

ADMINISTRATIVE PANEL DECISION

ABG Volcom LLC v. Client Care, Web Commerce Communications Limited Case No. D2023-3060

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 Client Care, Web Commerce Communications Limited, Malaysia.

2. The Domain Name and Registrar

The disputed domain name <volcomchile.com> is registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 17, 2023. On July 18, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 19, 2023, 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 (John Doe) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 19, 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 amendment to the Complaint on July 19, 2023.

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 the Respondent of the Complaint, and the proceedings commenced on July 31, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 20, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 23, 2023.

The Center appointed Gökhan Gökçe as the sole panelist in this matter on September 5, 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 ABG Volcom, LLC, a United States-based company established in 1991. The Complainant offers a range of clothing inspired by surfing, skateboarding, and snowboarding culture through 100,000 points of sale in North America, Europe, Asia, South America and the Middle East.

The Complainant is the owner of the registered trademarks in the mark VOLCOM including, *inter alia*:

- Chile Trademark Registration No. 1240019 for VOLCOM, registered on January 8, 2017, in Classes 9, 18, 24, 25, and 28;
- Chile Trademark Registration No. 873211 for VOLCOM and Stone Device on Black Background Logo (the "VOLCOM and Stone Logo"), registered on November 17, 2009, in Class 25.

The Complainant also owns and operates the website to which the domain name <volcom.com> resolves.

The disputed domain name <volcomchile.com> was registered on November 14, 2022, and, pursuant to Annex 1 of the Complaint, it was connected to a commercial website displaying the Complainant's trademark and Stone Logo, and allegedly offering for sale the Complainant's goods. At the time of this decision, the disputed domain name still resolves to active website.

5. Parties' Contentions

A. Complainant

The Complainant requests the transfer of the disputed domain name.

The Complainant contends that disputed domain name <volcomchile.com> is confusingly similar to the trademark VOLCOM in which the Complainant has rights as it reproduces the trademark in its entirety with the mere addition of the term "Chile" and the generic Top-Level Domain ("gTLD") ".com".

Regarding 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 Complainant contends that the disputed domain name has been registered and is being used in bad faith. The Complainant claims registration is in bad faith since the Respondent was well aware of the Complainant's trademarks at the time of registration. The Complainant notes that the trademarks were registered 30 years before the disputed domain name and are well known around the world. Furthermore, they add, a simple Google search would have disclosed the Complainant's marks and business. Moreover, the Complainant asserts that the use of the disputed domain name is also in bad faith. By using the disputed domain name for a website passing off as the Complainant's website selling competing and unauthorized goods, the Respondent intentionally attempts to attract for commercial gain Internet users to its website. Thus, the Complainant claims, 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

Paragraph 15(a) of the Rules requires the Panel to decide a complaint based on the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Under paragraph 4(a) of the Policy, the Complainant bears the burden of showing:

- (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.

Paragraph 4(a) of the Policy states that the Complainant bears the burden of proving that all these requirements are fulfilled, even if the Respondent has not replied to the Complainant's contentions. *Stanworth Development Limited v. E Net Marketing Ltd.*, WIPO Case No. [D2007-1228](#).

However, concerning the uncontested information provided by the Complainant, the Panel may, where relevant, accept the provided reasonable factual allegations in the Complaint as true. See section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

It is further noted that the Panel has taken note of the [WIPO Overview 3.0](#) and, where appropriate, will decide consistent with the [WIPO Overview 3.0](#).

A. Identical or Confusingly Similar

The Panel finds that the Complainant has established rights over the trademarks VOLCOM and VOLCOM and Stone Logo, based on the trademark registrations cited under section 4 above.

A domain name is "identical or confusingly similar" to a trademark for the purposes of the Policy when the domain name includes the trademark, or a confusingly similar approximation, regardless of other terms in the domain name (*Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. [D2000-0662](#)). As stated in the [WIPO Overview 3.0](#), section 1.8, "[w]here 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. The nature of such additional term(s) may however bear on assessment of the second and third elements". Hence, the Panel holds that the addition of the term "Chile" to the Complainant's VOLCOM trademark does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark because the Complainant's VOLCOM trademark is entirely reproduced, and clearly recognizable, in the disputed domain name.

