

## **ADMINISTRATIVE PANEL DECISION**

### **ETEX N.V, ETEX Services N.V v. Jim Wilson**

### **Case No. D2023-2754**

#### **1. The Parties**

The Complainant is ETEX N.V, Belgium, and ETEX Services N.V, Belgium, represented by BrandIT GmbH, Switzerland.

The Respondent is Jim Wilson, United States of America (“United States”).

#### **2. The Domain Name and Registrar**

The disputed domain name <etexgroup.cam> (the “Disputed Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 28, 2023. On June 28, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On June 28, 2023, 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, Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 30, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on July 4, 2023.

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 July 5, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 25, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 26, 2023.

The Center appointed Nicholas Weston as the sole panelist in this matter on August 4, 2023. 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

Both Complainants are members of the ETEX group, a global supplier founded in 1905 of lightweight construction products such as fiber cement applications, plasterboard applications, offsite modular building systems, fire protection products, and insulation. ETEX Services N.V. is a subsidiary of ETEX N.V. involved in the group's management of trademarks and domain names (for reasons set out in para 6.1, the Complainants are referred to in this decision collectively as "the Complainant").

The Complainant holds a number of registrations for the trademark ETEX in various jurisdictions including, for example: International Trademark Registration No. 652141, registered on February 1, 1996 in classes 11, 17, 19, and 25.

The Complainant owns numerous domain names that contain the trademark ETEX including <etexgroup.com> and <etexgroup.eu> which resolve to its main website.

The Respondent registered the Disputed Domain Name <etexgroup.cam> on January 16, 2023. The Disputed Domain Name resolves to an inactive webpage.

#### 5. Parties' Contentions

##### A. Complainant

The Complainants request to consolidate the Complainant parties in this proceeding on the basis that the Complainant parties have a sufficient common legal interest in the ETEX trademark included in the Disputed Domain Name to file a joint Complaint.

The Complainant cites several trademarks registrations internationally for the mark ETEX as *prima facie* evidence of ownership.

The Complainant submits that its rights in the mark ETEX predate the Respondent's registration of the Disputed Domain Name. It submits that the Disputed Domain Name is confusingly similar to its trademark, because the Disputed Domain Name incorporates in its entirety the ETEX trademark and that the confusing similarity is not removed by the addition of the word "group" or the generic Top-Level Domain ("gTLD") ".cam". It submits that "[d]ue to extensive use, advertising and revenue associated with its trademarks worldwide, the Complainant and the ETEX group enjoy a high degree of renown in many regions around the world."

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and that "[t]he Complainant has not licensed or authorized the Respondent to register or use the [D]isputed [D]omain [N]ame, nor is the Respondent affiliated to the Complainant in any form". The Complainant also submits that "There is no evidence that the Respondent is known by the [D]ispute[d] [D]omain [N]ame or owns any corresponding registered trademarks."

Finally, the Complainant alleges that the Respondent registered and is using the Disputed Domain Name in bad faith and that it "has been passively held." The Complainant further submits that "[t]he Respondent registered the [D]isputed [D]omain [N]ame to take advantage of the Complainant's widely known trademark."

## **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1 Consolidation and Common Control**

A complaint is allowed to proceed with multiple complainants against a single respondent where the parties each have standing to file a UDRP complaint. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.1 states: "Paragraph 10(e) of the UDRP Rules grants a panel the power to consolidate multiple domain name disputes. 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."

The Panel accordingly concludes that it is fair and equitable for the Complaint to proceed in the name of both of the Complainants since both Complainants have a common legal interest in the trademark rights on which the Complaint is based and it is procedurally efficient to proceed in a single Complaint.

### **6.2 Substantive Matters**

Under paragraph 4(a) of the Policy, the Complainant has the burden of proving the following:

- (i) that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (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 Complainant has produced sufficient evidence to demonstrate that it has registered trademark rights in the mark ETEX in numerous jurisdictions. The propriety of a domain name registration may be questioned by comparing it to a trademark registered in any country (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1).

Turning to whether the Disputed Domain Name is identical or confusingly similar to the ETEX trademark, the Panel observes that the Disputed Domain Name comprises: (a) the Complainant's trademark ETEX; (b) followed by the word "group"; (c) followed by the gTLD ".cam".

