

ADMINISTRATIVE PANEL DECISION

Etex N.V., ETEX Services N.V v. Joe Nnela, Joe Nnela
Case No. D2023-5406

1. The Parties

The Complainants are Etex N.V, ETEX Services N.V, Belgium (the “Complainant”), represented by BrandIT GmbH, Switzerland.

The Respondent is Joe Nnela, Joe Nnela, Canada.

2. The Domain Names and Registrar

The disputed domain names, <etexigroup.com> and <etexigroup.xyz> (the “Domain Names”) are both registered with Atak Domain Hosting Internet ve Bilgi Teknolojileri Limited Sirketi d/b/a Atak Teknoloji (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 29, 2023. On January 2, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On January 3, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Names, which differed from the named Respondent (Domain Administrator) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 4, 2024, 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 January 9, 2024.

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 January 10, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 30, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 31, 2024.

The Center appointed Olga Zalomiy as the sole panelist in this matter on February 5, 2024. 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 Complainant, which is formed in 1905, and its subsidiaries form the ETEX group, a global group offering futureproof lightweight interior and exterior building solutions including fire protection and high-performance insulation. The ETEX group exports its products in Canada, where the Respondent is located.

The Complainant owns numerous trademarks ETEX registered in various jurisdictions, such as:

- The International trademark ETEX No. 652141, registered on February 1, 1996;
- The International trademark ETEX No. 1546890, registered on June 2, 2020, designating Canada;
- The United States trademark ETEX No. 6303449, registered on March 30, 2021.

The Complainant also owns numerous domain names containing the trademark ETEX, among them: <etexgroup.com> and <etexgroup.eu>. The Complainant uses these domain names to resolve to the ETEX group's official website.

The Respondent registered the Domain Names on July 21, 2023. Neither of the Domain Names resolves to an active website.

On September 18, 2023, the Complainant's representatives sent a cease-and-desist letter to the Respondent objecting, amongst other matters, to the Respondent's use of the Complainant's trademarks. The letter was also sent to the Registrar with a request that the letter is forwarded to the registrant of the Domain Names. On September 19, 2024, the Registrar communicated a response to the letter from reseller, which read as follows: "not true. my clients is planning his businesses with the said name.. the claim is not true bcos [sic] its not exactly same name. thank you". On September 21, 2023, the Complainant's representatives sent another letter to the Respondent and to the Registrar with a request that it forwarded the email to the reseller reiterating their position and requesting that the Respondent ceased use of the Domain Names. No response was received to that communication.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Names.

Notably, the Complainant contends that the Domain Names are similar to the Complainant's widely known ETEX trademarks because the Domain Names incorporate its ETEX trademark in its entirety. The Complainant argues that the addition of the term "group" and the letter "I" does not prevent finding confusing similarity because the Complainant's mark is recognizable in the Domain Names. The Complainant argues that the addition of the generic Top-Level Domains ("gTLDs") ".com" and ".xyz" should be disregarded from the confusing similarity analysis because they are a standard registration requirement.

The Complainant states that it did not license or authorize the Respondent to register or use the Domain Names. The Complainant argues that the Respondent has no rights or legitimate interests in the Domain Names because the Respondent is not commonly known by the Domain Names. Nor does he own any trademark rights in the terms "etexgroup.com", "etexgroup.xyz" or "etexgroup". The Complainant contends that the Respondent is using a privacy shield service to mask its identity, which confirms that it is not known by the Domain Names. The Complainant contends that the Respondent did not use the Domain Names in

connection with a bona fide offering of goods or services or for a legitimate noncommercial or fair use because the Domain Names are passively held.

The Complainant alleges that the Domain Names were registered in bad faith by the Respondent because the Respondent registered the Domain Names many years after the Respondent registered its widely known ETEX trademark. The Complainant contends that the structure of the Domain Names, which include its widely known trademark and the letter “i” and term “group” indicate that the Respondent registered the Domain Names with the Complainant’s trademark in mind. The Complainant alleges that the Respondent is using the Domain Names in bad faith even though the Respondent is passively holding the Domain Names because the Domain Names include the Complainant’s widely known trademark, there is no evidence of any actual or contemplated good-faith use of the Domain Names; the Respondent did not respond to the Complainant’s cease and desist letter and the Respondent was involved in typo squatting.

B. Respondent

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

6. Discussion and Findings

6.1. Procedural Issue – Consolidation of the Parties

Paragraph 10(e) of the Rules grants a panel the power to consolidate multiple domain name disputes. Multiple complainants may file a single complaint against a respondent if the complainants establish that: “(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 finds that consolidation in this case is proper. The Complainants Etex N.V. and ETEX Services N.V. filed a joint Complaint against the Respondent. The Complainants are part of the Etex Group. The Complainant Etex N.V., which is a parent company of ETEX Services N.V., owns trademark registrations in the ETEX trademark. The Complainant ETEX Services N.V. holds and manages the ETEX Group’s trademark and domain names portfolio.

The Respondent registered and is using the Domain Names, which is confusingly similar to the Complainant ETEX N.V.’s trademark. The activities of the Respondent have affected both Complainants, and they, therefore, have a common grievance against the Respondent. It is equitable and procedurally efficient to permit consolidation. Despite ample opportunity to do so, the Respondent did not object to the consolidation or indicated that it would suffer any prejudice.

6.2. Substantive Issues

Pursuant to paragraph 4(a) of the UDRP, to succeed in this proceeding, the Complainant must prove each of the following elements with respect to each of the Domain Names:

- (i) the Domain Names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the Domain Names; and
- (iii) the Domain Names have been registered and are being used in bad faith.

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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the mark is recognizable within the Domain Names. Prior UDRP panels have agreed that the addition of terms does not prevent a finding of confusing similarity. [WIPO Overview 3.0](#), section 1.8. In this case, the Domain Names include the ETEX trademark in its entirety, where the Domain Names add the letter "i" at the end of the mark and the term "group". Accordingly, the Domain Names are confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. The inclusion of the gTLDs ".com" and ".xyz" is typically disregarded in the context of the confusing similarity assessment, being a technical requirement of registration. [WIPO Overview 3.0](#), section 1.11. 1.

Although the addition of other terms here, "group" may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the Domain Names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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 Domain Names. 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 Domain Names such as those enumerated in the Policy or otherwise.

Here, there is no evidence on record that shows that the Respondent is commonly known by the Domain Names. The Respondent is not using the Domain Names in connection with bona fide offering of goods or services. Nor is the Respondent making a legitimate noncommercial or fair use of the Domain Names, because the Domain Names do not direct to any active websites.

The Panel finds 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.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In the present case, the Panel notes that the Respondent mostly likely registered the Domain Names with the Complainant's ETEX trademark in mind given that the Domain Names include the Complainant's distinctive mark, the letter "i" and the term "group", which makes the Domain Names confusingly similar to the Complainant's own domain names <etexgroup.com> and <etexgroup.eu>. Such registration indicates that the Domain Names were registered in bad faith.

Panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the Domain Names does not prevent a finding of bad faith in the circumstances of this proceeding. Although 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, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the composition of the Domain Names, the Respondent's failure to respond to submit a response with evidence of actual or contemplated good faith use, the Respondent's failure to cease use of the Domain Names following receipt of the Complainant's cease and desist letters, and the Respondent's using false contact details and finds that in the circumstances of this case the passive holding of the Domain Names does not prevent a finding of bad faith under the Policy.

The Panel 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 Domain Names <etexgroup.com> and <etexgroup.xyz> be transferred to the Complainant ETEX Services N.V.

/Olga Zalomiy/

Olga Zalomiy

Sole Panelist

Date: February 16, 2024