

## **ADMINISTRATIVE PANEL DECISION**

**Black Diamond Equipment, LTD v. Lu jiaWang**  
**Case No. D2023-4866**

### **1. The Parties**

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

The Respondent is Lu jiaWang, China.

### **2. The Domain Name and Registrar**

The disputed domain name <bdoutdoorstore.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 November 21, 2023. On November 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 28, 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 (Redacted) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 30, 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 amended Complaint on December 5, 2023.

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 8, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 28, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 2, 2024.

The Center appointed Kiyoshi Tsuru as the sole panelist in this matter on January 4, 2024. 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 Black Diamond Equipment, LTD, a manufacturer of equipment for climbing, skiing, and mountain sports, based in Utah, United States, and is a wholly-owned indirect subsidiary of Clarus Corporation.

The Complainant is the owner of several trademark registrations before the United States Patent and Trademark Office, among others, the following:

Trademark	No. Registration	Jurisdiction	Date of Registration
<b>BD</b>  <b>dry</b>	5552576	United States	August 28, 2018
<b>BD</b>  <b>dry</b>	5705361	United States	March 19, 2019
<b>BD</b>  <b>dry</b>	5814816	United States	July 23, 2019
<b>BD</b>  <b>dry</b>	5829300	United States	August 06, 2019
<b>BD</b>  <b>dry</b>	6014301	United States	March 17, 2020
<b>BLACK DIAMOND</b>	1686547	United States	May 12, 1992
<b>BLACK DIAMOND</b>	1669513	United States	December 24, 1991
<b>BLACK DIAMOND</b>	3812723	United States	July 06, 2010
<b>BLACK DIAMOND</b>	3895591	United States	December 21, 2010
<b>BLACK DIAMOND</b>	4313399	United States	April 02, 2013

The Complainant's official domain name is <blackdiamondequipment.com>, which was registered on January 24, 1997.

The Respondent registered the disputed domain name on November 22, 2022, and it resolves to a website that operates an online store that purportedly offers apparel and accessories for climbing, skiing, and mountain sports.

#### 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:

It is the owner of the BD DRY (AND DESIGN) and BLACK DIAMOND trademarks that cover fabric used for outdoor apparel, climbing and outdoor equipment.

It has invested significant time, resources, and effort promoting the BD DRY (AND DESIGN) and BLACK DIAMOND trademarks, as a result of which they have become strong and famous source identifiers for the goods commercialized by the Complainant.

It has used and registered the BD DRY (AND DESIGN) and BLACK DIAMOND trademarks prior to the (unauthorized) use that the Respondent has made of the trademarks BD DRY (AND DESIGN) and BLACK DIAMOND.

It has been using the trademark BD DRY (AND DESIGN) in connection with the mentioned goods covered by it at least since as early as September 30, 2017, and has been using the BLACK DIAMOND trademark in connection with said goods since at least as early as February 18, 1992.

BD DRY (AND DESIGN) and BLACK DIAMOND are well-known trademarks.

### **I. Identical or Confusingly Similar**

The disputed domain name is confusingly similar to the Complainant's trademark, since it incorporates entirely the term "BD", followed by the term "outdoorstore". That the term "BD" is the distinctive portion of the trademark BD DRY (AND DESIGN).

The disputed domain name merely removes the descriptive term "dry" from the literal elements of the trademark BD DRY (AND DESIGN), appropriates the most distinctive portion of said trademark ("BD"), and adds other descriptive terms to said domain name.

### **II. Rights or Legitimate Interests**

There is no evidence of the Respondent's use of, or demonstrable preparations to use the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services.

There is no evidence to support that the Respondent is commonly known by the disputed domain name.

There is no evidence that the Respondent has acquired any trademark or service mark rights in connection with the trademark BD DRY (AND DESIGN).

The Respondent is not making a legitimate noncommercial or fair use of the disputed domain name.

The Complainant has no connection to and has never heard of the Respondent prior to this dispute.

### **III. Registered and Used in Bad Faith**

The disputed domain name resolves to a website that:

1. is purportedly offering for sale counterfeit goods at the website to which the disputed domain name resolves, which goods are being falsely identified and labeled as BLACK DIAMOND goods;
2. the Respondent is also falsely holding itself out as the Complainant and/or affiliated with and/or an authorized distributor of the Complainant.
3. features copyright-protected images copied from the Complainant's official website.

Therefore, the disputed domain name was registered by the Respondent primarily for the purpose of disrupting the business of the Complainant.

By using the disputed domain name, the Respondent has intentionally attempted to attract for commercial gain Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of the Respondent's website, and the products offered therein.

### **B. Respondent**

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

## 6. Discussion and Findings

Given the Respondent's failure to submit a formal Response, the Panel may decide this proceeding based on the Complainant's undisputed factual allegations, in accordance with paragraphs 5(f), 14(a), and 15(a) of the Rules, (see *Joseph Phelps Vineyards LLC v. NOLDC, Inc., Alternative Identity, Inc., and Kentech*, WIPO Case No. [D2006-0292](#)).

