

## **ADMINISTRATIVE PANEL DECISION**

**Black Diamond Equipment, Ltd v. Zhang Qiang**  
**Case No. D2024-2009**

### **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 Qiang, China.

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

The disputed domain name <blackdiamondsverige.com> (the “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 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 Name. On May 15, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the 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 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 was registered on July 20, 2023, and resolves to a website that appears to mimic the Complainant’s website and offers for sale products that are purportedly counterfeit products of the Complainant’s products.

#### **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 Name.

Notably, the Complainant first contends that the Domain Name is confusingly similar to its Trademarks, since it incorporates the Trademarks in their entirety with the mere addition of the geographical term “sverige” that refers to Sweden.

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

Finally, according to the Complainant, the Respondent was aware of the Trademarks that would be well-known when registering the Domain Name and uses the Domain Name 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 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 mark is reproduced within the Domain Name. Accordingly, the Domain Name is 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, “sverige” 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 Name 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 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 Domain Name such as those enumerated in the Policy or otherwise.

Furthermore, the construction of the Domain Name and the impersonating nature of the website at the Domain Name demonstrate the Respondent’s intention of taking unfair advantage of the likelihood of confusion between the Domain Name and the Complainant’s Trademarks as to the origin or affiliation of the website at the Domain Name.

Also, Panels have held that the use of a domain name for illegal activity here, claimed sale of counterfeit goods or 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, the Panel notes that the Complainant provided evidence that the Domain Name 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 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.

Finally, Panels have held that the use of a domain name for illegal activity here, claimed sale of counterfeit goods or impersonation, 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 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 Domain Name <blackdiamondsverige.com> be transferred to the Complainant.

*/Gregor Vos/*

**Gregor Vos**

Sole Panelist

Date: July 19, 2024