

ADMINISTRATIVE PANEL DECISION

Dakine IP Holdings LP v. Scmd Umjq
Case No. D2022-4400

1. The Parties

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

The Respondent is Scmd Umjq, Hong Kong, China.

2. The Domain Name and Registrar

The disputed domain name <discountdakine.com> (the “Disputed Domain Name”) is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 17, 2022. On November 18, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On November 21, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on November 22, 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 22, 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 25, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 15, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 20, 2022.

The Center appointed Gabriela Kennedy 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 was founded in 1979 and sells a variety of consumer goods such as bags, backpacks, clothing, accessories, footwear, surfing gear, sailing gear, wind surfing gear under and by reference to the DAKINE trademark.

The Complainant owns trademark registrations around the world in over 70 countries, including, *inter alia*, Chinese Trademark Registration (“Reg.”) No. 3298663, No.3298646 for DAKINE (Stylized), registered on April 7, 2004; US Trademark Reg. No. 3644469 for DAKINE, registered on June 23, 2009; European Union Trademark Reg. No. 011320033 for DAKINE, registered on April 12, 2013 and New Zealand Trademark Reg. No. 1111269 for DAKINE, registered on May 23, 2019 (the “Complainant’s Trademark”).

The Complainant maintains and operates “www.dakine.com” as a primary retailing site.

The Disputed Domain Name was registered on August 18, 2022, and currently resolves to a website which is an online store that purports to sell DAKINE branded goods at a discount (the “Website”).

5. Parties’ Contentions

A. Complainant

The Complainant’s primary contentions can be summarized as follows:

(a) The Disputed Domain Name is identical or confusingly similar to the Complainant’s Trademark. The Complainant’s Trademark is reproduced in its entirety in the Disputed Domain Name. The only element which differentiates the Disputed Domain Name from the Complainant’s Trademark is the addition of the prefix “discount” to read <discountdakine.com>.

(b) The Respondent does not have any rights or legitimate interests in the Disputed Domain Name. There is no evidence to show that the Respondent is commonly known by the Disputed Domain Name or has any registered trademarks for DAKINE or any similar marks. The Complainant has never licensed, authorized or given permission to the Respondent, who is not associated with the Complainant in any way, to use the Complainant’s Trademark or register the Disputed Domain Name. There is also no evidence of the Respondent’s use of the Disputed Domain Name or a name corresponding to the Disputed Domain Name in connection with a *bona fide* offering of goods or services, nor a legitimate non-commercial or fair use of the Complainant’s Trademark. In addition, the Complainant believes the goods sold on the Website to be counterfeits.

(c) Both the Respondent’s registration and use of the Disputed Domain Name establish the Respondent’s bad faith. The Respondent’s registration of the Disputed Domain Name, which completely incorporates the Complainant’s Trademark, is in itself an act of bad faith by someone with no legal connection to the Complainant’s business. The Respondent is intentionally attempting to misleadingly divert consumers for commercial gain by creating a likelihood of confusion with the Complainant’s Trademark, and creating an impression that the Disputed Domain Name, the Website and the goods offered for sale on the Website originate from the Complainant or are somehow affiliated to the Complainant, when they are not.

In addition, the Respondent has copied proprietary content from the Complainant’s website, and uses images and language from the Complainant’s website to advertise and sell products on the Website. The Respondent seeks to create an impression of association by prominently displaying the Complainant’s Trademark on the Website, which is likely to mislead Internet users and is an act of bad faith.

B. Respondent

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

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements:

- (i) the Disputed Domain Name is 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 Name; and
- (iii) the Disputed Domain Name has been registered and is being used by the Respondent in bad faith.

A. Identical or Confusingly Similar

The Panel accepts that the Complainant has rights in the Complainant's Trademark, based on its various trademark registrations listed above in Section 4.

It is well established that in making an enquiry as to whether a trademark is identical or confusingly similar to a domain name, the generic Top-Level Domain ("gTLD") extension, ".com" in this case, may be disregarded. See Section 1.11 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Disputed Domain Name incorporates the Complainant's Trademark in its entirety with the addition of the prefix "discount". UDRP panels have consistently found that the addition of other terms to a mark (whether descriptive, geographical, pejorative, meaningless, or otherwise) will not alter the fact that the disputed domain name is confusingly similar to the trademark in question. See Section 1.8 of the [WIPO Overview 3.0](#).

The Panel therefore finds that the mere addition of the prefix "discount" does not prevent a finding of confusing similarity between the Disputed Domain Name and the Complainant's Trademark.

As such, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's Trademark, and accordingly, paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Once a complainant establishes a *prima facie* case in respect of the lack of rights or legitimate interests of a respondent in a disputed domain name, the respondent then carries the burden of demonstrating that it has rights or legitimate interests in the domain name. Where the respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. See Section 2.1 of the [WIPO Overview 3.0](#).

