Decision for dispute CAC-UDRP-106827

Case number	CAC-UDRP-106827
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Domain names	arcelormittallcom.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	ARCELORMITTAL

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Organization	ArcelorMittal Construction

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

International Trademark No. 947668 ARCELORMITTAL registered from 3 August 2007 for various goods and services in classes 6, 7, 9, 12, 19, 21, 39, 40, 41 and 42 and designating numerous jurisdictions.

FACTUAL BACKGROUND

The Complainant is the largest steel producing company in the world. It creates steel products for use in the automotive industry, constructions industry, household appliances and packaging. In 2023 it produced 58.1 million tons of crude steel.

The Complainant is the owner of the above-mentioned International Trademark No. 947668 ARCELORMITTAL, which designates numerous jurisdictions.

The Complainant is also the owner of numerous domain names containing the words ARCELOR MITTAL. Including arcelormittal.com, which it has held since 27 January 2006.

The disputed domain name was registered on 27 August 2024. It does not resolve to an active website. Rather it resolves to a page stating the website is under construction. MX services have been configured. The registrant's name appears ARCELORMITTAL CONSTRUCTION, which is a subsidiary of the Complainant. However this subsidiary does not control the disputed domain name.

Hence the Complainant asserts its subsidiary's name is being used without its consent to increase the likelihood of confusion with the Complainant.

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

Paragraph (4)(a) of the Policy lists three elements that the Complainant must prove to merit a finding that the disputed domain name registered by the Respondent be transferred to the Complainant:

1) the disputed domain name is identical or confusingly similar to a trademark or service mark ("mark") in which the Complainant has rights; and

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

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

The Panel is satisfied the Complainant has satisfied all three elements for the principal reasons set out below.

RIGHTS IN AN IDENTICAL OR CONFUSINGLY SIMILAR TRADEMARK

As mentioned above the Complainant asserts it has an international trademark registration consisting of the words ARCELORMITTAL. Further this registration designates a number of jurisdictions and it predate the registration date of the disputed domain name by over a decade.

To satisfy paragraph 4(a)(i) of the Policy it is enough that the panel is satisfied that the Complainant has registered rights in a trademark that predates the registration of the disputed domain name in a single jurisdiction (even if that single jurisdiction is not one in which the Respondent resides or operates) (Koninklijke KPN N.V. v. Telepathy, Inc D2001-0217 (WIPO May 7, 2001); see also WIPO Case Nos. D2012-0141 and D2011-1436). The Complainant has clearly satisfied such in relation to the trademark ARCELORMITTAL.

The next question is whether the disputed domain name is confusingly similar to the ARCELORMITTAL trademark.

The Panel disregards the gTLD suffix ".com" for the purpose of this comparison. However the Panel further notes that if such a suffix were to add anything it would only make the disputed domain name more similar to the Complainant's well used <arcelormittal.com> domain name, which has the same suffix.

Turning to the remaining elements of the disputed domain name, aside from completely reproducing ARCELORMITTAL, the disputed domain name merely adds a second "l" to the end of the MITTAL element and follows this letter with a further COM element. The end result, <ARCELORMITTALLCOM.COM>, appears like a subtle typographically erred for of <ARCELORMITTAL.COM>. The likelihood of confusion of the former with the latter is heightened by the fact that the repetitious LCOM element in the disputed domain name appears inconspicuously in the center of the elements making up the disputed domain name. Internet users perusing the disputed domain name quickly are likely to mistakenly see it as the Complainant's domain name, being its well-known trademark followed by the common gTLD .com.

The disputed domain name is confusingly similar to the ARCELORMITTAL trademark.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant is required to make out a prima facie case that the Respondent lacks rights or legitimate interests (Croatia Airlines d. d. v. Modern Empire Internet Ltd. WIPO Case No. D2003-0455). Once such prima facie case is made, the Respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a) (ii) of the UDRP.

As mentioned above, the Complainant asserts, and the Respondent does not deny, that the disputed domain was registered in the name of the Complainant's subsidiary without its consent. In such circumstances the Complainant has made out its prima facie case the Respondent lacks rights or legitimate interests in the disputed domain name.

The Respondent has no rights or interests in the disputed domain name.

BAD FAITH

The disputed domain name does not resolve to an active website. It resolves to a webpage the merely indicates a website is under construction.

Failing to redirect a domain name to an active website or merely directing the domain name to a basic parking page that contains links to other websites can be legitimate conduct. It is commonly referred to as 'passive holding'. Whilst it is true that the passive holding of a domain name may, in appropriate circumstances, be indicative of bad faith. It will only be so indicative when all the circumstances of the Respondent's behaviour indicate he or she is acting in bad faith (Telstra Corporation Ltd v. Nuclear Marshmallows D2000-0003 (WIPO 18 February 2000). There is no law or rule that a domain name cannot be parked or that it must be used to redirect to an active website within a specific period of time.

In the present proceeding the fact that the disputed domain name does not redirect to an active website adds nothing to an allegation of bad faith. If anything, it simply shows the Complainant has not yet decided to direct the disputed domain name to any active website. This passive action is of no concern to the Panel whatsoever. The disputed domain name was only registered approximately one month before the ADR proceeding was commenced by the Complainant.

In the Panel's view one ought not be harshly judging a registrant's mere passive holding of a domain name over such a short period of time. It is prudent to consider what a reasonably minded bona fide registrant may intend by the same behaviour. And it is entirely possible that such a hypothetical person may first register a domain name they wish to use and then take weeks or even months to develop a web page or web site for which they wish to use it. Potentially legitimate foreseeable possibilities must be considered when determining if an allegation of passive holding amounts to, or contributes to, a finding of bad faith.

However, what is of great concern to the Panel in this present proceeding is that ARCELORMITTAL is a well-known trade mark.

It is entirely unforeseeable that a reasonable person could register the strikingly similar disputed domain name without knowledge of the Complainant's rights.

The Panel finds that the Respondent had such prior knowledge at the time of registering the disputed domain name and therefore its only purpose in registering the disputed domain name was to opportunistically profit from confusing similarity. The Respondent clearly targeted the Complainant's well-known trademark for this purpose.

Having made this finding, it is of further great concern that the Respondent has configured MX servers. The only foreseeable reason for doing so would be to perpetuate such confusion through email.

Therefore, in consideration of all the circumstances the disputed domain name has been registered and is being used in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

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1. **arcelormittallcom.com**: Transferred

PANELLISTS

Name	**Andrew Sykes**

DATE OF PANEL DECISION 2024-09-30

Publish the Decision