It is well established that the gTLD used as technical part of a domain name may be disregarded (see section 1.11.1 of the [WIPO Overview 3.0](#)). The relevant comparison to be made is with the Second-Level portion of the Disputed Domain Name, specifically: "etexgroup".

In this case, the Disputed Domain Name identically incorporates the entirety of the Complainant's trademark. It is also well-established that in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing (see [WIPO Overview 3.0](#), section 1.7).

The Panel finds that the addition of the word “group” does not avoid a finding of confusing similarity between the Disputed Domain Name and the Complainant’s trademark as the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (see [WIPO Overview 3.0](#), section 1.8).

The Panel finds that the Complainant has established paragraph 4(a)(i) of the Policy.

### **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy lists the ways that the Respondent may demonstrate rights or legitimate interests in the Disputed Domain Name. The Policy also places the burden on the Complainant to establish the absence of the Respondent’s rights or legitimate interests in the Disputed Domain Name. Because of the inherent difficulties in proving a negative, the consensus view is that the Complainant need only put forward a *prima facie* case that the Respondent lacks rights or legitimate interests. The burden of production then shifts to the Respondent to rebut that *prima facie* case (see [WIPO Overview 3.0](#), section 2.1).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because (i) the Disputed Domain Name is inactive; (ii) the Respondent has not acquired or owned any trademark or service mark rights in the name ETEX, and has not been commonly known by the name ETEX; and (iii) the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name without intent for commercial gain.

The Respondent is not using the Disputed Domain Name with legitimate interests in a domain name incorporating the Complainant’s mark, and is not commonly known by the Disputed Domain Name. The Panel accepts the Complainant’s uncontested submission that “[t]here is no evidence showing that the Respondent has been using, or preparing to use, the [D]isputed [D]omain [N]ame in connection with a *bona fide* offering of goods and services or has made a legitimate noncommercial or fair use of the [D]isputed [D]omain [N]ame”.

The composition of the Disputed Domain Name, which consists of the Complainant’s trademark and the term “group”, in this Panel’s view, carries a risk of implied affiliation with the Complainant (see [WIPO Overview 3.0](#), section 2.5.1).

The Panel finds for the Complainant on this element of the Policy.

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

The third element of the Policy requires that the Complainant must also demonstrate that the Disputed Domain Name has been registered and used in bad faith. Paragraph 4(b) of the Policy sets out certain circumstances to be construed as evidence of both of these conjunctive requirements.

The Panel finds that the evidence in the case shows the Respondent registered and has used the Disputed Domain Name in bad faith.

On the issue of registration, given the composition of the Disputed Domain Name, the Panel is satisfied that the Respondent targeted the Complainant’s trademark ETEX when it registered the Disputed Domain Name and the Panel is prepared to infer that the Respondent knew, or should have known, that its registration would be identical or confusingly similar to the Complainant’s trademark (see [WIPO Overview 3.0](#), section 3.2.2).

Further, a gap of several years between registration of a complainant’s trademark and respondent’s registration of a disputed domain name (containing the trademark) can indicate bad faith registration. In this case, the Disputed Domain Name was registered more than 26 years after the Complainant established registered trademark rights in the ETEX mark.

On the issue of use, the evidence is that the Disputed Domain Name is inactive and unconnected with any *bona fide* supply of goods or services by the Respondent. Previous UDRP panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. “While panelists 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 [WIPO Overview 3.0](#), section 3.3). This Panel notes that the evidence is that all these factors are present in this proceeding.

The Respondent’s conduct calls for an explanation, which was not forthcoming. In the absence of any countervailing evidence, this Panel accepts the Complainant’s evidence and finds that the Respondent has registered and used the Complainant’s trademark ETEX in the Disputed Domain Name, without the Complainant’s consent or authorization, for the likely purpose of capitalizing on the reputation of the trademark to infringe upon the Complainant’s rights.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of 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 <etexgroup.cam> be transferred to the Complainant, ETEX Services N.V.

*/Nicholas Weston/*

**Nicholas Weston**

Sole Panelist

Date: August 16, 2023