

ADMINISTRATIVE PANEL DECISION

Huf Worldwide, LLC v. Domain Admin, Whoisprotection.cc / Bernd Schuster
Case No. D2022-0020

1. The Parties

The Complainant is Huf Worldwide, LLC, United States of America (“United States”), represented by Sandidge IP, Inc., United States.

The Respondent is Domain Admin, Whoisprotection.cc, Malaysia / Bernd Schuster, Germany.

2. The Domain Name and Registrar

The disputed domain name <lakaiuk.com> (the “Disputed Domain Name”) is registered with Web Commerce Communications Limited dba WebNic.cc (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 31, 2022. On January 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On January 5, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on January 5, 2022, 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 January 11, 2022.

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 January 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 31, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 1, 2022.

The Center appointed Isabel Davies as the sole panelist in this matter on February 7, 2022. 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 operates in the apparel industry and is the owner of various trademark registrations for LAKAI, including:

United States Registration No. 2525949 for LAKAI (stylized), registered on January 1, 2002;

United States Registration No. 2497003 for LAKAI, registered on October 9, 2001;

United States Registration No. 2621866 for LAKAI (stylized), registered on September 17, 2002; and

United States Registration No. 2721743 for LAKAI, registered on June 3, 2003.

These trademarks are collectively referred to as the “Trademarks”.

The Complainant also owns the domain name <lakai.com>, registered on November 21, 1999.

The Disputed Domain Name <lakaiuk.com> was registered on June 9, 2021. As evidenced in the Complaint, the Disputed Domain Name resolved to a website displaying the Trademarks and offering goods bearing the Trademarks.

5. Parties’ Contentions

A. Complainant

A. The Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (Policy, Paragraph 4(a)(i), Rules, Paragraphs 3(b)(viii), (b)(ix)(1).

The Complainant states that the Trademarks are registered for a wide variety of apparel, footwear, bags, and other items, and that Complainant’s numerous federal trademark registrations and widespread use, advertising, and promotion of its the Trademarks since as early as 2000 sufficiently establish rights in the Trademarks.

The Complainant submits that the Disputed Domain Name incorporates the Complainant’s Trademarks in their entirety and that the addition of generic term “uk”, a country, does not sufficiently distinguish the Disputed Domain Name from the Trademarks. Further, the addition of a generic Top-Level domain (“gTLD”), “.com”, fails to distinguish the Disputed Domain Name from the Trademarks.

B. The Respondent has no rights or legitimate interests in respect of the Disputed Domain Name (Policy, Paragraphs 4(a)(ii), 4(c), Rules, Paragraph 3(b)(ix)(2).

The Complainant states that its first use and first registration of the Trademarks predate any use the Respondent may have made of the Disputed Domain Name as a trade name, domain name, mark, or common name. The Complainant states that the Disputed Domain Name was registered on June 9, 2021. This is more than twenty years after the Complainant’s first use of the Trademarks. Additionally, the Complainant registered its <lakai.com> domain name in 1999, over twenty years before the Respondent registered the Disputed Domain Name.

The Complainant states that, in all likelihood, the Respondent was aware of the Complainant's domain name and website associated with the same before it registered the Disputed Domain Name because the Complainant's site was operational, and thus easily accessible to the Respondent, at the time the Respondent registered the Disputed Domain Name. It states that, because the Trademarks and common law use predate the registration of the Disputed Domain Name, and because the Respondent is charged with constructive knowledge of the Trademarks, the Respondent has no proprietary rights or legitimate interests in the Disputed Domain Name.

The Complainant contends that the Respondent has no proprietary or legitimate rights in "lakai" or the Disputed Domain Name because the Respondent is not using or preparing to use the Disputed Domain Name or names corresponding to the Disputed Domain Name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. A review of the website reveals that each prominently displays the Trademarks and is selling counterfeit goods bearing the Trademarks.

The Complainant states that it has not authorized or licensed the Respondent to manufacture, sell or offer for sale any products bearing its Trademarks and that there is no indication that the Respondent is or has ever been known by the Disputed Domain Name. The Respondent is using the Complainant's Trademarks, incorporated in the Disputed Domain Name, to offer for sale counterfeit products bearing the Complainant's Trademarks. The Complainant therefore contends that the use does not constitute a *bona fide* offering of goods.

The Complainant contends that the Respondent has copied the Complainant's images, website design, and text to create a "lookalike" shopping experience, clearly all in bad faith and intended to misleadingly divert consumers, create commercial gain and tarnish the Trademarks.

C. The Disputed Domain Name was registered and is being used in bad faith (Policy, Paragraphs 4(a)(iii), 4(b); Rules, Paragraph 3(b)(ix)(3)).

The Complainant contends that the Respondent registered and is using the Disputed Domain Name in bad faith based on the following facts.

