

ADMINISTRATIVE PANEL DECISION

Dakine IP Holdings LP v. ATyson William
Case No. D2024-1040

1. The Parties

Complainant is Dakine IP Holdings LP, United States of America (“United States”), represented by ESCA Legal, United States.

Respondent is ATyson William, United States.

2. The Domain Name and Registrar

The disputed domain name <salesdakine.com> is registered with Gname.com Pte. Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 8, 2024. On March 11, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 12, 2024, 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 (Registrant of www.salesdakine.com) and contact information in the Complaint. The Center sent an email communication to Complainant on March 12, 2024 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on March 12, 2024.

The Center verified that the Complaint together with the amendment to 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 Respondent of the Complaint, and the proceedings commenced on March 18, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 7, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on April 8, 2024.

The Center appointed Lynda J. Zadra-Symes as the sole panelist in this matter on April 15, 2024. 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

Complainant is the owner of the mark DAKINE, which it has used since 1979 in connection with retail and online store services, as well as snow, surf, biking, fishing, and windsurfing products, among others. Complainant enjoys a strong social media presence with 195,000 followers on Instagram, and has collaborated with world class brands and public figures such as Yamamoto, AX Materials, Sammy Carlson, Louif Paradis, Jill Perkins and Karl Fostevdt.

Complainant owns trademark registrations for the mark DAKINE and associated logo designs in numerous countries for, inter alia, retail store services featuring sporting goods, bags and clothing; online retail store services featuring sporting goods, bags and clothing; metal key rings and chains; kayak and canoe leashes; stickers; and wallets, athletic bags, backpacks, travel bags, messenger bags, luggage, duffle bags.

Complainant's registered trademarks include the following:

- United States Registration No. 2704219, registered April 8, 2003;
- United States Registration No. 2711020, registered April 29, 2003;
- United States Registration No. 3644469, registered June 23, 2009;
- United States Registration No. 5675443, registered February 12, 2019;
- United States Registration No. 6748190, registered May 31, 2022.

Complainant advertises and promotes products bearing its DAKINE trademark to consumers throughout the world. Complainant also owns International Registration No. 1443465, registered September 24, 2018, covering Australia, Israel, New Zealand, Republic of Korea, Switzerland, among other jurisdictions.

The disputed domain name was registered on January 18, 2024.

Respondent is using the website at the disputed domain name to sell what appears to be counterfeit versions of Complainant's products, bearing Complainant's marks, at reduced prices. Respondent's website also offers for sale products from Complainant's competitors.

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, Complainant contends that the disputed domain name is confusingly similar to Complainant's trademark, that Respondent has no rights or legitimate interest in respect of the disputed domain name, and that the disputed domain name was registered and is being used in bad faith.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

In order to succeed in its claim, Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied:

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

Paragraph 15(a) of the Rules instructs the 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”.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between Complainant’s trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.7.

Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of Complainant’s DAKINE mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The Panel finds that the addition of the term “sales” does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name. Respondent has not rebutted Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Panel notes that the disputed domain name has been used to resolve to a website offering what appears to be counterfeit versions of Complainant's products at discounted prices. Panels have held that the use of a domain name for illegal activity, as claimed here: sale of apparently counterfeit goods, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1. In addition, the website at the disputed domain name also offers for sale products from Complainant's competitors.

The Panel further notes that the composition of the disputed domain name carries a risk of implied affiliation as it effectively impersonates or suggests sponsorship or endorsement by Complainant. [WIPO Overview 3.0](#), section 2.5.1.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

Complainant has not authorized Respondent to use its trademarks or any variation thereof. Respondent is not a licensee of Complainant. Complainant submitted evidence that its DAKINE trademark is well known that it is inconceivable that Respondent was unaware of Complainant or its trademark rights at the time of registering the disputed domain name. Moreover, Respondent's website at the disputed domain name also reproduces Complainant's logo trademark on some of the products, evidencing Respondent's awareness of Complainant's marks and its intent to target Complainant. Registration of a domain name that is identical or confusingly similar to a well-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. Respondent has failed to rebut that presumption here.

In addition, the Panel notes that Respondent has used the disputed domain name to sell what appears to be counterfeit products bearing Complainant's trademarks as well as products from Complainant's competitors. Thus, Respondent is using the disputed domain name to disrupt Complainant's business and to intentionally attract for commercial gain, Internet users by creating a likelihood of confusion with Complainant's mark.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Panels have held that the use of a domain name for illegal activity, as claimed here: sale of apparently counterfeit goods, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

The Panel finds that Complainant has established the third element 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 <salesdakine.com> be transferred to Complainant.

/Lynda J. Zadra-Symes/

Lynda J. Zadra-Symes

Sole Panelist

Date: April 29, 2024