The Panel accepts that the Complainant has not authorized the Respondent to use the Complainant's Trademark, and there is no relationship between the Complainant and the Respondent which would otherwise entitle the Respondent to use the Complainant's Trademark. Accordingly, the Panel is of the view that a *prima facie* case has been established by the Complainant and it is for the Respondent to show rights or legitimate interests in the Disputed Domain Name.

The Respondent did not submit a Response. The fact that the Respondent did not submit a formal Response does not automatically result in a decision in favor of the Complainant. However, the Respondent's failure to file a Response may result in the Panel drawing appropriate inferences from such default. The Panel may also accept all reasonable and supported allegations and inferences flowing from

the Complainant as true (see *Entertainment Shopping AG v. Nischal Soni, Sonik Technologies*, WIPO Case No. [D2009-1437](#); and *Charles Jourdan Holding AG v. AAIM*, WIPO Case No. [D2000-0403](#)).

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights or legitimate interests in the Disputed Domain Name by demonstrating any of the following:

- (i) before any notice to the Respondent of the dispute, the Respondent's use of, or demonstrable preparations to use the Disputed Domain Name or a name corresponding to the Disputed Domain Name was in connection with a *bona fide* offering of goods or services;
- (ii) the Respondent has been commonly known by the Disputed Domain Name, even if it has acquired no trademark or service mark rights; or
- (iii) the Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

There is no evidence to suggest that the Respondent's use of, or demonstrable preparations to use the Disputed Domain Name or a name corresponding to the Disputed Domain Name was in connection with a *bona fide* offering of goods or services. The Panel agrees with the Complainant that the Respondent's registration and use of the Disputed Domain Name cannot be regarded as legitimate noncommercial or fair use, noting in particular that the Complainant's Trademark would not likely be adopted by the Respondent other than for the purpose of creating an impression that the Disputed Domain Name is associated with the Complainant or otherwise taking advantage of the goodwill of the Complainant's Trademark. In this regard, the Panel also notes the nature of the Disputed Domain Name, incorporating the Complainant's Trademark in its entirety with the addition of the term "discount", carries a risk of implied affiliation. See Section 2.5.1 of the [WIPO Overview 3.0](#).

In addition, no evidence has been provided to prove that the Respondent has trademark rights corresponding to the Disputed Domain Name, or that the Respondent has become known by the Disputed Domain Name.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Name and the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

UDRP panels have consistently found that the mere registration of a domain name that is confusingly similar to a widely-known trademark by an unaffiliated entity (particularly domain names which incorporate a mark plus a descriptive term) can already by itself create a presumption of bad faith. See Section 3.1.4 of the [WIPO Overview 3.0](#).

After reviewing the supporting evidence submitted by the Complainant, the Panel agrees with the Complainant that the Complainant's Trademark appears to be fairly well-known. A quick Internet search conducted by the Panel shows that the top search results returned for the keyword "dakine" are the Complainant's website and third party's websites providing information relating to the Complainant's sportswear and sports equipment business. Therefore, taking this into consideration together with the fact that the Disputed Domain Name incorporates the Complainant's Trademark in its entirety with the addition of the prefix "discount", the Respondent must have been aware of the Complainant and the rights in the Complainant's Trademark when registering the Disputed Domain Name.

The Panel also agrees with the Complainant that, given the fact that the Respondent used the Disputed Domain Name to carry out the online sales of sport clothing, and the substantial similarity between the content of the Website and the Complainant's site, the addition of the term "discount" may increase the possibility of Internet users being led to believe that the Disputed Domain Name is owned by or associated with the Complainant.

In addition, the Panel finds that the following factors further support a finding that the Disputed Domain Name was registered and is being used by the Respondent in bad faith:

(i) The Respondent failed to respond to the Complainant's contentions and has provided no evidence of any actual or contemplated good faith use by it of the Disputed Domain Name.

(ii) It is difficult to conceive of any plausible use of the Disputed Domain Name that would amount to good faith use, given that the Disputed Domain Name contains the Complainant's Trademark in its entirety (with the addition of the prefix "discount"). The Respondent intentionally used the Complainant's Trademark to mislead the public and to generate commercial gains. The Respondent has not demonstrated any attempt to make legitimate use of the Disputed Domain Name and the website to which it resolves, which evidences a lack of rights or legitimate interests in the Disputed Domain Name, as confirmed by past Panels (see *Washington Mutual, Inc., v. Ashley Khong*, WIPO Case No. [D2005-0740](#)).

In the circumstances, the Panel finds that the Respondent registered and has been using the Disputed Domain Name in bad faith, and paragraph 4(a)(iii) of the Policy has been satisfied.

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, <discountdakine.com> be transferred to the Complainant.

/Gabriela Kennedy/

Gabriela Kennedy

Sole Panelist

Date: January 9, 2023