ARBITRATION
AND
MEDIATION CENTER

WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

# ADMINISTRATIVE PANEL DECISION
Etex N.V, ETEX Services N.V v. A-TON, LLC
Case No. D2024-5355

## 1. The Parties

The Complainants are Etex N.V, Belgium (the "First Complainant"), and ETEX Services N.V., Belgium (the "Second Complainant") (together the "Complainants"), both represented by Abion GmbH, Switzerland.

The Respondent is A-TON, LLC, Russian Federation.

## 2. The Domain Name and Registrar

The disputed domain name <equitone.pro> is registered with Registrar of Domain Names REG.RU LLC (the "Registrar").

## 3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the "Center") on December 31, 2024. On January 2, 2025, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 9, 2025, 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 (REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainants on January 9, 2025, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. On January 14, 2025, the Complainants requested an extension to file the amended Complaint until January 20, 2025, and the Center confirmed the requested extension. The Complainants filed an amended Complaint on January 20, 2025.

On January 9, 2025, the Center informed the Parties in Russian and English that the language of the registration agreement for the disputed domain name was Russian. On January 20, 2025, the Complainants confirmed their request that English be the language of the proceeding. The Respondent did not submit any comment on the language of the proceeding.

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 in English and Russian of the Complaint, and the proceedings commenced on January 21, 2025. In accordance with the Rules, paragraph 5, the due date for Response was February 10, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 11, 2025.

The Center appointed Assen Alexiev as the sole panelist in this matter on February 14, 2025. 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, established in 1905. The group offers lightweight interior and exterior building solutions, including fire protection and high-performance insulation, and employs over 13,500 people in over 160 locations around the world. The group markets its architectural fiber cement façade products under the brand EQUITONE and operates a website at the domain name <equitone.com>.

The First Complainant is the owner of the following trademark registrations for the sign "EQUITONE" (the "EQUITONE trademark"):

− the International trademark EQUITONE with registration No. 1114346, registered on March 14, 2012 for goods in International Classes 6, 17, and 19, designating the Russian Federation among other jurisdictions; and
− the European Union trademark EQUITONE with registration No. 010723781, registered on August 14, 2012 for goods in International Classes 6, 17, and 19.

The disputed domain name was registered on February 26, 2023. It is currently inactive. At the time of filing of the Complaint, the disputed domain name directed to a Russian language website that displayed the EQUITONE trademark and contained images of the Complainants' products and references to the Complainants.

## 5. Parties' Contentions

### A. Complainant

The Complainants state that they previously had business presence in the Russian Federation which has been terminated, and currently they are only technically present there via their affiliate Etex OOO, which has no commercial activities and is in the process of liquidation.

The Complainants state that they became aware of the disputed domain name and the associated website at the end of October 2024. They point out that the disputed domain name resolves to a website displaying the EQUITONE trademark, images of EQUITONE products, and references to the First Complainant. The Complainants note that the website at the disputed domain name lists the names of Managing Partners of the team of the operator of the website. The Complainants point out in this regard that persons with the same names previously worked with their affiliate Etex OOO as Head of Sales Direction and Project Manager. The Complainant notes that the service contracts of both with their affiliate were terminated in September 2022, and since then, the Complainants have had no business relationship with these two persons.

The Complainants further note that the information from the online company register database of Russian companies shows that the Respondent A-TON, LLC was established on August 17, 2022, where one of the above persons is listed as the General Manager and legal representative of the company, and both are also listed as the "Participants/Founders" of the company. The Complainants submit that they had no knowledge

about the existence of the Respondent before October 2024.

The Complainants state that the disputed domain name is confusingly similar to the EQUITONE trademark, because it incorporates the trademark in its entirety.

