

## **ADMINISTRATIVE PANEL DECISION**

**Bunzl IP Holdings, LLC v. Gbvdh Oncvw, ZIhsn Rvza**  
**Case No. D2023-0375**

### **1. The Parties**

The Complainant is Bunzl IP Holdings, LLC, United States of America (“United States”), represented by Husch Blackwell LLP, United States.

The Respondents are Gbvdh Oncvw and ZIhsn Rvza, both of Hong Kong, China.

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

The disputed domain names <blackstallionsale.com> and <sassafetysale.com> are both registered with Name.com, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 27, 2023. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On January 31, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named respondent (*i.e.*, the Registrar) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 1, 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 February 3, 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 Respondents of the Complaint, and the proceedings commenced on February 9, 2023. In accordance with the Rules, paragraph 5(a), the due date for Response was March 1, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 2, 2023.

The Center appointed Matthew Kennedy, Sally M. Abel, and Pablo A. Palazzi as panelists in this matter on April 11, 2023. The Panel finds that it was properly constituted. Each member of 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 is a subsidiary of Bunzl Distribution, Inc. Two other subsidiaries of Bunzl Distribution, Inc., named Revco Industries, Inc. and SAS Safety Corp., manufacture and supply gloves, welding garments and personal protective equipment. The Complainant holds the following United States trademark registrations:

- No. 2,314,421 for BLACK STALLION and design, registered on February 1, 2000 with a claim of first use in commerce on May 5, 1986, specifying certain welders' protective clothing in class 9;
- No. 4,995,697 for BLACK STALLION, registered on July 12, 2016, with a claim of first use in commerce on July 31, 1996, specifying protective gloves for industrial use and other goods in class 9;
- No. 4,254,143 for SAS, registered on December 4, 2012, with a claim of first use in commerce in 1995, specifying goods in classes 5, 10, 11, 21, 22; and
- No. 4,398,155 for SAS, registered on September 10, 2013, with a claim of first use in commerce in 1995, specifying safety and protective devices and other goods in class 9.

The above trademark registrations remain current. Bunzl Distribution has registered the domain name <blackstallion.com> that is used in connection with a website (the "official Black Stallion website") that prominently displays a BLACK STALLION logo and offers for sale BLACK STALLION gloves and personal protective clothing. Bunzl Distribution has also registered the domain name <sassafety.com> that is used in connection with a website (the "official SAS Safety website") that prominently displays a SAS Safety Corp. logo and offers for sale SAS personal protective equipment.

The Respondent Gbvdh Oncvw is the registrant of the disputed domain name <blackstallionsale.com>, created on August 8, 2022. This disputed domain name formerly resolved to a website that displayed the BLACK STALLION mark and offered for sale personal protective clothing bearing the Complainant's BLACK STALLION and device trademark and the BLACK STALLION logo shown on the official Black Stallion website, at discount prices.

The Respondent Zlhn Rvza is the registrant of the disputed domain name <sassafetysale.com>, created on September 20, 2022. This disputed domain name formerly resolved to a website that displayed the SAS Safety Corp. logo and offered for sale personal protective equipment, including gloves that bore the SAS Safety Corp. logo, at discount prices.

At the time of this Decision, neither of the disputed domain names resolves to any active website; rather, they are both passively held.

#### **5. Parties' Contentions**

##### **A. Complainant**

The disputed domain names are confusingly similar to the Complainant's BLACK STALLION and SAS marks.

The Respondents have no rights or legitimate interests in respect of the disputed domain names. The Respondents have no rights to the Complainant's marks and are not commonly known by the disputed domain names. The Respondents are using the disputed domain names primarily for the purpose of attracting, for commercial gain, Internet users to their websites, or to otherwise make a profit on use of the Complainant's marks. Moreover, the nature of the websites associated with the disputed domain names

makes it appear as if the Complainant is selling its own goods at a lower cost.

