

## **ADMINISTRATIVE PANEL DECISION**

Arcelormittal (SA) v. Whois Privacy Protection Foundation / Bill Chill  
Case No. DCO2022-0050

### **1. The Parties**

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

The Respondent is Whois Privacy Protection Foundation, Netherlands / Bill Chill, Romania.

### **2. The Domain Name and Registrar**

The disputed domain name <arcelormittal-poland.co> is registered with Hosting Concepts B.V. d/b/a Openprovider (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 21, 2022. On June 21, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 23, 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 June 23, 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 June 23, 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 sent notification to the Respondent of the Complaint, and the proceedings commenced on June 27, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 17, 2022. The Respondent did not submit any response. Accordingly, the Center sent notification of the Respondent’s default on July 18, 2022.

The Center appointed Petra Pecar as the sole panelist in this matter on July 27, 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 a steel producing company, which produces steel for use in the automotive, construction, household appliances and packaging industries.

The Complainant is the owner of the International trademark registration no. 947686 for ARCELORMITTAL, registered on August 3, 2007 for goods and services in classes 6, 7, 9, 12, 19, 21, 39, 40, 41 and 42. The Complainant also owns a domain name portfolio reflecting its ARCELORMITTAL trademark, including the domain name <arcelomittal.com>, registered since January 27, 2006.

The disputed domain name was registered on June 13, 2022, and resolves to a parking page, and MX records are configured.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that the disputed domain name <arcelormittal-poland.co> is confusingly similar to its trademark ARCELORMITTAL and includes the trademark in its entirety. The Complainant contends that the addition of the geographical term "Poland" and the addition of the ccTLD ".co" is not sufficient to escape the finding that the disputed domain name is confusingly similar to the Complainant's trademark. The Complainant also stresses that it does not change the overall impression of the disputed domain name as being connected to the Complainant's trademark and it does not prevent the likelihood of confusion between the disputed domain name and the Complainant and its trademark.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. According to the Complainant, the Respondent is not sponsored by or affiliated with the Complainant in any way. In addition, the Complainant states that it has not licensed, authorized or permitted the Respondent to use its trademark or to register any domain name incorporating its trademark. The Complainant stresses that the Respondent is not commonly known by the disputed domain name.

The Complainant contends that the disputed domain name resolves to a parking page. Further, the Complainant contends that the Respondent did not make any use of the disputed domain name since its registration, and that this confirms that the Respondent has no demonstrable plan to use the disputed domain name, which demonstrates a lack of legitimate interests in respect of the disputed domain name.

The Complainant stresses that its ARCELORMITTAL trademark is widely known. Further, the Complainant contends that past UDRP panels have confirmed the notoriety of the trademark ARCELORMITTAL:

##### **B. Respondent**

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

#### **6. Discussion and Findings**

Even if the Respondent did not file a Response to the Complainant's contentions, the Panel shall consider the issues present in the case based on the statements and documents submitted by the Complainant. "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance

with the Policy, these Rules and any rules and principles of law that it deems applicable”, as indicated in paragraph 15(a) of the Rules.

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three 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 by the Respondent in bad faith.

#### **A. Identical or Confusingly Similar**

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must, firstly, establish rights in a trademark or service mark and, secondly, establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

A trademark registration provides a clear indication that the rights in the trademark belong to the Complainant (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, - [“WIPO Overview 3.0”](#), section 1.2.1). From the evidence provided by the Complainant, the Panel finds that the Complainant is the owner of the International trademark registration for ARCELORMITTAL, and therefore, the Complainant has demonstrated that it has rights in the trademark ARCELORMITTAL.

UDRP panels have found that a disputed domain name is confusingly similar to a complainant’s trademark where the disputed domain name incorporates the complainant’s trademark in its entirety.

