispute is making a legitimate non-commercial or fair use of the domain name, without an intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Thus, if the respondent proves any of these elements or indeed anything else that shows that it has a right or legitimate interest in the disputed domain name, the complainant will have failed to discharge its burden of proof and the complaint will fail. The burden is on the complainant to demonstrate a prima facie case that the respondent does not have rights or legitimate interests in the disputed domain name. Once the complainant has made out a prima facie case, then the respondent may, inter alia, by showing one of the above circumstances, demonstrate rights or legitimate interests in the disputed domain name.

The Complainant contends that the Respondent has nothing to do with the Complainant or not related in any way and given no authorization for any use of the trademark “ARCELOR”. Moreover, the disputed domain name has no relation with the Respondent and the Respondent is not commonly known as the disputed domain name.

In the absence of a response, the Panel accepts the Complainant’s allegations as true that the Respondent has no authorization to use the Complainant’s trademark in the disputed domain name.

Hence, as the Complainant has made out its prima facie case, and as the Respondent has not demonstrated any rights or legitimate interests as illustrated under paragraph 4(c) of the Policy, nor has the Panel found any other basis for finding any rights or legitimate interests of the Respondent in the disputed domain name, the Panel concludes that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

3. BAD FAITH

The Panel concludes that the Complainant's “ARCELOR” trademark is of distinctive character and is well-known. Therefore, the Panel is of the opinion that due to the earlier rights of the Complainant in well-known “ARCELOR” trademark, the Respondent, was aware of the Complainant and its trademark at the time of registration of the disputed domain name (see e.g., Ebay Inc. v. Wangming, WIPO Case No. D2006-1107). Referring to Dansko, LLC v. Wenhong Chen and <danskooutletonline.com>, WIPO Case No. D2012-0583, the Panel believes that the awareness of the Complainant’s trademark at the time of the registration of the disputed domain name is to be considered an inference of bad faith registration.

Moreover, the disputed domain name is currently inactive. Besides, although there is no present use of the disputed domain name, the fact that there is MX record connected to the disputed domain name suggests that the Respondent will not be able to make any good faith use of the disputed domain name as part of an e-mail address.

Therefore, in light of the above-mentioned circumstances in the present case, the Panel finds that the disputed domain name has been registered in bad faith and that the Complainant has established the third element under 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. **arcelor-kiswire.com**: Transferred

PANELLISTS

Name	**Mrs Selma Ünlü**

DATE OF PANEL DECISION 2024-09-03

Publish the Decision