

PANEL DECISION

Eastman Chemical Company and Eastman Chemical HTF GmbH v. Rodun International B.V.

Case No. DEU2022-0032

1. The Parties

The Complainants are Eastman Chemical Company, United States of America (“United States”) and Eastman Chemical HTF GmbH, Germany, represented by Finnegan, Henderson, Farabow, Garrett & Dunner, LLP, United States.

The Respondent is Rodun International B.V., the Netherlands.

2. The Domain Name, Registry and Registrar

The Registry of the disputed domain name <marlotherm.eu> (the “Disputed Domain Name”) is the European Registry for Internet Domains (“EURid” or the “Registry”). The Registrar of the Disputed Domain Name is AutoDNS.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 11, 2022. On October 12, 2022, the Center transmitted by email to the Registry a request for registrar verification in connection with the Disputed Domain Name. On October 13, 2022, the Registry transmitted by email to the Center its verification response, confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the .eu Alternative Dispute Resolution Rules (the “ADR Rules”) and the World Intellectual Property Organization Supplemental Rules for .eu Alternative Dispute Resolution Rules (the “Supplemental Rules”).

In accordance with the ADR Rules, Paragraph B(2), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on October 28, 2022. On the same day, the Respondent sent an email to the Center asking for clarification and stating that “There is agreement to transfer the domains (...)”. On November 11, 2022, the Center sent an email to the Parties inviting the Complainants to request a suspension of the proceedings if the Parties wish to explore settlement options. On the same day, the Complainants replied that the Parties did not reach a settlement to their dispute, but that the Respondent agreed to inform the Center that it did not object to the transfer of the Disputed Domain Name and the

domain name <marlotherm.nl> to the Complainants. The Complainants further stated that the proceedings regarding the Disputed Domain Name and the domain name <marlotherm.nl> may proceed with the understanding that the Respondent does not object to transfer. In accordance with the ADR Rules, Paragraph B(3), the due date for Response was December 9, 2022. The Respondent did not submit a compliant Response. Accordingly, the Center notified the Respondent's default on January 4, 2022.

The Center appointed Flip Jan Claude Petillion as the sole panelist in this matter on January 17, 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 ADR Rules, Paragraph B(5).

4. Factual Background

Eastman Chemical Company (the "First Complainant") is an American Fortune 500 company engaged in the global manufacture and sale of chemicals, fibers, and plastics. The First Complainant is a USD 9.3 billion business with around 14,000 global employees, more than fifty manufacturing locations, and offices around the globe serving customers in around 100 countries.

Eastman Chemical HTF GmbH (the "Second Complainant") is a wholly owned subsidiary of the First Complainant.

In April 2019, the First Complainant announced it was adding to its portfolio of specialty businesses by acquiring the Marlotherm heat transfer fluids manufacturing assets and intellectual property. "Marlotherm" is a synthetic organic heat transfer fluid used in heating and cooling in various industrial applications.

The Complainants promote their Marlotherm products and services on their "www.eastman.com" website. The Complainants use the following logo at the top of their related webpages ("the MARLOTHERM logo"):



The Complainants own *inter alia* the following trademark registrations for the sign MARLOTHERM (hereafter jointly referred to as the "MARLOTHERM mark"):

- MARLOTHERM, European Union Trade Mark No. 003491941 registered on August 30, 2005, covering goods in class 1 ("chemical products for industrial purposes; heat transfer fluids (synthetic and mineral oilbased)");
- MARLOTHERM, International trademark registration No. 286333 registered on July 13, 1964, covering goods in class 1 ("industrial chemicals");
- MARLOTHERM, United States trademark registration No. 1598020 registered on May 29, 1990, covering goods in class 1 ("chemical products used in industry, namely organic liquids for use as heat-transfer media in industry") (asserted first-use date: December 18, 1953, asserted first-use in commerce: September 7, 1983).

The Disputed Domain Name has been registered on October 7, 2019. According to the evidence provided by the Complainants, the Disputed Domain Name redirected to the domain name <marlotherm.nl>. This domain name resolved to a web page promoting products identical to the Complainants' products and mentioning the MARLOTHERM mark and logo. The Panel observes that the Disputed Domain Name still redirects to the domain name <marlotherm.nl>, but currently resolves to an error page.

