

ADMINISTRATIVE PANEL DECISION

Black Diamond Equipment, Ltd v. Huangming Fang Case No. D2022-4781

1. The Parties

The Complainant is Black Diamond Equipment, Ltd, United States of America (“United States” or “US”), represented by Kane Kessler, PC, United States.

The Respondent is Huangming Fang, China.

2. The Domain Name and Registrar

The disputed domain name <usa-blackdiamond.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 December 13, 2022. On December 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 14, 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), and contact information in the Complaint. The Center sent an email communication to the Complainant on December 15, 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 amended Complaint on December 16, 2022.

The Center verified that the Complaint together with the amended 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 22, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 11, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 13, 2023.

The Center appointed George R. F. Souter 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 has, since 1992 been selling sports clothing, equipment, and accessories under its BLACK DIAMOND trademark, and is the proprietor of numerous registrations of its BLACK DIAMOND trademark, including United States registration, No. 1576481, registered on January 9, 1990; United States registration, No. 1669513, registered on December 24, 1991; United States registration, No.1686547, registered on May 12, 1992; United States registration, No.3812723, registered on July 6, 2010; United States registration, No.3895591, registered on December 21, 2010; and, United States registration, No.4313399, registered on April 2, 2013.

The disputed domain name was registered on September 24, 2022, and is being used in connection with a website allegedly offering goods bearing the BLACK DIAMOND trademark for sale.

5. Parties' Contentions

A. Complainant

The Complainant alleges that the disputed domain name is confusingly similar to its BLACK DIAMOND trademark, containing the Complainant's trademark in its entirety, with the mere addition of the geographical abbreviation "USA" and a hyphen.

The Complainant alleges that the Respondent lacks rights or legitimate interests in the disputed domain name, in particular that it has never granted the Respondent permission to use its BLACK DIAMOND trademark in connection with the registration of a domain name, or otherwise.

The Complainant alleges that the disputed domain name was registered in bad faith, and is being used in bad faith in connection with the website described above.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy lists three elements that the Complainant must prove to merit a finding that the disputed domain name be transferred to the Complainant:

- (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.

A. Identical or Confusing similarity

The Panel finds that the Complainant has rights to its BLACK DIAMOND trademark for the purposes of these proceedings.

It is well established in prior decisions under the UDRP, with which the Panel agrees, that a generic Top-Level Domain (“gTLD”) may generally be disregarded when comparing a trademark with a disputed domain name. The Panel considers the “.com” gTLD to be irrelevant in the circumstances of the present case, and finds that it may be disregarded here.

The Complainant’s BLACK DIAMOND trademark is clearly recognizable in the disputed domain name, rendering the disputed domain name confusingly similar to the Complainant’s trademark, and the additional elements do not prevent this finding.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy in connection with the disputed domain names at issue.

B. Rights or Legitimate Interests

The Panel considers that the Complainant’s allegations are sufficient to provide a *prima facie* case under this heading.

It is the consensus view of UDRP panels, with which the Panel agrees, that a *prima facie* case advanced by the complainant will generally be sufficient for the complainant to be deemed to have satisfied the requirement of paragraph 4(a)(ii) of the Policy, provided the respondent does not come forward with evidence demonstrating rights or legitimate interests in the domain name and the complainant has presented a sufficient *prima facie* case to succeed under paragraph 4(a)(ii) of the Policy.

The Respondent did not advance any claim of rights or legitimate interests in the disputed domain name to rebut this *prima facie* case.

Furthermore, the nature of the disputed domain name, incorporating the Complainant’s BLACK DIAMOND trademark, carries a risk of implied affiliation to the Complainant, contrary to the fact, which cannot constitute fair use. See [WIPO Overview 3.0](#), section 2.5.1. Moreover, given the use of the disputed domain name for a web store allegedly offering the Complainant’s goods for discounted prices, such a risk has clearly manifested itself given the impersonating nature of the content, which fails to include any information regarding the relation (lack thereof) to the Complainant. Regardless of whether the goods are genuine, which seems unlikely given the unauthorized nature of the disputed domain name and the discounted prices therein, the overall nature of the disputed domain name cannot constitute a *bona fide* offering of goods or services, nor noncommercial fair use. See [WIPO Overview 3.0](#), sections 2.8 and 2.13.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy, in connection with the disputed domain name.

C. Registered and Used in Bad Faith

The Panel is of the view that the finding that a respondent has no rights or legitimate interests in a disputed domain name can lead, in appropriate circumstances, to a finding of registration of a disputed domain name in bad faith. The circumstances of the present case, in which the Panel regards it as self-evident that the Complainant’s BLACK DIAMOND trademark was deliberately appropriated in the disputed domain name, are such that the Panel concludes that a finding of registration in bad faith is justified, in connection with the disputed domain name and so finds.

Further, given the impersonating web store connected to the disputed domain name, the Panel considers the use of the dispute domain name falls squarely within the meaning of paragraph 4(b)(iv) of the Policy. The circumstances of the present case constitute, in the Panel’s opinion, a clear example of bad faith use, and, accordingly, the Panel finds that the disputed domain name is being used in bad faith.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of 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 <usa-blackdiamond.com> be transferred to the Complainant.

/George R. F. Souter/

George R. F. Souter

Sole Panelist

Date: February 8, 2023