

ADMINISTRATIVE PANEL DECISION

Dakine IP Holdings LP v. Yonghao Wu

Case No. D2022-4844

1. The Parties

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

The Respondent is Yonghao Wu, China.

2. The Domain Name and Registrar

The disputed domain name <dakinesales.com> 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 December 16, 2022. On December 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 20, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 January 5, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 25, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 26, 2023.

The Center appointed Tobias Malte Müller as the sole panelist in this matter on February 8, 2023. 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 specialized in the production of backpacks, travel accessories, sports clothing, footwear, and sports gear. It results from the Complainant's undisputed allegations that the Dakine Brand was established in 1979 by Rob Kaplan, a surfer and craftsman living in Maui, Hawaii.

It further results from the allegations and evidence provided by the Complainant, which remain undisputed, that the Complainant holds trademark registrations containing or consisting of the word element DAKINE in over 70 countries, in particular European Union ("EU") trademark DAKINE (registered on April 12, 2013 with no. 011320033 for goods in classes 8, 12, 18, 25, and 28).

The disputed domain name was registered on September 8, 2022. The language of the Registration agreement is English.

Finally, the Complainant has provided evidence demonstrating that the disputed domain name resolves to a website that uses the stylized DAKINE mark together with images and language taken from the Complainant's official website and advertisement campaigns without any authorization by the Complainant. In addition, that website purports to offer only DAKINE branded products for an allegedly discounted price.

5. Parties' Contentions

A. Complainant

The Complainant asserts that the disputed domain name is confusingly similar to its trademark DAKINE since it simply combines said mark with the word "sales", which does not change the significance of the DAKINE mark.

Secondly, the Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name. In particular, the disputed domain name resolves to an online store that is dedicated to being deceptively and confusingly similar to the Complainant's genuine online retail store and seeks to hold itself out as a retailer of genuine DAKINE-branded goods. Furthermore, the Complainant has not authorized nor licensed the Respondent to use its registered DAKINE trademarks. Finally, the Respondent is not commonly known by the disputed domain name.

Thirdly, the Complainant finds that the Respondent's registration and use of the disputed domain name constitutes bad faith. According to the Complainant, the Respondent selected the disputed domain name precisely for undue profit since it identically included the DAKINE mark, with the intention to sell suspicious products bearing DAKINE trademark and by reproducing copyrighted content without authorization. This falsely creates the impression that the Respondent's website and the goods being offered there are actually those of the Complainant. Therefore, the Respondent is attempting to generate commercial gain by creating confusion with the DAKINE trademark as to the source, affiliation, or endorsement of the Respondent's website.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements in order to obtain an order that the disputed domain name should be transferred or cancelled:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainants have rights; and
- (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 in bad faith.

The Panel is satisfied that the registrant of record for the disputed domain name is the Respondent and will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must first of all establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

The Complainant is the owner of several trademark registrations consisting of the verbal element DAKINE, e.g., in particular EU trademark DAKINE registered on April 12, 2013.

The Panel notes that the Complainant's registered trademark DAKINE is fully included in the disputed domain name and merely followed by the term "sales" at the end of the trademark. It is the view of this Panel that the combination of the trademark DAKINE with the term "sales" placed after the mark does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademarks. In fact, in accordance with the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8, where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element (see *Dakine IP Holdings LP v. Chang Zhang*, WIPO Case No. [D2022-4426](#) on <dakine-sale.com> and *Dakine IP Holdings LP v. Cjfej Ydbehe*, WIPO Case No. [D2022-4598](#) on <dakinesale.com>).

The Top-Level Domain ".com", which is a technical requirement, is generally disregarded for the purpose of the analysis of confusing similarity.

