

ADMINISTRATIVE PANEL DECISION

ABG-Volcom, LLC v. Online Trade
Case No. D2023-4370

1. The Parties

Complainant is ABG-Volcom, LLC, United States of America ("United States"), represented by Authentic Brands Group, United States.

Respondent is Online Trade, United States.

2. The Domain Name and Registrar

The disputed domain name <volcomoutlets.shop> is registered with Sav.com, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on October 20, 2023. On October 23, 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 (John Doe) and contact information in the Complaint. The Center sent an email communication to Complainant on October 24, 2023, 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 the same day.

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 October 25, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 14, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on November 17, 2023.

The Center appointed Scott R. Austin as the sole panelist in this matter on January 3, 2024. 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 following facts appear from the Complaint (as amended) and its attached Annexes, which have not been contested by Respondent, and which provide evidence sufficient to support:

Founded in 1991 by two entrepreneurs who based the ethos of the company on their own experiences with board sports, Complainant operates a board sports-riding company which provides goods and services under the trademark VOLCOM (the "VOLCOM Mark") and sponsors what Complainant asserts is one of the best surfing, skateboarding, and snowboarding teams in the world.

Complainant asserts its VOLCOM Mark is famous in connection with a wide variety of goods and services, including women's clothing and accessories, which has 100,000 points of sale throughout North America, Europe, Asia, Latin America and the Middle East, as well as on its official website accessed at "www.volcom.com" (the "Official VOLCOM Mark Website")

Complainant owns a number of registrations in the United States and around the world for the VOLCOM Mark for a range of products and services, including the following:

United States Registration No. 1,725,875, VOLCOM, registered on October 20, 1992, for a range of sportswear products in International Class 25, claiming a first use in commerce date of September 30, 1991; and

United States Registration No. 2,534,210, VOLCOM, registered on January 29, 2002, for a range of clothing including sportswear, headwear and footwear in International Class 25, claiming a first use in commerce date of September 30, 1991.

Complainant also shows it incorporates the VOLCOM Mark into its official registered domain name <volcom.com>, registered to Complainant since October 12, 1996, used to promote its products through the Official VOLCOM Mark Website.

In addition to its official domain name and the Official VOLCOM Mark Website, Complainant has established a strong social media presence and asserts that it has over 234 million total fans on social media.

Respondent registered the disputed domain name on August 15, 2023, and it resolves to an impersonation or "copycat" website featuring Respondent's unauthorized use of the VOLCOM Mark and Volcom Stone Logo as well as unauthorized images of products bearing the VOLCOM Mark.

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a cancellation of the disputed domain name: that the disputed domain name is confusingly similar to Complainant's trademark; that Respondent has no rights or legitimate interests in respect of the disputed domain name; and that the disputed domain name was registered and is being used in bad faith.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted in accordance with the Policy, the Rules, and any rules and principles of law that it deems applicable.

The onus is on Complainant to make out its case and it is apparent from the terms of the Policy that Complainant must show that all three elements set out in paragraph 4(a) of the Policy have been established before any order can be made to cancel a domain name. As the proceedings are administrative, the standard of proof under the Policy is often expressed as the “balance of the probabilities” or “preponderance of the evidence” standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.2.

Thus, for Complainant to succeed it must prove within the meaning of paragraph 4(a) of the Policy and on the balance of probabilities that:

1. The disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
2. Respondent has no rights or legitimate interests in respect of the disputed domain name; and
3. The disputed domain name has been registered and is being used in bad faith.

The Panel finds that Complainant has met its burden in all three elements of the Policy and will deal with each of these elements in more detail below.

A. Identical or Confusingly Similar

Ownership of a nationally registered trademark constitutes *prima facie* evidence that the complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. [WIPO Overview 3.0](#), section 1.2.1. Complainant has demonstrated its rights because it has shown that it is the holder of numerous valid and subsisting trademark registrations for its VOLCOM Mark. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#).

