

## **ADMINISTRATIVE PANEL DECISION**

Dakine IP Holdings LP v. Client Care, Web Commerce Communications Limited

Case No. D2024-1289

### **1. The Parties**

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

The Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

### **2. The Domain Name and Registrar**

The disputed domain name <dakineireland.com> is 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 March 19, 2024. On March 26, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 27, 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) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 27, 2024, 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 amendment to the Complaint on April 10, 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 the Respondent of the Complaint, and the proceedings commenced on April 11, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 1, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 3, 2024.

The Center appointed Jane Lambert as the sole panelist in this matter on May 13, 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

The Complainant is the proprietor of the registrations of the word DAKINE as a trade mark with the United States Patent and Trademark Office and with other trade mark registries around the world. Those registrations include the following:

Mark	Jurisdiction	Registration Number	Date of Registration
	United States	5,675,443	February 12, 2019
	United Kingdom	UK00002307550	December 19, 2003
DAKINE	European Union	018214957	August 13, 2020

The DAKINE mark has gained worldwide recognition as a sports accessory and clothing brand since 1979.

The disputed domain name was registered on August 24, 2022. The disputed domain name has been used for a website that offers to sell goods bearing the above marks. Captures of the pages from the disputed domain name website, show pictures of products that resemble the Complainant's merchandise. The Complainant alleges that the goods offered by that website are counterfeit.

Nothing is known about the Respondent other than the name and contact details that the Registrar disclosed to the Center.

#### 5. Parties' Contentions

##### A. Complainant

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

It submits that the disputed domain name is confusingly similar to trade marks in which it has rights. It argues that the combination of the mark DAKINE with the geographical term "Ireland" and the generic Top-Level Domain ("gTLD") ".com" does not have any impact on the overall impression of the dominant portion of the disputed domain name, which is DAKINE. Indeed, the Complainant suggests that the addition of the term "Ireland" and ".com" gTLD to the trade mark DAKINE could be viewed as an attempt by the Respondent to deceive consumers into believing that the disputed domain name belongs to the Complainant or that there is some kind of commercial relation with the Complainant to trick them into buying fake merchandise. It refers to section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)) which states:

"Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements."

In support of its contention, the Complainant refers to section 1.11 of the [WIPO Overview 3.0](#) and cites *Yves Salomon SAS v. Rachel Carey, Laura Lewis, Keira Sullivan, Sam Bartlett, Harriet Howells, and Isobel Stone*, WIPO Case No [D2023-5151](#). In that case, the UDRP panel found that the addition of a country name to a domain name that incorporated the complainant's trade mark in its entirety did not prevent a finding of similarity. The UDRP panel in that case found the disputed domain name to be confusingly similar to the complainant's mark.

The Complainant asserts that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant affirms that it has neither authorized nor licensed the Respondent to use the DAKINE mark. Referring to paragraph 4(c)(i) of the Policy, the Complainant refutes any suggestion that the business conducted through the website, which the disputed domain name resolves to (Annex 6 to the Complaint), constitutes a bona fide offering of goods or services. As the Complainant has never authorized or licensed the Respondent to use its trade mark, the Respondent cannot rely on paragraph 4(c)(ii) of the Policy, because any use of the disputed domain name without its consent would be an actionable infringement or amount to passing off. The Complainant observes that the Respondent was not making a legitimate noncommercial or fair use of the disputed domain name within the meaning of paragraph 4(c)(iii) of the Policy.

The Complainant alleges that the registration of the disputed domain name was an act of bad faith in itself in that the disputed domain name incorporates the Complainant's well-known brand. The use of the disputed domain name for a website that sells goods purporting to emanate from the Complainant falls within paragraph 4(b)(iv) of the Policy. Concealing its name and contact details from the public by the use of a privacy service is further evidence of bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 4 (a) of the Policy requires the Complainant to prove that:

- (i) The disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has 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.

### **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 the Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

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

The entirety of the 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.

Although the addition of the term "ireland" and the gTLD ".com" may bear on assessment of the second and third elements, the Panel finds the addition of such terms 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**

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.

The Complainant has clearly stated that it has neither authorized nor licensed the Respondent to use its DAKINE mark. Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name. However, no evidence has been adduced by either party that any of those circumstances apply. It is the case that the Respondent has used the disputed domain name for a website that purports to distribute DAKINE merchandise. UDRP panels have held that the use of a domain name for illegal activity, such as passing off, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the 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 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. One of those circumstances is set out in paragraph 4(b)(iv) of the Policy: “by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.”

The Panel has already found that the disputed domain name to be confusingly similar to the Complainant’s trade marks and that the Respondent does not have a legitimate interest in the disputed domain name. The Panel has also found that the Respondent has used the disputed domain name for a web site that purports to distribute DAKINE merchandise, from which sales the Respondent can expect commercial and financial gain. The Panel has also found that the disputed domain name is likely to lead consumers to believe that the website is an authorized distributor of DAKINE merchandise in Ireland, thereby creating a likelihood of confusion with the Complainant’s trade marks as to the source of the products on its web site. The Panel concludes that all the elements of paragraph 4(b)(iv) of the Policy are present. There is therefore evidence of registration and use of the disputed domain name in bad faith.

The Panel finds that the 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, <dakineireland.com> be transferred to the Complainant.

*/Jane Lambert/*

**Jane Lambert**

Sole Panelist

Date: May 24, 2024