

## **ADMINISTRATIVE PANEL DECISION**

**Black Diamond Equipment, LTD v. BoNiu Cao**  
**Case No. D2022-4347**

### **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 BoNiu Cao, China.

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

The disputed domain name <blackdiamondshop.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 15, 2022. On November 16, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 18, 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 28, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 18, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 19, 2022.

The Center appointed Mihaela Maravela as the sole panelist in this matter on January 12, 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.

The language of the proceeding is English, being the language of the Registration Agreement, as per paragraph 11(a) of the Rules.

#### **4. Factual Background**

According to information in the Complaint, the Complainant has been using the trademark BLACK DIAMOND for outdoor apparel, climbing equipment, and other related goods since 1992. The Complainant has expended significant time, resources, and effort promoting and developing its trademark as a source identifier for its goods.

The Complainant has registered several trademarks consisting of BLACK DIAMOND, including the United States Registration No. 1576481 for BLACK DIAMOND (figurative) registered on January 9, 1990. The Complainant has registered the domain name <blackdiamondequipment.com> to conduct its business on the Internet.

The disputed domain name was registered on December 11, 2021 and the Complainant has presented evidence of the disputed domain name resolving to a website purporting to sell the Complainant's branded goods at discounted prices. The disputed domain name does not resolve to an active website at the date of this Decision.

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

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

The Complainant argues that the disputed domain name is nearly identical to and confusingly similar to the Complainant's registered trademark BLACK DIAMOND, apart from the removal of the letter "d" at the beginning of "diamond".

As regards the second element, the Complainant argues that the Respondent has not been commonly known by the disputed domain name. Also, the Complainant has no connection whatsoever to the Respondent and has never heard of the Respondent prior to this dispute. Moreover, there is no evidence of the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services. Rather, the Respondent is using the disputed domain name to offer for sale counterfeit goods falsely identified and labeled as BLACK DIAMOND goods. The Respondent is also falsely holding itself out as the Complainant and/or affiliated with and/or an authorized distributor of the Complainant.

With respect to the third element, the Complainant argues that it has been using the BLACK DIAMOND trademark since 1992. As the Respondent has only recently registered the disputed domain name and given the well-known character of the Complainant's trademark, the Respondent was aware of the Complainant's trademark, therefore the disputed domain name should be considered as having been registered and used in bad faith. In addition, the Complainant argues that it is the owner of all right, title, and interest (including copyright) in and to certain photographs displayed on and distributed through the website at the disputed domain name.

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

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

## 6. Discussion and Findings

### 6.1. Preliminary Matters

No communication has been received from the Respondent in this case. However, given that the Complaint was sent to the relevant physical and electronic addresses disclosed by the Registrar, the Panel considers that this satisfies the requirement in paragraph 2(a) of the Rules to “employ reasonably available means calculated to achieve actual notice”. Accordingly, the Panel considers it can proceed to determine the Complaint based on the statements and documents submitted by the Complainant as per paragraph 15(a) of the Rules and to draw inferences from the Respondent’s failure to file any Response. While the Respondent’s failure to file a Response does not automatically result in a decision in favor of the Complainant, the Panel may draw appropriate inferences from the Respondent’s default.

The applicable standard of proof in UDRP cases is the “balance of probabilities” or “preponderance of the evidence”, and the Panel can draw certain inferences in light of the particular facts and circumstances of the case. See section 4.2, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

### 6.2. Substantive Matters

Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following elements:

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

#### A. Identical or Confusingly Similar

The Complainant has proved rights over the BLACK DIAMOND trademark.

The disputed domain name consists of the obvious misspelling of the BLACK DIAMOND trademark of the Complainant and the addition of “shop”. The addition of other terms (whether geographical wording, descriptive, pejorative, meaningless, or otherwise) to trademarks in a domain name or a domain name which consists of a common, obvious, or intentional misspelling of a trademark would not prevent a finding of confusing similarity for purposes of the first element. See sections 1.8 and 1.9 of the [WIPO Overview 3.0](#).

