

ADMINISTRATIVE PANEL DECISION

ABG Volcom LLC v. Client Care, Web Commerce Communications Limited Case No. D2023-2908

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 Client Care, Web Commerce Communications Limited, Malaysia.

2. The Domain Names and Registrar

The disputed domain names <volcomargentina.com> and <volcomfactory-outlet.com> are 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 6, 2023. On July 7, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On July 10, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (John Doe) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 10, 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 the same day.

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 July 18, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 7, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 18, 2023.

The Center appointed Gökhan Gökçe as the sole panelist in this matter on September 4, 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 is ABG Volcom LLC, a United States-based company established in 1991. The Complainant offers a range of clothing inspired by surfing, skateboarding, and snowboarding culture through 100,000 points of sale in North America, Europe, Asia, South America and the Middle East.

The Complainant is the owner of the registered trademarks in the mark VOLCOM including, *inter alia*:

- United States Trademark Registration No. 1725875 for VOLCOM, registered on October 20, 1992, in International Class 25;
- United States Trademark Registration No. 2534210 for VOLCOM, registered on January 29, 2002, in International Class 25;
- United States Trademark Registration No. 2689830 for VOLCOM, registered on February 25, 2003, in International Classes 9, 16, and 18;
- Argentina Trademark Registration No. 2451663 for VOLCOM, registered on July 6, 2011, in International Class 25;
- Argentina Trademark Registration No. 2451824 for Stone Device on Black Background Logo (the "Stone Logo"), registered on July 7, 2011, in International Class 25.

The Complainant also owns and operates the website to which the domain name <volcom.com> resolves.

The disputed domain name <volcomargentina.com> was registered on November 18, 2022, and, pursuant to Annex 5 of the Complaint, it was connected to a commercial website displaying the Complainant's trademark and Stone Logo, and allegedly offering for sale the Complainant's goods.

The disputed domain name <volcomfactory-outlet.com> was registered on November 17, 2022, and, pursuant to Annex 5 of the Complaint, it was connected to a commercial website displaying the Complainant's trademark and Stone Logo, and allegedly offering for sale the Complainant's goods.

At the time of this decision, the disputed domain names do not resolve to active websites.

5. Parties' Contentions

A. Complainant

The Complainant requests the transfer of the disputed domain names.

The Complainant contends that the disputed domain name <volcomargentina.com> is confusingly similar to the trademark VOLCOM in which the Complainant has rights as it reproduces the trademark in its entirety with the mere addition of the geographical term "Argentina" and the generic Top-Level Domain ("gTLD") ".com".

The Complainant contends that the disputed domain name <volcomfactory-outlet.com> is confusingly similar to its VOLCOM trademark. Further, the Complainant states that the disputed domain name incorporates entirely the Complainant's VOLCOM trademark and additionally consists of the descriptive terms "factory" and "outlet" with hyphen and the applicable gTLD ".com" which does not prevent a finding of confusing similarity with the VOLCOM trademark.

Regarding the second requirement, the Complainant alleges that the Respondent has not been licensed, contracted or otherwise permitted by the Complainant in any way to use the VOLCOM or Stone Logo trademark or to apply for any domain name incorporating the VOLCOM trademark, nor has the Complainant acquiesced in any way to such use or application of the VOLCOM trademark by the Respondent.

The Complainant contends that the disputed domain names have been registered and are being used in bad faith. The Complainant claims registration is in bad faith since the Respondent was well aware of the Complainant's trademarks at the time of registration. The Complainant notes that the trademarks were registered 30 years before the disputed domain names and are well known around the world. Furthermore, they add, a simple Google search would have disclosed the Complainant's marks and business. Moreover, the Complainant asserts that the use of the disputed domain names is also in bad faith. By using the disputed domain names for a website passing off as the Complainant's website selling competing and unauthorized goods, the Respondent intentionally attempts to attract for commercial gain Internet users to its websites. Thus, the Complainant claims that 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

Paragraph 15(a) of the Rules requires the Panel to decide a complaint based on the statements and documents submitted in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Under paragraph 4(a) of the Policy, the Complainant bears the burden of showing:

- (i) that the disputed domain names are 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 names; and
- (iii) that the disputed domain names have been registered and are being used in bad faith.

Paragraph 4(a) of the Policy states that the Complainant bears the burden of proving that all these requirements are fulfilled, even if the Respondent has not replied to the Complainant's contentions. *Stanworth Development Limited v. E Net Marketing Ltd.*, WIPO Case No. [D2007-1228](#).

