

ADMINISTRATIVE PANEL DECISION

Arcelormittal (SA) v. restrepo luz
Case No. D2022-3677

1. The Parties

The Complainant is Arcelormittal (SA), Luxembourg, represented by Nameshield, France.

The Respondent is restrepo luz, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <arcelornetworks.net> is registered with Gname.com Pte. Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 3, 2022. On October 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 8, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on October 10, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on October 10, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on October 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 31, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 1, 2022.

The Center appointed Torsten Bettinger as the sole panelist in this matter on November 7, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and

Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is headquartered in Luxembourg and is a large global steel producer. It is the market leader in steel for use in the automotive, construction, household appliances and packaging industries with 69.1 million tons of crude steel made in 2021.

The Complainant provided evidence of the registrations of the International trademark No. 947686 ARCELORMITTAL registered for goods and services in International Classes 6, 7, 9, 12, 19, 21, 39, 40, 41, and 42.

Furthermore, the Complainant has a large Internet presence and shares information about its products, services, and news on its website at “www.arcelormittal.com”, which was registered on January 27, 2006.

The disputed domain name was registered by the Respondent on September 29, 2022. The disputed domain name is inactive.

5. Parties' Contentions

A. Complainant

The Complainant claims that the disputed domain name is confusingly similar to its trademark ARCELOR as:

- the disputed domain name contains the Complainant's ARCELOR trademark in its entirety;
- the addition of the term “networks” does not change the overall impression of the designation as being connected to the Complainant's trademark;
- the addition of the generic Top Level-Domain (“gTLD”) “.net” is disregarded under the first element confusing similarity test as it is viewed as a standard registration requirement.

With regard to the Respondent having no rights or legitimate interests in the disputed domain name, the Complainant submitted that:

- the Respondent is not known as the disputed domain name, but as “bill chill”;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name <arcelornetworks.net> and is not related in any way with 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 ARCELORMITTAL, or apply for registration of the disputed domain name by the Complainant;
- the Respondent did not make any use of disputed domain name since its registration, and has no demonstrable plan to use the disputed domain name.

Finally, with regard to the disputed domain name having been registered and being used in bad faith, the Complainant argues that:

- the Complainant's trademark ARCELOR is widely known;

- given the distinctiveness of the Complainant's trademark and reputation, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademark;
- the Respondent has not demonstrated any activity in respect of the disputed domain name, and 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, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law;
- the incorporation of a famous mark into a domain name, coupled with an inactive website, may be evidence of bad faith registration and use.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy states that the Complainant must prove each of the three following elements:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has demonstrated that it owns an International trademark No. 947686 ARCELORMITTAL registered for goods and services in International Classes 6, 7, 9, 12, 19, 21, 39, 40, 41, and 42. The Complainant contends that the disputed domain name is confusingly similar to its trademark registration ARCELOR, but did not provide evidence of the registration of the trademark ARCELOR.

Pursuant to paragraph 10(a) of the Rules, the Panel considers itself competent to independently access trademark registration databases (e.g. WIPO Global Brand Database) pursuant to 4.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") in order to investigate whether the Complainant owns trademark rights in the word ARCELOR.

The Panel research showed that the Complainant is also the owner of International Trademark Registration Number 778212, ARCELOR, registered by the Complainant on February 25, 2002.

As regards the first element confusing similarity test it is well established that the test of identity or confusing similarity under the Policy is confined to a comparison of the disputed domain name and the trademark alone, independent of the products for which the trademark is used or other marketing and use factors usually considered in trademark infringement cases (see sections 1.1.2 and 1.7 of the [WIPO Overview 3.0](#)).

In this case, the disputed domain name contains the disputed domain name in its entirety and only differs from the Complainant's trademark ARCELOR by the addition of the term "networks".

