

## **ADMINISTRATIVE PANEL DECISION**

ABG Volcom LLC v. Shuzhen Liu

Case No. D2023-0386

### **1. The Parties**

The Complainant is ABG Volcom LLC, United States of America (“United States”), represented by Authentic Brands Group, United States.

The Respondent is Shuzhen Liu, China

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

The disputed domain name <volcomstoreonlinout.com> is 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 January 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 31, 2023, the Registrar 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 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 February 8, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 28, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 1, 2023.

The Center appointed Manuel Moreno-Torres as the sole panelist in this matter on March 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 Rules, paragraph 7.

#### **4. Factual Background**

The Complainant is a United States company founded in 1991. The Complainant is the owner of the VOLCOM trademark and holds more than 350 trademarks registrations worldwide. By way of example United States Patent and Trademark Office with registration number 1725875 and registered on October 20, 1992.

The Respondent registered the disputed domain name on December 20, 2021, and redirects to a website having a similar appearance to the Complainant's website allegedly offering discounted products marked and branded as VOLCOM and displaying the Complainant's trademarks and logos.

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

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

The Complainant asserts that the disputed domain name consists of its VOLCOM trademark followed by the descriptive term "store" and what seems to be the misspelling of the descriptive terms "online outlet". Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. Accordingly, the disputed domain name is identical or confusingly similar to the Complainant's registered trademarks.

With regard to the second requirement, the Complainant alleges that the Respondent has not been licensed, contracted or otherwise permitted by the Complainant in any way to use the VOLCOM or Stone Logo trademark or to apply for any domain name incorporating the VOLCOM trademark, nor has the Complainant acquiesced in any way to such use or application of the VOLCOM trademark by the Respondent.

The Respondent has not been commonly known by the disputed domain name.

The Complainant asserts that the Respondent is not making a legitimate non-commercial or fair use of the disputed domain name. Additionally, there is no evidence that the Respondent is using or plans to use the VOLCOM trademark or the disputed domain name incorporating the VOLCOM trademark for a *bona fide* offering of goods or services. On the contrary, the Respondent has been actively using the VOLCOM trademarks in the disputed domain name as well on the website to promote its website for illegitimate commercial gains. Such unauthorized use of the VOLCOM trademarks is likely to trick consumers into erroneously believing that the Complainant is somehow affiliated with Respondent or endorsing its commercial activities, while in fact, no such relationship exists.

The Complainant's trademarks are well-known around the world. Thus, the Respondent was well aware of Complainant's trademark at the time the Respondent registered the disputed domain name.

About the use of the disputed domain name, the Complainant contends that the Respondent is trying to pass off the domain as the Complainant's website to sell competing and unauthorized goods. However, the Respondent has no reason to use the mark in the disputed domain name other than to attract Internet users to its site for commercial gain. Therefore, the Respondent is intentionally trying to create a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement.

##### **B. Respondent**

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

## 6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed the Complainant must satisfy the Panel that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

There are no exceptional circumstances within paragraph 5(f) of the Rules to prevent the Panel from determining the dispute based upon the Complaint, notwithstanding the failure of the Respondent to file a Response. Under paragraph 14(a) of the Rules in the event of such a “default” the Panel is still required “to proceed with a decision on the complaint”, whilst under paragraph 14(b) it “shall draw such inferences there from as it considers appropriate”. This dispute resolution procedure is accepted by the domain name registrant as a condition of registration.

### A. Identical or Confusingly Similar

As set out above, the Complainant has demonstrated trademarks rights over VOLCOM for purposes of the Policy, paragraph 4(a)(i).

The first requirement 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. Indeed, VOLCOM is clearly recognizable within the disputed domain and the additional terms do not prevent a finding of confusing similarity under the first element, disregarding the generic Top-Level Domain “.com”. The Panel also refers to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) section 1.8 to conclude that the additional words, “storeonlinout”, that said “store”, “onlin” and “out” do not prevent a finding of confusingly similarity under the first element. See also *Wachovia Corporation v. Peter Carrington*, WIPO Case No. [D2002-0775](#).

Accordingly, the first requirement of the Policy is met.

### B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out non-exclusive examples in which the Respondent may establish rights or legitimate interests in the disputed domain name, by demonstrating any of the following:

- (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) that 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 or to tarnish the trademark or service mark at issue.

The Panel finds that the above considerations do not apply for the Respondent. The Panel has visited the website to which the disputed domain name directs and finds that the Respondent is impersonating or at very least falsely suggesting affiliation with the Complainant when there is no authorization to use the Complainant’s trademark in any manner. Namely, by reproducing the Complainant’s trademark in the disputed domain name, by reproducing its logo in its website and by offering products like those of the Complainant, the Respondent is giving the false impression of being the Complainant or someone affiliated.

Indeed, in the “terms and conditions” of the website to which the disputed domain name directs the Respondent claims to be “Volcom Fashion Store”.

The Panel finds that the Respondent has targeted the Complainant and is using the Complainant’s trademark rights to misleadingly divert Internet users to its website. Therefore, there is no *bona fide* offering of services. To this regard, the Panel notes that the disputed domain name resolves to a website offering the Complainant’s products and the Respondent might be considered a reseller. However, the Respondent does not meet the criteria established in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#), that said, and by way of example, the site does not accurately and prominently disclose the Respondent’s relationship with the Complainant.

Besides there is no evidence in the records as the Respondent to be commonly known by the disputed domain name neither that the Respondent is making a legitimate noncommercial or fair use of the domain name since there is clear commercial purpose.

Under these circumstances the Panel finds that the Complainant has established a clear *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. The Panel also notes the silence and lack of rebuttal in the Respondent.

Therefore, the second requirement under paragraph 4(a)(ii) of the Policy is met to the satisfaction of the Panel.

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

Paragraph 4(a)(iii) of the Policy provides that the Complainant must establish that the Respondent registered and subsequently used the disputed domain name in bad faith.

As noted above, in the Panel’s view the Respondent targeted the Complainant and its well-known VOLCOM trademark. Indeed, the subsequent use of the disputed domain name in a website that mimics Complainant’s site, reproduces its trademark logo and intends to impersonate the Complainant allows the Panel to conclude that, on balance, the Respondent knew or should have known about the Complainant and its trademark at the moment of the registration of the disputed domain name.

The Panel also looks at [WIPO Overview 3.0](#) section 3.1.1. for circumstances indicating bad faith registration: “... the nature of the domain name (e.g., whether a typo of a famous mark, a domain name wholly incorporating the relevant mark plus a geographic term or one related to the complainant’s area of commercial activity, or a pure dictionary term) and the distinctiveness of trademark at issue, among other factors, are relevant to this inquiry” and concludes that the disputed domain name falls within what is deemed to be considered bad faith registration.

Considering the use of the disputed domain the Panel finds that the circumstances of the case matches with paragraph 4(b)(iv) of the Policy: “by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location”. As set out, the Respondent uses the Complainant’s VOLCOM trademark with no authorization both in the disputed domain name and in the website to which it resolves. Besides, there is an implied confusion about who is in charge of the site and clearly the Respondent is using the Complainant’s trademark in the disputed domain name to “bait and switch” consumers. In short, the use of the disputed domain name is in bad faith. See *Calvin Klein Trademark Trust and Calvin Klein, Inc. v. rafel bueno de costa*, WIPO Case No. [D2022-3681](#).

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(iii) 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 <volcomstoreonlinout.com> be cancelled.

/Manuel Moreno-Torres/

**Manuel Moreno-Torres**

Sole Panelist

Date: March 31, 2023