

ADMINISTRATIVE PANEL DECISION

Arcelormittal v. Eric Philipson
Case No. D2024-0638

1. The Parties

The Complainant is Arcelormittal, Luxembourg, represented by Nameshield, France.

The Respondent is Eric Philipson, Germany.

2. The Domain Name and Registrar

The disputed domain name <projects-arcelormittal.com> is registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 12, 2024. On February 12, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 14, 2024, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 14, 2024, 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 February 14, 2024.

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 February 20, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 11, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 13, 2024.

The Center appointed Angela Fox as the sole panelist in this matter on March 21, 2024. 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 based in Luxembourg and is one of the largest steel producing companies in the world and is one of the market leaders in steel for use in automotive, construction, household appliances and packaging with 59 million tons of crude steel made in 2022. It holds sizeable captive supplies of raw materials and operates extensive distribution networks. It has carried out its business under the name and trademark ARCELORMITTAL since 2006.

The Complainant owns International Registration no. 947686 for ARCELORMITTAL which was registered on August 3, 2007, based on a Benelux registration filed on May 25, 2007, and designating a wide range of countries, including Australia, the European Union, Norway, Switzerland and the United States of America. The registration covers multiple classes, including metals and alloys in Class 6. Details of the registration were annexed to the Complaint.

The disputed domain name was registered on February 8, 2024. It does not link to any active site, although the Complainant has shown evidence that MX servers for the disputed domain name have been configured to enable it to be used for email purposes.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is confusingly similar to its ARCELORMITTAL trademark. The disputed domain name incorporates the ARCELORMITTAL trademark and merely precedes it by the generic word "projects" and a hyphen.

The Complainant also submits that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant has not authorized the Respondent to use the Complainant's trademark and there is no evidence that the Respondent has ever been commonly known by a name corresponding to the disputed domain name.

Finally, the Complainant argues that the disputed domain name was registered and has been used in bad faith. The disputed domain name is confusingly similar to the Complainant's trademark and there is no conceivable use the Respondent could make of it which would not be linked to the Complainant. The Complainant asserts that its trademark is well-known and that the Respondent must have had the Complainant in mind when registering the disputed domain name. Although the Respondent is not making any use of the disputed domain name, the Complainant submits that its passive holding of it, taken into account along with other factors including the Respondent's configuration of MX servers to enable the disputed domain name to be used for emails, amounts to registration and use in bad faith.

The Complainant asks that the disputed domain name be transferred to it.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, a complainant can only succeed in an administrative proceeding under the Policy if the panel finds that:

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

All three elements must be present before a complainant can succeed in an administrative proceeding under the Policy.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of the trademark ARCELORMITTAL for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms, here, the word "projects" and a hyphen, may bear on assessment of the second and third elements, the Panel finds the addition of such elements does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, 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 domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the disputed domain name incorporates the whole of the Complainant's trademark. It also incorporates the generic word "projects", which is relevant to the business of companies like the Complainant, whose products may be used in large building or construction projects. The Complainant is, moreover, one of the largest steel producing companies in the world and other UDRP panelists have found that its ARCELORMITTAL trademark is well-known. Against this backdrop, it is implausible that the Respondent would not have been aware of, and targeting, the Complainant when it registered the disputed domain name.

Panels have found that the non-use of a domain name does not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists 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, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3.

Having reviewed the available record, the Panel notes that the Complainant's ARCELORMITTAL trademark is inherently distinctive and that prior panels have found it to have achieved a wide reputation. The Respondent has failed to respond to this Complaint and has therefore not sought to deny that it was aware of the Complainant's trademark when it registered the disputed domain name, and has not put forward any evidence of actual or contemplated good-faith use. The Respondent also used a privacy service to conceal its identity.

The Panel also takes into account the Respondent's configuration of MX servers to enable the disputed domain name to be used for emails, and accepts the Complainant's assertion that there is no evident good faith manner in which a domain name that is inherently confusingly similar to the Complainant's trademark could be used as an email address. The Respondent has made no effort to explain its conduct in this regard.

Taking all of these factors into account, the Panel finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

The Panel finds that the Complainant has 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 <projects-arcelormittal.com> be transferred to the Complainant.

/Angela Fox/

Angela Fox

Sole Panelist

Date: April 8, 2024