



DISPUTE RESOLUTION SERVICE

D00012383

Decision of Independent Expert

ArcelorMittal (Societe Anonyme)

and

Shahab Hanif

1. The Parties:

Lead Complainant: ArcelorMittal (Societe Anonyme)
19 Avenue de la Liberte, L-2930
Luxembourg
Luxembourg

Complainant: Mittal Steel Technologies Limited, now incorporated as part of LNM
Technologies Ltd
IFS Court, 28, Cybercity
Ebene
Mauritius

Complainant: Lakshmi Niwas Mittal c/o ArcelorMittal (Societe Anonym)
Berkeley Square House,
7th Floor, Berkeley Square
London
W1J 6DA
United Kingdom

Respondent: Mr Shahab Hanif
Suite 22 Sparkford House,
Battersea Church Road
London
England
SW11 3NQ
United Kingdom

2. The Domain Names:

mittalbank.co.uk
mittalgold.co.uk (together the "Domain Names")

3. Procedural History:

I confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

25 January 2013 16:11 Dispute received
28 January 2013 11:51 Complaint validated
28 January 2013 11:57 Notification of complaint sent to parties
14 February 2013 01:30 Response reminder sent
19 February 2013 10:02 Response received
19 February 2013 10:02 Notification of response sent to parties
22 February 2013 01:30 Reply reminder sent
25 February 2013 15:13 Reply received
25 February 2013 15:14 Notification of reply sent to parties
25 February 2013 15:14 Mediator appointed
28 February 2013 09:31 Mediation started
05 April 2013 17:16 Mediation failed
05 April 2013 17:17 Close of mediation documents sent
12 April 2013 10:35 Expert decision payment received

4. Factual Background

The Lead Complainant is the owner of a Community trade mark for MITTAL registered as of 16 August 2005 for services related to metal storage and transportation. The Domain Names were registered in March 2012 and display sponsored links. The Respondent has made repeated offers to sell domain names including those not the subject of this Complaint to the Complainants including one to sell all the domains he owned including the Domain Names for £450,000.

5. Parties' Contentions

The Complainants' submissions in the Complaint can be summarised as follows:

ArcelorMittal is the largest steelmaker in the world by turnover and volume and was created through the merger of Arcelor and Mittal Steel in 2006. ArcelorMittal is the successor to the registered MITTAL marks owned by Mittal Steel Technologies Limited. Lakshmi Niwas Mittal ('Mr Mittal') is the Chairman and Chief Executive Officer of ArcelorMittal whose name was used by Mittal Steel and ArcelorMittal as a trade mark. ArcelorMittal is the Lead Complainant to which the Domain Names should be transferred. The Respondent first came to the attention of the Complainants in September 2009 when he wanted to establish Mittal Bank with the backing of ArcelorMittal and Mr Mittal. The Respondent claims to have met Pramod Mittal the brother of Mr Mittal, been

contacted by his PA, spoken with him on the telephone and been encouraged by him to spend time and money putting a venture together. However, neither Pramod Mittal, his PA or anybody else in any way connected with Mr Mittal offered the Respondent any encouragement or permitted him to use the MITTAL name.

In August 2009 the Respondent rented an office in the same building as ArcelorMittal's UK registered office and service company presumably to further the appearance of links between Mittal Bank and Mr Mittal/ArcelorMittal. He subsequently made an uninvited visit to the ArcelorMittal reception and asked for a meeting with Mr Mittal. After several such attempts he was asked by the Complainants' receptionist not to approach their premises on the seventh floor. He was subsequently told by head of security not to attempt to gain unauthorised access to the premises again.

Believing the Respondent to be acting in bad faith the Lead Complainant instructed external lawyers to write to the Respondent and threaten him with legal action if he did not stop this behaviour. At this point the Respondent had also registered mittalbank.com and mittalgold.com. The Respondent agreed to change his company name from Mittal Bank Limited and dispose of these two domain names. Having abandoned Mittal Bank the Respondent now seeks to trade as Mittal Gold without the permission of ArcelorMittal or Mr Mittal.

The Respondent applied to register MITTAL GOLD as a trade mark on 27 August 2011, This application has been opposed by Mittal Steel Technologies Limited and ArcelorMittal on the grounds that the application was in bad faith, that it is contrary to the law of passing off and that it is too similar to the family of marks owned by ArcelorMittal. Mr Mittal has also opposed on grounds of bad faith and passing off.

In December 2011 it came to the attention of the Complainants that the domain names mittalgold.com and mittalbank.com were active. The Lead Complainant wrote to the Respondent directly asking him to desist from using his website, to withdraw his trade mark application and transfer these domain names to the Lead Complainant. Because of the strong reputation of the Complainants' MITTAL marks and because of the Respondent's dealings with the Complainants it is inconceivable that the Respondent was not aware of the Complainants' rights when he acquired the Domain Names and did not do so with a view to either benefitting from the reputation of Mr Mittal or seeking to sell them to Mr Mittal or ArcelorMittal.