Furthermore, it is the view of this Panel that the addition of “Poland”, which is a geographical term, and the ccTLD “.co” of the disputed domain name does not affect the finding of confusing similarity between the Complainant’s trademark and the disputed domain name. Such additional terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) do not prevent a finding of confusing similarity between the disputed domain name and the Complainant’s trademarks, in accordance with section 1.8 of the [WIPO Overview 3.0](#). Finally, it is well accepted practice by UDRP panels that a TLD (such as ccTLD “.co” in this case), is typically ignored when assessing whether a domain name is identical or confusingly similar to a trademark (see section 1.11.1 of the [WIPO Overview 3.0](#)). Accordingly, the Panel determines that the disputed domain name is confusingly similar to the Complainant’s trademarks.

In accordance with the above, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy in establishing its trademark rights and showing that the disputed domain name is confusingly similar to its ARCELORMITTAL trademark.

#### **B. Rights or Legitimate Interests**

Under this second element of the Policy, a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name. Once such *prima facie* case is made, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, the complainant is generally deemed to have satisfied the second element, as set out in paragraph 4(a)(ii) of the Policy (see also [WIPO Overview 3.0](#), section 2.1).

Moreover, the Policy provides guidance to respondents on how to demonstrate rights or legitimate interests in the domain name. In particular, paragraph 4(c) of the Policy gives examples that might show rights or legitimate interests in a domain name, including: (i) use of the domain name “in connection with a *bona fide* offering of goods or services”; or (ii) demonstration that the respondent has been “commonly known by the

domain name”; or (iii) “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 Panel notes that the Respondent has not filed a response and thus did not deny the Complainant’s assessment, nor brought any information or evidence demonstrating any rights or legitimate interests. The Respondent is not affiliated with the Complainant in any way, and the Complainant never authorized the Respondent to use its trademark as part of the disputed domain name.

The Complainant further contends that the Respondent is not commonly known under the disputed domain name, does not own any right in the ARCELORMITTAL trademark, and does not make any *bona fide* use, either commercial or noncommercial, of the same.

The Complainant contends that the Respondent has been using the disputed domain name for fraudulent purposes. In particular, the Complainant contends that the disputed domain name resolves to a parking page and points out that the active MX records are present, which means that the disputed domain name can be used for sending and receiving emails (including messages containing spam or/and phishing content), which is also an indication of lack of legitimate interests, having in mind that use (or potential) use of the disputed domain name for illegal activities (such as phishing) can never confer rights or legitimate interests on a respondent (see [WIPO Overview 3.0](#), section 2.13.1).

Furthermore, the Respondent has already been involved in several UDRP cases initiated by the Complainant, such as *Arcelormittal (SA) v. Whois Privacy Protection Foundation / bill chill*, WIPO Case No. [DCO2022-0038](#) and *Arcelormittal (SA) v. Whois Privacy Protection Foundation / bill chill*, WIPO Case No. [DCO2022-0035](#). The Respondent clearly appears to be engaged in a pattern of registering domain names corresponding to the Complainant’s trademarks, which is, in accordance with previous UDRP practice, a clear indicator for lack of legitimate interest (see [WIPO Overview 3.0](#), section 2.5.2).

The Panel therefore finds that the Complainant has made a *prima facie* demonstration of the Respondent’s lack of rights or legitimate interests in respect of the disputed domain name, which has not been rebutted by the Respondent, and that the Complainant has accordingly established the second element of the Policy in accordance with paragraph 4(a)(ii).

### **C. Registered and Used in Bad Faith**

According to paragraph 4(a)(iii) of the Policy, the Complainant must establish that the disputed domain name has been registered and is being used in bad faith.

The Complainant has substantiated that its ARCELORMITTAL trademark was registered in 2007, 15 years before the registration of the disputed domain name and was also used long before the registration of the disputed domain name. As established in respect to the first UDRP element, the disputed domain name is confusingly similar to the Complainant’s trademark since it consists of the Complainant’s trademark, a hyphen and the geographical term “Poland”, which means that it is rather unlikely for the Respondent not to be aware of the Complainant and its rights at the time of registration of the disputed domain name.

