

ADMINISTRATIVE PANEL DECISION

ABG-Volcom, LLC v. Bgstr Bgstr
Case No. D2023-3398

1. The Parties

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

The Respondent is Bgstr Bgstr, China.

2. The Domain Name and Registrar

The disputed domain name <volcomofficial.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 August 9, 2023. On August 9, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 11, 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. The Center sent an email communication to the Complainant on August 21, 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 21, 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 22, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 11, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 12, 2023.

The Center appointed Adam Samuel as the sole panelist in this matter on September 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 manufactures clothes. The Complainant owns a number of trademarks for the name VOLCOM, including the United States of America trademark, number 1725875, registered on October 20, 1992. The Complainant registered the domain name <volcom.com> on October 12, 1996 through which it promotes its products.

The disputed domain name was registered on September 22, 2022. The disputed domain name resolves to a website which appears to be marketing clothes manufactured by the Complainant.

5. Parties' Contentions

A. Complainant

The disputed domain consists of the usual "www." prefix, the Complainant's well-known trademark and name, the descriptive word "official" and the generic suffix ".com". Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless or otherwise) does not prevent a finding of confusing similarity.

The Respondent has not been licensed or otherwise permitted by the Complainant to use the VOLCOM trademarks or to apply for any domain name incorporating the VOLCOM marks. There is no evidence that "Volcom Official" is the name of the Respondent's corporate entity. The Respondent has been actively using the VOLCOM trademarks in the disputed domain name and the physical website to which it resolves to promote its website for illegitimate commercial gains. This use is likely to trick consumers into erroneously believing that the Complainant is somehow affiliated with the Respondent or endorsing the Respondent's commercial activities.

The Respondent is selling counterfeit VOLCOM goods via a website that mirrors the Complainant's website in an attempt to pass the disputed domain name's website off as an official website of the Complainant.

B. Respondent

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

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (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 disputed domain name consists of the Complainant's trademark, the word "official", and the generic Top-Level Domain ("gTLD") ".com". The gTLD is irrelevant here as it is a standard registration requirement. See section 1.11.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)).

Section 1.8 of the [WIPO Overview 3.0](#) says:

"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."

VOLCOM is a distinctive made-up word with no independent meaning. The word "official" either seems to denote that the domain name is the official website of the Complainant or is meaningless.

For all these reasons, the Panel concludes that the disputed domain name is confusingly similar to the Complainant's trademark.

B. Rights or Legitimate Interests

The Respondent is not called "volcomofficial" or anything similar. There is no evidence that the Complainant has ever authorised the Respondent to use its trademarks. The Respondent does not appear to have used the disputed domain name for any legitimate purpose.

Based on the available record, where the Complainant has made out a preliminary case that the Respondent lacks rights or legitimate interests, and in the absence of any response on this point, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name. See section 2.1 of the [WIPO Overview 3.0](#).

C. Registered and Used in Bad Faith

In this case, the website to which the disputed domain name resolves offers for sale the Complainant's clothing using the Complainant's logo. The Respondent knew of the Complainant and its business when it registered the disputed domain name.

The Respondent appears to have registered the disputed domain name in order to exploit the Complainant's trademark and brand in order to sell clothes without the Complainant's authorisation.

In using the disputed domain name, the Respondent appears to have "intentionally attempted to attract, for commercial gain, Internet users" to its website, by creating "a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement" of its website or location or of a product on its website. This is evidence of registration and use in bad faith under paragraph 4(b)(iv) of the Policy.

For all these reasons, the Panel concludes, therefore, that the Respondent registered and is using the disputed domain name in bad faith.

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

/Adam Samuel/

Adam Samuel

Sole Panelist

Date: September 25, 2023