However, concerning the uncontested information provided by the Complainant, the Panel may, where relevant, accept the provided reasonable factual allegations in the Complaint as true. See section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

It is further noted that the Panel has taken note of the [WIPO Overview 3.0](#) and, where appropriate, will decide consistent with the [WIPO Overview 3.0](#).

A. Identical or Confusingly Similar

The Panel finds that the Complainant has established rights over the trademarks VOLCOM and Stone Logo, based on the trademark registrations cited under section 4 above.

It is well accepted that the first element functions primarily as a standing requirement, and that the threshold test for confusing similarity involves a reasoned but relatively straightforward comparison between a complainant's trademark and the disputed domain name to assess whether the trademark is recognizable

within the disputed domain name (section 1.7 of the [WIPO Overview 3.0](#)). Moreover, as found in a number of prior cases decided under the Policy and indicated in section 1.8 of the [WIPO Overview 3.0](#), where a trademark is recognizable within a domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element. Furthermore, the gTLD is commonly disregarded under the first element confusing similarity test (section 1.11.1 of the [WIPO Overview 3.0](#)).

In the case at hand, the Complainant's trademark VOLCOM is entirely reproduced, and clearly recognizable, in the disputed domain name <volcomargentina.com>. The mere addition of the geographical term "Argentina" and the applicable gTLD suffix ".com" do not prevent a finding of confusing similarity between this disputed domain name and the Complainant's trademark VOLCOM.

The disputed domain name <volcomfactory-outlet.com> consists of the Complainant's trademark VOLCOM, together with the additional terms "factory" and "outlet", a hyphen and the applicable gTLD suffix ".com". Because the Complainant's VOLCOM trademark is recognizable within this disputed domain name, the inclusion of the additional elements does not prevent a finding of confusing similarity. Therefore, the Panel holds that the combination of the Complainant's trademark VOLCOM and the terms "factory" and "outlet" together with a hyphen in between, and the applicable gTLD suffix ".com" does not prevent a finding of confusing similarity between this disputed domain name and the Complainant's VOLCOM mark, which remains clearly recognizable in this disputed domain name (see also sections 1.8 and 1.11 of the [WIPO Overview 3.0](#)).

Accordingly, the Panel finds that the Complainant has established the first element under 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 names.

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 names, nor any use in connection with a *bona fide* offering of goods or services.

Indeed, pursuant to Annex 5 of the Complaint, it appears that the Respondent has attempted to usurp the Complainant's goodwill in the trademark, 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 names resolved 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 names falsely suggest 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 without any prominent and accurate disclaimer of lack of association with the Complainant. In addition, the Respondent does not appear to be commonly known by the disputed domain names or by similar names. Moreover, the Respondent has not replied to the Complainant's contentions, claiming any rights or legitimate

interests in the disputed domain names. Moreover, the nature of the disputed domain names 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](#).

Therefore, the Panel finds that the Complainant has established the second element under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel will first discuss the Respondent's registration of the disputed domain names. The Panel believes that the Respondent knew at the time of registration that the disputed domain names included the Complainant's abovementioned trademarks. Knowledge of the VOLCOM trademarks may be inferred from the fact that these trademarks existed for a long time prior to the Respondent's registration of the disputed domain names, and has been reinforced by the fact that the websites at the disputed domain names used the Complainant's VOLCOM trademarks (see section 3.2.2 of the [WIPO Overview 3.0](#)).

Moreover, 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](#)). Additionally, the use of the disputed domain names for websites that, without authorization of the Complainant, displayed the Complainant's VOLCOM trademarks and allegedly offered VOLCOM branded goods is a further indicator that the Respondent was aware of the Complainant, the nature of its business and the VOLCOM mark when it registered the disputed domain names. As the disputed domain names are confusingly similar to the Complainant's VOLCOM trademarks and pointed to the websites which made unauthorized use of the Complainant's VOLCOM trademarks and images from the Complainant's websites and purported to sell products which were branded with the Complainant's VOLCOM trademarks, it is inevitable that confusion will be caused to Internet users. It is also clear that the Respondent intends to create that confusion for the purpose of commercial gain. For this reason, the Panel finds that the disputed domain names have been used in bad faith.

The current non-use of the disputed domain names does not change the Panel's finding of the Respondent's bad faith under the circumstances of this case.

Therefore, the Panel finds that the Complainant has established the third element under 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 names <volcomargentina.com> and <volcomfactory-outlet.com> be transferred to the Complainant.

/Gökhan Gökçe/

Gökhan Gökçe

Sole Panelist

Date: September 18, 2023