It should also be noted that the Complainant’s ARCELORMITTAL trademark shows a high level of distinctiveness, as it reflects the specific company name which was formed in 2006 after the takeover and merger of Arcelor by Mittal Steel. In that sense, it seems implausible that the Respondent has registered the disputed domain name corresponding to the Complainant’s distinctive trademark out of pure coincidence. Furthermore, the Complainant’s ARCELORMITTAL trademark enjoys a certain degree of reputation through the word as determined and confirmed by previous UDRP panels.

Moreover, as noted above, the Panel has concluded it is very unlikely that the Respondent has chosen the disputed domain name without the intention to target the Complainant and its trademark.

As indicated above, MX records are configured on the disputed domain name. The existence of MX records (*i.e.* mail exchanger record that governs sending and receipt of emails within certain domain name) *per se* may not indicate the use of the disputed domain name in bad faith. However, in cases like this, where the disputed domain name clearly corresponds with the distinctive trademark of the Complainant, configuration of such records can be quite relevant. In particular, MX records in such cases can indicate that the disputed domain name is or could be used for fraudulent email communications, which creates a grave risk that the Respondent may be using the disputed domain name for misrepresentations and/or phishing and spamming activities. The mere fact that such e-mails would consist of the extension that prominently includes the Complainant's ARCELORMITTAL trademark, puts in question any good faith use for which such emails could be used. Given these circumstances and the fact that the Respondent failed to submit a response or to provide any evidence of actual possible good-faith use, the Panel concludes that the Respondent's use of the Complainant's trademark is in bad faith.

The Panel notes that the disputed domain name is not connected to any active website.

In that sense, the Panel has made an assessment as to whether the lack of actual use of the disputed domain name can lead to a finding of bad faith against the Respondent. The doctrine of so-called "passive holding" where a disputed domain name resolves to a blank, "coming soon", or similar page has been considered by numerous panels previously. In accordance with section 3.3 of the [WIPO Overview 3.0](#), the relevant factors that should be taken into account when assessing the existence of bad faith in the passive holding of a domain name are the following: (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 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. It should also be borne in mind that it is not required that all the above-listed factors be present in order to establish bad faith use of the disputed domain name.

In this particular case, the Panel is of the opinion that all the factors described in section 3.3 of the [WIPO Overview 3.0](#) are present to some extent. In particular, the Complainant's ARCELORMITTAL trademark should be observed as sufficiently distinctive and as a trademark that enjoys a certain degree of reputation; the Respondent has failed to provide any response to the Complaint and has therefore failed to provide any justification for the registration and use of the disputed domain name; the Respondent has registered the disputed domain name through a privacy shield, thereby concealing his identity; finally, it seems rather unlikely that even if the disputed domain name was put to actual use, such use would be in good faith. Based on the foregoing reasons, the Panel finds that the passive holding of the disputed domain name in the present case should be observed as use in bad faith.

Further, paragraph 4(b)(ii) of the Policy contemplates the situation where a respondent has registered a disputed domain name in order to prevent the owner of the trademark from reflecting the trademark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct.

Section 3.1.2 of the [WIPO Overview 3.0](#) explains that a pattern of conduct may include a scenario where the respondent, on separate occasions, has registered trademark-abusive domain names, even where directed at the same brand owner. Given the fact that the Respondent had previous UDRP disputes regarding domain names, which included the Complainant's trademark, it demonstrates that the Respondent has developed a pattern of conduct, which is also an indication of bad faith.

Consequently, the Panel finds that the disputed domain name has been registered and is being used in bad faith pursuant to paragraph 4(a)(iii) 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 <arcelormittal-poland.co> be transferred to the Complainant.

*/Petra Pecar/*

**Petra Pecar**

Sole Panelist

Date: August 10, 2022