

## **ADMINISTRATIVE PANEL DECISION**

Dakine IP Holdings LP v. Client Care, Web Commerce Communications Limited

Case No. D2022-4013

### **1. The Parties**

The Complainant is Dakine IP Holdings LP, United States of America (“United States”), represented by Tucker & Latifi, LLP, United States.

The Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

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

The disputed domain names <dakinebackpacknz.com>, and <dakinepolska.com> 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 October 26, 2022. On October 26, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On October 27, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on October 31, 2022, 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 November 4, 2022.

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 November 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 30, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 1, 2022.

The Center appointed Benoit Van Asbroeck as the sole panelist in this matter on December 28, 2022. 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 sportswear and sports equipment company. The Complainant is the owner of registered trademarks in the mark DAKINE including, *inter alia*:

United States Trademark No. 2704219 for DAKINE, registered on April 8, 2003, in International Classes 6, 12, 16, 18, 25 and 28;

United States Trademark No. 3644469 for DAKINE, registered on June 23, 2009, in International Class 35;

European Union Trademark No. 011320033 for DAKINE, registered on April 12, 2013, in International Classes 8, 12, 18, 25 and 28;

Singapore Trademark No. T0209844D for DAKINE (figurative), registered on November 10, 2003, in International Class 12; and

Singapore Trademark No. T0209850I for DAKINE (figurative), registered on June 18, 2003 in International Class 25.

The Complainant also owns and operates the website to which the domain name <dakine.com> resolves.

The disputed domain names were registered on August 24, 2022, well after the Complainant secured rights to the trademarks. However, according to evidence submitted by the Complainant the disputed domain names previously resolved to websites selling DAKINE branded goods, which the Complainant believes are counterfeit, at an allegedly discounted rate.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant asserts that each of the three elements specified in paragraph 4(a) of the Policy are present. The three elements being: (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain names; and (iii) the disputed domain names have been registered and are being used in bad faith.

(i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights

The Complainant contends that the disputed domain names are identical or confusingly similar to its trademarks since both incorporate the DAKINE mark in its entirety. The <dakinebackpacknz.com> disputed domain name combines this with the words "backpack" and "nz", the former referring to a product that the Complainant sells and the latter referring to the country they are selling the products in, New Zealand. The <dakinepolska.com> combines DAKINE with "polska", the Polish word for Poland, the country this website is targeted to. In addition, the Complainant points to the contents of the websites that the disputed domain names previously resolve to. According to the Complainant, the websites contain online stores that are deceptively and confusingly similar to the Complainant's genuine online retail store. The online stores present themselves as retailers of discounted genuine DAKINE-branded goods and apparel. In fact, the

Complainant asserts, all goods sold in the online stores appear to be counterfeit products and the websites use images and language from the Complainant's advertisement campaigns and official website without the Complainant's permission.

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain names.

The Complainant claims that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The Complainant points to the fact that the Respondent is not commonly known by the disputed domain names and has not been authorized to use the Complainant's trademarks. Furthermore, the Complainant contends that there is no evidence of the Respondent's use of the disputed domain names or a name corresponding to the disputed domain names in connection with a *bona fide* offering of goods or services. In contrast, the Complainant mentions, the disputed domain names resolve to online store websites selling allegedly counterfeit goods using the Complainant's logo and brand name without permission, thus creating a misleading impression of association with the Complainant.

(iii) the disputed domain names have been registered and are being used in bad faith

The Complainant contends that the disputed domain names have been registered and are being used in bad faith. According to the Complainant, by using the disputed domain names, the Respondent intentionally attempted to attract for commercial gain Internet users to the Respondent's websites by creating a likelihood of confusion with the DAKINE trademarks to falsely create the impression that the Respondent's website and the goods and services being offered on the Respondent's website are actually those of the Complainant or somehow affiliated with the DAKINE-branded goods of the Complainant. In support of this, the Complainant points to the fact that the disputed domain names combine the DAKINE mark with products that the Complainant is known for and countries in which the Complainant is actively doing business. Bad faith is further demonstrated, according to the Complainant, by the appearance of the websites, which is very similar to the Complainant's own official website due to the unauthorized use of the Complainant's proprietary content.

## **B. Respondent**

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

## **6. Discussion and Findings**

The Panel finds that it has jurisdiction to hear this dispute as the Policy has been incorporated by reference into the registration agreements between the Registrar and the Respondent.

