

## **ADMINISTRATIVE PANEL DECISION**

ABG-Volcom, LLC v. Bgstr Bgstr  
Case No. D2022-4392

### **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 Bgstr Bgstr, China.

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

The disputed domain name <volcomsales.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 November 17, 2022. On November 18, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 21, 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 (Whois Agent, Domain Protection Services, Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 22, 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 the same date.

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 December 6, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 26, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 29, 2022.

The Center appointed Marilena Comanescu as the sole panelist in this matter on January 25, 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's brand VOLCOM has expanded to many product categories, including but not limited to, men's, women's, and children's apparel, outerwear, sportswear, swimwear, footwear, and accessories. Currently, VOLCOM brand has over six million followers worldwide across social media channels and the VOLCOM branded goods are sold in over 60 countries, as well as on the Complainant's website, available at "www.volcom.com".

The Complainant owns more than 350 trademark filings for the trademark VOLCOM, different variations of the VOLCOM Stone Logo, and combinations thereof, such as the following:

- the United States trademark registration number 1725875 for the word VOLCOM, filed on February 21, 1992, registered on October 20, 1992, and covering goods in Nice class 25; and
- the United States trademark registration number 2048820 for the word VOLCOM with device element, the VOLCOM Stone Logo, filed on December 14, 1995, registered on April 1, 1997, and covering goods in Nice class 25.

The disputed domain name <volcomsales.com> was registered on September 22, 2022, and, at the time of filing the Complaint, it was connected to a commercial website having the same look-and-feel as the Complainant's e-commerce website allegedly offering products marked VOLCOM with significant price reductions, displaying the Complainant's VOLCOM trademarks, logos, and product images.

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

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

The Complainant contends that the disputed domain name is confusingly similar to its distinctive and well-known trademark, that the Respondent has no rights or legitimate interests in the disputed domain name, and that the Respondent registered and is using the disputed domain name in bad faith.

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

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

#### **6. Discussion and Findings**

In view of the Respondent's default, the discussion and findings will be based upon the contentions in the Complaint and any reasonable position that can be attributable to the Respondent. Under paragraph 4(a) of the Policy, a complainant can only succeed in an administrative proceeding under the Policy if the following circumstances are met:

- (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 the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Panel will further analyze the potential concurrence of the above circumstances.

## A. Identical or Confusingly Similar

The Panel finds that the Complainant holds rights in the VOLCOM trademark.

The disputed domain name <volcomsales.com> incorporates the Complainant's VOLCOM trademark in its entirety with an additional term "sales". However, such addition does not prevent a finding of confusing similarity as the Complainant's trademark is clearly recognizable within the disputed domain name.

Numerous UDRP panels have considered that the addition of other terms (whether geographical, descriptive, pejorative, meaningless or otherwise) to trademarks in a domain name does not prevent a finding of confusing similarity, where the relevant trademark is recognizable within the domain name. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)).

Further, it is well established in decisions under the UDRP that the Top-Level-Domain ("TLD") (e.g., ".com", ".site", ".info", ".shop") in a domain name may typically be disregarded for the purposes of consideration of confusing similarity between a trademark and a domain name. See section 1.11 of the [WIPO Overview 3.0](#).

Given the above, the Panel finds that the disputed domain name is confusingly similar to the Complainant's trademark VOLCOM, pursuant to the Policy, paragraph 4(a)(i).

## B. Rights or Legitimate Interests

The Complainant asserts that the Respondent does not hold any trademark rights, license or authorization whatsoever to use the mark VOLCOM, that the Respondent is not commonly known by the disputed domain name, and that the Respondent has not used the disputed domain name in connection with a legitimate noncommercial or fair use or a *bona fide* offering of goods and services.

Under the Policy, "where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element". See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent has not replied to the Complainant's contentions and has not come forward with relevant evidence to rebut the Complainant's *prima facie* case.

There is nothing in the record suggesting that the Respondent has made a *bona fide* use of the disputed domain name, or has been known by this disputed domain name, or is making any legitimate noncommercial or fair use of the disputed domain name. In fact, at the time of filing the Complaint the disputed domain name resolved to a commercial website featuring the VOLCOM trademark and logos and offering purportedly discounted products branded VOLCOM for sale.

