Decision for dispute CAC-UDRP-105126

Case number	CAC-UDRP-105126
Time of filing	2023-01-16 09:10:54
Domain names	hexcarb.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	ARCELORMITTAL

Complainant representative

Organization	NAMESHIELD S.A.S.

Respondent

Organization	ERA GEMS DMCC

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 Trademark Registrations for the marks XCARB and EXCARB as follows:

- International Trademark No. 1610773 for XCARB registered on April 9, 2021 in classes 04, 06, 12, 36, 40, 42, 45;

- European Trademark No. 18383608 for XCARB registered on January 27, 2021 in classes 04, 06, 12, 36, 40, 42, 45; and

- European Trademark No. 18312217 for EXCARB registered on September 23, 2020 in classes 04, 06, 09, 12, 40, 42.

FACTUAL BACKGROUND

Commencing in 2020, the Complainant has sold steel products under trademarks XCARB and EXCARB. The Respondent resolves the disputed domain name to a registrar parking page with monetized links relating to car parts and electric vehicles.

PARTIES CONTENTIONS

COMPLAINANT:

The Complainant is the largest steel producing company in the world and is the market leader in steel for use in automotive, construction, household appliances and packaging. In 2020 the Complainant began using the trademark XCARB to bring together all of its reduced, low and zero-carbon products and steelmaking activities, as well as its wider initiatives and green innovation projects, into a single effort. The Complainant owns trademark registrations for the marks XCARB and EXCARB as well as a number of domain names such as <xcarb.net>, <xcarb.uk>, <xcarb.green>, <excarb.net>, and <excarb.eu>.

The disputed domain name <hexcarb.com> was registered on November 24, 2022 and resolves to a registrar parking page displaying monetized links in relation with the Complainant's activity.
The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it.

RESPONDENT:

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has demonstrated its ownership of certain trademarks but it has not, to the satisfaction of the Panel, shown that the disputed domain name is identical or confusingly similar to such trademarks (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has not shown that the Respondent has 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

The Complainant has not shown that the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) 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

In view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations set forth in a complaint; however, the Panel may deny relief where a complaint contains mere conclusory or unsubstantiated arguments. See WIPO Jurisprudential Overview 3.0 at paragraph 4.3; see also GROUPE CANAL + v. Danny Sullivan, UDRP-102809 (CAC January 21, 2020) ("the Panel, based on the poorly supported and conclusory allegations of the Complainant, retains that the Complainant has not prevailed on all three elements of the paragraph 4(a) of the Policy and, therefore, rejects the Complaint.").

1. The disputed domain name is not confusingly similar to a trademark or service mark in which the Complainant has rights

Paragraph 4(a)(i) of the Policy requires that the Complainant demonstrate its ownership of trademark rights and that the disputed domain name is confusingly similar to such trademark. Boehringer Ingelheim Animal Health France / Merial v. S Jon Grant, UDRP-103255 (CAC September 30, 2020) ("it is imperative that the Complainant provides evidence that it has rights in a trade mark or service mark, following which the Panel shall assess whether or not the disputed domain name is identical or confusingly similar to the Complainant's trade mark(s).").

The Complainant has submitted screenshots from the websites of the World Intellectual Property Office (WIPO) and the European

Intellectual Property Office (EUIPO) as evidence that it owns registered rights to its asserted XCARB and EXCARB trademarks in multiple jurisdictions. These were all filed in late 2020 or early 2021. Registration with national offices has been found sufficient to satisfy the threshold requirement of proving trademark rights under Paragraph 4(a)(i) of the Policy. Margaritaville Enterprises, LLC v. Neil Wein, FA 1916531 (FORUM November 9, 2020) ("It is well established by decisions under this Policy that a trademark registered with a national authority is evidence of trademark rights").

The disputed domain name was registered on November 24, 2022 and the Complainant asserts that it is confusingly similar to the asserted trademarks as it "incorporates the dominant ExCarb element of the mark in its entirety, merely omitting [1] the letter "H" (is a reference to Hydrogen who has a role in the strategy of the decarbonization of the steel industry…"). The Complaint argues that this will lead internet users to wrongly believe that the domain name originates or is endorsed by the Complainant. The Panel is unable to agree.

Past decisions have noted that, in certain instances where a disputed domain name takes on a new and independent meaning, small variations from a trademark can avoid a finding of confusing similarity under Paragraph 4(a)(i) of the Policy. In a case asserting the trademark NAMECHEAP against the domain name <namechap.com>, the Complainant's claim of confusing similarity was rejected where "the Panel finds that despite the fact that apparently the disputed domain name is different with only one letter "e" from Complainant's trademark, such difference cannot be considered as misspelling or even "typosquatting," as the Complainant asserts...." Namecheap, Inc. v. KY SONG, FA 1537272 (FORUM March 12, 2014). The Panel in that decision went on to note that "the disputed domain name consists of two generic terms "name" and the "chap," each with its clear meaning of its own" and declined to find confusing similarity based on "the distinctive character, the disputed domain name gains by the omission of the second letter "e" from the Complainant's trademark…." Id. In a similar vein, in Google Inc. v. Andrey Korotkov, FA 1463221 (FORUM October 31, 2012), the Panel noted that "Complainant argues Respondent's <woogle.com> domain name is confusingly similar to Complainant's mark, merely replacing the letter "g" of the GOOGLE mark with the letter "w"" but it went on to hold that "[w]hile changing a single letter is often not enough to differentiate a mark from a domain name, in this case the letter at issue is the first letter. This Panel does not believe Respondent's disputed domain name can be confused with Complainant's mark."