With Complainant’s rights in the VOLCOM Mark established, the remaining question under the first element of the Policy is whether the disputed domain name is identical or confusingly similar to Complainant’s VOLCOM Mark. It is well accepted that the first element of the Policy functions primarily as a standing requirement and that the threshold test for confusing similarity involves a “reasoned but relatively straightforward comparison between the complainant’s trademark and the disputed domain name”. [WIPO Overview 3.0](#), sections 1.11.1 and 1.7.

The disputed domain name incorporates Complainant’s VOLCOM Mark in its entirety, while adding the term “outlets”, and the Top Level Domain (“TLD”) “.shop”. Although the addition of other terms may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the VOLCOM Mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

Prior UDRP panels have held “the fact that a domain name wholly incorporates a complainant’s registered mark is sufficient to establish identity or confusing similarity for purposes of the Policy despite the addition of other words to such marks”. *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#); see also *Rakuten, Inc. v. Domain Admin, Privacy Protect, LLC (PrivacyProtect.org) / Matthew Connor, No Company*, WIPO Case No. [D2019-2983](#).

The TLD, in this case “.shop”, is disregarded for this comparison because it is functionally necessary for the disputed domain name to be registered. See *Research In Motion Limited v. Thamer Ahmed Alfarshooti*, WIPO Case No. [D2012-1146](#) (TLD irrelevant for confusing similarity determination); [WIPO Overview 3.0](#), section 1.11 (“The applicable Top Level Domain (‘TLD’) in a domain name (e.g., “.com”, “.club”, “.nyc”) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.”).

Complainant’s VOLCOM Mark is recognizable as incorporated in its entirety into the disputed domain name and for that reason the Panel finds the disputed domain name confusingly similar to the VOLCOM Mark in which Complainant has rights. Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under the second element of the Policy, a complainant is first required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. If a complainant makes that showing, the burden of production on this element shifts to the respondent to come forward with relevant evidence of such rights or legitimate interests in the domain name. If the respondent fails to come forward with such evidence, a complainant is generally deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1. See also, *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#).

Complainant has established a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain name. Respondent has not rebutted Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

First, it is clear from the record submitted that Respondent is not and has never been a representative or licensee of Complainant nor is Respondent authorized by Complainant to register or use the VOLCOM Mark in any manner in a domain name or otherwise. Prior UDRP panels have found the fact that a respondent is not authorized to register or use a complainant’s mark, “on its own, can be sufficient to prove the second criterion [of the Policy]”. *Six Continents Hotels, Inc. v. IQ Management Corporation*, WIPO Case No. [D2004-0272](#); see also *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) (finding no rights or legitimate interests where domain name incorporated complainant’s registered mark and respondent was not a licensee of complainant).

Complainant has also shown that Respondent is not commonly known by the disputed domain name. The Registrar disclosed the underlying registrant/registrant organization as, “Online Trade”, which Complainant amended its Complaint to name as Respondent. Respondent bears no resemblance to the disputed domain name whatsoever. These facts combined with the well-known status of the VOLCOM Mark and the lack of evidence in the record to suggest otherwise allows this Panel to find that Respondent is not commonly known by the disputed domain name or any variation thereof pursuant to Policy paragraph 4(c)(ii). See *Six Continents Hotels, Inc. v. Trasporto di Networ and Pro Intel*, WIPO Case No. [D2004-0246](#) (“given Complainant’s established use of its... marks, it is unlikely that the Respondents are commonly known by any of these marks”).

It is generally regarded as *prima facie* evidence of no rights or legitimate interests if a complainant shows that the disputed domain name is identical or confusingly similar to a complainant’s trademark, that the respondent is not commonly known by the disputed domain name, and that a complainant has not authorized the respondent to use its mark (or an expression which is confusingly similar to its mark), whether in the disputed domain name or otherwise. See *Roust Trading Limited v. AMG LLC*, WIPO Case No. [D2007-1857](#).