Furthermore, the gTLD is commonly disregarded under the first element confusing similarity test (section 1.11.1 of the [WIPO Overview 3.0](#))

Accordingly, the Panel finds that the Complainant has established the first element under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

This Panel finds that the Complainant has made a *prima facie* case that the Respondent does not have rights or legitimate interests in the disputed domain name.

The Respondent has no connection or affiliation with the Complainant and the Complainant has not licensed or otherwise authorized the Respondent to use or register any domain name incorporating the Complainant's trademark.

The Respondent does not appear to engage in any legitimate noncommercial or fair use of the disputed domain name, nor any use in connection with a *bona fide* offering of goods or services.

Indeed, pursuant to Annex 1 of the Complaint, it appears that the Respondent has attempted to usurp the Complainant's goodwill in the trademark, to confuse and deceive Internet users into doing business with the Respondent. The nature of the goods offered at the website to which the disputed domain name resolves is unclear (*i.e.*, whether genuine VOLCOM-branded products or not) and whether or not there are actual goods available for sale. However, distributors or resellers can be making a *bona fide* offering of goods and thus have a right or legitimate interest in a domain name only if the following cumulative requirements are met (*Okidata Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#); [WIPO Overview 3.0](#), section 2.8.1: (i) respondent must actually be offering the goods at issue; (ii) respondent must use the site to sell only the trademarked goods; (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and (iv) respondent must not try to "corner the market" in domain name that reflect the trademark.)

These requirements are not fulfilled in the present case because the disputed domain name falsely suggests that the website be an official site of the Complainant or of an entity affiliated to or endorsed by the Complainant by reproducing, without authorization by the Complainant, the Complainant's Stone Logo trademark without any prominent and accurate disclaimer of lack of association with the Complainant. In addition, the Respondent does not appear to be commonly known by the disputed domain name or by a similar name. Moreover, the Respondent has not replied to the Complainant's contentions, claiming any rights or legitimate interests in the disputed domain name. Moreover, the nature of the disputed domain name is inherently misleading as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

Therefore, the Panel finds that the Complainant has established the second element under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel is convinced that the Respondent was fully aware of the Complainant's trademark when it registered the disputed domain name in November 2022. At the date of registration of the disputed domain name, the Complainant's VOLCOM trademark was already registered and widely used for many years. *Ebay Inc. v. Wangming*, WIPO Case No. [D2006-1107](#); *General Electric Company v. CPIC NET and Hussain Syed*, WIPO Case No. [D2001-0087](#). Referring to *Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net*, WIPO Case No. [D2000-0226](#), the Panel believes that the awareness of the Complainant's trademark at the time of the registration of the disputed domain name must be considered as an inference of bad faith registration.

The disputed domain name incorporates the Complainant's trademark, and the website operated under the disputed domain name copied the look-and-feel of the Complainant's website displays the Complainant's trademarks, logos, and product images and is offering likely counterfeit copies of the Complainant's products. Consequently, it is clear that the Respondent registered the disputed domain name with the Complainant's trademark and activity in mind, and did so with the intention to attract, for commercial gain, Internet users to its own website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of either the Respondent and/or its website, so as to trick

those users into doing business with the Respondent. This constitutes bad faith registration and use under the Policy as well as a disruption of the Complainant's business. Inference of bad faith can also be found in the failure to respond to the Complainant's contentions, and the Respondent's lack of any rights or legitimate interests in the disputed domain name. Moreover, UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely known trademark by an unaffiliated entity can by itself create a presumption of bad faith (see section 3.1.4 of the [WIPO Overview 3.0](#)).

Moreover, the Panel's limited independent search has revealed that the Respondent has been involved in many other UDRP cases (such as *Swarovski Aktiengesellschaft v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2023-2685](#)) and have been found in bad faith registration and use of the domain names incorporating the third party trademarks (see section 4.8 of the [WIPO Overview 3.0](#)). For the purposes of the third element of the Policy, such pattern of abusive conduct shall be further evidence of bad faith registration.

Therefore, the Panel finds that the Complainant has established the third element under 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 <volcomchile.com> be transferred to the Complainant.

/Gökhan Gökçe/

Gökhan Gökçe

Sole Panelist

Date: September 18, 2023