The disputed domain names were registered and are being used in bad faith. The Respondents registered and are using the disputed domain names in bad faith to disrupt the Complainant's business and capitalize on the reputation of the Complainant's marks. The Respondents are using the disputed domain names in bad faith by attempting to attract, for commercial gain, Internet users to the Respondents' websites by creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, or endorsement of Respondents' websites and the goods offered by those websites.

## **B. Respondents**

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

## **6. Discussion and Findings**

### **6.1. Consolidation: Multiple Domain Name Registrants**

The amended Complaint initiates disputes in relation to two nominally different domain name registrants regarding two disputed domain names. The Complainant alleges that the domain name registrants are individuals acting on behalf of the same entity or are so interrelated that they may be treated as the same for the purposes of this Complaint. The Complainant in essence requests consolidation of the disputes against the two nominally different domain name registrants pursuant to paragraph 10(e) of the Rules. The disputed domain name registrants did not comment on the Complainant's request.

Paragraph 3(c) of the Rules states that a complaint may relate to more than one domain name, provided that the domain names are registered by the same domain name holder. However, the Panel does not consider that paragraph 3(c) was intended to enable a single person or entity to put a complainant to the unnecessary time, expense and effort of initiating multiple proceedings against technically different domain name registrants, particularly when each registration raises the same issues. In addressing the Complainant's request, the Panel will consider: (i) whether the disputed domain names or associated websites are subject to common control; and, if so, (ii) whether the consolidation would be fair and equitable to all Parties. See *Speedo Holdings B.V. v. Programmer, Miss Kathy Beckerson, John Smitt, Matthew Simmons*, WIPO Case No. [D2010-0281](#) and WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.2.

As regards common control, the Panel notes that the disputed domain names were created within a relatively short space of time, they are registered with the same Registrar, and they follow a pattern in that each incorporates a trademark belonging to the Complainant and the word "sale", with other elements. According to information from the Registrar's Whois database, the registrants share the same contact telephone number and their contact street addresses are in the same building (albeit on different levels). In these circumstances, the Panel is persuaded that the disputed domain names or the associated websites, or both, are under common control.

As regards fairness and equity, the Panel sees no reason why consolidation of the disputes regarding both disputed domain names would be unfair or inequitable to any Party.

Accordingly, the Panel decides to consolidate the complaint regarding the two disputed domain names and will refer to the Respondents below separately and collectively as the "Respondent".

### **6.2 Substantive Issues**

Paragraph 4(a) of the Policy provides that the Complainant must prove each of the following elements with respect to each disputed domain name:

- (i) the disputed domain name is 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 disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The burden of proof of each element is borne by the Complainant. The Respondent's default does not by itself mean that the Complainant is deemed to have prevailed. See [WIPO Overview 3.0](#), section 4.3.

#### **A. Identical or Confusingly Similar**

Based on the evidence presented, the Panel finds that the Complainant has rights in the BLACK STALLION and SAS marks.

The disputed domain name <blackstallionsale.com> wholly incorporates the BLACK STALLION mark as its initial element. The disputed domain name <sassafetysale.com> wholly incorporates the SAS mark as its initial element. The disputed domain name <sassafetysale.com> also incorporates the word "safety" and both disputed domain names add the word "sale". However, the addition of this word or these words does not avoid a finding of confusing similarity because the Complainant's marks remain clearly recognizable within the disputed domain names. See [WIPO Overview 3.0](#), section 1.8.

The only additional element in the disputed domain names is a generic Top-Level Domain ("gTLD") extension (".com"). As a standard requirement of domain name registration, this element may be disregarded in the comparison with a mark for the purposes of the first element of paragraph 4(a) of the Policy unless it has some impact beyond its technical function, which is not the case here. See [WIPO Overview 3.0](#), section 1.11.

For the above reasons, the Panel finds that the disputed domain names are each confusingly similar to a trademark in which the Complainant has rights. The Complainant has satisfied the first condition in paragraph 4(a) of the Policy.