In the light of the above, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent's rights or legitimate interests in a disputed domain name. In the Panel's view, based on the undisputed allegations stated above, the Complainant has made a *prima facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

First, it results from the Complainant's uncontested evidence that the disputed domain name resolves to a website that uses the stylized DAKINE mark together with images and language taken from the Complainant's official website and advertisement campaigns without any authorization by the Complainant. In addition, that website purports to offer only DAKINE branded products for an allegedly discounted price. In this Panel's view, such use cannot be qualified as a *bona fide* offering of goods or services in accordance

with paragraph 4(c)(i) of the Policy, since such use is likely to mislead Internet users. In addition, the Respondent did not submit any evidence of *bona fide* pre-Complaint preparations to use the disputed domain name. In particular, the Complainant's uncontested allegations demonstrate that it has not authorized or licensed the Respondent's use of the DAKINE trademarks for registering the disputed domain name which is confusingly similar to the Complainant's trademark.

Furthermore, the Panel notes that there is no evidence in the record or Whois information showing that the Respondent might be commonly known by the disputed domain name in the sense of paragraph 4(c)(ii) of the Policy.

Finally, the Panel notes that there is no evidence in the record either showing that the Respondent might be making a noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark at issue pursuant to paragraph 4(c)(iii) of the Policy. In particular, the Panel considers it obvious that the Respondent wanted to mimic the Complainant's original website under the disputed domain name which entirely incorporates the trademark DAKINE. Noting the absence of any disclaimer, the disputed domain name's content exacerbates the confusion caused by the incorporation of the Complainant's trademark in the construction of the disputed domain name by further impersonating the Complainant. Accordingly, further to section 2.8 of the [WIPO Overview 3.0](#), the Respondent's use of the disputed domain name to host an impersonating webstore excludes any *bona fide* offering, noncommercial, or fair use of the disputed domain name from the outset.

It is acknowledged that once the Panel finds a *prima facie* case has been established, the burden of production shifts to the Respondent to come forward with relevant and concrete evidence demonstrating rights or legitimate interests in the disputed domain name. Since the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has therefore satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith. One of these circumstances that the Panel finds applicable to the present dispute is that the Respondent by using the disputed domain name, has intentionally attempted to attract, for commercial gain, Internet users to its 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 its website or location or of a product or service on its website or location (paragraph 4(b)(iv) of the Policy).

It is the view of this Panel that these circumstances are met in the case at hand:

It results from the documented and undisputed evidence provided by the Complainant that the disputed domain name resolves to a website that uses the stylized DAKINE mark together with images and language taken from the Complainant's official website and advertisement campaigns without any authorization by the Complainant. In addition, that website purports to offer only DAKINE branded products for an allegedly discounted price. However, the Complainant has not given any authorization for such use and is not linked to the Respondent or its website. For the Panel, it is therefore evident that the Respondent positively knew the Complainant's trademarks and products. Consequently, and in the absence of any evidence to the contrary, the Panel is convinced that the Respondent also knew that the disputed domain name included the Complainant's trademarks DAKINE entirely when it registered the disputed domain name. Registration of a domain name which contains a third party's trademark, in awareness of said trademark and in the absence of rights or legitimate interests is suggestive of registration in bad faith (see *e.g. Vorwerk International AG v. ayoub Iagnadi, Iagnadi LTD*, WIPO Case No. [D2022-1592](#) with further references). While the ability to

purchase the goods is not known to the Panel, the alleged commercial offering and impersonation of the Complainant is sufficient to establish the Respondent's bad faith intent to mislead Internet users.

In addition, the finding of bad faith registration and use is supported by the following further circumstances resulting from the case at hand:

- (i) the trademark DAKINE is fully and identically incorporated in the disputed domain name. At the date the Respondent registered the disputed domain name, said mark existed and had been used for roughly 40 years;
- (ii) the Respondent's failure to submit a formal response;
- (iii) the Respondent's failure to provide any evidence of actual or contemplated good-faith use;
- (iv) the implausibility of any good faith use to which the disputed domain name may be put, and
- (v) the fact that the details disclosed for the Respondent by the Registrar are incomplete, noting the courier's inability to deliver the Center's Written Notice.

In the light of the above the Panel finds that the disputed domain name has been registered and is being used in bad faith pursuant to paragraph 4(a)(iii) 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, <dakinesales.com> be transferred to the Complainant.

/Tobias Malte Müller/

Tobias Malte Müller

Sole Panelist

Date: February 22, 2023