

ADMINISTRATIVE PANEL DECISION

ETEX N.V. and ETEX Services N.V v. Ricardo Valencia
Case No. DCO2023-0039

1. The Parties

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

The Respondent is Ricardo Valencia, Colombia.

2. The Domain Name and Registrar

The disputed domain name <etex-group.com.co> is registered with Mi.Com.Co (Central Comercializadora de Internet S.A.S) (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 18, 2023. On April 19, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 24, 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) and contact information in the Complaint.

The Center sent an email communication in English and Spanish to the parties on April 24, 2023 regarding the language of the proceeding, as the Complaint has been submitted in English and the language of the registration agreement for the disputed domain name is Spanish. The Complainant submitted a request for English to be the language of the proceeding on April 27, 2023. The Respondent did not comment on the language of the proceeding.

The Center sent an email communication to the Complainant also on April 24, 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 April 28, 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 May 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 22, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 23, 2023.

The Center appointed Miguel B. O'Farrell as the sole panelist in this matter on May 31, 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

Preliminary procedural statement on the consolidation of the Complainants

The Complainants ETEX N.V. and ETEX Services N.V. have requested the Panel to allow the consolidation of the Complainants into a single Complaint for the purpose of the present proceeding.

Both Complainants are parent companies, part of the ETEX group. ETEX Services N.V. is a subsidiary of ETEX N.V., which has registered rights in the trademark ETEX. ETEX Services N.V. is involved in the management of trademarks and domain names matters of the ETEX group.

The Panel considers that both Complainants have a common legal interest in the trademark rights upon which the Complaint is based and likewise share a specific common grievance against the Respondent.

Therefore, the Panel considers that is equitable and procedurally efficient to permit the consolidation requested by the Complainants (hereafter "the Complainant").

Language of Proceedings

Pursuant to Paragraph 11 of the Rules, unless otherwise agreed by the Parties or 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, having regard to the circumstances of the administrative proceeding.

Whilst the language of the Registration Agreement is Spanish, the Complainant filed the Complaint in English and has made a request for English to be the language of the proceeding, based on the following reasons:

Even if the Respondent is located in Colombia, the Respondent chose to register the disputed domain name <etex-group.com.co> incorporating the Complainant's ETEX trademark and the English word "group", which shows that the Respondent understands English.

Since the Complainant is based in Belgium and the Respondent seems to be located in Colombia, it would therefore be fair to the Parties that the language of the present proceeding be English, which is the language commonly used internationally.

Moreover, translating the Complaint and other documents into Spanish would entail significant additional costs to the Complainant and delay the proceedings.

The Panel tends to agree to with the Complainant and taking into consideration that the Respondent was given the opportunity to object to the language request made by the Complainant and did not do so, the Panel resolves that the language of the proceedings is English.

Factual Background

The Complainant and its subsidiaries form the ETEX group, a global group founded in 1905 and offering futureproof lightweight interior and exterior building solutions including fire protection and high performance insulation.

The Complainant owns numerous trademark registrations for ETEX as a word mark and figurative mark in many jurisdictions, including the following:

International Trademark Registration No. 652141 ETEX, registered on February 1, 1996 in classes 11, 17, 19 and 25;

International Trademark Registration No. 788905 ETEX, registered on August 28, 2002 in classes 6, 11, 17, 19, 35 and 36;

European Trademark Registration No. 017910895 ETEX, registered on March 19, 2019 in classes 2, 6, 17, 19, 35, 37 and 42 and

Colombian Trademark Registration No. 687275 ETEX, registered on July 28, 2021 in classes 6, 17 and 19.

The Complainant also owns the domain names <etexgroup.com> and <etexgroup.eu>, which resolve to websites in which the Complainant informs Internet users about its products and services.

The disputed domain name was registered on April 27, 2022, and resolves to an inactive website.

5. Parties' Contentions

A. Complainant

The Complainant was founded in 1905 and has 110 teammates in over 110 sites around the world. The Complainant has 4 sales divisions: Building Performance, Exteriors, Industry and New Ways. For over 110 years the Complainant has provided innovative products and solutions.

The Complainant, in essence, claims that the disputed domain name is confusingly similar with the trademark ETEX in which the Complainant has rights and that the Respondent has no rights or legitimate interests in the disputed domain name, which was registered and is being used in bad faith.

More specifically, the Complainant has no relationship or affiliation with the Respondent.

The Complainant has not authorized or licensed the use of the trademark ETEX to the Respondent or to register a domain name containing it.