The Panel notes that it has long been established under the UDRP case law that the addition of a descriptive wording to a trademark in a domain name does not prevent a finding of confusing similarity under the first element of the UDRP (see section 1.8 of [WIPO Overview 3.0](#)). The Panel therefore agrees with the

Complainant's assertion that the addition of the term "networks" does not prevent a finding of confusing similarity the disputed domain name from the Complainant's trademark.

Furthermore, it is well accepted under the UDRP case law that the specific gTLD designation such as ".com", ".net", ".org" is not to be taken into account when assessing the issue of identity and confusing similarity, except in certain cases where the applicable Top-Level suffix may itself form part of the relevant trademark (see [WIPO Overview 3.0](#) section 1.11).

For the foregoing reasons the Panel concludes that the disputed domain name is confusingly similar to the Complainant's ARCELOR trademark in which the Complainant has exclusive rights.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy a respondent may establish its rights or legitimate interests in the domain name, among other circumstances, by showing any of the following elements:

"(i) before any notice to you [the Respondent] of the dispute, your use of, or 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) you [the Respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you [the Respondent] are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

The Complainant stated that the Respondent is not related in any way with the Complainant and that no license or authorization has been granted to the Respondent to make use of the Complainant's trademark ARCELOR or apply for the registration of the disputed domain name.

These assertions and evidence are sufficient to establish a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

Where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent chose not to contest the Complainant's allegations and has failed to come forward with any evidence to refute the Complainant's *prima facie* showing that the Respondent lacks rights or legitimate interests. The Panel therefore accepts these allegations as undisputed facts.

From the record in this case, the Respondent has not used the disputed domain name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use.

On this basis and in light of the fact that the disputed domain name except for the addition of the descriptive designation "networks" contains the Complainant's trademark in its entirety the Panel concludes that the Respondent lacks rights and legitimate interests in the disputed domain name and that, accordingly, the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides four, non-exclusive, circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the Respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting or otherwise transferring the disputed domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) the Respondent has registered the disputed domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or
- (iii) the Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location.

The Complainant holds trademark registrations for the ARCELOR and ARCELORMITTAL in various countries that predate the registration of the disputed domain name. The ARCELOR and ARCELORMITTAL marks are distinctive and clearly associated with the Complainant and its products through widespread and intensive use.

It is therefore likely that the Respondent registered the disputed domain name with knowledge of the Complainant's rights in the ARCELOR mark in bad faith. Indeed, prior UDRP panels have found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See section 3.1.4 of the [WIPO Overview 3.0](#).

The fact that the disputed domain name has not yet been actively used to show any substantive content does not prevent a finding of bad faith use.

UDRP Panels have consistently found that, in certain circumstances, passive holding does not prevent a finding of bad faith under the Policy. (See, e.g., *Teachers Insurance and Annuity Association of America v. Wreaks Communications Group*, WIPO Case No. [D2006-0483](#); *Telstra Corporation Limited. v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); see also [WIPO Overview 3.0](#), section 3.3.)

While UDRP panels will look at the totality of the circumstances in each case, 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. (See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); see also [WIPO Overview 3.0](#), section 3.3.)

The circumstances of the present case are sufficiently similar to those present in *Telstra* to establish bad faith passive holding of the disputed domain name.

Based on the record in this proceeding, the Panel is satisfied that the Complainant's ARCELOR and ARCELORMITTAL marks are distinctive and widely known.

Given that the disputed domain name consists of the Complainant's ARCELOR mark in combination with the descriptive term "networks", the disputed domain name is also not susceptible to be used in a good faith manner.

Furthermore, the Respondent has not replied to the Complaint nor provided any evidence of actual or contemplated good faith use of the disputed domain name.

The Panel therefore finds that the circumstances, as described above, show that the Respondent's registration and passive holding of the disputed domain name equals a bad faith registration and use of the disputed domain name. The Complainant has therefore also established the third element of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <arcelornetworks.net> be transferred to the Complainant.

/Torsten Bettinger/

Torsten Bettinger

Sole Panelist

Date: November 21, 2022