

ADMINISTRATIVE PANEL DECISION

Black Diamond Equipment, Ltd v. Zhang Fei
Case No. D2024-2006

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 Names and Registrar

The disputed domain names <blackdiamond-equipmentspain.com> and <blackdiamondequipmentspain.com> (the “Domain Names”) are 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 14, 2024. On May 15, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On May 16, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Names 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 20, 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 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 May 28, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 17, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 24, 2024.

The Center appointed Gregor Vos as the sole panelist in this matter on July 1, 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 company active in the field of outdoor equipment and outdoor clothing.

The Complainant is the owner of inter alia the following trademark registrations (the “Trademarks”):

- Unites States Trademark registration No. 1669513 for the wordmark BLACK DIAMOND, registered on December 24, 1991;
- Unites States Trademark registration No. 1686547 for the wordmark BLACK DIAMOND, registered on May 12, 1992.

The Domain Name <blackdiamond-equipmentspain.com> was registered on September 9, 2023, and the Domain Name <blackdiamondequipmentspain.com> was registered on August 6, 2022. The Domain Name <blackdiamond-equipmentspain.com> used to resolve to a website that appeared to mimic the Complainant’s website and offered for sale products that are purportedly counterfeit products of the Complainant’s products. Currently, the Domain Names do not resolve to an active webpage.

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 Domain Names.

Notably, the Complainant first contends that the Domain Names are confusingly similar to its Trademarks, since they incorporate the Trademarks in their entirety with the mere addition of the geographical term “spain” and the term “equipment”.

Second, the Complainant states that the Respondent has no rights or legitimate interests in the Domain Names. The Respondent has never received authorization from the Complainant to use the Trademarks in the Domain Names and is not commonly known by the Domain Names. Also, the Respondent is not making a legitimate noncommercial or fair use of the Domain Names.

Finally, according to the Complainant, the Respondent was aware of the Trademarks that would be well-known when registering the Domain Names and uses the Domain Names to attract for commercial gain Internet users to its website.

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 names. 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 Trademarks is reproduced within the Domain Names. Accordingly, the Domain Names are confusingly similar to the Trademarks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, “spain” and “equipment” may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the Domain Names and the Trademarks 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 Domain Names. 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 Domain Names such as those enumerated in the Policy or otherwise.

Furthermore, the construction of the Domain Names and the impersonating nature of the website at the Domain Name <blackdiamond-equipmentspain.com> demonstrate the Respondent’s intention of taking unfair advantage of the likelihood of confusion between the Domain Names and the Complainant’s Trademarks as to the origin or affiliation of the websites at the Domain Names.

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

Finally, the current non-use of the Domain Names cannot be considered a bona fide offering of goods and services.

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 Complainant provided evidence that the Domain Name <blackdiamond-equipmentspain.com> previously resolved to a website impersonating the Complainant and offering for sale purportedly counterfeit products. The Panel finds that the Respondent used the Domain

Name <blackdiamond-equipmentspain.com> to intentionally attract, for commercial gain, Internet users to its 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 which the Panel finds constitutes bad faith registration and use under paragraph 4(b)(iv) of the Policy.

Also, Panels have held that the use of a domain name for illegal activity here, claimed sale of counterfeit goods constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the Domain Name <blackdiamond-equipmentspain.com> constitutes bad faith under the Policy.

Finally, panels have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the current non-use of the Domain Names does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the composition of the Domain Names in which merely the geographical term "spain" and the term "equipment" that refers to the Complainant's products are added to the Trademarks, and finds that in the circumstances of this case the passive holding of the Domain Names does not prevent a finding of 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 Domain Names <blackdiamond-equipmentspain.com> and <blackdiamondequipmentspain.com> be transferred to the Complainant.

/Gregor Vos/

Gregor Vos

Sole Panelist

Date: July 19, 2024