

ADMINISTRATIVE PANEL DECISION

ABG Volcom, LLC v. Web Commerce Communications Limited, Client Care Case No. D2023-3190

1. The Parties

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

The Respondent is Web Commerce Communications Limited, Client Care, Malaysia.

2. The Domain Name and Registrar

The disputed domain name <volcomusale.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 24, 2023. On July 25, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 26, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name[s] which differed from the named Respondent (John Doe) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 8, 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 August 8, 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 August 23, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 12, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 18, 2023.

The Center appointed Fabrice Bircker as the sole panelist in this matter on October 2, 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, ABG Volcom, LLC, operates the board sports-riding VOLCOM brand which has been created in 1991.

It is notably the owner of the following trademark registrations:

- VOLCOM, United States trademark registration No. 1725875, with first use in commerce dating September 30, 1991, filed on February 21, 1992, registered on October 20, 1992, regularly renewed since then, and designating products of class 25,
- VOLCOM, United States trademark registration No. 2689830, filed on September 20, 2000, registered on February 25, 2003, regularly renewed since then, and designating products of classes 9 (with first use in commerce on August 15, 1993), 16 (with first use in commerce on May 31, 1991) and 18 (with first use in commerce on July 20, 1994),



- (Stone Logo), United States trademark registration No. 2689825, filed on September 20, 2000, registered on February 25, 2003, regularly renewed since then, and designating products of classes 9 (with first use in commerce on August 15, 1993), 16 (with first use in commerce on May 31, 1991) and 18 (with first use in commerce on July 20, 1994).

The Complainant has also an online presence through the <volcom.com> domain name, which is used to resolve to a retailing website dedicated to the Complainant's products.

Very little is known about the Respondent, except that it is apparently located in Malaysia, based on the information disclosed by the Registrar.

The disputed domain name, <volcomusasale.com>, was registered on November 14, 2022.

It is directing to a website purported to offer for sale at discounted prices fashion articles (shoes, clothing, bags...) bearing the VOLCOM trademark. This website is drafted in English, shows prices in United States dollars and displays the United States of America's flag.

Besides, this website displays the Complainant's Stone Logo.

5. Parties' Contentions

A. Complainant

The Complainant requests the transfer of the disputed domain name, and its main arguments can be summarized as follows.

First, the Complainant contends that the disputed domain name is confusingly similar to its VOLCOM trademark because it incorporates said trademark in its entirety and the latter remains recognizable within it.

Then, the Complainant submits that the Respondent has no rights or legitimate interests in the disputed domain name because:

- it has never been authorized in any way to register or to use the VOLCOM or the Stone Logo trademarks,
- there is no evidence that VOLCOM is the name of Respondent,

- the latter has been actively using the VOLCOM trademark to trick consumers into erroneously believing that the Complainant is somehow affiliated with the Respondent or endorsing its commercial activities, while in fact, no such relationship exists.

At last, the Complainant puts forward that the disputed domain name was registered and is being used in bad faith because:

- the VOLCOM trademark is wellknown around the world,
- the Respondent registered the disputed domain name at least 30 years after the Complainant's rights,
- the Respondent is trying to pass off the website available through the disputed domain name as the Complainant's website to sell competing and unauthorized goods. Thus, 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

Pursuant to paragraph 4(a) of the Policy, for obtaining the transfer of the disputed domain name, the Complainant must establish each of the following three elements:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

Besides, paragraph 15(a) of the Rules provides that "[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

Paragraphs 10(b) and 10(d) of the Rules also provide that "[i]n all cases, the Panel shall ensure that the Parties are treated with equality and that each Party is given a fair opportunity to present its case" and that "[t]he Panel shall determine the admissibility, relevance, materiality and weight of the evidence".

Besides, the Respondent's failure to reply to the Complainant's contentions does not automatically result in a decision in favor of the Complainant, although the Panel is entitled to draw appropriate inferences therefrom, in accordance with paragraph 14(b) of the Rules (see section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). Taking the foregoing provisions into consideration the Panel finds as follows.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or 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](#), section 1.7.

Based on the available record (Annex 4 to the Complaint), the Panel finds the Complainant has shown rights in respect of a trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

While the addition of other terms (here, “usa” and “sale”) may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy, because the Complainant’s trademark remains recognizable within the disputed domain name. [WIPO Overview 3.0](#), section 1.8.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, 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. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name.

Indeed, the Complainant contends that it has not given its consent for the Respondent to use its VOLCOM trademark in a domain name registration or in any other manner.

In addition, there is nothing in the record of the case likely to indicate that the Respondent may be commonly known by the disputed domain name.

Besides, the Respondent is using the disputed domain name to operate a website:

- purporting to offer for sale, at discounted prices, exclusively clothing under the Complainant’s VOLCOM trademark,
- ostentatiously displaying the Stone logo trademark,
- reproducing the look and feel of the Complainant’s website.

This situation opens the question of whether the website available through the disputed domain name is genuinely offering VOLCOM products, or if the goods are counterfeits, or even if it is a fake shop.

Of course, if the products would be counterfeits or if the online stores would be fake, there would be a clear absence of rights or legitimate interests.

Panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

On the other side, one cannot exclude that the products sold on the website available through the disputed domain name are genuine VOLCOM goods.

In this respect, there is a consensus view (see [WIPO Overview 3.0](#), section 2.8) that a reseller using a domain name containing the complainant’s trademark to undertake sales related to the complainant’s goods

makes a *bona fide* offering of goods and services and thus has a legitimate interest in the domain name if the following cumulative requirements are met:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder;
and
- (iv) the respondent must not try to "corner the market" in domain names that reflect the trademark.

Here, the Panel notably finds that the Respondent's website does not disclose its (lack of) relationship with the Complainant. Rather, the Respondent seeks to create an impression of association with the Complainant, by running a website that prominently display the Stone Logo trademark, while looking close to the Complainant's official website.

In these conditions, even assuming that the Respondent would be offering for sale genuine VOLCOM goods, it would not be in a position to claim any legitimate fair use of the disputed domain name.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular but without limitation, that if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel finds that the Respondent registered the disputed domain name being fully aware of the Complainant's rights, and that he is intentionally using said disputed domain name for commercial gain by creating a likelihood of confusion with the Complainant's VOLCOM trademark as to the source, sponsorship, affiliation, or endorsement of his websites and of the products offered for sale therein, in the meaning of paragraph 4(b)(iv) of the Policy.

Indeed:

- the disputed domain name is confusingly similar with the Complainant's VOLCOM trademark which predates it by 30 years and is distinctive,
- the disputed domain name is being used to resolve to a website that give a strong impression of being operated or authorized by the Complainant, whereas this is not the case, and purporting to sell VOLCOM branded products of the same nature than those protected by the Complainant's prior trademark,
- the Respondent has proceeded with the registration of another domain name reproducing the Complainant's prior trademark and used in the same way than the disputed domain name,
- the Respondent, while invited to defend his case, has remained silent in this procedure.

Based on the available record, the Panel finds the third element of the Policy has been established.

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, <volcomusasale.com>, be transferred to the Complainant.

/Fabrice Bircker/

Fabrice Bircker

Sole Panelist

Date: October 13, 2023