

ADMINISTRATIVE PANEL DECISION

Kingspan Holdings (IRL) Limited v. CATCHDADDY LLC
Case No. D2024-0154

1. The Parties

The Complainant is Kingspan Holdings (IRL) Limited, Ireland, represented by Tomkins & Co., Ireland.

The Respondent is CATCHDADDY LLC, United States of America.

2. The Domain Name and Registrar

The disputed domain name <bacacierbykingspan.com> is registered with Dynadot Inc (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on January 15, 2024. On January 16, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 17, 2024, 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 to the Complainant on January 18, 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 the same day.

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 31, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 20, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 22, 2024.

The Center appointed Federica Togo as the sole panelist in this matter on February 28, 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

It results from the Complainant's undisputed allegations that the Kingspan Group, of which the Complainant forms part, is a building materials company founded in 1966 and based in Ireland. The Group trades in over 80 countries with more than 210 factories employing over 22,000 people. The Group is an international leader in the building industry and operates with six divisions: insulated panels, insulation, light and air, water and energy, data and flooring, and roofing and waterproofing. In 2020, the Complainant acquired a majority interest in the French company Groupe Bacacier, which is specialized in steel processing services for the production of metal goods for roofing, coverings, facades, cladding, flooring and structures.

The Complainant is the registered owner of many trademarks for BACACIER BY KINGSPAN, e.g. European Union trademark registration no. 018834876, BACACIER BY KINGSPAN (word) filed on February 10, 2023, and registered on August 15, 2023 for goods and services in the classes 6, 17, 19 and 37.

In addition, the Complainant uses the following domain names <bacacierbykingspan.co.uk>, <bacacierbykingspan.es>, <bacacierbykingspan.fr>, and <bacacierbykingspan.it>, which resolves to the official website at "www.bacacier.com", in order to promote its products.

The disputed domain name <bacacierbykingspan.com> was registered on February 10, 2023. Furthermore, the undisputed evidence provided by the Complainant proves that the disputed domain name resolved to a parked page and is offered for sale. The disputed domain name is listed as being for sale for USD 4,995.

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 disputed domain name.

Notably, the Complainant contends that the disputed domain name is identical to the Complainant's BACACIER BY KINGSPAN trademark since it consists exclusively of the Complainant's registered trademark with no additions or alterations whatsoever.

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain name. According to the Complainant, the Respondent, or any other third party, has not received authorisation from the Complainant to use its trademark, the Respondent is not commonly known by the disputed domain name, nor is affiliated with the Complainant, the Respondent is neither a licensee or an authorised agent of the Complainant.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. According to the Complainant, the Respondent registered the disputed domain name on the same date of application of three of the Complainant's BACACIER BY KINGSPAN trademarks. The application of its trademarks effectively provided constructive notice to the Respondent of the Complainant's rights at the time the disputed domain name was created. The Complainant's application to register its trademarks was the sole reason why the Respondent elected to register the disputed domain name on the same day.

The Respondent's sale offer on its website is directly aimed at the Complainant and the Respondent registered the disputed domain name for sale to the Complainant or to a competitor of the Complainant for an amount likely in excess of the Respondent's out-of-pocket costs.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to “decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”. Paragraph 4(a) of the Policy requires a complainant to prove each of the following three elements in order to obtain an order that each disputed domain name be transferred or cancelled:

- (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 Panel will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

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 entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Finally, the generic Top-Level Domain (“gTLD”) “.com” of the disputed domain name may be disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#) at section 1.11.1.

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 disputed domain name. 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 disputed domain name such as those enumerated in the Policy or otherwise.

Moreover, the Panel notes that the nature of the disputed domain name carries a high risk of implied affiliation, since the disputed domain name is identical to the Complainant's trademark BACACIER BY KINGSPAN and that the trademark BACACIER BY KINGSPAN is not a combination of terms that one would legitimately adopt as a domain name unless to suggest an affiliation with the Complainant. Generally speaking, previous UDRP panels have found that domain names identical to a complainant's trademark carry a high risk of implied affiliation (see [WIPO Overview 3.0](#), at section 2.5.1). The Panel shares this view.

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.

One of these circumstances is that the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name to the Complainant who is the owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the disputed domain name (paragraph 4(b)(i) of the Policy).

In the present case, the Panel notes that the Respondent has actually registered the disputed domain name primarily for the purpose of selling it either to the Complainant or to third persons, in particular to one of the Complainant's competitors, for valuable consideration in excess of the documented out-of-pocket costs directly related to the disputed domain name. According to the Complainant's uncontested allegations, the Respondent has offered the disputed domain name for sale on the domain marketplace DAN. The disputed domain name is listed as being for sale for USD 4,995. This Panel finds that this sum is likely in excess of any out-of-pocket costs directly related to the disputed domain name (see e.g. *Tosara Pharma Limited v. Super Privacy Service LTD c/o Dynadot / zuhal topuz*, WIPO Case No. [D2021-4062](#)).

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. On this regard, the further circumstances surrounding the disputed domain name's registration and use confirm the findings that the Respondent has registered and is using the disputed domain name in bad faith:

(i) the nature of the disputed domain name (i.e., a domain name identical to the Complainant's mark, which seemed to result of the combination of the BACACIER and KINGSPAN marks);

(ii) the timing and circumstances of the registration (i.e. on the same date of application as three of the Complainant's BACACIER BY KINGSPAN trademark registrations, and years after the Complainant acquired a majority interest in the French company Groupe Bacacier); and

(iii) a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the disputed domain name.

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 disputed domain name, <bacacierbykingspan.com>, be transferred to the Complainant.

/Federica Togo/

Federica Togo

Sole Panelist

Date: March 13, 2024