

ADMINISTRATIVE PANEL DECISION

Etex N.V and ETEX Services N.V v. Vlad Eruskibon, VladBons LLC
Case No. D2022-3455

1. The Parties

The Complainants are Etex N.V, Belgium, and ETEX Services N.V, Belgium, represented by BrandIT GmbH, Switzerland.

The Respondent is Vlad Eruskibon, VladBons LLC, Germany.

2. The Domain Name and Registrar

The disputed domain name <etexegroup.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on September 16, 2022. On September 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 20, 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 Complainants on September 22, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on September 27, 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 notified the Respondent of the Complaint, and the proceedings commenced on September 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 18, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 19, 2022.

The Center appointed Kateryna Oliinyk as the sole panelist in this matter on November 1, 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 Complainants are members of the ETEX group, a global group offering futureproof lightweight interior and exterior building solutions including fire protection and high performance insulation. Founded in 1905, for over 110 years the ETEX group has provided innovative products and solutions. The ETEX group has business activities in many countries, including in Germany. The ETEX group employs over 11,000 teammates in over 110 sites around the world and has four sales divisions (“Building Performance”, “Exteriors”, “Industry”, and “New ways”).

One of the Complainants, ETEX N.V., is the registered owner of a number of trademark registrations around the world for the ETEX trademark, including:

- International Registration No. 652141 for ETEX, registered on February 1, 1996;
- International Registration No. 788905 for ETEX, registered on August 28, 2002;
- International Registration No. 1546890 for ETEX, registered on June 2, 2020;
- European Union Trademark Registration No. 017910895 for ETEX, registered on March 19, 2019;
- United States Trademark Registration No. 6303449 for ETEX, registered on March 30, 2021.

The Complainants also own numerous domain names containing the ETEX trademark, among them: <etexgroup.com>, <etexgroup.eu>, and <etexgroup.de>. The Complainants use these domain names to resolve to the ETEX group’s official website through which it informs Internet users and potential consumers about its ETEX mark and its products and services. The Complainants are also present on social media.

On July 4, 2022, the Complainants sent a cease and desist letter to the Respondent informing of the Complainants’ rights regarding the ETEX trademark, to which the Respondent did not reply.

The disputed domain name was created on June 9, 2022. The disputed domain name does not resolve to an active website.

5. Parties’ Contentions

A. Complainant

Identical or Confusingly Similar

The Complainants assert registered rights in the ETEX trademark. The Complainants submit that the disputed domain name is confusingly similar to the ETEX trademark.

The Complainants contend that the disputed domain name incorporates in its entirety the ETEX trademark and add at the end the letter “e” and the term “group”. This misspelling and addition of the descriptive term “group” would not prevent a finding of confusing similarity of the disputed domain name to the ETEX trademark.

The Complainants submit that the applicable Top-Level Domain (“TLD”) in the disputed domain name should be viewed as a standard registration requirement and as such should be disregarded under the first element confusing similarity test.

No rights or legitimate Interests

The Complainants submit that disputed domain name was registered on June 9, 2022, many years after the first registrations of the Complainants' ETEX trademarks.

The Complainants claim that they have not licensed or authorized the Respondent to register or use the disputed domain name, nor is the Respondent affiliated to the Complainants in any form.

There is no evidence that the Respondent is known by the dispute domain name or owns any corresponding registered trademarks.

The disputed domain name has been passively held. It does not resolve to an active website. The Complainants submit that there is no evidence showing that the Respondent has been using, or preparing to use, the disputed domain name in connection with a *bona fide* offering of goods and services or has made a legitimate noncommercial or fair use of the disputed domain name.

The Complainants assert that the structure of the disputed domain name is such that it reflects the Respondent's intention to create an association and subsequent likelihood of confusion with the Complainants and the ETEX trademark in the minds of Internet users.

Thus, the Complainants claim that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Registered and used in bad faith

The Complainants submit that the disputed domain name was registered and is being used in bad faith. The Complainants assert that the Respondent must have had knowledge of the Complainants' rights in the ETEX trademark when registering the disputed domain name, and did so with the intent to create a likelihood of confusion with the Complainants amongst Internet users. The Complainants submit that the Respondent's non-use of the disputed domain name amounts to use of the disputed domain name in bad faith, under the doctrine of passive holding.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

6. Discussion and Findings

6.1. Procedural Issue - Consolidation of Multiple Complainants

The present proceeding involves two complainants bringing a single complaint against the Respondent. The Complainants have made a request for consolidation and bear the *onus* of establishing that such a consolidation is justified.

In assessing whether a complaint filed by multiple complainants can be brought against a single respondent, panels typically consider whether (1) the complainants have a specific common grievance against the respondent, and (ii) it would be equitable and procedurally efficient to permit the consolidation. See section 4.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)).

