

## **ADMINISTRATIVE PANEL DECISION**

ABG Volcom, LLC v. Whois Agent, Domain Protection Services, Inc. / Zexian Chang

Case No. D2022-0265

### **1. The Parties**

Complainant is ABG Volcom, LLC, United States of America (“United States”), represented by Bridgette Fitzpatrick, United States.

Respondent is Whois Agent, Domain Protection Services, Inc., United States / Zexian Chang, China.

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

The disputed domain name <volconline.com> is registered with Name.com, Inc. (Name.com LLC) (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 26, 2022. On January 27, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 27, 2022, 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 and contact information in the Complaint. The Center sent an email communication to Complainant on January 28, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on January 28, 2022.

The Center verified that the Complaint together with the amendment to 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 Respondent of the Complaint, and the proceedings commenced on January 31, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 20, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on February 21, 2022.

The Center appointed David Perkins as the sole panelist in this matter on February 24, 2022. 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

##### 4.1 Complainant

4.1.1 Complainant was founded in 1991 as a board sports-riding company. The Complaint states that it has one of the best surfing, skateboarding, and snowboarding teams in the world and has over 234 million fans on social media.

4.1.2 Under the VOLCOM brand Complainant sells a range of men's, women's, and children's apparel, outerwear, swimwear, footwear, and accessories. The Complaint states that its products are sold in 100,000 points of sale spread across more than 60 countries.

4.1.3 A selection of those products is illustrated on Complainant's website at "www.volcom.com", a screenshot of which is annexed to the Complaint.

4.1.4 The Complaint states that the VOLCOM brand is supported by a global trade mark portfolio of more than 350 filings. These include the word mark VOLCOM, the Volcom stone logo, and the VOLCOM & stone logo mark. Exhibited to the Complaint are the following United States registrations of the VOLCOM word mark:

Jurisdiction	Registration	Mark	Classes of Goods	Dates of Application and Registration
United States	1,725,875	VOLCOM	25	Filed: February 21, 1992 Registered: October 20, 1992
United States	2,534,210	VOLCOM	25	Filed: June 8, 2001 Registered: January 29, 2002
United States	2,689,830	VOLCOM	9, 16 & 18	Filed: September 20, 2000 Registered: February 25, 2003

4.1.5 A cease and desist letter dated January 4, 2022 was sent to Respondent through the Registrar at the email address listed in the Whois information. No reply was received.

##### 4.2 Respondent

4.2.1 In the absence of a Reply, what is known of Respondent is contained in the Complaint and its Annexes.

4.2.2 The disputed domain name was registered on December 7, 2020.

4.2.3 The disputed domain name resolves to a website, which Complainant says mirrors its own website. This is illustrated in a screenshot of Respondent's website, which is annexed to the Complaint (Annex 7). It depicts what Complainant asserts are counterfeit men's and women's clothing branded with the VOLCOM and VOLCOM & stone logo marks.

## 5. Parties' Contentions

### 5.A Complainant

#### 5.A.1 Identical or Confusingly Similar.

5.A.1.1 Citing *Intercontinental Holdings, Inc. v. Yin Lei*, WIPO Case No. [D2021-1395](#), Complainant's case is that the addition to Complainant's trade mark of other terms that describe or refer to part of Complainant's business does not eliminate the confusing similarity of the disputed domain name from Complainant's trade mark.

5.A.1.2 Citing three additional decisions under the Policy - *Rakuten, Inc. v. Domain Admin, Privacy Protect, LLC (PrivacyProtect.org) / Matthew Connor, No Company*, WIPO Case No. [D2019-2983](#) (disputed domain name <travelrakutenmexico.com> versus Complainant's RAKUTEN registered trade mark); *Advance Magazine Publishers Inc. v Marcellod Russo*, WIPO Case No. [D2001-1049](#) (disputed domain name <vogueaustralia.com> versus Complainant's VOGUE registered trade mark); and *Yahoo! Inc. v. Microbiz, Inc.*, WIPO Case No. [D2000-1050](#) (disputed domain name <yahooflorida.com> versus Complainant's YAHOO registered trade mark) – Complainant's case is that the addition of misspelled words does not prevent a finding of confusing similarity.

5.A.1.3 Further, Complainant characterises this as a form of typosquatting. The form taken in this case is substituting the letter "m" in the VOLCOM trade mark by "n" to "volcon", which Complainant says is phonetically, virtually identical. Complainant points to cases under the Policy finding confusing similarity where some letters have been interchanged or replaced with a phonetically similar letter. See *Neuberger Bergman, Inc v Alfred Jacobsen*, WIPO Case No. [D2000-0323](#) (<newbergerberman.com> versus Complainant's Neuberger Bergman trade mark); *Playboy Enterprises v. Movie Name Company et al*, WIPO Case No. [D2001-1201](#) (disputed domain names including <playbychannel.com>, <playbooy.com>, and <pelayboy.com> versus Complainant's PLAYBOY trade mark); and *Yahoo! Inc. v. Data Art Corp. et al*, WIPO Case No. [D2000-0587](#) (disputed domain names including <yahoo.com> and <myhoo.com> versus Complainant's YAHOO and MY YAHOO trade marks).

