

ADMINISTRATIVE PANEL DECISION

Tecta America Corp. v. JAMEEL KHAN

Case No. D2024-2774

1. The Parties

The Complainant is Tecta America Corp., United States of America (“United States”), represented by Quarles & Brady LLP, United States of America.

The Respondent is JAMEEL KHAN, United Kingdom.

2. The Domain Name and Registrar

The disputed domain name <tectaamericametro.com> (the “Disputed Domain Name”) is registered with 123-Reg Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 8, 2024. On July 9, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On July 12, 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 (Registration Private, Domains by Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 16, 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 July 19, 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 July 25, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 14, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 16, 2024.

On August 27, 2024, the Center resent the Notification of Complaint to one of Respondent's email that, due to an administrative error, had been excluded from the Notification of Complaint emails. The Center granted the Respondent five days until September 1, 2024, to indicate whether it wishes to participate to this proceeding. On August 29, 2024, and September 11, 2024, the Respondent, sent email communications to the Center, using the email that was not missed in the initial Notification of Complaint.

The Center appointed Nicholas Weston as the sole panelist in this matter on September 11, 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 operates a roofing business with over 4,400 roofing professionals and 97 locations in the United States. The Complainant holds a number of registrations for the trademark TECTA AMERICA, including United States Registration No. 2,635,876, registered on October 15, 2002.

The Complainant's domain name <tectaamerica.com>, registered in August 1999, hosts its main website.

The Disputed Domain Name was registered on June 11, 2024. The Disputed Domain Name resolves to a webpage that is identical in many respects to that of the Complainant's and displays the Complainant's logo.

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 cites its trademark registration in the United States for the mark TECTA AMERICA, as prima facie evidence of ownership.

The Complainant submits that its rights in the TECTA AMERICA mark predate the Respondent's registration of the Disputed Domain Name. It submits that the Disputed Domain Name is confusingly similar to its trademark, because the Disputed Domain Name is comprised of the TECTA AMERICA trademark and that the addition of the word "metro" is not sufficient to avoid the confusing similarity to its trademark.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and that "Complainant is not affiliated with Respondent and has not licensed or otherwise permitted Respondent to use its TECTA AMERICA Mark as a domain name or in source identifying fashion." It submits that the Respondent's use of the Complainant's trademark "in connection with services identical to Complainant's own" do not confer rights or legitimate interests in the Disputed Domain Name.

Finally, the Complainant alleges that the registration and use of the Disputed Domain Name was, and currently is, in bad faith, contrary to the Policy and the Rules having regard to the prior use and substantial reputation of the Complainant's trademark. The Complainant also submits that the "Respondent's bad faith is further demonstrated by the way it holds itself out as being Complainant by using the TECTA AMERICA Logo in connection with its website and displaying text taken directly from Complainant's website."

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant has the burden of proving the following:

- (i) that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (iii) that the Disputed Domain Name has been registered and is 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. The requirements of the first element for purposes of the Policy may be satisfied by a trademark registered in any country. [WIPO Overview 3.0](#), section 1.2.1. The Complainant has produced sufficient evidence to demonstrate that it has registered trademark rights in the mark TECTA AMERICA in numerous countries.

Turning to whether the Disputed Domain Name is identical or confusingly similar to the TECTA AMERICA trademark, the Panel observes that the Disputed Domain Name is comprised of: (a) an exact reproduction of the Complainant's trademark TECTA AMERICA; (b) followed by the word "metro"; (c) followed by the generic Top-Level Domain ("gTLD") ".com".

It is well established that the gTLD used as part of a domain name is generally disregarded under the first element of confusing similarity test. [WIPO Overview 3.0](#), section 1.11. The relevant comparison to be made is with the second-level portion of the Disputed Domain Name, specifically: "tectamericametro".

The Panel finds the entirety of the mark TECTA AMERICA is reproduced within the Disputed Domain Name. Accordingly, the Disputed Domain Name is confusingly similar to the marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of the word "metro" 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 Disputed Domain Name 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 Disputed 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.

The Panel notes the evidence that the Disputed Domain Name resolves to a webpage that prominently displays the Complainant's trademark and artwork, and purports to offer the same roofing services using the Complainant's branding and content, without any disclaimer disclosing the lack of relationship between the Parties. The Panel finds that this use does not represent a bona fide offering of goods or services, or a legitimate noncommercial or fair use, given the substantial reputation and goodwill of the Complainant's mark in the United States and has the capacity to otherwise mislead Internet users.

Panels have held that the use of a domain name for illegal activity here, claimed impersonation or passing off, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

The Panel also notes that the Disputed Domain Name contains the word "metro", suggesting that the Respondent seeks to impersonate the Complainant in a targeted way. The Panel finds that that this creates the false impression that the Respondent's website is related to, authorized by, or affiliated with the Complainant, particularly considering the nature of the national business the Complainant is engaged in.

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 finds that the evidence in the case shows the Respondent registered and has used the Disputed Domain Name in bad faith.

On the issue of registration, taking into account the composition of the Disputed Domain Name and the Evidence demonstrating a national reputation in the United States, of the Complainant's trademark, the Panel is satisfied that the Respondent knew of and targeted the Complainant's trademark TECTA AMERICA when it registered the Disputed Domain Name.

This Panel finds that there is no reason for the Respondent to have registered the Disputed Domain Name other than to target the reputation and goodwill of the Complainant's distinctive trademark. [WIPO Overview 3.0](#), section 3.1.4.

Further, a gap of several years between registration of a complainant's trademark and the respondent's registration of a disputed domain name (containing the trademark) can indicate bad faith registration. In this case, the Respondent registered the Disputed Domain Name nearly 25 years after the Complainant established registered trademark rights in the TECTA AMERICA mark.

On the issue of use, the Complainant's evidence is that the Disputed Domain Name resolves to a webpage that offers the same roofing services to those supplied by the Complainant, using the Complainant's trademark, branding, artwork and content. Targeting of this nature is a common example of bad faith as referred to in paragraphs 4(b)(iii) and 4(b)(iv) of the Policy and identified in many previous UDRP decisions. [WIPO Overview 3.0](#), sections 3.1.3, 3.1.4 and 3.2.1.

Panels have held that the use of a domain name for illegal activity here, claimed impersonation and passing off constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the Disputed Domain Name constitutes 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 Disputed Domain Name <tectaamericametro.com> be transferred to the Complainant.

/Nicholas Weston/

Nicholas Weston

Sole Panelist

Date: September 19, 2024.