Most importantly, Complainant contends Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services because, as Complainant’s Annex evidence of web page printouts shows, the disputed domain name resolves to a website where Respondent is attempting to pass

itself off as Complainant. The Panel notes that evidence submitted in the Annexes to the Complaint persuasively supports Complainant's argument because it shows Respondent's website prominently features infringing copies of Complainant's copyright protected product images copied from Complainant's Official VOLCOM Mark Website as well as the VOLCOM Mark and the Volcom Stone Logo using a similar website design and layout. Respondent, therefore, is using the disputed domain name to suggest an affiliation with or sponsorship by Complainant. Based on these facts the Panel finds Respondent's actions are clearly not legitimate and clearly are misleading and, therefore, Respondent cannot establish rights or legitimate interests pursuant to paragraph 4(c)(iii) of the Policy. See *Six Continents Hotels v. "m on"*, WIPO Case No. [D2012-2525](#).

In view of the above, the Panel finds that Complainant has made out a *prima facie* case that Respondent has no rights or legitimate interests in the disputed domain name. Respondent has not submitted any arguments or evidence to rebut Complainant's *prima facie* case. The Panel determines, therefore, that Respondent does not have rights or legitimate interests in the disputed domain name and Complainant has successfully met its burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Complainant first contends that Respondent registered the disputed domain name in bad faith because Respondent has created a domain name that is confusingly similar to Complainant's globally well-known VOLCOM Mark, as found in section 6A above. Prior UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a widely known or famous trademark by an unaffiliated entity can by itself create a presumption of bad faith. See, [WIPO Overview 3.0](#), section 3.1.4.

A prior UDRP panel recently found the VOLCOM Mark well known and known specifically to this Respondent. See *Age International, Inc. dba Blanton Distilling Company v. Michael Chan*, WIPO Case No. [D2021-2292](#).

Given the record shows that Complainant's well-known VOLCOM Mark is protected by trademark registrations around the world, the oldest of which was registered decades prior to Respondent's registration of the disputed domain name, which like Complainant's official domain name <volcom.com>, encompasses the VOLCOM Mark in its entirety, the Panel finds it is implausible to believe that Respondent did not have actual knowledge of Complainant's well-known VOLCOM Mark when it registered the confusingly similar disputed domain name.

Prior UDRP panels have held that a respondent's actual knowledge of a complainant's mark may serve as a basis for finding bad faith registration. See *OSRAM GmbH v. Azarenko Vladimir Alexeevich, Azarenko Group Ltd*, WIPO Case No. [D2016-1384](#) (finding bad faith where "Respondent must have been aware of the Complainant and its said trademark when it registered the disputed domain name" and "the Panel cannot conceive of any use that the Respondent could make of the disputed domain name that would not interfere with the Complainant's long-established trademark rights"). Accordingly, the Panel finds that Respondent had actual knowledge of the VOLCOM Mark when it registered the disputed domain name, and such a showing is sufficient to establish bad faith registration of the disputed domain name.

Further, as discussed in detail in section 6B and shown in Complainant's Annex evidence, Respondent's website accessed at the disputed domain name includes a picture perfect copy of sections of Complainant's Official VOLCOM Mark Website. In the circumstances of this case, where Respondent registered the disputed domain name to engage in *per se* illegitimate activity, impersonating Complainant to attract Internet users to Respondent's site to sell competing and unauthorized goods for Respondent's commercial gain, the Panel finds such a showing is sufficient to establish bad faith registration and use. See, [WIPO Overview 3.0](#), section 3.1.4 (the use of a domain name for *per se* illegitimate activity is behavior to be manifestly considered evidence of bad faith).

Bad faith use is also clear because Respondent's website accessed through the disputed domain name, has been created to confuse consumers into visiting Respondent's copycat site, leading them to believe it is affiliated with Complainant. The Panel finds bad faith use, therefore, because the substantial evidence in the record shows Respondent has been and is using the disputed domain name to intentionally attempt to attract, for commercial gain, Internet users to Respondent's website by creating a likelihood of confusion with Complainant's VOLCOM Mark as to the source, sponsorship, affiliation, or endorsement of its misleading website to sell unauthorized and competing products in violation of paragraph 4(b)(iv) of the Policy.

Accordingly, the Panel finds that the disputed domain name has been registered and is being used in bad faith. Complainant has met its burden 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 <volcomoutlets.shop> be cancelled as requested by Complainant.

/Scott R. Austin/

Scott R. Austin

Sole Panelist

Date: January 16, 2024