

Decision for dispute CAC-UDRP-104976

Case number	CAC-UDRP-104976
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Time of filing	2022-11-08 08:55:03
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Domain names	ex-carbon.com
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Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	ARCELORMITTAL
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Complainant representative

Organization	NAMESHIELD S.A.S.
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Respondent

Organization	SoftFab
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Respondent representative

Organization	George Z. Georgiou and Associates LLC
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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

The Complainant owns the EUIPO trademark registration number 18312217 "ExCarb" registered on February 13, 2021.

FACTUAL BACKGROUND

The Complainant is specialized in steel producing in the world. The Complainant is the market leader in steel for use in automotive, construction, household appliances and packaging with 69.1 million tons crude steel made in 2021. It holds sizeable captive supplies of

raw materials and operates extensive distribution networks. The Complainant is the owner of the EUIPO trademark registration number 18312217 "ExCarb" registered on February 13, 2021.

The disputed domain name <ex-carbon.com> was registered on October 6, 2022 and resolves to a Registrar's parking page. The Respondent's company Softfab Limited is a start-up company registered in the Republic of Cyprus since October 21, 2021 specialized in the automotive industry attracting car enthusiasts from all over the world.

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, failed to show 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

As the Panel concludes that the Complainant has not satisfied the second element of paragraph 4(a) of the Policy, the Panel declines to analyse the third element of paragraph 4(a) 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 15(a) of the Rules for the UDRP ('the Policy') instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by respondent is identical or confusingly similar to a trademark or service mark in which complainant has rights; and
- (2) respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

Rights

The Complainant claims rights in the mark "ExCarb" as identified in the section 'Identification of Rights' above. The Panel notes that an international trademark registration is sufficient to establish rights in that mark. As such, the Panel finds that the Complainant has established its rights in the mark "ExCarb." The Complainant contends that the disputed domain name is confusingly similar to the Complainant's mark because the disputed domain name incorporates the Complainant's mark in its entirety with the addition of the letters "on" and the ".com" gTLD.

The Panel notes that the use of a mark in its entirety with the mere addition of one or two letter(s), a hyphen and/or a gTLD fails to sufficiently distinguish a disputed domain name for the purposes of paragraph 4(a)(i) of the Policy. See *Google, Inc. v. DktBot.ORG aka dalok0kat Scripts*, FA286993 (Forum August 4, 2004) ("The mere addition of a single letter to Complainant's mark does not remove Respondent's domain names from the realm of confusing similarity in relation to Complainant's mark pursuant to Policy paragraph 4(a)(i)"); *Health Devices Corporation d/b/a Doc Johnson Enterprises v. Aspen S T C*, FA158254 (Forum July 1, 2003) ("The addition of punctuation marks such as hyphens is irrelevant in the determination of confusing similarity pursuant to Policy 4(a)(i)"). Therefore, the Panel finds that the disputed domain name is confusingly similar to Complainant's "ExCarb" mark.

The Respondent contends that the disputed domain name <ex-carbon.com> is comprised of the generic and descriptive words “carbon” and “ex,” which means “previous/past or without carbon” supporting the environmental non-profit idea of the Respondent for which the disputed domain name will be used; the component “Carb” in the Complainant’s mark is also generic and descriptive and is usually understood to mean an abbreviation of the word carbohydrate; and thus the disputed domain name is not confusingly similar to the Complainant’s mark.

The Panel finds that such a determination is not necessary under Policy paragraph 4(a)(i) as this portion of the Policy considers only whether the Complainant has rights in the mark and whether the disputed domain name is identical or confusingly similar to the Complainant’s mark. See *Caribbean Travel Network N.V. v. Administration Department / Digital Panorama S.A.*, FA1691456 (Forum October 15, 2016) (finding that such a determination is not necessary under Paragraph 4(a)(i) of the Policy as this portion of the Policy considers only whether Complainant has rights in the mark and whether the disputed domain names are identical or confusingly similar to Complainant’s mark.); *Precious Puppies of Florida, Inc. v. kc*, FA 1028247 (Forum August 10, 2007) (examining Respondent’s generic terms arguments only under Paragraphs 4(a)(ii) and 4(a)(iii) and not under Paragraph 4(a)(i) of the Policy); *Vitello v. Castello*, FA 159460 (Forum July 1, 2003) (finding that the respondent’s disputed domain name was identical to complainant’s mark under Policy paragraph 4(a)(i), but later determining the issue of whether the disputed domain name was comprised of generic terms under paragraphs 4(a)(ii) and 4(a)(iii) of the Policy).

No rights or legitimate interests

The Complainant must first make a *prima facie* case that the Respondent lacks rights and legitimate interests in the disputed domain name under Policy paragraph 4(a)(ii), then the burden shifts to the Respondent to show it does have rights or legitimate interests. See *Croatia Airlines d. d. v. Modern Empire Internet Ltd.*, WIPO Case No. D2003-0455 (the Complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests. 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). See also *Advanced International Marketing Corporation v. AA-1 Corp*, FA 780200 (FORUM Nov. 2, 2011) (finding that a complainant must offer some evidence to make its *prima facie* case and satisfy Policy paragraph 4(a)(ii)).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not commonly known by the disputed domain name. The Complainant is not related in any way with the Respondent. 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 ExCarb, or to apply for registration of the disputed domain name. The disputed domain name resolves to a parking page with commercial links. It is not a *bona fide* offering of goods or services or legitimate non-commercial or fair use.

