

ADMINISTRATIVE PANEL DECISION

Dakine IP Holdings LP v. Gkiuy Gkiuy
Case No. D2023-0407

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 Gkiuy Gkiuy, China.

2. The Domain Name and Registrar

The disputed domain name <skisdakine.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 January 28, 2023. On January 30, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 31, 2023, 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 (Whois Agent, Domain Protection Services, Inc.) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 1, 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 13, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 5, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 13, 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:

- United States Trademark No. 2704219 for DAKINE, registered April 08, 2003, in International Classes 6, 8, 12, 14, 16, 18, 22, 25, and 28;
- United States Trademark No. 3644469 for DAKINE, registered 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;
- New Zealand Trademark No. 1111269, registered May 23, 2019, in International Classes 12, 18, 25, 28 and 35.

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

The Respondent registered the disputed domain name on September 21, 2022, and has operated an active retail website since that time, which purports 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 in the United States, Europe and other countries where it carries on business. The disputed domain name is confusingly similar to the Complainant's registered trademark as it incorporates the trademark in its entirety. The word "skis" is related to one of the outdoor activities for which DAKINE branded goods are designed, and it does not change the significance of the DAKINE trademark.

With respect to the absence of rights or legitimate interests, the Complainant asserts that the Respondent has never been authorized to use its registered trademarks and adopt a confusingly similar domain name. It further submits that the Respondent is not making a *bona fide* offering of services but rather is using the disputed domain name to deceive unknowing users into purchasing possible counterfeit DAKINE goods through the use of a copycat website. 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 website, which mirrors the Complainant's own website, to establish that the Respondent has deliberately targeted its 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 disputed 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 registrations in the United States, 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 name is confusingly similar to the Complainant's registered trademark. The disputed domain name includes the entirety of the DAKINE mark with the addition of the term "skis". This does not prevent a finding of confusing similarity under the first element. See *Starbucks Corporation v. Sumol Jha*, WIPO Case No. [D2022-2574](#). The Complainant's trademark is clearly recognizable within the disputed domain name ([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 a Complainant to make out a *prima facie* case, which then shifts the burden of production of evidence to the Respondent to bring forward evidence to demonstrate the relevant rights or legitimate interests in the disputed domain name. 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 evidence that the Respondent has never been authorized or licensed to use or register the DAKINE trademark or related domain name, nor has the Respondent been commonly known under these names. Detailed evidence has also been furnished of the Respondent's misconduct in misappropriating the Complainant's DAKINE trademark and creating a virtual copy of the Complainant's website (associated with the disputed domain name) which forms part of a scheme to deceive unknowing users into purchasing counterfeit or non-existent goods. The documentary evidence 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.)

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 the disputed domain name constitutes an abusive registration, which was registered and is being used in bad faith. The Respondent clearly set out to target the Complainant and to deceive users into believing that his copycat website associated with the disputed domain name was in fact the website of the Complainant. The Respondent’s website was cunningly adapted so it had 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. As a result, the Respondent appears to be engaged in a deliberate attempt to pass off his online store as an authentic DAKINE store. See *Dakine IP Holdings LP v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-4397](#). This squarely falls under paragraph 4(b)(iv) of the Policy “by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the Complainant’s trademark as to the source, sponsorship, affiliation, or endorsement of its web site”. [WIPO Overview 3.0](#), section 3.4 furthermore 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 disputed domain name, <skisdakine.com> be transferred to the Complainant.

/Christopher J. Pibus/

Christopher J. Pibus

Sole Panelist

Date: March 30, 2023