The registration of the disputed domain name reflects the Respondent's clear intention to create an association, and subsequent likelihood of confusion, with the Complainant's trademark in Internet users mind. The Respondent registered the disputed domain name to take advantage of the Complainant's widely known trademark.

The Complainant sent a cease and desist letter to the Respondent informing of the Complainant's rights regarding the trademark ETEX, to which the Respondent did not reply.

Furthermore, active MX records are associated with the disputed domain name which means that it may be used in fraudulent email addresses. There is therefore a risk of the disputed domain name being used for fraudulent purposes, by impersonating the Complainant.

Finally, the Complainant requests the Panel to issue a decision ordering that the disputed domain name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

As set forth in section 1.7 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), the standing test for confusing similarity involves a reasoned but relatively straightforward comparison between the trademark and the disputed domain name to determine whether the disputed domain name is confusingly similar with the trademark. The test involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

The Panel considers that the disputed domain name is confusingly similar to the Complainant's ETEX trademark.

The disputed domain name incorporates the Complainant's trademark ETEX in its entirety with the addition of a dash and the term "group" which do not prevent a finding of confusing similarity. See sections 1.8 and 1.9 of the [WIPO Overview 3.0](#).

The ".com" generic Top-Level Domain, as well as the ".co" country code Top-Level Domain, are viewed as a standard registration requirement and are generally disregarded under the first element confusing similarity test, as set forth in section 1.11 of the [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the disputed domain name is confusingly similar to the trademark ETEX in which the Complainant has rights, and that the requirements of paragraph 4(a)(i) of the Policy are fulfilled.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights to or legitimate interests in a domain name by demonstrating any of the following non-exclusive defenses:

- (i) before any notice to it of the dispute, the respondent's 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) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers.

Although the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a disputed domain name, it is well established, as it is put in section 2.1 of [WIPO Overview 3.0](#), that a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name. Once such *prima facie* case is made, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

There is no evidence in the present case that the Respondent has been commonly known by the disputed domain name, enabling it to establish rights or legitimate interests therein.

Furthermore, there is no evidence in the file to prove any of the circumstances mentioned in paragraph 4(c) of the Policy, nor any other circumstances to suggest that the Respondent has rights or legitimate interests in the disputed domain name.

As established in section 2.5 of [WIPO Overview 3.0](#): “Fundamentally, a respondent’s use of a domain name will not be considered ‘fair’ if it falsely suggests affiliation with the trademark owner; the correlation between a domain name and the complainant’s mark is often central to this inquiry.” Here, the nature of the disputed domain name carries a risk of implied affiliation. See also section 2.5.1 of the [WIPO Overview 3.0](#).

The Panel finds that the Complainant has made out a *prima facie* case, a case calling for an answer from the Respondent. The Respondent has not responded and the Panel is unable to conceive of any basis upon which the Respondent could sensibly be said to have any rights or legitimate interests in respect of the disputed domain name (*Telstra Corporation Limited. v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

The Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name and that the requirements of paragraph 4(a)(ii) of the Policy have been fulfilled.

C. Registered and Used in Bad Faith

The Panel is satisfied that the Respondent must have been aware of the Complainant’s trademark ETEX mentioned in section 4 above (Factual Background) and also of the Complainant’s website “www.etexgroup.com”, when it registered the disputed domain name on April 27, 2022. By that time, the Complainant had registered and widely used the trademark ETEX for many years.

By registering the disputed domain name, the Respondent was targeting the Complainant and its business by incorporating the Complainant’s trademark ETEX in the disputed domain name in its entirety. The addition of the word “group” contributes to create confusion among Internet users, who will think that the site to which the disputed domain may resolve belongs to or is sponsored by the Complainant.

The fact that there is a clear absence of rights or legitimate interests, coupled with no credible explanation for the Respondent’s choice of the disputed domain name and the nature of the disputed domain name, are indicative of bad faith (as stated in section 3.2.1 of the [WIPO Overview 3.0](#)).

The disputed domain name does not resolve to an active webpage. Pursuant to section 3.3 of [WIPO Overview 3.0](#), the fact that the disputed domain name does not resolve to any active website does not prevent a finding of bad faith under the doctrine of “passive holding”. See also *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

The Panel finds that the Respondent registered and is using the disputed domain names in bad faith and that the requirements of paragraph 4(a)(iii) of the Policy have been fulfilled.

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 <etex-group.com.co> be transferred to the Complainant.

/Miguel B. O’Farrell/

Miguel B. O’Farrell

Sole Panelist

Date: June 7, 2023