

ADMINISTRATIVE PANEL DECISION

Dakine IP Holdings LP v. Web Commerce Communications Limited,
Client Care
Case No. D2023-0351

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 Web Commerce Communications Limited, Client Care, Malaysia.

2. The Domain Names and Registrar

The disputed domain names <dakinedeutschland.com>, <dakineespana.com>, <dakinefrance.com>, <dakinegreece.com>, <dakineireland.com>, <dakineitalia.com>, <dakinenederland.com>, <dakineosterreich.com>, <dakineromania.com>, <dakinesouthafrica.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 January 25, 2023. On January 26, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On January 28, 2023, 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 January 31, 2023, 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 February 8, 2023.

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 February 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 6, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 10, 2023.

The Center appointed Christopher J. Pibus as the sole panelist in this matter on March 16, 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 holds trademark rights in the word mark DAKINE across 70 different countries. Its business was founded in Hawaii in 1979, initially focusing on equipment for surfing but eventually expanding into a range of sports-related gear, bags, footwear and apparel, as well as retail store services.

The Complainant's registered marks include:

- European Union Trademark No. 006730782 for DA KINE, registered on January 29, 2009;
- European Union Trademark No. 011320033 for DAKINE, registered on April 12 2013;
- European Union Trademark No. 017959801 for DAKINE design, registered on January 30, 2019; and
- South African Trademark No. 1111269, for DA KINE registered August 6, 2007.

The Complainant maintains and operates its principal retail website at "www.dakine.com".

The Respondent registered the disputed domain names on August 24, 2022, and has operated active retail websites since that time, which purport to offer for sale various sports apparel, bags and related accessories, in association with the DAKINE trademark.

5. Parties' Contentions

A. Complainant

The Complainant submits that it is the owner of well-established registered rights in the trademark DAKINE particularly in Europe and in other countries around the world where it carries on business. The disputed domain names are confusingly similar to the Complainant's registered trademark as they are virtually identical except for the addition of suffixes designating countries, namely Ireland, Greece, Espana, Italia, France, Deutschland, Osterreich, Nederland, Romania and South Africa, which does not diminish the likelihood of confusion. By combining the DAKINE mark with a country name, the Respondent is trying to insinuate that its various websites are the official retailers of DAKINE goods for that region.

With respect to the absence of rights or legitimate interests, the Complainant submits that the Respondent has engaged in a scheme to deceive users who access its websites, by copying the content of the Complainant's website including product photographs and text taken from the Complainant's business, and by promoting goods which are counterfeit or non-existent. The Complainant asserts that the Respondent has never been authorized to engage in this conduct or to adopt confusingly similar domain names. It further submits that the Respondent is not making a *bona fide* offering of services but rather is using the disputed domain names to deceive unknowing Internet users through its association with the use of multiple copycat websites. The Complainant submits that it has put forward clear *prima facie* evidence of the absence of rights or legitimate interests.

With respect to bad faith, the Complainant relies on evidence of the Respondent's look-a-like websites, which mirror the Complainant's own website and trade indicia, to establish that the Respondent has deliberately targeted the Complainant's business and its distinctive DAKINE word mark and logo. Based on this misconduct, the Complainant submits that there is sufficient evidence to support a finding of bad faith.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, in order to succeed, the Complainant must establish each of the following elements:

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

A. Identical or Confusingly Similar

The Complainant clearly owns rights in its DAKINE trademark, established through long-term use and its portfolio of registrations across Europe and internationally where it carries on its business.

The test for confusing similarity is described as a "reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name" in WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

The Panel finds that the disputed domain names are confusingly similar to the Complainant's registered trademark. The disputed domain names each include the entirety of the distinctive DAKINE mark with the addition of various geographic terms designating specific countries, as listed above. These variations do not prevent a finding of confusing similarity under the first element. See *Starbucks Corporation v. Sumol Jha*, WIPO Case No. [D2022-2574](#); and *Dakine IP Holdings LP v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-4013](#). The Complainant's trademark is clearly recognizable as the dominant distinctive element within the disputed domain names ([WIPO Overview 3.0](#), section 1.8).

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

B. Rights or Legitimate Interests

Although the Policy places on the Complainant the burden of proof to establish the absence of rights or legitimate interests, the practice now recognizes that it is often sufficient for the Complainant to make out a *prima facie* case, which then shifts the burden of production to the Respondent to bring forward evidence to demonstrate the relevant rights or interests. Where the Respondent fails to produce such evidence, the Complainant will be deemed to have satisfied the second element ([WIPO Overview 3.0](#), section 2.1).

In this proceeding, the Complainant has provided detailed evidence of the Respondent's misconduct in misappropriating the Complainant's DAKINE trademark and creating multiple country-specific copies of the Complainant's website (associated with the disputed domain names) which form part of a scheme to deceive users, without authorization. The documentary evidence provided by the Complainant shows misappropriation of product images and names on pages of the copycat website. The totality of the evidence clearly establishes a *prima facie* case of the absence of rights or legitimate interests on the part of the Respondent. Illegal conduct of this nature is highly probative in connection with this issue. "Panels have categorically held that the use of a domain name for illegal activity (e.g., [...] impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent." ([WIPO Overview 3.0](#), section 2.13.1.). The creation and use of ten copycat websites is impersonation writ large.

In the absence of any response from the Respondent, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that each of the disputed domain names constitutes an abusive registration and each of the disputed domain names is being used in bad faith. The Respondent clearly set out to target the Complainant and to deceive users into believing that its copycat websites associated with each disputed domain names were in fact the websites of the Complainant.

The Panel identifies several aspects of the Respondent's scheme as particularly probative evidence of bad faith:

- (1) the fact that the Respondent registered ten similar domain names designating major European markets (plus South Africa) on the same day supports the conclusion that this was part of a deliberate orchestrated plan targeting the Complainant's business;
- (2) the fact that the same Respondent had previously registered three other similar DAKINE-formative domain names, designating additional targeted countries, which were found to have been registered and used in bad faith. See *Dakine IP Holdings LP v. Client Care, Web Commerce Communications Limited*, *supra*; and *Dakine IP Holdings LP v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-4397](#).
- (3) the fact that the Respondent's websites were cunningly adapted to give all the appearance of the Complainant's virtual shop, including the replication of the Complainant's distinctive logo in multiple places as well as the reproduced product images, graphics, text and layout.
- (4) the likelihood that the goods purported to be offered by the Respondent were counterfeit or non-existent.

The evidence taken as a whole supports a finding that the Respondent engaged in a deliberate attempt to pass off its network of ten online stores as authentic DAKINE stores. [WIPO Overview 3.0](#), section 3.4 recognizes that this type of abusive conduct involving the use of deceptive copycat websites will be viewed as probative evidence of bad faith (see *Magna International Inc. v. Stefan Polisky*, WIPO Case No. [D2021-0875](#)).

The Complainant has satisfied 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 following disputed domain names be transferred to the Complainant;

<dakinedeutschland.com>, <dakineespana.com>, <dakinefrance.com>, <dakinegreece.com>, <dakineireland.com>, <dakineitalia.com>, <dakinenederland.com>, <dakineosterreich.com>, <dakineromania.com>, <dakinesouthafrica.com>.

/Christopher J. Pibus/

Christopher J. Pibus

Sole Panelist

Date: March 30, 2023