Given the Complainant’s contentions above, the Panel finds that the Complainant has made out a *prima facie* case. As the onus thus shifts to the Respondent, the Panel must now see if the Respondent has rebutted the *prima facie* case and shown that it has a right or legitimate interest in the disputed domain name.

The respondent rebuts to the effect that:

i) The disputed domain name <ex-carbon.com> is comprised of the generic and descriptive words “carbon” and “ex.” The word “ex” is generic intending to mean among others “free from/without, former.” The word “carbon” is also generic meaning “a non-metallic chemical element with atomic number 6 that readily forms compounds with many other elements and is a constituent of organic compounds in all known living tissues.” Both components combined constitute the disputed domain name, which is understood as meaning previous/past or without carbon, supporting the environmental non-profit idea of the Respondent for which the disputed domain name will be used; and

ii) The time period from the registration of the domain until the filing of this complaint was insufficient for the Respondent to commence the process or instruct others in relation to the construction of the ex-carbon website which it fully intends to do. Due to its relatively recent registration, the Respondent’s company “Softfab Ltd” is still developing. It has a few projects ready to be launched and other projects which are pending, as part of its business plans. The Respondent’s company Softfab Limited registered the disputed domain name <ex-carbon.com> on October 6, 2022 as part of a project which includes a portfolio of other domains as well, which is aimed to be launched in early 2024. The project relates to environmental causes and aims to educate car enthusiasts and users regarding the use of alternative energy, targeting the largest group of car enthusiasts, racing tracks, and small and medium businesses with a view at reducing carbon emissions and alternative energy sources, but for a non-commercial purpose. The ex-carbon project will be associated and complimentary to the Respondent’s other start-up “Pros Map Garage.” Users will be charged a certain amount depending on their profile type which will be donated to organizations, institutions and projects which aim to reduce carbon dioxide of their own choosing. The disputed domain name will be used internally as a platform by Pros Map Garage users with a view of speeding up the process of facilitating the exchange of data to ex-carbon users and other concerned organizations and institutions within certain agreed terms. At present, the Respondent is unable to fully launch an operational website due to cash flow difficulties but it is optimistic it will be able to do so in the near future.

The Panel finds that the disputed domain name refers to “free from/without carbon,” and thus it is generic or descriptive in the context of supporting the environmental non-profit idea of the Respondent for which the disputed domain name will be used. Given the timeframe that the complaint was filed on November 3, 2022 shortly after the disputed domain name was registered on October 6, 2022 and in the light of the nature of the disputed domain name being generic or descriptive, the Panel infers that the Respondent’s business plan by using the disputed domain name is genuine and in good faith on the balance of probabilities. The Panel agrees and finds that the Respondent has successfully rebutted the *prima facie* case against it, and thus it concludes that the Respondent has legitimate interests in the disputed domain name. The Panel therefore finds that the Complainant has failed to establish the second element of paragraph 4(a) of the Policy.

Bad faith

As the Panel concludes that the Complainant has not satisfied the second element of paragraph 4(a) of the Policy, it declines to analyze the third element of paragraph 4(a) of the Policy. See *Creative Curb v. Edgetec Int'l Pty. Ltd.*, FA 116765 (Forum September 20, 2002) (finding that because the complainant must prove all three elements under the Policy, the complainant's failure to prove one of the elements makes further inquiry into the remaining element unnecessary); see also *Hugo Daniel Barbaca Bejinha v. Whois Guard Protected*, FA 836538 (Forum December 28, 2006) (deciding not to inquire into the respondent's rights or legitimate interests or its registration and use in bad faith where the complainant could not satisfy the requirements of Policy 4(a)(i)).

Reverse Domain Name Hijacking ("RDNH")

The Respondent submits that the Panel should make a finding of reverse domain name hijacking contending that the Complainant should have known it could not succeed in these proceedings. The Respondent contends that the Complainant knew that the content displayed was a result of GoDaddy's default settings, and ignored the requirements for establishing bad faith registration and use of the disputed domain name adducing no evidence of bad faith on behalf of the Respondent. Provided that the Complainant is a multinational steel production company, it aims to prevent the use of generic terms such as "ex carbon," which aims to cease any environmental initiatives which aim to reduce carbon dioxide and carbon emissions.

Paragraph 15(e) of the UDRP Rules provides that, if "after considering the submissions the panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding".

The Panel observes that previous panels have consistently found that the mere lack of success of a complaint is not itself sufficient for a finding of RDNH. The Panel finds that the allegation of the Respondent is not sufficient to demonstrate that the Complainant knew it could not succeed as to any of the required three elements – such as clear knowledge of respondent rights or legitimate interests, or clear knowledge of a lack of respondent bad faith such as registration of the disputed domain name well before the complainant acquired trademark rights. Given the Panel has found that the Complainant has satisfied the first element of paragraph 4(a) of the Policy, the Panel concludes that the Complainant has not engaged in reverse domain name hijacking. See *Gallup, Inc. v. PC+s.p.r.l.*, FA 190461 (Forum December 2, 2003) (finding no reverse domain name hijacking where complainant prevailed on the "identical/confusingly similar" prong of the Policy).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **ex-carbon.com**: Remaining with the Respondent

PANELLISTS

Name	Mr. Ho-Hyun Nahm Esq.
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DATE OF PANEL DECISION	2022-12-09
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Publish the Decision