5. Parties' Contentions

A. Complainant

The Complainants consider the Disputed Domain Name to be identical to a trademark in which they claim to have rights. The Complainants further claim that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. According to the Complainants, the Respondent has not been commonly known by the Disputed Domain Name and was not authorized by the Complainants to use the MARLOTHERM mark. Also, according to the Complainants, the Respondent's registration and use of a domain name that incorporates the Complainants' MARLOTHERM mark in its entirety to impersonate the Complainants and operate a website that displays the Complainants' MARLOTHERM logo does not constitute a *bona fide* offering of goods or services or fair use. The Complainants further claim that the Respondent does not satisfy the *Oki Data* criteria for resellers, as it fails to disclose its lack of relationship with the Complainants. Finally, the Complainants claim that the Disputed Domain Name was registered and is being used in bad faith. The Complainants contend that the Respondent has intentionally used the Disputed Domain Name to attract Internet users, for commercial gain to the Respondent's website or other online location, by creating a likelihood of confusion with the MARLOTHERM mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. The Complainants also claim that bad faith can be found because the Respondent registered multiple domain names using the MARLOTHERM trademark.

B. Respondent

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

6. Discussion and Findings

6.1. Preliminary Procedural Issue: Multiple Complainants

In the present case, the Complaint was filed by two separate Complainants. While the ADR Rules do not directly contemplate the consolidation of multiple complainants in a single administrative Complaint, numerous panels have found that in certain circumstances such a consolidation may be permitted.

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 (see section 4.11.1 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").¹

In the case at hand, the link between both Complainants is clear from the evidence provided. The company names of both Complainants are similar, and both Complainants own trademarks for the sign MARLOTHERM.

The Panel therefore finds that it is sufficiently established that the Complainants have a specific common grievance against the Respondent and that it would be equitable and procedurally efficient to consolidate the Complainants.

6.2. Substantive Elements of the ADR Rules

For the Complainants to succeed in their Complaint, it is required to demonstrate the following under Paragraph B(11)(d)(1) of the ADR Rules:

¹ Given the similarities between the ADR Rules and the Uniform Domain Name Dispute Resolution Policy ("UDRP") and Rules, the Panel finds UDRP precedent to be relevant to this case.

1. The Disputed Domain Name is identical or confusingly similar to a name in respect of which a right is recognized or established by national law of a Member State and/or European Union law; and either
2. The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; or
3. The Disputed Domain Name has been registered or is being used in bad faith.

The Panel finds that, on the balance of probabilities, the Complainants have established all three substantive elements of the ADR Rules. In addition, the Panel need not make extensive findings in this regard as it notes that where parties to a proceeding have not been able to settle their dispute prior to the issuance of a panel decision, but where the respondent has nevertheless given its consent on the record to the transfer (or cancellation) remedy sought by the complainant, many panels will order the requested remedy solely on the basis of such consent (see section 4.10 of the [WIPO Overview 3.0](#)).

In the present case, the Panel observes that in the context of the present case, the Respondent expressly stated that “There is agreement to transfer the domains (...)” in an email of October 28, 2022. On November 11, 2022, the Complainants indicated that the Parties did not reach a settlement to their dispute, but that the Respondent agreed to inform the Center that it did not object to the transfer of the Disputed Domain Name to the Complainants. The Complainants further stated that the proceedings regarding the Disputed Domain Name may proceed with the understanding that the Respondent does not object to transfer. The Respondent did not object to the Complainants’ statements and did not file a compliant Response. In the circumstances of this case, the Panel finds that this is sufficient to order the transfer of the Disputed Domain Name to the Complainants (see *Pierre Balmain S.A. v. Domains By Proxy, LLC / Daniel Phillips*, WIPO Case No. [D2015-0189](#)).

7. Decision

For the foregoing reasons, in accordance with Paragraph B(11) of the ADR Rules, the Panel orders that the Disputed Domain Name <marlotherm.eu> be transferred to the Second Complainant, Eastman Chemical HTF GmbH.²

/Flip Jan Claude Petillion/

Flip Jan Claude Petillion

Sole Panelist

Date: January 31, 2023

² The Complainants request the transfer of the Disputed Domain Name to the Second Complainant as the remedy for the Complaint. As the Second Complainant is established and located within the European Union, namely Germany, it satisfies the general eligibility criteria for registration of the Disputed Domain Name set out in Article 3 of Regulation (EU) 2019/517.