

ADMINISTRATIVE PANEL DECISION

ABG Volcom LLC v. Whois Agent, Domain Protection Services, Inc. / Rfdiop Chopusb

Case No. D2022-2325

1. The Parties

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

The Respondent is Whois Agent, Domain Protection Services, Inc., United States of America / Rfdiop Chopusb, China.

2. The Domain Name and Registrar

The disputed domain name <volcosoldes.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 June 27, 2022. On June 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 28, 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 the Complainant on June 30, 2022, 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 8, 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 the Respondent of the Complaint, and the proceedings commenced on July 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 31, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 1, 2022.

The Center appointed Alistair Payne as the sole panelist in this matter on August 17, 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

The Complainant founded in 1991, 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. It owns numerous trade mark registrations for its VOLCOM mark and for the Volcom stone logo, including European Union trade mark registration number 013194791 registered on January 13, 2015, for VOLCOM and European Union trade mark registration 005176201 registered on June 8, 2007. The Complainant owns the domain name <volcom.com> from which it operates its main website.

The disputed domain name was registered on January 14, 2021. It resolves to a website in the French language that is branded with the Complainant's VOLCOM mark and the Volcom stone logo and which appears to offer a range of VOLCOM branded clothing products at discount prices.

5. Parties' Contentions

A. Complainant

The Complainant submits that the disputed domain name consists of the term "volco" (not case sensitive), the descriptive term "soldes" (meaning "sales" in French language), and the generic Top-Level Domain (gTLD) ".com". It says that "volco" is a clear misspelling of "volcom" and that various past UDRP panels have found that the addition of the misspelled words does not prevent a finding of confusing similarity and that the addition of descriptive words such as "soldes" does not prevent a finding of confusing similarity.

The Complainant submits that the Respondent has no rights or legitimate in the disputed domain name, has not been licensed, contracted or otherwise permitted by the Complainant in any way to use the VOLCOM or stone logo trade mark or to apply for any domain name incorporating the VOLCOM trade mark, nor has the Complainant acquiesced in any way to such use or to application of the VOLCOM trade mark by the Respondent. Additionally, says the Complainant, there is no evidence that "volcosoldes" is the name of the Respondent's corporate entity, nor is there any evidence of fair use. Furthermore, there is no evidence that the Respondent is using or plans to use the VOLCOM or stone logo trade mark or the domain name incorporating the VOLCOM trade mark for a *bona fide* offering of goods or services.

The Complainant asserts that the Respondent has in fact been actively using the VOLCOM trade marks in the disputed domain name and on the physical website to promote its website for illegitimate commercial gains. It says that such unauthorised use of the VOLCOM trade marks, including typosquatting in the disputed domain name and the unauthorised use of its trade marks on the website to which it resolves is likely to trick consumers into erroneously believing that the Complainant is somehow affiliated with the Respondent or endorsing its commercial activities, when in fact, no such relationship exists.

It maintains that the Respondent was well aware of the Complainant's trade mark at the time the Respondent registered the disputed domain name on January 14, 2021, because the Complainant's trade marks are well-known around the world. The Complainant relies on the extensive range of registered trade marks for VOLCOM to which references have already been made. This says the Complainant is proof of bad faith at the time of registration. Further, a gap of several years between the registration of the Complainant's trade mark and the Respondent's registration of a disputed domain name (containing the trade mark) can indicate bad faith registration according to the Complainant.

According to the Complainant, the Respondent is selling counterfeit VOLCOM goods through a website that mirrors the Complainant's website in an attempt to pass itself off as an official website of the Complainant. It

says that the Respondent has no reason to use the trade mark in the disputed domain name other than to attract Internet users to its site for commercial gain. It says that the exploitation of consumer confusion for the purpose of selling counterfeit goods, with evident knowledge of the Complainant's rights in its trade marks, is one of the strongest examples of registration and use in bad faith and a blatant case of cybersquatting.