The Panel notes that while the Respondent has been duly notified, it did not reply to the Complainant's contentions within the time period established by the Rules. Pursuant to paragraph 14 of the Rules the Panel shall nonetheless proceed to a decision on the Complainant's complaint and it may draw such inferences from the Respondent's failure to respond as it considers appropriate.

Paragraph 4(a) of the Policy requires that in order for its complaint to succeed, the Complainant must prove that the following three elements are present:

- (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

The above three elements will each be discussed in further detail below.

## A. Identical or Confusingly Similar

The Complainant is required to establish: (1) that it owns rights in a trademark or service mark, and, if so, (2) that the disputed domain names are identical or confusingly similar to its trademarks.

Firstly, the Panel finds that the Complainant has clearly evidenced that it owns registered trademark rights to DAKINE. The Panel is satisfied with the evidence provided in support of the existence of trademarks for or containing the word “dakine”. Some of the registered trademarks that the Complainant relies on are figurative, however these can also be taken into account to show “rights in a mark” since the dominant portion of these trademarks is the word “dakine”. It is a consensus view of UDRP panels, with which the Panel agrees, that trademark registrations with design elements can *prima facie* satisfy the requirement that a complainant shows “rights in a mark” (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.10) so long as the textual elements are not overtaken. Finally, it should be noted that paragraph 4(a)(i) of the Policy does not set minimum requirements as to the jurisdictions of the trademarks a complainant relies on, nor as to the number, nature or scope of protection of such trademarks.

Secondly, the Panel finds that the disputed domain names are confusingly similar to the Complainant’s registered trademarks since both incorporate the DAKINE mark in its entirety (see [WIPO Overview 3.0](#), section 1.7, as well as *L’Oréal, Lancôme Parfums et Beauté & Cie v. Jack Yang*, WIPO Case No. [D2011-1627](#), *Rapidshare AG, Christian Schmid v. InvisibleRegistration.com, Domain Admin*, WIPO Case No. [D2010-1059](#), and *The Stanley Works and Stanley Logistics, Inc. v. Camp Creek Co., Inc.*, WIPO Case No. [D2000-0113](#)).

As the trademark DAKINE is recognizable within the disputed domain names, the addition of the terms “backpack”, “nz” or “polska” does not prevent the Panel’s finding of confusing similarity under the first element. It is a well-established view of UDRP panels, with which the Panel agrees, that the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (see for instance: *Ansell Healthcare Products Inc. v. Australian Therapeutics Supplies Pty, Ltd.*, WIPO Case No. [D2001-0110](#); *Nintendo of America Inc. v. Fernando Sascha Gutierrez*, WIPO Case No. [D2009-0434](#); *M/s Daiwik Hotels Pvt. Ltd v. Senthil Kumaran S, Daiwik Resorts*, WIPO Case No. [D2015-1384](#); and *BHP Billiton Innovation Pty Ltd v. Oloyi*, WIPO Case No. [D2017-0284](#)).

Finally, as for the applicable Top Level Domain (“TLD”), *i.e.* the suffix “.com”, the Panel holds that this can be disregarded under the first element confusing similarity test (*CANAL + FRANCE v. Franck Letourneau*, WIPO Case No. [DTV2010-0012](#); *Bentley Motors Limited v. Domain Admin / Kyle Rocheleau, Privacy Hero Inc.*, WIPO Case No. [D2014-1919](#); and *SAP SE v. Mohammed Aziz Sheikh, Sapteq Global Consulting Services*, WIPO Case No. [D2015-0565](#)).

On the basis of the foregoing findings, and according to paragraph 4(a)(i) of the Policy, this Panel finds and concludes that the disputed domain names are confusingly similar to the Complainant’s trademarks.

## B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy non-exhaustively lists three circumstances that shall demonstrate a right or legitimate interest:

“Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

It is a well-established view of UDRP panels, with which the Panel agrees, that a *prima facie* case advanced by a complainant is generally sufficient to satisfy the requirements under paragraph 4(a)(ii) of the Policy, and the burden of production shifts to the respondent to provide relevant evidence demonstrating rights or legitimate interests in the disputed domain name (*AGUAS DE CABREIROA, S.A.U. v. Hello Domain*, WIPO Case No. [D2014-2087](#); *Spigen Korea Co., Ltd., Spigen Inc. v. Domain Admin, Whois Privacy Corp.*, WIPO Case No. [D2016-0145](#); and *HubSpot, Inc. v. WhoisGuard Protected, WhoisGuard, Inc. / Steve Johnson*, WIPO Case No. [D2016-1338](#)).