According to the Complainants, the Respondent has no rights or legitimate interests in respect of the disputed domain name. They note that the disputed domain name was registered in February 2023, many years after the first registrations of the Complainant's EQUITONE trademark, and submit that the Complainants have not licensed or authorized the Respondent or its founders to register or use the disputed domain name, and none of them is affiliated to the Complainants. The Complainants also note that there is no evidence that the Respondent is known by the disputed domain name or that it owns any corresponding registered trademarks.

The Complainants maintain that the Respondent is not using the disputed domain name in connection with a bona fide offering of goods and services and is not making a legitimate noncommercial or fair use of it. They add that the composition of the disputed domain name reflects the Respondent's intention to create an association and a likelihood of confusion with the Complainants and their EQUITONE trademark to mislead Internet users that the associated website is authorized by the Complainants to sell their EQUITONE products. The Complainants note in this regard that the website at the disputed domain name contains statements that create the wrong impression that the Respondent's founders are currently directly working with the Complainants and that a business relationship currently exists between the provider of the website and the Complainants. The Complainants add that in 2023 they stopped the exports of fiber cement products to the Russian Federation and that it is unclear whether the website at the disputed domain name offers genuine EQUITONE products.

The Complainants contend that the disputed domain name was registered and is being used in bad faith. They note that the Respondent registered the disputed domain name many years after the registration of the EQUITONE trademark, and that the circumstances of this case show that the disputed domain name was registered and is being used to target the Complainants and their EQUITONE trademark in an attempt to create a likelihood of confusion in Internet users as to the affiliation or endorsement of the website at the disputed domain name for financial gain.

**B. Respondent**

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

## 6. Discussion and Findings

### 6.1. Procedural issue – Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is Russian. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement, subject to the authority of the Panel to determine otherwise.

The Complaint was filed in English. The Complainants request that the language of the proceeding be English. They submit that they are based in Belgium, while the Respondent is located in the Russian Federation, and since the English language is commonly use internationally, it would be fair to the Parties to adopt this language as the language of the present proceeding. The Complainants add that an eventual translation of the Complaint in Russian would entail significant additional costs and would delay the proceeding. The Respondent did not object to the Complainants' request regarding the language of the proceeding and did not bring to the attention of the Panel any reasons why the use of English would be unfair, inappropriate, or inefficient.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to proceed judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 4.5.1.

Having considered all the matters above, the Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

**6.2. Procedural issue – Consolidation of the Complainants**

The Complainants request the Panel to allow them to proceed with a single Complaint in the present proceeding.

Paragraph 10(e) of the UDRP Rules grants a panel the power to consolidate multiple domain name disputes. At the same time, paragraph 3(c) of the UDRP Rules provides that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder. As discussed in section 4.11.1 of the WIPO Overview 3.0, in assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation.

In support of their consolidation request, the Complainants submit that they are affiliates and belong to the Etex group, that the First Complainant is the owner of the EQUITONE trademark, while the Second Complainant is involved in the management of trademarks and domain names of the Etex group, and that the Respondent's conduct affects them in a similar fashion. The Complainants also note that they are represented by the same counsel in the present proceeding, and submit that there is no apparent reason why it would not be equitable to permit their consolidation.

The Respondent did not object to the consolidation request of the Complainants and did not bring forward any reasons why the consolidation would be unfair or would lead to procedural inefficiency.

Having considered the above, the Panel decides to allow the consolidation of the Complainants in the present proceeding.

**A. Identical or Confusingly Similar**

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview 3.0, section 1.7.

The Complainants have shown rights in respect of the EQUITONE trademark for the purposes of the Policy. A trademark owner's affiliate such as a subsidiary of a parent or of a holding company, or an exclusive trademark licensee, is considered to have rights in a trademark under the UDRP for purposes of standing to file a complaint. Here, the First Complainant is the owner of the EQUITONE trademark, while the Second Complainant is its affiliate. WIPO Overview 3.0, sections 1.2.1 and 1.4.1.

The entirety of the EQUITONE trademark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the EQUITONE trademark for the purposes of the Policy. WIPO Overview 3.0, section 1.7.

