

ADMINISTRATIVE PANEL DECISION

Econosto N.V., and ERIKS N.V. v. Aymen Ahmed Omara, Otskw
Case No. D2022-2085

1. The Parties

The Complainants are Econosto N.V., and ERIKS N.V., the Netherlands, represented by Novagraaf Nederland B.V., the Netherlands.

The Respondent is Aymen Ahmed Omara, otskw, Kuwait.

2. The Domain Name and Registrar

The disputed domain name <econostogroup.com> is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 9, 2022. On June 9, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 9, 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 June 14, 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 June 17, 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 June 23, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 13, 2022. The Respondent did not submit a formal response, but on June 17, 2022, the Center received an informal communication seemingly from the Respondent. On July 21, 2022, the Center informed the parties that it will proceed to panel appointment.

The Center appointed Luca Barbero as the sole panelist in this matter on August 3, 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 first Complainant Econosto N.V. (“the first Complainant”) is a subsidiary of the second Complainant ERIKS N.V. (“the second Complainant”). The second Complainant is an international service partner for industrial Original Equipment Manufacturer (“OEM”) and Maintenance, repair and operations (“MRO”) customers, providing a wide range of high-quality technical products and associated technical and logistics services. The first Complainant was founded in 1892 and was acquired by the second Complainant in 2008.

The Complainants are the owners of several trademark registrations for ECONOSTO, including the following, as per trademark certificates submitted as annexes 4 to the Complaint:

- European Union trade mark registration No. 008448862 for ECONOSTO (word mark), filed on July 24, 2009 and registered on February 22, 2010 in classes 6, 7 and 9, owned by the first Complainant;
- International trademark registration No. 1210281 for ECONOSTO (word mark), registered on January 23, 2014 in classes 35, 37, 40, 41, and 42, owned by the second Complainant;
- Kuwait trade mark registration No. 90101 for ECONOSTO (word mark), registered on August 9, 2009 in class 6, owned by the first Complainant.

The disputed domain name <econostogroup.com> was registered on October 23, 2019, and is currently not redirected to an active website. According to the screenshots submitted by the Complainants – which have not been contested by the Respondent – the disputed domain name was previously pointed to an active website displaying the ECONOSTO trademark and promoting an “Econosto Group”, described as “a leading manufacturer of quality Pipes, Fittings and Valves, for all the mechanical, electrical and communication industries”.

5. Parties’ Contentions

A. Complainant

The Complainants contend that the disputed domain name is confusingly similar to the trademark ECONOSTO as it reproduces the trademark in its entirety with the mere addition of the generic word “group” and the generic Top-Level Domain (“gTLD”) “.com”.

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainants state that the Respondent is in no way related, licensed or authorized by the Complainants, to use the trademark ECONOSTO for any purpose, including the registration of the disputed domain name.

The Complainants also submit that the Respondent has no trademark registrations for ECONOSTO or ECONOSTO GROUP and that the Respondent was not authorized to use the Complainants’ trademarks to offer goods and services similar to those of the Complainants. The Complainants further points out that, since their trademarks are well-known in light of the Complainants’ leading role in the European market, the Respondent’s use of the disputed domain name, containing the Complainants’ trademarks, could not give rights or legitimate interests. The Complainants further highlight that the Respondent did not publish any disclaimer on the website at the disputed domain name, thus falsely creating the impression that the Respondent may be somewhat connected with the Complainants.

With reference to the circumstances evidencing bad faith, the Complainants indicate that the Respondent should have been aware of the Complainants' prior trademark rights when it registered the disputed domain name.

The Complainants also state that the Respondent's use of the disputed domain name amounts to bad faith since, given the fact that the Complainant's trademarks have acquired a certain reputation and that the second Complainant is a worldwide known service partner for industrial OEM and MRO customers under the trademark ECONOSTO, the average Internet user may be misled into believing that the disputed domain name and the correspondent website be affiliated with the Complainants, as the Respondent claims to be active in the exact same field of business as the Complainants. The Complainants further claim that possible negative experiences with the Respondent's website could cause negative impact on the Complainants.

The Complainants highlight that the Respondent also provided false information both on its website, stating that it was active since 2009 whilst the disputed domain name was registered in 2019, and in the Whois records.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

The Center did however receive an anonymous informal email communication from an email address based on the disputed domain name, on June 17, 2022, stating that the logo ECONOSTO would have been changed to avoid future misunderstandings.