Common grievance against the respondent is established when the multiple complainants have a common legal interest in the trademark rights on which the complaint is based. Moreover, a common legal interest can be characterized when "the multiple complainants form part of a single entity such as where individual companies are part of a larger corporate group or joint venture" (see *Fulham Football Club (1987) Limited*,

Tottenham Hotspur Public Limited, West Ham United Football Club PLC, Manchester United Limited, The Liverpool Football Club And Athletic Grounds Limited v. Domains by Proxy, Inc./ Official Tickets Ltd, WIPO Case No. [D2009-0331](#); *MLB Advanced Media, The Phillies, Padres LP v. OreNet, Inc.*, WIPO Case No. [D2009-0985](#)).

The Complainants are parent companies, part of the ETEX group. The company ETEX N.V. is the registered owner of the ETEX trademark. ETEX Services N.V is involved in the management of trademarks and domain names matters regarding the ETEX group. The above facts demonstrate that the Complainants have a corporate connection and a shared interest in the ETEX trademarks.

The Panel is satisfied, based on the case records, that the Complainants have a specific common grievance against the Respondent.

Therefore, the Panel finds that it is equitable and procedurally efficient to consolidate the proceedings. This is consistent with the Policy and the Rules, comports with prior relevant UDRP decisions in this area, and is appropriate in light of the aforementioned principles. The Panel therefore will proceed to a decision on the merits.

6.2. Substantive Elements of the Policy

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: “[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”.

Considering that the Respondent did not reply to the Complainants’ contentions, in order to determine whether the Complainants have met their burden as stated in paragraph 4(a) of the Policy, the Panel bases its Decision on the statements and documents submitted and in accordance with the Policy and the Rules. Under paragraph 14(b) of the Rules, where a Party does not comply with any provision of the Rules, the Panel “shall draw such inferences therefrom as it considers appropriate”.

Paragraph 4(a) of the Policy directs that the Complainants must prove each of the following: (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainants have rights; (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and (iii) that the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The first element that the Complainants must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainants’ trademark rights.

There are two parts to this inquiry: the Complainants must demonstrate that it has rights in a trademark and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

According to section 1.1.1 of the [WIPO Overview 3.0](#), the term “trademark or service mark” as used in UDRP paragraph 4(a)(i) encompasses both registered and unregistered (sometimes referred to as common law) marks.

Ownership of a nationally or regionally registered trademark serves as a *prima facie* evidence that the Complainants have trademark rights for the purposes of standing to file this Complaint. See section 1.2 of [WIPO Overview 3.0](#). The Complainants submitted evidence that the ETEX trademark enjoys protection under national and international trademark registrations. Thus, the Panel finds that the Complainants’ rights in the ETEX trademark have been established pursuant to the first element of the Policy.

The disputed domain name fully incorporates the Complainants' ETEX trademark.

Under section 1.9. of the [WIPO Overview 3.0](#), a domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element. Examples of such typos include (i) adjacent keyboard letters, (ii) substitution of similar-appearing characters (e.g., upper vs lower-case letters or numbers used to look like letters), (iii) the use of different letters that appear similar in different fonts, (iv) the use of non-Latin internationalized or accented characters, (v) the inversion of letters and numbers, or (vi) the addition or interspersing of other terms or numbers.

As provided in section 1.8 of the [WIPO Overview 3.0](#), the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.

The disputed domain name comprises a close variant of the Complainants' ETEX trademark as its leading element, whereby an additional letter "e" is added to the Complainants' ETEX trademark, followed by the term "group", under the generic Top-Level Domain ("gTLD") ".com".

The Panel finds that the addition of the letter "e" and of the term "group" does not prevent a finding of confusing similarity between the disputed domain name and the Complainants' ETEX trademark, which remains clearly recognizable in the disputed domain name (See e.g. *Volvo Trademark Holding Aktiebolag v. Nanci Nette*, WIPO Case No. [D2022-0299](#)). The gTLD ".com" may be disregarded for purposes of comparison under the first element; see [WIPO Overview 3.0](#), section 1.11.1.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the ETEX trademark in which the Complainants have rights.

The first element of paragraph 4(a) of the Policy is therefore satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, a complainant must make at least a *prima facie* showing that a respondent possesses no rights or legitimate interests in a disputed domain name. See, e.g., *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#). Once a complainant makes such a *prima facie* showing, the burden of production shifts to the respondent, though the burden of proof always remains on the complainant. If the respondent fails to come forward with evidence showing rights or legitimate interests, the complainant will have sustained its burden under the second element of the UDRP.

Based on the Complainants' contentions, the Respondent is not a licensee of, or otherwise affiliated with, the Complainants, and has not been authorized by the Complainants to use their ETEX trademark.

The Complainants further contend that the Respondent is not commonly known by the disputed domain name and has not made any *bona fide* use - neither commercial nor noncommercial, of the same.

Based on the case records, the Panel finds that there is no evidence that the Respondent has been commonly known by the disputed domain name, and there is no similarity or association between the name of the Respondent and the disputed domain name, which could demonstrate rights or legitimate interests of the Respondent. See, e.g., *World Natural Bodybuilding Federation, Inc. v. Daniel Jones TheDotCafe*, WIPO Case No. [D2008-0642](#).

