

ADMINISTRATIVE PANEL DECISION

Black Diamond Equipment, Ltd. v. Zhang Fei
Case No. D2024-1844

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 <blackdiamond-nederland.com> 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 May 1, 2024. On May 2, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 6, 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 May 6, 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 May 7, 2024.

The Center verified that the Complaint [together with the amendment to the Complaint/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 May 14, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 3, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 4, 2024.

The Center appointed Andrew F. Christie as the sole panelist in this matter on June 11, 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 designs, manufactures, and sells mountain sports equipment. It is the owner of a number of registrations for word and figurative trademarks consisting of or containing BLACK DIAMOND, including: United States Trademark No. 1669513 (filed September 20, 1990; registered December 24, 1991) and International Trademark No. 854464 (registered June 22, 2005), both of which are for the BLACK DIAMOND word trademark; and United States Trademark No. 1576481 (filed March 27, 1989; registered January 9, 1990) and International Trademark No. 854462 (registered June 22, 2005), both of which are for the BLACK DIAMOND figurative trademark. The Complainant conducts business on the Internet at “www.blackdiamond.com”, among other locations.

The disputed domain name was registered on December 23, 2023. The Complainant provided a screenshot, said to be taken on February 22, 2024, of a webpage displaying the Complainant’s figurative BLACK DIAMOND trademark, showing a picture of a rock climber wearing a helmet with the Complainant’s trademark, and containing menus labelled “Heren”, “Dames”, and “Unisex”, at which the Complainant said counterfeit goods were offered for sale. As of the date of this decision, the disputed domain name does not resolve to an active location.

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.

The Complainant contends that the disputed domain name is confusingly similar to a trademark in which it has rights on the following grounds, among others. The disputed domain name appropriates the entirety of the Complainant’s BLACK DIAMOND trademark, only adding “Nederland”, which means “Netherlands” in Dutch.

The Complainant contends that the Respondent does not have any rights or legitimate interests in the disputed domain name on the following grounds. 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 has not been 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 Complainant’s trademark. The Respondent is not making a legitimate noncommercial or fair use of the disputed domain name, but instead is intentionally and misleadingly diverting consumers to its fraudulent website and tarnishing the Complainant’s trademark. The Complainant has no connection whatsoever to the Respondent and had never heard of the Respondent prior to this dispute.

The Complainant contends that the Respondent has registered and is using the disputed domain name in bad faith on the following grounds. 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 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

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. It is the owner of a number of trademark registrations for the word trademark BLACK DIAMOND.

The entirety of the Complainant's word trademark is reproduced within the disputed domain name, followed by a hyphen and the Dutch word for Netherlands. Although the addition of other terms 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 trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8. The Panel finds the Complainant's trademark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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 Panel considers that the composition of the disputed domain name carries a risk of implied affiliation with the Complainant. [WIPO Overview 3.0](#), section 2.5.1. Also, the evidence establishes that the Respondent has used the disputed domain name to resolve to a website which seeks to impersonate the Complainant by reproducing the Complainant's trademark and products. Panels have held that the use of a domain name for illegal activity, such as impersonation, 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, the Panel notes that: (i) the Respondent registered the disputed domain name more than three decades after the Complainant first registered its BLACK DIAMOND trademark; (ii) the disputed domain name incorporates the Complainant's trademark in its entirety, and merely adds the name of a country (in this case, the Netherlands); and (iii) the Respondent used the disputed domain name to resolve to a website displaying the Complainant's trademark and falsely giving the impression it is associated with the Complainant. It is clear the Respondent registered the disputed domain name with knowledge of the Complainant's trademark.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1. The evidence shows that the Respondent has used the disputed domain name in an intentional attempt to attract, for commercial gain, Internet users to a website by creating a likelihood of confusion with the Complainant's trademark. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes 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 <blackdiamond-nederland.com> be transferred to the Complainant.

/Andrew F. Christie/

Andrew F. Christie

Sole Panelist

Date: June 25, 2024