6. Discussion and Findings

According to paragraph 15(a) of the Rules: "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." Paragraph 4(a) of the Policy directs that the Complainants must prove each of the following:

- (i) that the disputed domain name registered by the Respondent 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 Panel finds that the Complainants have established rights over the trademark ECONOSTO based on the trademark registrations cited under section 4 above and the related trademark certificates submitted as annex 4 to the Complaint.

As highlighted in section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), the first element functions primarily as a standing requirement, and the threshold test for confusing similarity typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. Moreover, as stated in section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.

In the case at hand, the Panel finds that the disputed domain name is confusingly similar to the trademark ECONOSTO as it reproduces the trademark in its entirety with the mere addition of the gTLD “.com”, which can be disregarded when comparing the similarities between a domain name and a trademark, and of the word “group”, which does not prevent a finding of confusing similarity.

Therefore, the Panel finds that the Complainants have proven that the disputed domain name is confusingly similar to a trademark in which the Complainants have established rights according to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainants must show that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent may establish a right or legitimate interest in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following:

“(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

The Panel finds that in the case at hand, by not submitting a Response, the Respondent has failed to invoke any circumstance that could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain name. In addition, according to the evidence on record, there is no relationship between the Complainants and the Respondent and the Complainants have not authorized the Respondent to register or use their trademark or the disputed domain name.

Moreover, there is no element from which the Panel could infer a Respondent’s right over the disputed domain name, or that the Respondent, whose name is Aymen Ahmed Omara, Otskw according to the Registrar-disclosed registrant information, might be commonly known by the disputed domain name.

The Complainants have provided evidence of the prior redirection of the disputed domain name to a website prominently displaying the Complainants’ trademark ECONOSTO and promoting products identical to the ones offered by the Complainants under the trademark, without publishing any disclaimer of non-affiliation with the Complainants. Furthermore, the Respondent has not challenged the screenshots submitted by the Complainant and has not provided any explanation for its registration and use of the disputed domain name, incorporating the Complainants’ trademark.

The Panel finds that the above-described use did not amount to *bona fide* offering of goods or services or a legitimate non-commercial or fair use without intent for commercial gain to misleadingly divert consumers looking for the Complainants and its products.

As mentioned above, the disputed domain name is currently not resolving to an active website. The Panel shares the view held *i.a.*, in *Teachers Insurance and Annuity Association of America v. Wrecks Communications Group*, WIPO Case No. [D2006-0483](#), where the Panel found that “Absent some contrary evidence from Respondent, passive holding of a Domain Name does not constitute legitimate noncommercial or fair use”.

Furthermore, the Panel finds that the disputed domain name carries a high risk of implied affiliation. As stated in section 2.5.1 of the [WIPO Overview 3.0](#), “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”.

Therefore, the Panel finds that the Complainants have proven that the Respondent has no rights or legitimate interests in the disputed domain name according to paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires that the Complainants prove that the disputed domain name was registered and is being used by the Respondent in bad faith.

As to the bad faith at the time of the registration, the Panel notes that, in light of the prior registration and use of the Complainants’ trademark ECONOSTO in connection with the Complainants’ technical products, the Respondent, which appears to be active in the same field as it was promoting virtually identical products to those sold by the Complainants on the website to which the disputed domain name resolved, was more likely than not aware of the Complainants’ trademark.

Indeed, also in light of the fact that the Respondent has not denied knowledge of the Complainants’ trademark and that the Respondent made reference to the Complainants’ trademark ECONOSTO on the website to which the disputed domain name resolved, the Panel finds that the Respondent likely registered the disputed domain name with the Complainants’ trademark in mind.

The Panel also finds that, by pointing the disputed domain name, confusingly similar to the Complainants’ trademark ECONOSTO, to a website promoting valves under the trademark ECONOSTO and indicating that the website was operated by “Econosto Group”, without displaying any disclaimer of non-affiliation with the Complainants, the Respondent has intentionally attempted to attract Internet users to its website for commercial gain, by causing a likelihood of confusion with the trademark ECONOSTO as to the source, sponsorship, affiliation or endorsement of its website and the products promoted therein according to paragraph 4(b)(iv) of the Policy.

The disputed domain name is currently not pointed to an active website. As established in a number of prior cases the concept of “bad faith” in paragraph 4(b) of the Policy includes not only positive action but also passive holding. See *i.a.* the landmark case *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

Therefore, the Panel finds that the Complainants have also proven that the Respondent registered and is using the disputed domain name in bad faith according to paragraph 4(a)(iii) 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 <econostogroup.com> be transferred to the second Complainant ERIKS N.V..

/Luca Barbero/

Luca Barbero

Sole Panelist

Date: August 22, 2022