

## **ADMINISTRATIVE PANEL DECISION**

Black Diamond Equipment, Ltd, v. Zhang Fei  
Case No. D2024-1621

### **1. The Parties**

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

The Respondent is Zhang Fei, China.

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

The disputed domain name <blackdiamondpolska.com> (the “Disputed Domain Name”) is 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 April 17, 2024. On April 18, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On April 19, 2024, 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 (“Whois Agent”) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 23, 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 April 23, 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 April 26, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 16, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 22, 2024.

The Center appointed Mariia Koval as the sole panelist in this matter on May 28, 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, founded in 1989, is a manufacturer of equipment for climbing, skiing, and mountain sports.

The Complainant is the owner of numerous BLACK DIAMOND trademark registrations (the "BLACK DIAMOND Trademark") around the world, among which are:

- United States Trademark Registration No. 1669513, registered on December 24, 1991, in respect of goods in class 22;
- United States Trademark Registration No. 1686547, registered on May 12, 1992, in respect of goods in class 28;
- International Trademark Registration No. 854462, registered on June 23, 2005, in respect of goods in classes 6, 8, 11, 22, 25, 28.

The Complainant has expended significant time, resources, and effort promoting its BLACK DIAMOND Trademark and developing it as a strong and famous source identifier for its goods. The Complainant operates a domain name <blackdiamondequipment.com> for sale and promotion of its goods under the BLACK DIAMOND Trademark. The Complainant also established a social media presence and uses the BLACK DIAMOND Trademark to promote its goods on social media platforms such as Facebook, Instagram and YouTube.

The registration date of the Disputed Domain Name is August 6, 2022. As of the date of this Decision, the Disputed Domain Name resolves to an inactive website. However, according to the evidence presented by the Complainant (Annexes 4, 6, 7 to the Complaint), the Disputed Domain Name previously resolved to a website where allegedly counterfeit goods falsely identified and labeled under the BLACK DIAMOND Trademark were offered for sale. The Respondent has also falsely held itself out as the Complainant and/or affiliated with and/or an authorized distributor of the Complainant.

#### **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 confusingly similar to the Complainant's BLACK DIAMOND Trademark. The Disputed Domain Name incorporates the Complainant's BLACK DIAMOND Trademark in its entirety with the addition of the word "polska" (which means "Poland" in Polish).

The Complainant further contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name in view of the following. To the best of the Complainant's knowledge, 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. The Respondent is not making a legitimate non-commercial or fair use of the Disputed Domain Name, but is instead intentionally and misleadingly diverting consumers to his fraudulent website and tarnishing the BLACK DIAMOND Trademark. Moreover, the Respondent reproduced the images, for which the Complainant has a copyright, on the website under the Disputed Domain Name.

The Respondent has not been commonly known by the Disputed Domain Name. To the best of the Complainant's knowledge, there is no evidence that the Respondent has acquired any rights in connection with the BLACK DIAMOND Trademark. The Complainant has no connection whatsoever to the Respondent and has never heard of the Respondent prior to this dispute.

The Complainant further contends that the Respondent registered and is using the Disputed Domain Name in bad faith. 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 intentionally attempted to attract for commercial gain Internet users to the Respondent's website by creating a likelihood of confusion with the Complainant's BLACK DIAMOND Trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website and of a product or service on the Respondent's website or location.

## **B. Respondent**

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

## **6. Discussion and Findings**

Under paragraph 4(a) of the Policy, in order to succeed a complainant must satisfy the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which 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 was registered and is being used 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 or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the Complainant's BLACK DIAMOND Trademark is reproduced within the Disputed Domain Name with the addition of the geographical term "polska" and the generic Top-Level domain ("gTLD") ".com". According to the [WIPO Overview 3.0](#), section 1.8, 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. In this case, the addition of the term "polska" (which means "Poland" in Polish), to the BLACK DIAMOND Trademark does not prevent a finding of confusing similarity.

According to the [WIPO Overview 3.0](#), section 1.11, the applicable gTLD in a domain name (e.g., ".com", ".club", ".nyc") is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test.

Pursuant to the [WIPO Overview 3.0](#), section 1.7, in cases where a domain name incorporates the entirety of a trademark, the domain name will normally be considered identical or confusingly similar to that mark for purposes of UDRP standing.

Accordingly, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's BLACK DIAMOND Trademark pursuant to paragraph 4(a)(i) of the Policy.