The Panel finds the first element of the Policy has been established.

**B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. WIPO Overview 3.0, section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The disputed domain name is identical to the Complainants' EQUITONE trademark. The Respondent is a company that was established by two former contractors of the Complainants' affiliate in the Russian Federation, and it registered the disputed domain name several months after these two persons terminated their relationship with the Complainants' affiliate. The disputed domain name resolves to a Russian language website that prominently displays the Complainants' EQUITONE trademark and features fiber cement products branded with the same trademark.

As discussed in section 2.5 of the WIPO Overview 3.0, generally speaking, UDRP panels have found that domain names identical to a complainant's trademark carry a high risk of implied affiliation. In the case of their registration by a competitor or former contractor therefore, this would be impermissible.

For completeness, section 2.8.1 of the WIPO Overview 3.0 states that panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant's trademark to undertake sales or repairs related to the complainant's goods or services may be making a bona fide offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the "Oki Data test", the following cumulative requirements will be applied in the specific conditions of a UDRP case:

(i) the respondent must actually be offering the goods or services at issue;

(ii) the respondent must use the site to sell only the trademarked goods or services;

(iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and

(iv) the respondent must not try to "corner the market" in domain names that reflect the trademark.

Cases applying the Oki Data test usually involve a domain name comprising a trademark plus a descriptive term (e.g., "parts", "repairs", or "location"), whether at the second-level or the top-level. At the same time, the risk of misrepresentation has led panels to find that a respondent lacks rights or legitimate interests in cases involving a domain name identical to the complainant's trademark.

The disputed domain name is identical to the Complainants' EQUITONE trademark, so this alone is sufficient to exclude the application of the Oki Data test.

Even if this identity is disregarded, the Respondent's conduct still does not comply with the requirements of this test. The Respondent's website contains no disclaimer for the absence of a relationship with the Complainants, but describes the team of its provider in the following terms:

"КОМАНДА
[…]
Управляющий партнер
Внештатный сотрудник в официальном представительстве EQUITONE (компании ETEX Россия). Развивает бренд EQUITONE в РФ с самого его основания

[…]
Управляющий партнер
Внештатный сотрудник в официальном представительстве EQUITONE (компании ETEX Россия). Занимается проектными продажами и развитием дилерской сети в РФ и РБ."

translated in English as:

"TEAM
[…]
Managing Partner
External collaborator in the official representative office of EQUITONE (company ETEX Russia). Develops the EQUITONE brand in the Russian Federation since its foundation.

[…]
Managing Partner
External collaborator in the official representative office of EQUITONE (company ETEX Russia). In charge of project sales and dealer network development in the [Russian Federation] and the [Republic of Belarus]."

The website at the disputed domain name thus creates a false impression that its provider is affiliated to the Complainants and is an authorized commercial channel for the sales of their products in the Russian Federation.

Considering all the above, the Panel finds that the evidence in the case supports the prima facie case made by the Complainants and finds that the second element of the Policy has been established.

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

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent registered the disputed domain name eleven years after the registration of the Complainants' EQUITONE trademark with effect in the Russian Federation and used it for a website that featured the same trademark and offered products branded with it while displaying statements that are likely to mislead Internet users that the Respondent is affiliated to the Complainants or that its activities are endorsed by them. The Respondent has not provided a plausible explanation for its actions or convincing arguments as to why its activities should be considered to be in good faith.

The above leads the Panel to the conclusion that, by registering and using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the website at the disputed domain name by creating a likelihood of confusion with the Complainant's EQUITONE trademark as to the affiliation or endorsement by the Complainant of the Respondent's website and of the products and services offered on it, which supports a finding of registration and use in bad faith under paragraph 4(b)(iv) of

the Policy.

The Panel therefore finds that the Complainant has established the third element 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 <equitone.pro> be transferred to the Complainant.

*/Assen Alexiev/*
**Assen Alexiev**
Sole Panelist
Date: February 25, 2025