The disputed domain name does not resolve to an active website. Prior UDRP panels have found that the passive holding of a disputed domain name is neither a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use. See, by way of example, *Skyscanner Limited v. WhoisGuard Protected, WhoisGuard, Inc. / petrov petya*, WIPO Case No. [DCC2020-0003](#), *Instagram, LLC v. Zafer Demir*,

Yok, WIPO Case No. [D2019-1072](#), “The passive holding of the disputed domain name does not amount to use or preparations to use it in connection with a *bona fide* offering of goods and services. Nor is there any evidence which indicates that the Respondent is commonly known by the disputed domain name. Nor does a passive holding of the disputed domain name comprise a legitimate noncommercial or fair use of it.”). The Panel agrees and holds the passive holding of the disputed domain name by the Respondent in this case as evidence that the Respondent has not registered the disputed domain name in connection with any *bona fide* offering of goods or services.

Previous UDRP panels have found that domain names identical to a complainant's trademark carry a high risk of implied affiliation. Even where a domain name consists of a trademark plus an additional term (at the Second- or Top-Level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. See section 2.5.1 of the [WIPO Overview 3.0](#).

In this case the disputed domain name in its structure refers to the Complaint's group and its extensively used domain name <etexgroup.com>. The structure of the disputed domain name reflects the Respondent's intention to create an association, and a subsequent likelihood of confusion, with the Complainants and their ETEX trademark in Internet users' mind.

The Panel finds that the composition of the disputed domain name effectively impersonates or suggests sponsorship or endorsement by the Complainants which cannot constitute fair use.

By not submitting a Response, the Respondent has failed to invoke any circumstances which could demonstrate any rights or legitimate interests in the disputed domain name. Under such circumstances the Panel draws adverse inferences from this failure, where appropriate, in accordance with the Rules, paragraph 14(b).

The second element of paragraph 4(a) of the Policy is therefore satisfied.

C. Registered and Used in Bad Faith

The disputed domain name was created on June 9, 2022, and is passively held by the Respondent.

Under section 3.3 of the [WIPO Overview 3.0](#), the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Previous UDRP panels have held that the passive holding of a domain name that incorporates a well-known trademark may confirm the bad faith use of a disputed domain name. See, *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

While panels 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, (iii) the respondent's 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. See, *Andrey Ternovskiy dba Chatroulette v. WhoisGuard Protected, WhoisGuard, Inc. / Armando Machado*, WIPO Case No. [D2018-0082](#), *Carrefour SA v. Dexter Turner*, WIPO Case No. [D2022-2032](#), see also *Skandinaviska Enskilda Banken AB v. Nick Jones*, WIPO Case No. [D2021-0703](#).

The Complainants have produced evidence showing that they own registrations for the ETEX trademark, of which registration dates significantly precede the creation date of the disputed domain name.

In addition, the Complainants have credibly submitted that over the years they have developed substantial goodwill in the ETEX trademark. The Panel is convinced that the Complainants' trademark is well established through long and widespread use and the Complainants have acquired a significant reputation and goodwill in their trademark. See, e.g., *Carrefour SA v. hanib bas*, WIPO Case No. [D2020-1798](#);

Carrefour SA. v. Reliant-web Domain Admin / Jean Marie Grolleau / Joanne Elvert, WIPO Case No. [D2021-2389](#); *Carrefour v. Andre Machado*, WIPO Case No. [DIO2020-0004](#).

As stated above, the structure of the disputed domain name shows that the Respondent registered it having the Complainants and their ETEX trademark in mind. It reflects the Respondent's clear intention to create an association, and a subsequent likelihood of confusion, with the Complainants' trademark in Internet users' mind. By reading the disputed domain name, the Internet users may believe that it is directly connected to or authorized by the Complainants. The Respondent registered the disputed domain name to take advantage of the Complainants' widely known trademark.

Furthermore, according to section 3.1.4 of the [WIPO Overview 3.0](#), the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. Given the reputation of the BARNES trademark, registration in bad faith can be inferred. See, e.g., *Charles Jourdan Holding AG v. AAIM*, WIPO Case No. [D2000-0403](#).

Taking the above facts into consideration, it is not possible to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate. See *Telstra Corporation Limited v. Nuclear Marshmallows*, *supra*.

Finally, the Panel considers the following factors as well:

- (i) the Respondent has failed to submit the response to the cease and desist letter;
- (ii) the Respondent has failed to submit a response or to provide any evidence of actual or contemplated good faith use of the disputed domain name;
- (iii) the Respondent provided erroneous information when it registered the disputed domain name, as the Respondent's postal address provided in the Whois record appears to be erroneous;
- (iv) the Respondent is involved in typosquatting in an effort to take advantage of a typographical error.

In light of the aforesaid and applying the above-referenced factors, the Panel establishes that the Respondent's passive holding of the disputed domain name does not prevent a finding of bad faith.

The third element of paragraph 4(a) of the Policy is therefore satisfied.

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 <etexegroup.com> be transferred to the Complainant ETEX Services N.V.

/Kateryna Oliinyk/

Kateryna Oliinyk

Sole Panelist

Date: November 22, 2022