## 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 registered the Disputed Domain Name more than 30 years after the BLACK DIAMOND Trademark had been registered; there is no evidence that the Respondent owns any BLACK DIAMOND Trademarks, nor that he is commonly known by the Disputed Domain Name.

There is no evidence that the Respondent is making a legitimate non-commercial or fair use of the Disputed Domain Name or that before any notice of the dispute the Respondent has made 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. On the contrary, the Disputed Domain Name is being used to mislead Internet users, by offering allegedly counterfeit products for sale under the BLACK DIAMOND Trademark, for the purpose of making a profit.

According to the [WIPO Overview 3.0](#), section 2.8.1, UDRP panels have recognized that resellers, distributors, or service providers using a domain name containing the complainant’s trademark to undertake sales or repairs related to the complainant’s goods or services may be making a bona fide offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the “Oki Data test” (*Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#)), the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant’s relationship with the trademark holder; and
- (iv) the respondent must not try to “corner the market” in domain names that reflect the trademark.

As is seen from the circumstances of this case, the website under the Disputed Domain Name does not disclose the relationship between the Complainant and the Respondent. On the contrary, it creates a false impression that the website under the Disputed Domain Name is the Complainant’s official website or related to the Complainant. The impression that the website under the Disputed Domain Name belongs to the Complainant is also reinforced by the Respondent’s use of the Complainant’s copyrighted photos. Thus, the Respondent does not satisfy the conditions of the Oki Data test.

Moreover, in accordance with the [WIPO Overview 3.0](#), section 2.5.1, even where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such

composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. The addition of the geographical term “polska”, which translates to “Poland” in the Polish language, where the Complainant also conducts business, to the Complainant’s BLACK DIAMOND Trademark in the Disputed Domain Name, is further evidence, that the Respondent was very well aware of the Complainant’s BLACK DIAMOND Trademark and business at the time of registration of the Disputed Domain Name and has done so for the only purpose of creating an impression that the Disputed Domain Name is connected with the Complainant’s BLACK DIAMOND Trademark.

The Respondent did not file any response to the Complaint and did not participate in this proceeding, respectively, the Respondent did not present any evidence for supporting any rights or legitimate interests in the Disputed Domain Name.

In view of the foregoing, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and that the Complainant succeeds under the second element of paragraph 4(a) of the Policy.

### **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 finds that the Respondent has registered and is using the Disputed Domain Name in bad faith in view of the following.

The Disputed Domain Name was registered long after the Complainant registered its BLACK DIAMOND Trademark. The Disputed Domain Name incorporates the Complainant’s BLACK DIAMOND Trademark in whole and previously resolved to the website with use of the Complainant’s photos and offering of the allegedly counterfeit Complainant’s products for sale that might create a likelihood of confusion with the Complainant’s BLACK DIAMOND Trademark as to the source, sponsorship, affiliation, or endorsement of the Disputed Domain Name. Having reviewed the record, the Panel finds the Respondent’s registration and use of the Disputed Domain Name constitutes bad faith under the Policy. Internet users might have been under the impression that it is a website created and operated by the Complainant or a certified service provider of the Complainant, which is not true. Moreover, such use of the Disputed Domain Name indicates that the Respondent was well aware of the Complainant’s business and BLACK DIAMOND Trademark when he registered the Disputed Domain Name. Generally speaking, the evidence in the case file as presented indicates that the Respondent’s aim in registering the Disputed Domain Name was obviously to profit from or exploit the Complainant’s BLACK DIAMOND Trademark.

The Panel is also of the opinion that it is clear that the Respondent, having registered and used the Disputed Domain Name, which is confusingly similar to the Complainant’s BLACK DIAMOND Trademark, intended to disrupt the Complainant’s business and confuse Internet users seeking for or expecting the Complainant. In view of the absence of any evidence to the contrary and that the Respondent did not file any response to claim otherwise, the Panel concludes that the Respondent has registered and is using the Disputed Domain Name in bad faith.

Finally, the Respondent, not participating in the proceeding, has failed to indicate any facts and/or evidence, which would show the good faith registration or use of the Disputed Domain Name.

The Panel finds the third element of the Policy has 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 <blackdiamondpolska.com> be transferred to the Complainant.

/Mariia Koval/

**Mariia Koval**

Sole Panelist

Date: June 11, 2024