### 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.

The Complainant has shown rights in respect of a trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the dominant feature (here "BD") of the relevant mark (here BD DRY) is recognizable 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.

Although the addition of other terms (here, "outdoor" and "store") may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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 to 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 to or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

According to the evidence filed by the Complainant, the website to which the disputed domain name resolves seems to be an online store, through which apparel and accessories for climbing, skiing, and mountain sports products are purportedly being sold. According to the affirmations and evidence submitted by the Complainant, and not rebutted by the Respondent, said products are counterfeit.

Moreover, the Panel notes that the composition of the disputed domain name carries a risk of implied affiliation since Internet users may think that the website to which this disputed domain name resolves is the

Complainant's official website or is otherwise affiliated to or sponsored by the Complainant (see section 2.5.1 of the [WIPO Overview 3.0](#), see also *Euro Sko Norge AS v. Whoisguard Inc. / Shier Dede, Shier Dede* WIPO Case No. [D2020-0194](#), *Bechtel Group, Inc. v. Raman Shuk* WIPO Case No. [D2020-1469](#), *Biofarma v. Dawn Mason* WIPO Case No. [D2019-1952](#)).

Furthermore, the website to which the disputed domain name resolves predominantly displays the Complainant's BLACK DIAMOND trademark. It also reproduces images of the Complainant's official products, which copyrights, according to the Complainant, belong to the said Complainant. Moreover, the copyright notice displayed on the website to which the disputed domain name resolves purports that the Respondent is the rights holder of said images and content. This shows that the Respondent has attempted to impersonate the Complainant. A finding of impersonation prevents a determination of a bona fide offering of goods (see sections 2.5.1, and 2.13.1 of the [WIPO Overview 3.0](#); see also *Self-Portrait IP Limited v. Franklin Kelly*, WIPO Case No. [D2019-0283](#); *Seminole Tribe of Florida, d/b/a Seminole Gaming v. Privacy Protect, LLC / Ibro King, Akara Inc*, WIPO Case No. [D2018-1692](#); *Allianz SE v. Paul Umeadi, Softcode Microsystems*, WIPO Case No. [D2019-1407](#); *SVB Financial Group v. WhoisGuard Protected, WhoisGuard, Inc. / Citizen Global Cargo*, WIPO Case No. [D2018-0398](#); and *Haas Food Equipment GmbH v. Usman ABD, Usmandel*, WIPO Case No. [D2015-0285](#)).

Further, panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1. The evidence submitted by the Complainant suggests that the Respondent has attempted to impersonate the Complainant. The website to which the disputed domain name resolves predominantly displays the Complainant's trademarks, including their logo.

The Panel finds the second element of the Policy has been established.

### **C. Registered and Used in Bad Faith**

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent chose to register the disputed domain name, which resolves to a website that displays the Complainant's trademark and logo, makes available images which rights apparently belong to the Complainant, and purportedly offers the same type of products that the Complainant sells (which, according to the Complainant, are counterfeit), which fact suggests that the Respondent knew the Complainant, its trademarks, and its business when registering the disputed domain name, and that the Respondent has targeted the Complainant, which constitutes opportunistic bad faith (see section 3.2.1 of the [WIPO Overview 3.0](#); see also *L'Oréal v. Contact Privacy Inc. Customer 0149511181 / Jerry Peter*, WIPO Case No. [D2018-1937](#); and *Gilead Sciences Ireland UC / Gilead Sciences, Inc. v. Domain Maybe For Sale c/o Dynadot*, WIPO Case No. [D2019-0980](#)).

The evidence submitted by the Complainant also shows that the Respondent has intentionally used the disputed domain name to attract, for commercial gain, Internet users to the website to which the disputed domain name resolves, by creating the impression among Internet users that said website is related to, associated with, or endorsed by the Complainant, which conduct constitutes bad faith under paragraph 4(b)(iv) of the Policy (see section 3.1.4 of the [WIPO Overview 3.0](#); see also *trivago GmbH v. Whois Agent, Whois Privacy Protection Service, Inc. / Alberto Lopez Fernandez, Alberto Lopez*, WIPO Case No. [D2014-0365](#); and *Jupiter Investment Management Group Limited v. N/A, Robert Johnson*, WIPO Case No. [D2010-0260](#)).

Panels have held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods, impersonation/passing off, or other types of fraud) constitutes bad faith. (See the Panel's determination on impersonation in the analysis of the second factor of the Policy, supra) [WIPO Overview 3.0](#), section 3.4.

The Panel finds that the Complainant has established the third element 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 <bdoutdoorstore.com>, be transferred to the Complainant.

*/Kiyoshi Tsuru/*

**Kiyoshi Tsuru**

Sole Panelist

Date: January 18, 2024