It is well accepted by UDRP panels that a generic Top-Level Domain (“gTLD”), such as “.com”, is typically ignored when assessing whether a domain name is identical or confusing similar to a trademark. See section 1.11.1 of the [WIPO Overview 3.0](#).

This Panel concludes that the disputed domain name is confusingly similar to the Complainant’s trademarks and therefore finds that the Complainant has satisfied the standing requirement under paragraph 4(a)(i) of the Policy.

#### B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

As established by previous UDRP panels, it is sufficient for the Complainant to make a *prima facie* case demonstrating that the Respondent has no rights or legitimate interests in the disputed domain name in order to place the burden of production on the Respondent (see section 2.1 of the [WIPO Overview 3.0](#)).

In the present case, the Complainant has established a *prima facie* case that it holds rights over the trademark BLACK DIAMOND and claims that the Respondent has no legitimate reason to acquire and use the disputed domain name. There is no evidence that the Respondent is using the disputed domain name in connection with a *bona fide* offering of goods or services. Rather, according to the unrebutted evidence of the Complainant, the website at the disputed domain name was used to offer for sale BLACK DIAMOND branded goods at a discounted price. Under these circumstances, it is reasonable to infer that the products offered on the website at the disputed domain name are counterfeit of the Complainant's products. Even if the products were genuine, the lack of any disclaimer on the website at the disputed domain name as to the registrant's relationship with the trademark owner or the lack thereof, would falsely suggest to Internet users that the website to which the disputed domain name resolved is owned by the Complainant or at least affiliated to the Complainant (as per the principles outlined in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#)).

Also, there is no evidence that the Respondent is commonly known by the disputed domain name within the meaning of paragraph 4(c)(ii) of the Policy.

The Panel considers that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent failed to rebut that *prima facie* case because the Respondent did not respond to the Complainant's contentions.

With the evidence on file, the Panel finds that the requirement of paragraph 4(a)(ii) of the Policy is satisfied.

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

According to paragraph 4(a)(iii) of the Policy, the Complainant must establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith.

The Complainant's registration and use of the relevant trademarks predate with over three decades the date at which the Respondent registered the disputed domain name. The disputed domain name resolved to a website reproducing the Complainant's trademark and purportedly offering for sale the Complainant's products but at a much lower price. Under these circumstances, and also given the distinctiveness of the Complainant's trademark, it is reasonable to infer that the Respondent has registered the disputed domain name with full knowledge of the Complainant's trademarks, and to target those trademarks.

The inherently misleading disputed domain name resolved to a website, which ostensibly offers the Complainant's products at a much lower price. As such, the disputed domain name suggests affiliation with the Complainant in order to attract Internet users and offer products that appear to be counterfeit.

It appears that the disputed domain name no longer resolves to an active website. The Panel finds that the passive holding of the disputed domain name does not in the circumstances of this case prevent a finding of bad faith. There is no evidence of a legitimate use of the disputed domain name. The trademark of the Complainant is distinctive and widely used in commerce. UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See section 3.1.4 of the [WIPO Overview 3.0](#). Moreover, the Respondent has not participated in the proceeding and has failed to rebut the Complainant's contentions and to provide any evidence of actual or contemplated good faith use, and indeed none would seem plausible. Further, the Respondent has provided what seems to be an incomplete contact address to the Registrar. Considering all the above, it is not possible to conceive any plausible actual or contemplated good faith registration and use of the disputed domain name by the Respondent.

In the Panel's view, the circumstances of the case represent evidence of registration and use in bad faith of the disputed domain name. The Respondent failed to bring evidence as to the contrary.

Consequently, the Panel concludes that the condition of paragraph 4(a)(iii) of the Policy is fulfilled.

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

*/Mihaela Maravela/*

**Mihaela Maravela**

Sole Panelist

Date: January 18, 2023