

ADMINISTRATIVE PANEL DECISION

ABG-Volcom, LLC v. chenjian ting

Case No. D2023-4646

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 chenjian ting, China.

2. The Domain Name and Registrar

The disputed domain name <volcomsports.com> is registered with Gransy, s.r.o. d/b/a subreg.cz (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 8, 2023. On November 9, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 10, 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 November 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 November 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 4, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 5, 2023.

The Center appointed Andrew Brown K.C. as the sole panelist in this matter on December 8, 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 located in New York, United States. The Complainant was founded in 1991. It operates as a board sports-riding company. It produces a wide variety of branded goods and services including clothing and accessories.

The Complainant has a worldwide trademark portfolio of more than 350 trademark filings with a mark VOLCOM and different forms of a logo form of VOLCOM (the VOLCOM Trademarks). Relevant trademarks owned by the Complainant and on which the Complaint is based are:

Mark	Jurisdiction	Registration No.	Date of Registration	Class
VOLCOM	United States	1725875	October 20, 1992	25
VOLCOM	United States	2534210	January 29, 2002	25
VOLCOM	United States	2689830	February 25, 2003	9, 16 and 18

The Complainant exerts control over the VOLCOM Trademarks and imposes quality control over the use of its VOLCOM Trademarks on goods and services.

The Complainant also actively uses its VOLCOM Trademarks in its domain name “www.volcom.com”.

The disputed domain name was registered on June 6, 2023. The Respondent is located in China. The disputed domain name hosts a website which uses the VOLCOM Trademark as well as images of products using the VOLCOM Trademark.

5. Parties’ Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is identical or confusingly similar to the VOLCOM Trademarks (and the extensive range of registration for VOLCOM which the Complainant holds worldwide).

The Complainant states that the word “volcom” is recognizable in the disputed domain name and that the addition of another generic term such as “sports” (in this case) does not prevent a finding of confusing similarity.

The Complainant further states that the Respondent has no rights or legitimate interests in respect of the disputed domain name. It states that the Respondent has not been licensed, contracted or otherwise permitted by the Complainant in any way to use its VOLCOM Trademarks or to apply for any domain name using the VOLCOM Trademarks.

The Complainant says that there is no evidence that the trademark VOLCOM is the name of the Respondent or its corporate entity nor is there any evidence of fair use or any *bona fide* offering of goods and services. Instead, the Complainant states that the Respondent has been using the disputed domain name to display the VOLCOM Trademark and to promote a website at the disputed domain name for illegitimate commercial gain through misleading consumers as to origins of the goods and services offered on that website.

The Complainant asserts there is no evidence of any use or demonstrable preparation to use the disputed domain name in connection with any *bona fide* offering of goods or services; nor is the Respondent commonly known by the disputed domain name, nor is the Respondent making any legitimate noncommercial or fair use of the disputed domain name.

Finally, the Complainant states that the disputed domain name was registered and is being used in bad faith – in particular to sell competing and unauthorized goods.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel is also satisfied that the disputed domain name has been registered in bad faith for the following reasons:

(i) The Panel finds that the Complainant's VOLCOM Trademark is well-known for core goods (including clothing) relating to board-riding activities. The VOLCOM Trademark has been in active use since 1992. It is inconceivable, given the reputation of the VOLCOM Trademark that the Respondent was unaware of the Complainant's VOLCOM Trademark. The Panel is satisfied that the Respondent was aware of the Complainant's VOLCOM Trademark at the time of registration. This is demonstrated by the use of the term "sports" as part of the disputed domain name and is reinforced by the creation of a website operating from the disputed domain name which purports to sell VOLCOM trademarked clothing.

(ii) Paragraph 2 of the UDRP puts a burden on registrants where it states:

"By applying to register a domain name, or by asking us to maintain or renew a domain name registration, you hereby represent and bond to us that [...] to your knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of a third party [...]. It is your responsibility to determine whether your domain name infringes or violates someone else's rights".

Even the most cursory trademark or other online search or any online search of existing domain names prior to the Respondent registering the disputed domain name would instantly have revealed the Complainant and its VOLCOM Trademark. See in this regard section 3.2.3 of the [WIPO Overview 3.0](#).

The Panel is also satisfied that the Respondent is using the disputed domain name in bad faith for the following reasons:

(i) The registration of the disputed domain name which prominently features the Complainant's VOLCOM Trademark plus the term "sports" has been found earlier to be confusingly similar to the Complainant's VOLCOM Trademark. Noting the connection of the Complainant and sports, and that there is no other apparent reason for the registration of the disputed domain name comprising the VOLCOM Trademark together with the term "sports" but to target the Complainant, the Panel finds this combination creates a presumption of bad faith. The presumption is confirmed by the fact that the website (to which the disputed domain name redirects) amounts to an attempt to impersonate the Complainant. The Panel finds that the disputed domain name and its use creates a serious likelihood of confusion with the Complainant and its VOLCOM Trademark.

(ii) The Respondent is using the disputed domain name to host a website which uses the VOLCOM Trademark as well as images of products bearing the VOLCOM Trademark without any authorization. The Panel is satisfied that this is intended to attract Internet users to the website for commercial gain and is trying to create a commercial gain and is trying to create a likelihood of confusion with the Complainant's Trademark as to source, sponsorship, affiliation or endorsement.

(iii) The Respondent had the opportunity to respond to the Complaint but has not done so. The Panel is therefore entitled to draw adverse inferences from that failure or omission, which in the circumstances of this case supports a finding of bad faith.

Based on the available record, the Panel finds the third element of the Policy has not been established.

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, <volcomsports.com> be cancelled.

/Andrew Brown K.C./

Andrew Brown K.C.

Sole Panelist

Date: December 15, 2023