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

Paragraph 4(c) of the Policy sets out the following circumstances which, without limitation, if found by the Panel, shall demonstrate that the Respondent has rights to, or legitimate interests in, a disputed domain name, for the purposes of paragraph 4(a)(ii) of the Policy:

- (i) before any notice to [the respondent] of the dispute, [the respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or
- (ii) [the respondent] (as an individual, business, or other organization) [has] been commonly known by the [disputed] domain name, even if [the respondent has] acquired no trademark or service mark rights; or
- (iii) [the respondent is] making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

With respect to the first circumstance set out above, the disputed domain name <blackstallionsale.com> formerly resolved to a website that displayed the Complainant's BLACK STALLION mark and offered for sale what were purported to be genuine BLACK STALLION products, while the disputed domain name <sassafetysale.com> formerly resolved to a website that displayed the Complainant's SAS mark and the logo of the Complainant's related company, SAS Safety Corp., and offered for sale what were purported to be genuine SAS Safety Corp. products. It is clear from the Complaint that the Respondent has no license or authorization from the Complainant to use its trademarks. Regardless of whether the products offered for

sale on the Respondent's websites were genuine or counterfeit, the websites did not display a disclaimer clarifying the lack of relationship between the Respondent, on one hand, and the Complainant and its related companies, on the other hand. Rather, the websites gave the false impression that they were operated by the Complainant's related companies. The disputed domain names are now passively held. These circumstances indicate that the disputed domain names are not being used in connection with a *bona fide* offering of goods or services. See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

With regard to the second circumstance set out above, the Respondent is identified in the Registrar's Whois database as "Gbvdh Oncvw" and "Zlhn Rvza", not the disputed domain names. Even if these names are false, nothing on the record indicates that the Respondent has been commonly known by the disputed domain names.

With regard to the third circumstance set out above, the disputed domain names resolved to commercial websites. That was not a legitimate noncommercial or fair use of the disputed domain names.

In summary, the Panel considers that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Respondent failed to rebut that *prima facie* case because it did not respond to the Complaint.

Therefore, based on the record of this proceeding, the Complainant has satisfied the second element in paragraph 4(a) of the Policy.

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

Paragraph 4(b) of the Policy provides that certain circumstances, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The fourth circumstance is as follows:

(iv) by using the [disputed] domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent's] website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] website or location or of a product or service on [the respondent's] website or location.

As regards registration, the disputed domain names were registered in 2022, years after the registration of the Complainant's BLACK STALLION and SAS marks. Each disputed domain name incorporates one of those marks as its initial element, with the addition of a dictionary word or words. The website associated with the disputed domain name <blackstallionsale.com> displayed the same BLACK STALLION logo as the official Black Stallion website and images of products bearing that logo or the Complainant's BLACK STALLION and device mark. The website associated with the disputed domain name <sassafetysale.com> displayed the SAS Safety Corp. logo from the official SAS Safety website. In view of these circumstances, the Panel has reason to find that the Respondent had the Complainant's BLACK STALLION and SAS marks in mind when it registered the disputed domain names.

As regards use, the disputed domain names resolved to websites that displayed the Complainant's trademarks, were falsely presented as the websites of the Complainant's related companies, and offered for sale what were purported to be the products of those companies. Given these circumstances and the findings in Section 6.2B above, the Panel considers that by using the disputed domain names, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its websites, by creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation, or endorsement of its websites and products on those websites within the terms of paragraph 4(b)(iv) of the Policy.

The Panel notes that the use of the disputed domain names has now changed and that they no longer resolve to any active website. This change in use does not alter the Panel's conclusion; if anything, it may be a further indication of bad faith.

Therefore, the Panel finds that the disputed domain names have been registered and are being used in bad faith. The Complainant has satisfied the third element in paragraph 4(a) 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 names <blackstallionsale.com> and <sassafetysale.com> be transferred to the Complainant.

*/Matthew Kennedy/*

**Matthew Kennedy**

Presiding Panelist

*/Sally M. Abel/*

**Sally M. Abel**

Panelist

*/Pablo A. Palazzi/*

**Pablo A. Palazzi**

Panelist

Date: April 21, 2023