In certain cases, Panels have recognized that resellers, distributors or service providers using a domain name containing the complainant's mark to undertake sales or repairs related to the complainant's goods and services may have a legitimate interest in such domain name. Relevant UDRP panel decisions in relation to this issue are helpfully summarized in section 2.8 of the [WIPO Overview 3.0](#) as follows:

Normally, a reseller, distributor or service provider can be making a *bona fide* offering of goods and services and thus have a legitimate interest in the domain name if its use meets certain requirements. These requirements include the actual offering of goods and services at issue, the use of the site to sell only the trademarked goods, the site's accurately and prominently disclosing the registrant's relationship with the trademark holder, and the respondent not trying to "corner the market" in domain names that reflect the trademark.

This summary is based on *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). At least one condition that is outlined has clearly not been satisfied by the Respondent in this case: at the time of filing the Complaint, on the website under the disputed domain name there was no accurate and clear information regarding the Respondent's (lack of) relationship with the Complainant. Further, images of the Complainant's trademarks and official pictures were displayed without any consent from the Complainant, thus generating a likelihood of confusion for the Internet users accessing the Respondent's website, and suggesting a false commercial relationship between the website under the disputed domain name and the Complainant.

In addition, and without prejudice to the above, UDRP panels have found that where a domain name consists of a trademark plus an additional term, such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. See section 2.5.1 of the [WIPO Overview 3.0](#). In the present case, the nature of the disputed domain name (including the Complainant's trademark in its entirety plus the additional term "sales") suggests an implied affiliation with the Complainant, contrary to the fact, which cannot constitute fair use under the circumstances of this proceeding.

For all these reasons, the Panel finds that the second element of the Policy is established, and the Respondent has no rights or legitimate interests in respect of the disputed domain name, pursuant to the Policy, paragraph 4(a)(ii).

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

The Complainant holds registered trademark rights for VOLCOM since at least 1992 and, according to the evidence provided, the Panel is satisfied that the trademark gained worldwide reputation in the fashion industry.

The disputed domain name was created in 2022 and incorporates the Complainant's distinctive mark in its entirety, with an additional generic term, "sales".

For the above reasons, the Panel finds that the disputed domain name was registered in bad faith, with knowledge of the Complainant, its business and particularly targeting the Complainant's trademark.

The Respondent is using without permission the Complainant's distinctive trademark in order to get Internet traffic on its web portal and to obtain commercial gain from the false impression created for the Internet users with regard to a potential connection with the Complainant. This impression is created particularly by the incorporation of the Complainant's trademark in the disputed domain name, and the content on the website provided thereunder which includes the Complainant's trademarks, logo, and images of official products.

Paragraph 4(b)(iv) of the Policy provides that the use of a domain name to intentionally attempt "to attract, for commercial gain, Internet users to [the respondent's] website 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 [the respondent's] website or location or of a product or service on [the respondent's] website or location" is evidence of registration and use in bad faith.

Given that 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 very likely counterfeit copies of the Complainant's products, indeed in this Panel's view, the Respondent intended to attract Internet users accessing the website corresponding to the disputed domain name who may be confused and believe that the website is held, controlled by, or somehow affiliated or related to the Complainant, for its commercial gain.

Additionally, the disputed domain name was registered under a privacy service. Also, the Respondent's physical address listed in the Whois was inaccurate or incomplete. Prior panels have viewed both the provision of false contact information and the use of a privacy or proxy service as indicators of bad faith. See section 3.6 of the [WIPO Overview 3.0](#).

The Respondent failed to provide any argument in its favor in response to the present Complaint. Having in view the other circumstances of this case, such fact constitutes further evidence of bad faith.

For all the above reasons, the Panel finds that the Respondent registered and is using the disputed domain name in bad faith, pursuant to the Policy, paragraph 4(a)(iii).

## **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, <volcomsales.com>, be transferred to the Complainant.

*/Marilena Comanescu/*

**Marilena Comanescu**

Sole Panelist

Date: February 8, 2023