

ADMINISTRATIVE PANEL DECISION

ABG Volcom, LLC v. Ynd Ynd
Case No. D2023-0920

1. The Parties

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

The Respondent is Ynd Ynd, Hong Kong, China.

2. The Domain Name and Registrar

The disputed domain name <soldesvolcom.store> 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 March 1, 2023. On March 2, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 2, 2023, 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, and differed from the registrant information (Domain Protection Services, Inc.) in Annex 1 to the Complaint. The Center sent an email communication to the Complainant on March 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 March 8, 2023. The Complainant also filed an amended Complaint on March 9, 2023 in response to the Center’s request for confirmation regarding the disputed domain name.

The Center verified that the Complaint together with the amendment to the Complaint and 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 March 10, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 30, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 4, 2023.


The Center appointed Fabrizio Bedarida as the sole panelist in this matter on April 18, 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 in this proceeding is the company ABG Volcom, LLC. This company was established in 1991. According to the Complainant, with over 234 million total fans on social media, the VOLCOM brand is famous in connection with its art, music, films, athletes and wide variety of branded goods and services, including women's clothing and accessories.

The Complainant further affirms that the VOLCOM brand has 100,000 points of sale throughout North America, Europe, Asia, South America and the Middle East, as well as on its own website, "www.volcom.com".

The Complainant is, *inter alia*, the owner of:

- French trademark VOLCOM registration number 92430513, filed on August 12, 1992, duly renewed;
- French trademark  ("stone logo trademark") registration number 3502265, filed on May 24, 2007, duly renewed.

The disputed domain name was registered on August 11, 2022.

The disputed domain name resolves to an active website where the content displayed shows the Complainant's stone logo trademark as well as purported VOLCOM-branded goods offered at discounted prices.

5. Parties' Contentions

A. Complainant

The Complainant claims that:

- (a) the disputed domain name is confusingly similar to the Complainant's trademark; (b) the Respondent lacks any rights or legitimate interests in the disputed domain name; and (c) the Respondent has registered and is using the disputed domain name in bad faith.

B. Respondent

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

6. Discussion and Findings

In order for the Complainant to obtain a transfer of the disputed domain name, paragraphs 4(a)(i) – (iii) of the Policy require that the Complainant must demonstrate to the Panel that:

- (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 Confusingly Similar

The Complainant has established rights in the VOLCOM trademark.

The disputed domain name contains the Complainant's VOLCOM trademark, with the addition of the term "soldes" ("sales" in French) and the generic Top-Level Domain ("gTLD") ".store". The addition of these elements in the disputed domain name does not prevent the VOLCOM trademark from being recognizable in the disputed domain name.

Pursuant to section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") which states: "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements." Section 1.11 of the [WIPO Overview 3.0](#) further states: the gTLD "is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test."

Therefore, the Panel finds the disputed domain name to be confusingly similar to the VOLCOM trademark in which the Complainant has rights.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

This Panel finds that the Complainant has made a *prima facie* case that the Respondent does not have rights or legitimate interests in the disputed domain name.

The Respondent has no connection or affiliation with the Complainant and the Complainant has not licensed or otherwise authorized the Respondent to use or register any domain name incorporating the Complainant's trademark.

The Respondent does not appear to engage in any legitimate noncommercial or fair use of the disputed domain name, nor any use in connection with a *bona fide* offering of goods or services.

Indeed, it appears that the Respondent has attempted to usurp the Complainant's goodwill in the trademark, in an attempt to confuse and deceive Internet users into doing business with the Respondent. The nature of the goods offered at the website to which the disputed domain name resolves is unclear (*i.e.*, whether genuine VOLCOM-branded products or not) and whether or not there are actual goods available for sale. However, distributors or resellers can be making a *bona fide* offering of goods and thus have a right or legitimate interest in a domain name only if the following cumulative requirements are met (*Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#); [WIPO Overview 3.0](#), section 2.8.1: (i) respondent must actually be offering the goods at issue; (ii) respondent must use the site to sell only the trademarked goods; (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and (iv) respondent must not try to "corner the market" in domain names that reflect the trademark.)

These requirements are not fulfilled in the present case because the disputed domain name falsely suggests that the website be an official site of the Complainant or of an entity affiliated to or endorsed by the Complainant by reproducing, without authorization by the Complainant, the Complainant's stone logo trademark without any disclaimer of lack of association with the Complainant.

In addition, the Respondent does not appear to be commonly known by the disputed domain name or by a similar name. Moreover, the Respondent has not replied to the Complainant's contentions, claiming any rights or legitimate interests in the disputed domain name.

Moreover, the nature of the disputed domain name is inherently misleading as it effectively impersonates or suggests sponsorship or endorsement by the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Based on the evidence put forward by the Complainant, the Panel is of the opinion that the Respondent was aware of the Complainant's trademark registrations and rights to the VOLCOM mark when it registered the disputed domain name.

The Complainant's VOLCOM trademark has been registered and used for many years. The disputed domain name is being used for a website where the content displayed shows the Complainant's stone logo trademark, purportedly offering for sale VOLCOM-branded goods at discounted prices. Consequently, it is clear that the Respondent registered the disputed domain name with the Complainant's trademark and activity in mind, and did so with the intention to attract, for commercial gain, Internet users to its own website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of either the Respondent and/or its website, so as to trick those users into doing business with the Respondent. This constitutes bad faith registration and use under the Policy as well as a disruption of the Complainant's business. Inference of bad faith can also be found in the failure to respond to the Complainant's contentions, and the Respondent's lack of any rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds, on the basis of the evidence presented, that the Respondent registered and is using the disputed domain name in bad faith.

Therefore, 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 disputed domain name, <soldesvolcom.store>, be transferred to the Complainant.

/Fabrizio Bedarida/

Fabrizio Bedarida

Sole Panelist

Date: April 24, 2023