The Complainant states that the Respondent is diverting the Complainant's customers or potential customers to the website to which the Disputed Domain Name resolves, seeking information about the Complainant, stating that the Respondent presumably obtains commercial benefits through the sale of counterfeit products bearing the Complainant's marks. The Complainant submits that this constitutes registration and use in bad faith.

The Complainant also submits that, given the fame of Complainant's Trademarks and the fact that the Respondent is using the Disputed Domain Name to sell counterfeit versions of the Complainant's products, it is clear that the Respondent had knowledge of the Trademarks when it registered the Disputed Domain Name. The Complainant contends that the Respondent's website is clearly a "lookalike" shopping experience of the Complainant's website.

B. Respondent

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

6. Discussion and Findings

The Policy establishes three elements, specified in paragraph 4(a) that must be established by the Complainant to obtain relief. These elements are:

- (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;
- (iii) the Disputed Domain Name has been registered and is being used in bad faith.

Each of these elements will be addressed below.

The Complainant must establish these elements even if the Respondent does not reply (see *The Vanguard Group, Inc. v. Lorna Kang*, WIPO Case No. [D2002-1064](#)). However, under paragraph 14(b) of the Rules, the Panel is entitled to draw such inferences as it considers appropriate from a party's failure to comply with any provision of or requirement under, the Rules, including the Respondent's failure to file a Response.

In the absence of a Response, the Panel may also accept as true the supported factual allegations in the Complaint (see *ThyssenKrupp USA, Inc. v. Richard Giardini*, WIPO Case No. [D2001-1425](#) (citing *Talk City, Inc. v. Michael Robertson*, WIPO Case No. [D2000-0009](#))).

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted. As the proceeding is an administrative one, the Complainant bears the onus of proving its case on the balance of probabilities. The Complainant must therefore establish all three of the elements specified in paragraph 4(a) of the Policy on the balance of probabilities before a decision can be made to cancel or transfer the Disputed Domain Name.

A Identical or Confusingly Similar

The Panel accepts that the Complainant has rights in the LAKAI Trademarks in connection with a wide variety of goods and services and that it owns registrations for the Trademarks in the United States.

The Panel accepts that the Disputed Domain Name incorporates the Trademarks in their entirety, notes that UDRP panels have routinely held that the addition of terms (like, in this instance, "uk") do not prevent a finding of confusing similarity between a complainant's mark and a domain name that incorporates a complainant's mark in its entirety, and refers to various cases including *Philip Morris USA Inc. v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2019-1109](#), which found that use of the term "cigarettes" in the disputed domain name with the well-known MARLBORO trademark did not prevent a finding of confusing similarity, and *Bayerische Motoren Werke AG ("BMW") v. Registration Private, Domains By Proxy, LLC, et al.*, WIPO Case No. [D2017-0156](#), which stated that "It is established that, where a mark is the distinctive part of a disputed domain name, the disputed domain name is considered to be confusingly similar to the registered mark".

Therefore, the Disputed Domain Name is confusingly similar to the Trademarks, in which the Complainant has rights.

B. Rights or Legitimate Interests

The Panel accepts that the Respondent would have been aware of the Trademarks when the Disputed Domain Name was registered on June 9, 2021 as the Complainant has registered and consistently used the Trademarks since at least 2001.

The Panel accepts that the Complainant's site was operational, and thus easily accessible to the Respondent, at the time the Respondent registered the Disputed Domain Name and that, because the Trademarks and common law use predate the registration of the Disputed Domain Name, the Respondent most likely registered the Disputed Domain Name with knowledge of the Trademarks in order to take unfair advantage of the Trademarks, rather than for any legitimate purpose, and so the Respondent likely has no rights or legitimate interests in the Disputed Domain Name.

Many cases refer to situations where the panels accepted that the respondent was aware of the complainant's mark such as in *CenturyLink Intellectual Property LLC v. Above.com Domain Privacy /*

Protection Domain, WIPO Case No. [D2017-0144](#) (finding that, where complainant used the CENTURYLINK mark since at least June 2009, respondent was likely aware of complainant's mark when it registered the disputed domain names beginning in November 2009); *Tata Sons Ltd. v. TATA Telecom Inc./Tata-telecom.com, et al.*, WIPO Case No. [D2009-0671](#) (drawing "a strong inference that the Respondent was well aware of the Complainant and the Complainant's TATA mark, and that the Respondent in fact registered the disputed domain name with the aim of trading on the strength and reputation of the Complainant's mark").

The Panel accepts that the Respondent has no rights or legitimate interests in "lakai" or the Disputed Domain Name because the Respondent is not using or preparing to use the Disputed Domain Name or names corresponding to the Disputed Domain Name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. A review of the website reveals that it prominently displays the Trademarks and is selling what appear to be counterfeit goods bearing the Trademarks.