The Complainant says that it sent a cease-and-desist letter to the Respondent through the Respondent's registrar at the email address listed in the Whois information on May 2, 2022, asking the Respondent to disable and transfer the disputed domain name back to the Complainant, however no response has been received to this letter, which says the Complainant further shows bad faith on the Respondent's part. In addition, submits the Complainant, the Respondent's use of a privacy shield to mask its real identity is a further indicator of bad faith.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has demonstrated that it owns registered trade mark rights for its VOLCOM mark under European Union trade mark registration number 013194791 registered on January 13, 2015. The substantive part of the disputed domain name consists firstly of the term "volco" and then of the descriptive term "soldes" which the Panel understand means "sale" in the French language. The only difference between the primary element "volco" and the Complainant's distinctive VOLCOM mark is the omission of the letter "m" and the Panel therefore considers that the disputed domain name is confusingly similar to the Complainant's VOLCOM mark. The addition of the term "soldes" does not prevent a finding of confusing similarity.

As a result, the Complaint succeeds under the first element of the Policy.

B. Rights or Legitimate Interests

The Complainant has submitted that the Respondent has neither been licensed nor authorised by the Complainant to use the VOLCOM or stone logo trade marks, or to apply for any domain name incorporating the VOLCOM trade mark. The Complainant has also asserted that there is no evidence that "volcosoldes" is the name of the Respondent's corporate entity or of fair use of the Complainant's mark. The Complainant has furthermore asserted that there is no evidence that the Respondent is using, or plans to use, the VOLCOM or stone logo trade mark or the disputed domain name for a *bona fide* offering of goods or services.

The disputed domain name resolves to a website on which the Complainant says that the Respondent has made unauthorised use of the VOLCOM mark and of the stone logo Mark. Certainly, the website appears to the Panel to be masquerading as if it is the Complainant's site, or is at least authorised by the Complainant. The site offers what appear to be genuine VOLCOM branded products but which the Complainant asserts are actually counterfeit goods. The Complainant has submitted that the website is likely to trick consumers into erroneously believing that the Complainant is somehow affiliated with the Respondent or endorses its commercial activities, when in fact, no such relationship exists.

The Panel finds that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent has failed to respond to or to rebut the Complainant's case and also for the reasons set out below under Part C, the Panel finds that the Complaint also succeeds under this element of the Policy.

C. Registered and Used in Bad Faith

The disputed domain name was registered on January 14, 2021, many years after the Complainant started its business under the VOLCOM brand and after it registered its VOLCOM trade mark as noted above. The Complainant's VOLCOM mark is highly distinctive as is its stone logo trade mark and coupled with the fact that both appear on the website to which the disputed domain name resolves, this strongly suggests that it is most likely that the Respondent was well aware of the Complainant's business and VOLCOM mark when it registered the disputed domain name.

Under paragraph 4(b)(iv) of the Policy there is evidence of registration and use of a disputed domain name in bad faith where a respondent has used the disputed domain name to intentionally attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trade marks as to the source, sponsorship, affiliation or endorsement of the website.

It is apparent in this case that the Respondent is seeking to present the website to which the disputed domain name resolves as belonging to or being authorised by the Complainant and of selling genuine VOLCOM goods when according to the Complainant this is not the case. The Respondent is using the disputed domain name to attract Internet users to its website by creating a likelihood of confusion with the Complainant's trade marks as to the source, sponsorship, affiliation or endorsement of the website. This is a straightforward case of the kind that clearly falls within paragraph 4(b)(iv) of the Policy and is exactly the sort of abuse that the Policy seeks to proscribe.

The fact that the Respondent failed to reply to the Complainant's cease and desist letter of May 2, 2022, asking the Respondent to disable and transfer the disputed domain name back to the Complainant and that it used a privacy service to mask his identity, only reinforces the Panel's view of the Respondent's bad faith.

Accordingly, the Panel finds that the disputed domain name has been registered and used in bad faith and that the Complaint also succeeds under this 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 <volcosoldes.com> be transferred to the Complainant.

/Alistair Payne/

Alistair Payne

Sole Panelist

Date: August 30, 2022