#### 5.A.2 Rights or Legitimate Interests.

5.A.2.1 First, Complainant says that it has not licensed or otherwise authorised use by Respondent of its VOLCOM trade mark.

5.A.2.2 Second, Complainant says that there is no evidence that Respondent can demonstrate rights to or legitimate interests in the disputed domain name under any of the circumstances set out in paragraph 4(c)(i) to (iii) of the Policy. On the contrary, Complainant points to Respondent actively using the VOLCOM trade mark in the disputed domain name and on its physical website to promote that website for commercial gain. This, Complainant says, is likely to trick consumers into erroneously believing that Complainant is somehow affiliated with Respondent or endorsing its commercial activities, while, in fact, no such relationship exists.

#### 5.A.3 Registered and Used in Bad Faith.

5.A.3.1 First, as noted in paragraph 5.A.1.3 above, Complainant asserts that this is a case of typosquatting.

5.A.3.2 Second, Complainant says that Respondent must have been well aware of the well-known VOLCOM trade mark, when registering the disputed domain name almost 30 years after Complainant obtained its first VOLCOM registered trade mark.

5.A.3.3 Third, Complainant says that Respondent's failure to respond to Complainant's cease and desist letter (4.1.5 above) and its continued use of the disputed domain name after that letter are evidence of Respondent's bad faith.

5.A.3.4 Fourth, Complainant points to Respondent selling counterfeit VOLCOM goods through a website that mirrors the Complainant's official website (paragraph 4.2.3 above). Complainant cites in that respect a number of cases under the Policy including the decision in *Balenciaga v liu zhixian*, WIPO Case No. D2010-1831. The disputed domain name in that case was held to have been registered and used in bad faith where Respondent was selling counterfeit handbags. Such conduct, Complainant says, is blatant cybersquatting.

5.A.3.5 Fifth, Complainant points to Respondent using a privacy shield as further indication of bad faith citing numerous cases under the Policy in support.

## **5.B Respondent**

5.B.1 As noted, no Reply has been submitted by Respondent.

## **6. Discussion and Findings**

6.1 The Policy paragraph 4(a) provides that Complainant must prove each of the following in order to succeed in an administrative proceeding

- (i) that the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) that 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.

6.2 The Policy paragraph 4(c) sets out circumstances which, in particular but without limitation, if found by the Panel to be proved shall demonstrate Respondent's rights or legitimate interests in the disputed domain name in issue.

6.3 The Policy paragraph 4(b) sets out circumstances which, again in particular but without limitation, if found by the Panel to be present shall be evidence of the registration and use of a domain name in bad faith.

6.4 As stated, the circumstances set out in paragraph 4(b) and 4(c) of the Policy are not exclusionary. They are without limitation. That is, the Policy expressly recognizes that other circumstances can be evidence relevant the requirements of paragraphs 4(a)(ii) and (iii) of the Policy.

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

6.A.1 It is indisputable that Complainant has rights in the registered VOLCOM trade mark, examples of which are set out in paragraph 4.1.4 above.

6.A.2 In this case, the disputed domain name substitutes the letter "n" for "m" in the VOLCOM trade mark, and adds the term "line". The VOLCOM trade mark remains sufficiently recognisable in the dispute domain name despite the single letter substitution, and the additional term does not prevent a finding of confusing similarity. Therefore, the disputed domain name is in the Panel's view, confusingly similar to that trade mark.

6.A.3 Accordingly, the Complaint meets the requirements of paragraph 4(a)(i) of the Policy.

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

6.B.1 Complainant's case summarised in paragraph 5.A.2 is well made out. In this regard, Complainant claims that Respondent is offering counterfeit goods on its website, which the Panel notes could never confer rights or legitimate interests on Respondent. The Panel notes that the products on the disputed

domain name are offered disproportionately below market value, which supports Complainant's contentions of illegal activity. Furthermore, the Panel finds that, irrespective of the nature of the goods being offered, Respondent's use of a website that mirrors the Complainant's website without any explanation regarding the lack of relationship between Respondent and Complainant does not constitute a *bona fide* or fair use. Lastly, there is nothing to demonstrate that Respondent could demonstrate rights to or legitimate interests in the disputed domain name under any of the circumstances set out in paragraph 4(c)(i) to (iii) of the Policy, or otherwise.

6.B.2 Accordingly, the Complaint meets the requirements of paragraph 4(a)(ii) of the Policy.

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

6.C.1 Complainant's case summarised in paragraph 5.A.3 does not need repetition. The Panel incorporates here the reasoning set out in the second element (paragraph 6.B.1), and notes it is plain on the evidence (see paragraph 4.2.3) that the disputed domain name was registered and is being used in bad faith.

6.C.2 Accordingly, the Complaint meets 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 <volconline.com> be transferred to Complainant.

*/David Perkins/*

**David Perkins**

Sole Panelist

Date: March 8, 2022