In the present case, the Complainant's trademarks are XCARB and EXCARB although only the EXCARB trademark is asserted in this section of the Complaint and XCARB is not mentioned – a notable contrast to the Complainant's submitted evidence as discussed at footnote 3 infra. The disputed domain name incorporates each of these trademarks but it adds an initial letter "h". The Panel must discount the Complainant's claim regarding the letter "h" being a reference to hydrogen as used in the disputed domain name as there is no evidence that the term "hexcarb" has any such meaning with respect to this element nor that Respondent has any level of sophistication in steel-making chemistry such that adding this letter would be an obvious choice. There is one brief mention of hydrogen in the Complainant's submitted evidence but its relationship to the asserted trademarks appears somewhat vague.

In contrast to the Complainant's characterization, the Panel views the disputed domain name as consisting of two abbreviations "hex" and "carb" which have generic meanings, both separately and together. The term "hex" is a Greek prefix meaning "six" and is often used as a shorthand for the word "hexagonal". The term "carb" also has Latin roots and is often used as an abbreviation for the words "carbohydrate" and, of most relevance to the present case, "carburetor", which is a component of certain vehicle engines. Together the terms are commonly used to refer to specific automobile parts known as a "hex carb" or "hex carb fitting" which are hexagonal pieces used in the operation of an engine's carburetor.[2] This generic meaning of the term "hex carb" is reinforced by the appearance of links to automobile parts in the disputed domain name's resolving website and leads the Panel to conclude that the domain name has a specific generic meaning and overall impression of its own and is therefore sufficiently different from the Complainant's trademarks so as to fall outside the scope of Paragraph 4(a)(i) of the Policy.

2. The Respondent has rights or legitimate interests in respect of the disputed domain name

Pursuant to Paragraph 4(a)(ii) of the Policy, the complainant has the burden of making a prima facie showing that the respondent has no rights or legitimate interests in the disputed domain name. Cephalon, Inc. v. RiskIQ, Inc., UDRP-100834 (CAC September 12, 2014). Once this burden is met, it then shifts to the respondent to demonstrate that it does have rights or legitimate interests in the domain name. Paragraph 4(c) of the Policy offers the respondent several examples of how to demonstrate its rights or legitimate interests in the disputed domain name.

Under Paragraph 4(c)(i) of the Policy, prior Panels that using a disputed domain name to display monetized (i.e., "pay-per-click" or "PPC") links that relate to the generic or descriptive meaning of the domain name may constitute a bona fide offering of goods or services or a fair use of a generic term. Paragraph 2.9 of the WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), states that "Panels have recognized that the use of a domain name to host a page comprising PPC links would be permissible – and therefore consistent with respondent rights or legitimate interests under the UDRP – where the domain name consists of an actual dictionary word(s) or phrase and is used to host PPC links genuinely related to the dictionary meaning of the word(s) or phrase comprising the domain name, and not to trade off the complainant's (or its competitor's) trademark." In the present case, the screenshots of the Respondent's website, which have been provided by the Complainant, show that the site includes links denoted as "Pièces Commander" (order parts), "Acheter Pièces Automobiles" (buy car parts), and "Véhicule Éléctrique" (electric vehicles). While it may be that the Complainant produces steel that is ultimately used in vehicles under its XCARB mark [3], the submitted evidence is not specific on this point and it is unclear to the Panel whether the Complainant's steel is used in vehicle parts or only in structural frames and bodies. However, the links at the Respondent's website directly relate to the generic meaning of the term "hex carb" for an automobile part as discussed in the previous section of this decision.

As such, the Panel finds that Complainant has not made out a prima facie case and, upon a preponderance of the evidence before it, the Panel finds that the Respondent does make a bona fide offering of goods or services using the disputed domain name and/or

makes a fair use thereof per Paragraphs 4(c)(i) and (iii) of the Policy.

3. The disputed domain name was not registered and used in bad faith

Under Paragraph 4(a)(iii) of the Policy, the Complainant must demonstrate both that the disputed domain name was registered and is being used in bad faith. As the Panel has found that the Respondent has rights or legitimate interests in the disputed domain name which is not confusingly similar to the Complainant's trademarks, it logically follows that evidence is lacking that the domain name was registered or is used in bad faith.

[1] The Panel assumes that this is a drafting error and that the Complainant intended to use the word "adding".

[2] While the Respondent has not provided a Response or made any other submission in this case, the Panel has exercised its own discretion to conduct an independent investigation of publicly available information afforded by the general powers of a panel articulated inter alia in paragraphs 10 and 12 of the Rules. The Panel accessed its own knowledge of automobile parts and repairs as well as the results of an online search for the phrase "hex carb" in preparing the present decision.

[3] The Panel notes that while the Complainant has submitted evidence that it owns a trademark registration for the EXCARB trademark, none of its other submitted evidence demonstrates its actual use of this particular mark or the reputation that it may have achieved with the relevant consumer.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Rejected

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

1. **hexcarb.com**: Remaining with the Respondent

PANELLISTS

Name	**Steven Levy**

DATE OF PANEL DECISION 2023-02-13

Publish the Decision