The Panel notes that the Respondent has not responded to any of the Complainant’s contentions, let alone submitted evidence to the contrary, and that, pursuant to paragraph 14 of the Rules, the Panel may draw such inferences from the Respondent’s failure to respond as it considers appropriate. In the present case, taking into consideration the Respondent’s default, this Panel finds that the Complainant has made out an un rebutted *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names, in view of the circumstances of this case, including the following factors.

The Panel agrees with the Complainant that there is no evidence that the Respondent uses the disputed domain names in connection with a *bona fide* offering of goods or services. Moreover, as the Complainant has demonstrated, the Respondent has used the disputed domain names to falsely suggest affiliation with the Complainant. The Panel agrees with the Complainant that the design and content of the website that the disputed domain names resolve to, including the use of the Complainant’s trademarks, images and language from the Complainant’s advertisement campaigns, may indeed have led consumers to be confused about the source of the websites and whether the websites are sponsored or otherwise endorsed by the Complainant (noting the website does not accurately and prominently disclose the lack of relationship between the Respondent and the Complainant). As is clear from sections 2.2, 2.5, and 2.8 of the [WIPO Overview 3.0](#), UDRP Panels have consistently found that such use of a domain name can neither be considered legitimate noncommercial or fair use of the domain name nor a *bona fide* offering of goods or services.

In addition, the Complainant asserts that the Respondent is not affiliated with the Complainant in any way nor has the Complainant licensed, authorized, or permitted the Respondent to register the disputed domain names incorporating the Complainant’s trademarks. The Panel has taken note of the Complainant’s confirmation in this regard and has not seen any evidence that would suggest the contrary. In the absence of any license or permission from the Complainant to use its trademarks, no actual or contemplated *bona fide* or legitimate use of the disputed domain names could reasonably be claimed (see e.g. *Sportswear Company S.P.A. v. Tang Hong*, WIPO Case No. [D2014-1875](#); *LEGO Juris A/S v. DomainPark Ltd, David Smith, Above.com Domain Privacy, Transure Enterprise Ltd, Host master*, WIPO Case No. [D2010-0138](#)).

Finally, the Panel agrees with the Complainant that there is no evidence that the Respondent has been commonly known by the disputed domain names.

Moreover, the nature of each of the disputed domain names carries a risk of implied affiliation as both effectively impersonate or suggest sponsorship or endorsement by the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

For all the foregoing reasons, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

### C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy non-exhaustively lists four circumstances that, if found by the Panel to be present, shall be evidence of the registration and use of the domain name in bad faith:

“(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.”

The Panel finds that the circumstances and evidence presented by the Complainant offer sufficient proof that both the Respondent’s registration and current use of the disputed domain names are in bad faith.

The Panel will first discuss the Respondent’s registration of the disputed domain names. The Panel believes that the Respondent knew or, at least, should have known at the time of registration that the disputed domain names include the Complainant’s abovementioned trademarks. Knowledge of the DAKINE trademarks may be inferred from the facts that these trademarks have been registered in different countries and existed for a long time prior to the Respondent’s registration of the disputed domain names (see *e.g.*, *SembCorp Industries Limited v. Hu Huan Xin*, WIPO Case No. [D2001-1092](#) and *American Funds Distributors, Inc. v. Domain Administration Limited*, WIPO Case No. [D2007-0950](#)). The use of the disputed domain names for websites that contain online stores that are deceptively and confusingly similar to the Complainant’s genuine online retail store and display without authorization the Complainant’s DAKINE trademarks and offer DAKINE branded goods is a further indicator of this.

As for the use of the disputed domain names, the Complaint relies on the circumstances described under paragraph 4(b)(iv) of the Policy and provided screenshots of the websites which the disputed domain names previously resolve to. The Panel notes that the websites in the screenshots indeed are deceptively and confusingly similar to the Complainant’s genuine online retail store, display the Complainant’s figurative and word DAKINE trademarks and DAKINE branded goods are being offered for discounted prices. The Panel finds that these facts can indeed support the conclusion that the Respondent appears to attempt to pass off the online stores associated with the disputed domain names as authentic DAKINE stores. Such use, which at its heart relies on exploiting user confusion for commercial gain, cannot constitute *bona fide* use as it may confuse the public about the business origin, sponsorship, affiliation, or endorsement of the websites associated with the disputed domain names.

In light of the above, the Panel finds that the disputed domain names were registered and are being used by the Respondent in bad faith.

## 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 names <dakinebackpacknz.com> and <dakinepolska.com> be transferred to the Complainant.

*/Benoit Van Asbroeck/*

**Benoit Van Asbroeck**

Sole Panelist

Date: January 11, 2023