The Complainants have rights in the Domain Names because they are identical to or at least highly and confusingly similar to a name or mark in which the Complainants have rights.

The Complainants or their predecessors in title have used the trade name MITTAL since 1976, including in the UK, over 30 years before the Domain Names were registered. The Complainants own 17 trade marks in the UK and EU consisting of or including the MITTAL mark all of which predate the Domain Names. Mr Mittal's steel business was established in Calcutta in 1976 and went on to trade in the UK as a group of listed and unlisted companies synonymous with the name MITTAL. In 2004 they merged to become Mittal Steel Company, the largest steel company in the world by this time. In 2006 it merged with Arcelor becoming ArcelorMittal in 2007. ArcelorMittal has operations in more than 60 countries and an industrial presence in more than 20 countries, spanning four continents. It is the leader in all main steel markets.

During the last 35 years the name MITTAL has become synonymous with the steel business through extensive and continuous use. It is famous in the UK for the supply of quality steel products and major iron ore produce in all major markets. The MITTAL brand has longstanding and widespread repute and MITTAL in any major business context is synonymous with Mr Mittal and his companies. ArcelorMittal has received industry awards. Advertising spend for the last five years has been approximately £5million per annum. Sales turnover was as follows:

As of	Sales Turnover \$US
31 December 2011	93,973,000,000
31 December 2010	78,025,000,000
31 December 2009	65,110,000,000
31 December 2008	124,936,000,000
31 December 2007	105,216,000,000

The Complainants own several domain names incorporating the MITTAL mark including mittalsteel.com and arcelormittal.com.

The Complainants have established a highly recognisable, distinctive and enforceable reputation in the MITTAL mark giving right to protectable unregistered rights. Rights in common law trade marks are sufficient under the Policy.

The Domain Names in the hands of the Respondent constitute abusive domain names. They were registered in March 2012. The Domain Names contain the MITTAL mark. The descriptive elements of the Domain Names 'gold' and 'bank' are descriptive of goods and services. The Domain Names are, therefore, identical or at least highly similar to the Complainant's MITTAL mark.

In addition the Respondent has also registered mittalbank.com, mittalgold.com, mittalsilver.com, mittalplatinum.com, mittalshop.com and mittaldiamonds.com. The websites currently appearing at the Domain Names do not appear to function and the Complainants submit they were never intended to do so. The Domain Names are not intended for and have never been used for genuine bona fide commercial use.

The Complainants have not consented to the Respondent's use of the Domain Names and the Respondent has no legitimate interest in them.

The Respondent is not commonly known by the Domain Names.

The Respondent has sent over 100 e-mails to the Complainants' legal representatives since he was notified of the trade mark opposition in February 2012. The correspondence has included numerous threatening and abusive messages. The Respondent has made at least 20 offers to sell domain names including the MITTAL mark ranging from £500 to £6,000,000, including an offer to sell all the domain names he owned including the Domain Names for £450,000. These sums are disproportionate, unwarranted and bear no resemblance to out of pocket costs paid by Respondent for his registrations and constitute bad faith.

Given the strong reputation of the MITTAL mark and the Respondent's apparent abusive activity the Domain Names were registered in bad faith.

There is no evidence that the Respondent used the Domain Names in connection with a bona fide offering of goods and services. Rather they have been registered to sell to the owner of the trade mark MITTAL for valuable consideration in excess of the Respondent's documented out of pocket costs directly related to the Domain Names.

Consumers will be confused by the threatened use by the Respondent of the Domain Names into believing that the Respondent's intended services are associated with the Complainants.

The Respondent has registered 13 domain names incorporating the well-known gambling brand 888 including 888ibet.co.uk and ibet888.co.uk. 888 Holdings Plc. is a well-known company which incorporates several high profile gambling web sites.

In an e mail of 6 December 2012 the Respondent claims to have previously attempted to sell registered domain names and business development ideas to other high profile businessmen including Roman Abramovich and Mohamed Al-Fayed.

The Respondent's submissions in its Response can be summarised as follows:

Nominet's DRS was not designed to give a trade mark holder exclusive rights for all domains when their trade mark rights are only for a few classes and territories.

Respondent has owned mittalgold.com and mittalbank.com for over three years now. He created, registered and paid for them.

Respondent has incorporated a UK Company Mittal Gold Ltd more than seven months before any domain name dispute and filed UK trade marks in four classes in September 2011 before the DRS dispute.

The Respondent has spent money on a logo for Mittal Gold.

There is a multi-billionaire from India Sunil Mittal CEO of Airtel, India's Vodafone. He is not related to the Complainants.

