

ADMINISTRATIVE PANEL DECISION

Black Diamond Equipment, LTD v. Qiu Xiaofeng
Case No. D2023-5405

1. The Parties

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

The Respondent is Qiu Xiaofeng, China.

2. The Domain Name and Registrar

The disputed domain name <blackdiamondaustralia.net> (“Disputed Domain Name”) is registered with PakNIC (Private) Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 29, 2023. On January 2, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On January 5, 2024, the Registrar transmitted by email to the Center its verification response disclosing the registrant and contact information for the Disputed Domain Name which differed from the named Respondent (Whois Agent, Web Domains By Proxy) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 10, 2024, 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 January 15, 2024.

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 January 19, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 8, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 20, 2024.

The Center appointed Gabriela Kennedy as the sole panelist in this matter on February 23, 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 a business trading in mountain equipment, such as apparel and equipment for skiing, running and hiking, under the mark "BLACK DIAMOND" (the "Complainant's Trademark") since as early as 1992. It is based in the United States ("US") and trades across America, Asia, Australia and Europe.

The Complainant owns various US trademark registrations for or containing the Complainant's Trademark. The relevant registrations include, inter alia, US Trademark Registration No. 1686547 for BLACK DIAMOND in Class 28 registered on May 12, 1992, US Registration No. 1669513 for BLACK DIAMOND in Class 22 registered on December 24, 1991; and US Registration No. 73789629 for  Black Diamond in Class 25 registered on January 9, 1990.

The Complainant's Trademark is fully incorporated in the Complainant's domain name <blackdiamondequipment.com> which resolves to the Complainant's website.

The Disputed Domain Name was registered by the Respondent on July 22, 2023. At the time of filing of the Complaint and at the time of the decision, the Disputed Domain Name resolved to a website in English, purporting to offer products under the Complainant's Trademark (the "Respondent's Website").

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 the following:

- (a) The Disputed Domain Name is confusingly similar to the Complainant's Trademark as it incorporates the Complainant's Trademark in its entirety. Combined with the geographical term "australia", the Disputed Domain Name does not prevent a finding of confusing similarity with the Complainant's Trademark;
- (b) The Respondent has no rights or legitimate interests in the Disputed Domain Name. The Respondent has not obtained any licence or authorization from the Complainant to use the Complainant's Trademark as part of a domain name or otherwise. The Respondent's fraudulent use of the Complainant's Trademark and photographs on the Respondent's Website in connection with counterfeit goods constitutes trademark and copyright infringement, unfair competition, and other violations of US laws; and
- (c) The Complainant's Trademark is well-known and predates the Respondent's use of the Complainant's Trademark, as such the Respondent was or should have been aware of the Complainant's Trademark prior to registering the Disputed Domain Name. The Respondent intentionally registered the Disputed Domain Name to disrupt the Complainant's business for commercial gain by creating a likelihood of confusion with the Complainant's Trademark. Therefore, the Respondent has registered and used the Disputed Domain Name in bad faith.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements:

- (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 by the Respondent in bad faith.

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 entirety of the Complainant's Trademark 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.

Although the addition of another term here, "australia" may bear on the assessment of the second and third elements, the Panel finds that the addition of such geographical term 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.

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.

The Respondent's failure to file a Response may result in the Panel drawing appropriate inferences from such default. The Panel may also accept all reasonable and supported allegations and inferences flowing from the Complainant as true (see *Entertainment Shopping AG v. Nischal Soni, Sonik Technologies*, WIPO Case No. [D2009-1437](#); and *Charles Jourdan Holding AG v. AAIM*, WIPO Case No. [D2000-0403](#)).

The Panel agrees with the Complainant that there is no evidence to show that the Respondent has trademark rights corresponding to the Disputed Domain Name, or that the Respondent has become known by the Disputed Domain Name.

The Respondent would likely not have adopted the Complainant's Trademark if not for the purpose of creating an impression that the Disputed Domain Name is associated with, or originates from, the Complainant.

There is no evidence to suggest that the Respondent's use of, or demonstrable preparations to use the Disputed Domain Name or a name corresponding to the Disputed Domain Name, is in connection with a bona fide offering of goods or services or be regarded as legitimate noncommercial or fair use.

Panels have held that the use of a domain name for illegal activity, the sale of counterfeit goods and the impersonation of the Complainant, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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, it is difficult to conceive of any plausible use of the Disputed Domain Name that would amount to good faith use, given that it has incorporated the Complainant's Trademark in its entirety and the Respondent is passing itself off as the Complainant and selling counterfeit products bearing the Complainant's Trademark on the Respondent's Website. As discussed above, the Respondent lacks any rights or legitimate interests in the Disputed Domain Name (see *Washington Mutual, Inc. v. Ashley Khong*, WIPO Case No. [D2005-0740](#)). Further, the Respondent failed to respond to the Complainant's contentions and has provided no evidence of its actual or contemplated good faith use of the Disputed Domain Name.

Panels have held that the use of a domain name for illegal activity, the sale of counterfeit goods and the impersonation of the Complainant, amount to bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the Disputed Domain Name constitute bad faith under the Policy.

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 <blackdiamondaustralia.net> be transferred to the Complainant.

/Gabriela Kennedy/
Gabriela Kennedy
Sole Panelist
Date: March 8, 2024