

ADMINISTRATIVE PANEL DECISION

Black Diamond Equipment, LTD v. Shuhua Lu
Case No. D2022-4311

1. The Parties

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

The Respondent is Shuhua Lu, China.

2. The Domain Name and Registrar

The disputed domain name <theblackdiam.com> (the “Domain Name”) 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 11, 2022. On November 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On November 14, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 November 17, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 7, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 9, 2022.

The Center appointed Jeremy Speres as the sole panelist in this matter on December 15, 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 has, since at least 1992, traded in outdoor apparel, climbing equipment, and other related goods under the BLACK DIAMOND trade mark. The Complainant's main website is accessible at "www.blackdiamondequipment.com".

The Complainant owns numerous trade mark registrations for the BLACK DIAMOND mark in the United States, including Registration No. 1686547 for BLACK DIAMOND in class 28 with a registration date of May 12, 1992.

The Domain Name was registered on March 9, 2022, and the Complainant has presented evidence of the Domain Name resolving to a website prominently entitled "BLACK DIAMOND" ostensibly offering the Complainant's products for sale using a replica of the Complainant's trade marked logo, the Complainant's product names, and product imagery. The Domain Name did not resolve to any website at the time of drafting of this Decision.

5. Parties' Contentions

A. Complainant

The Complainant contends that the Domain Name is confusingly similar to its BLACK DIAMOND mark, that the Respondent has no rights or legitimate interests in the Domain Name, and the Domain Name was registered and used in bad faith given that the Domain Name is used to impersonate the Complainant for purposes of selling counterfeit BLACK DIAMOND goods.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Domain Name incorporates an obvious contraction of the Complainant's BLACK DIAMOND mark, consisting of the majority of the mark plus the word "the". As such, the mark is easily recognisable within the Domain Name and, accordingly, the Domain Name is confusingly similar to the Complainant's mark (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") at section 1.7). The Complainant has satisfied the standing requirement under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant's un rebutted evidence establishes that its BLACK DIAMOND mark was registered and used long prior to the registration of the Domain Name. The Domain Name is confusingly similar to the Complainant's mark and the Complainant has certified that the Domain Name is unauthorised by it.

The general impression created by the Domain Name's website, including use of a replica of the Complainant's distinctive, trade marked logo, the Complainant's product imagery and product names, is one of impersonation of the Complainant. UDRP panels have categorically held that the use of a domain name for illegal activity (e.g., impersonation) can never confer rights or legitimate interests on a respondent ([WIPO Overview 3.0](#) at section 2.13). To the extent that the Domain Name's website might be considered that of a reseller of the Complainant's products, it does not meet the requirements of the well-known Oki Data test given that the site does not accurately and prominently disclose the Respondent's relationship with the Complainant (*Oki data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#); and

[WIPO Overview 3.0](#) at section 2.8).

There is no evidence that any of the circumstances set out in paragraph 4(c) of the Policy, nor any others which might confer rights or legitimate interests upon the Respondent, pertain. The Complainant has satisfied paragraph 4(a)(ii) of the Policy by virtue of having made out an unrebutted *prima facie* case ([WIPO Overview 3.0](#) at section 2.1).

C. Registered and Used in Bad Faith

The Domain Name's website, which ostensibly offers the Complainant's goods for sale at discounted prices, clearly and intentionally impersonates the Complainant. In light of this and the composition of the Domain Name featuring an obvious reference to the Complainant's mark, the Respondent must have had the Complainant in mind when registering and using the Domain Name. It is clear in these circumstances that the Respondent sought to impersonate the Complainant for commercial gain, falling squarely within paragraph 4(b)(iv) of the Policy (*Ebay Inc. v. Wangming*, WIPO Case No. [D2006-1107](#)). The fact that the Domain Name did not resolve to any website at the time of drafting of this Decision does not prevent a finding of bad faith.

The Panel draws an adverse inference from the Respondent's failure to take part in the present proceeding where an explanation is certainly called for ([WIPO Overview 3.0](#) at section 4.3).

The Complainant has satisfied 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 Domain Name, <theblackdiam.com>, be transferred to the Complainant.

/Jeremy Speres/

Jeremy Speres

Sole Panelist

Date: December 21, 2022