Respondent had not heard of Mr Mittal until 2006 when his profile was being created in the UK media.

6. Discussions and Findings

General

To succeed in this Complaint the Complainants have to prove to the Expert pursuant to paragraph 2 of the Policy on the balance of probabilities, first, that they have Rights (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Domain Names and, secondly, that the Domain Names, in the hands of the Respondent, are an Abusive Registration (as defined in paragraph 1 of the Policy).

Complainants' Rights

The Lead Complainant is the proprietor of, inter alia, a Community registered trade mark for MITTAL for metal storage. The Domain Names contain the MITTAL mark in its entirety. The addition of the generic terms "gold" and "bank" related to metals and financial services does not serve to distinguish between the Domain Names and the Lead Complainant's registered trade mark MITTAL being added matter descriptive of fields of trade related to the metal gold and financial services and non distinctive. MITTAL, the distinctive part of both Domain Names is directly equivalent to the Lead Complainant's registered trade mark. Accordingly the Expert finds that the Lead Complainant has Rights in respect of a name or mark, which is similar to the Domain Names. In view of the existence of a registered trade mark for MITTAL, the registration of which pre-dates the registration of the Domain Names or any other registrations or use by the Respondent of the Mittal name, it is not necessary for the Expert to consider the issue of unregistered rights.

Abusive Registration

This leaves the second limb. Are the Domain Names, in the hands of the Respondent, Abusive Registrations? Paragraph 1 of the Policy defines "Abusive Registration" as "a domain name which either:

- i. was registered or otherwise acquired in a manner, which at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; OR
- ii. has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant's Rights."

A non-exhaustive list of factors, which may be evidence that the Domain Names are Abusive Registrations is set out in paragraph 3a of the Policy. These include:

i "Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

A. for the purposes of selling, renting or otherwise transferring the domain name to the Complainant or to a competitor of the Complainant for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the domain name;

The Expert is of the opinion that the evidence submitted with the Complaint is indicative of relevant abusive conduct. The Respondent has admitted that he was aware of Mr Mittal in 2006 before the Domain Names were registered. The Domain Names have not yet been used for any web site or business other than to display sponsored links relating to the business of third parties not connected with this dispute. The Panel notes the points made by the Respondent that there are many third parties using the name Mittal. However, the Respondent himself appears to have made no use himself of the Domain Names and has not yet started to transact any business under the Mittal name. Rather, he has instead made a large number of offers to sell domain names containing the MITTAL mark to the Complainants including an offer to sell to them all the domains he owns including the Domain Names for £450,000.

This is very strong evidence that the Respondent has targeted the Complainants in particular in this case and that his motives were to make profit out of the Domain Names rather than to use them himself for any genuine business. It is difficult to see how his

demand of £450,000 can be justified even if it did include, in addition, domain names not the subject of this complaint. The large amount requested when the only allegations of out of pocket costs are £7,000 and domain name registration fees, which are undocumented in any event in the evidence, is out of all proportion to any value of the Domain Names created by the Respondent as the Domain Names have essentially been unused by him. The Expert does not accept that there is any evidence to support the proposition by the Respondent that the amounts requested are reasonable in the circumstances as an attempt to settle a dispute in a case where the Respondent is not yet carrying out any business under the Mittal name. There is no evidence that there was any business deal between the parties.

In the view of the Expert, in its registration and use of the Domain Names, the Respondent took unfair advantage of and caused detriment to the Complainants' rights as the evidence shows that on a balance of probabilities he registered the Domain Names for the purpose of selling them to the Complainants or one of them for money in excess of his documented out of pocket costs. As a result of the very strong evidence in this regard in e-mails showing the offer to sell the Domain Names for a very high price, in particular an e-mail dated April 24, 2012 offering to sell for £450,000 (albeit with other domain names containing the MITTAL name) there is no need for the Expert to consider the further evidence re 888 and approaches by the Respondent to other high profile businessmen. No submissions were made regarding the use of the Domain Names in relation to sponsored links and, again, consideration of this is unnecessary in light of the Expert's findings above.

Accordingly, the Expert finds that the Domain Names are Abusive Registrations within the definition of that term in paragraph 1 of the Policy.

In the light of the above findings the Expert cannot accept that the Complainants have made an attempt of reverse domain name hijacking. The Complainants have succeeded in making out their case under the Policy for transfer of the Domain Names to the Lead Complainant.

7. Decision

In light of the foregoing findings, namely that the Lead Complainant has Rights in respect of a name which is similar to the Domain Names and that the Domain Names, in the hands of the Respondent, are Abusive Registrations, the Expert directs that the Domain Names, mittalgold.co.uk and mittalbank.co.uk be transferred to the Lead Complainant.

Signed Dawn Osborne

Dated 09 May 2013