The Panel accepts that there is no evidence to support an argument that the Respondent is commonly known by the Disputed Domain Name.

The Panel also accepts that the Complainant has never licensed or otherwise authorized the Respondent's use of the Trademarks in any domain name, much less the confusingly similar Disputed Domain Name, and refers to *Suncor Energy Inc. v. Whois Privacy Protection Service, Inc./andre bechamp*, WIPO Case No. [D2012-2123](#) (noting that, "in the absence of any license or permission from a complainant to use well-known trademarks, no actual or contemplated *bona fide* or legitimate use of the domain name could reasonably be claimed"); *SanofiAventis v. Abigail Wallace*, WIPO Case No. [D2009-0735](#) (finding that complainant had established a *prima facie* case that respondent did not have rights or legitimate interests "due to the fact that the Complainant has not licensed or otherwise permitted the Respondent to use [Complainant's] trademark, or a variation thereof").

The Panel accepts that evidence of commercial use of the Disputed Domain Name refutes any purported claim of a legitimate noncommercial or fair use of the Disputed Domain Name in that the Disputed Domain Name takes potential customers to the Respondent's website which sells products which compete with the Complainant's products and uses the Trademarks.

The Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name, which the Respondent has not rebutted.

As a result, the Panel finds that the Respondent does not have rights or legitimate interests in the Disputed Domain Name.

C. Registered and Used in Bad Faith

The Panel accepts that the Complainant's use and registration of the Trademarks long predated the Respondent's registration of the Disputed Domain Name, and refers to *SanofiAventis v. Abigail Wallace*, WIPO Case No. [D2009-0735](#) (finding it suggestive of bad faith that complainant's trademark was registered in 2005, long before respondent registered the disputed domain name in 2008).

The Panel accepts that the Respondent was aware of the Trademarks when the Respondent registered the Disputed Domain Name, which UDRP panels have held supports a finding of bad faith, and refers to *Bayerische Motoren Werke AG ("BMW") v. Registration Private, Domains By Proxy, LLC, et al.*, WIPO Case No. [D2017-0156](#) (finding it "inconceivable" that respondent selected the disputed domain names without knowledge of complainant where they operated websites "clearly promoting a business which supplies technical information" about complainant's products) and *CenturyLink Intellectual Property LLC v. Above.com Domain Privacy / Protection Domain*, WIPO Case No. [D2017-0144](#) (finding that domain names were registered and used in bad faith based in part on finding that respondent was likely aware of complainant's mark when domain names were registered).

The Panel also accepts that the Respondent is diverting the Complainant's customers or potential customers, seeking information about the Complainant, to the website to which the Disputed Domain Name resolves from which the Respondent presumably obtains commercial benefits through the sale of apparently counterfeit products bearing the Complainant's marks.

The Panel accepts that this constitutes registration and use in bad faith. The Complainant submits that, given the use by the Complainant of the Trademarks and the fact that the Respondent is using the Disputed Domain Name to sell apparent counterfeit versions of the Complainant's products, it is clear that the Respondent had knowledge of the Trademarks when it registered the Disputed Domain Name.

Even if the goods on the Respondent's website are not counterfeit, the Panel accepts that the Respondent's website is clearly a "lookalike" shopping experience of the Complainant's website and finds the Respondent's impersonating and competing use supports a finding of bad faith in this case.

UDRP panels have explicitly held that, under paragraph 4(b)(iv) of the Policy, it will be evidence of bad faith registration and use by a respondent if, by using the domain name, it has intentionally attempted to attract, for commercial gain, Internet users to the websites or other online locations to which the domain name resolves, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the websites or locations or of a product or service on the websites or locations to which the domain name resolves. Such cases include *Advance Magazine Publishers Inc., et al. v. Voguechen*, WIPO Case No. [D2014-0657](#); and *Philip Morris USA Inc. v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2019-1109](#) (finding that the fact that the same Respondent as in this case "derives (or has the opportunity to derive) some commercial benefit from the click-through revenue generated by the website to which the Domain Name presently resolves" supported a bad faith finding).

Where, as here, "a domain name is so obviously connected with a Complainant, its very use by a registrant with no connection to the Complainant suggests 'opportunistic bad faith'" as stated in *Tata Sons Ltd. v. TATA Telecom Inc./Tata-telecom.com, et al.*, WIPO Case No. [D2009-0671](#).

Accordingly, the Panel finds that the Respondent has registered and is using the Disputed Domain Name in bad faith.

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 <lakaiuk.com> be transferred to the Complainant.

/Isabel Davies/

Isabel Davies

Sole Panelist

Date: February 21, 2022