

ADMINISTRATIVE PANEL DECISION

Black Diamond Equipment, Ltd v. Hhfeu Bhyde Case No. D2023-1202

1. The Parties

The Complainant is Black Diamond Equipment, Ltd, United States of America (“United States”), represented by Kane Kessler, PC, United States.

The Respondent is Hhfeu Bhyde, China.

2. The Domain Name and Registrar

The disputed domain name <climbblackdiamond.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 March 17, 2023. On March 20, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 (“Whois Agent, Domain Protection Services”) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 24, 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 March 27, 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 Respondent of the Complaint, and the proceedings commenced on March 30, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 19, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 20, 2023.

The Center appointed Andrea Mondini as the sole panelist in this matter on May 1, 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 provider of outdoor apparel and climbing equipment under the trademark BLACK DIAMOND.

The Complainant owns several registrations of the trademark BLACK DIAMOND, *inter alia*, the United States Trademark registration No. 1686 547, registered on May 12, 1992 for climbing and mountaineering equipment and protection devices.

The Complainant also holds several domain names, including the domain name <blackdiamondequipment.com>.

The disputed domain name was registered on May 17, 2022.

The disputed domain name resolves to a website offering outdoor and climbing goods under the Complainant's trademark BLACK DIAMOND.

5. Parties' Contentions

A. Complainant

The Complainant contends as follows:

The disputed domain name is confusingly similar to the BLACK DIAMOND trademark in which the Complainant has rights because it incorporates this trademark in its entirety, and the addition of the word "climb" is not sufficient to avoid confusing similarity.

The Respondent is operating the website posted under the disputed domain name to offer for sale counterfeit goods that are falsely identified and labeled as BLACK DIAMOND goods. The Respondent is also falsely holding itself out as the Complainant and/or affiliated with and/or an authorized distributor of the Complainant.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent has not been authorized by the Complainant to use this trademark, is not commonly known by the disputed domain name, and there is no evidence of the Respondent's use, or demonstrable preparation to use, the disputed domain name in connection with a *bona fide* offering of goods and services.

The disputed domain name was registered and is being used in bad faith by the Respondent primarily for the purpose of disrupting the business of the Complainant. By using the domain name, the Respondent intentionally attempted to attract for commercial gain Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website and of a product or service on the Respondent's web site or location.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, in order to succeed, a complainant must establish each of the following elements:

- (i) the disputed domain name is identical or confusingly similar to the 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 has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel is satisfied that the Complainant owns trademark registrations for its BLACK DIAMOND trademark.

The Panel notes that the disputed domain name incorporates the BLACK DIAMOND trademark in its entirety. The addition of the term “climb” does not prevent a finding of confusing similarity under Policy, paragraph 4(a)(i). See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.8.

The addition of the generic Top-Level Domain (“gTLD”) “.com” in the disputed domain name is a standard registration requirement and as such is disregarded under the confusing similarity test under Policy, paragraph 4(a)(i). See [WIPO Overview 3.0](#), section 1.11.

For these reasons, the Panel concludes that the disputed domain name is confusingly similar to the Complainant’s mark BLACK DIAMOND.

The first element of paragraph 4(a) of the Policy has been met.

B. Rights or Legitimate Interests

The Complainant states that it has not authorized the Respondent to use the trademark BLACK DIAMOND, that the Respondent is not commonly known by the disputed domain name, and that before notice of the dispute, there is no evidence of the Respondent’s use, or demonstrable preparation to use, the disputed domain name in good faith. The Panel does not see any contrary evidence from the record.

In the view of the Panel, the Complainant has succeeded in raising a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. For its part, the Respondent failed to provide any explanations as to any rights or legitimate interests. Therefore, the Panel finds that the Respondent does not have any rights or legitimate interests in the disputed domain name.

Furthermore, the nature of the disputed domain name, incorporating the Complainant’s BLACK DIAMOND trademark in its entirety preceded by the term “climb” (which refers to the Complainant’s products), along with its use for a website reproducing the Complainant’s logo and products, cannot be considered fair use as it falsely suggests an affiliation with the Complainant that does not exist.

The second element of paragraph 4(a) of the Policy has been met.

C. Registered and Used in Bad Faith

In the view of the Panel, noting that the Complainant’s trademark predates the registration of the disputed domain name and that the website posted under the disputed domain name features the Complainant’s trademark to offer the same type of goods, it is inconceivable that the Respondent could have registered the

disputed domain name without knowledge of the Complainant's well-known trademark. In the circumstances of this case, this is evidence of registration in bad faith.

The Complainant contends that the goods offered on the Respondent's website are counterfeit. The Respondent has not contested this allegation. In any event, the Complainant has shown that on the website posted under the disputed domain name the Respondent is falsely holding itself out as the Complainant by using the Complainant's BLACK DIAMOND trademark and reproducing images taken from the Complainant's website. The Panel thus finds that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its websites by creating a likelihood of confusion as to the source, sponsorship or affiliation of its website in the sense of paragraph 4(b)(iv) of the Policy.

The Panel thus finds that the disputed domain name was registered and is being used in bad faith.

The third element of paragraph 4(a) of the Policy has been met.

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, <climbblackdiamond.com>, be transferred to the Complainant.

/Andrea Mondini/

Andrea Mondini

Sole Panelist

Date: May 10, 2023