

ADMINISTRATIVE PANEL DECISION

Dansko, LLC v. Bryon Peters, Charles Russ, David Franks, Darwin Parker, Ricardo Uy, Steve Green, Julia Pabst, and Susan Pace
Case No. D2023-0217

1. The Parties

The Complainant is Dansko, LLC, United States of America (“United States”), represented by Cozen O’Connor, United States.

The Respondents are Bryon Peters, Germany, Charles Russ, United States, David Franks, United States, Darwin Parker, United States, Ricardo Uy, United States, Steve Green, United States, Julia Pabst, Germany, and Susan Pace, United States.

2. The Domain Name and Registrar

The disputed domain names <dansko-canada.com> (the “first disputed domain name”), <dansko-espana.com> (the “second disputed domain name”), <danskofactoryoutlet.com> (the “third disputed domain name”), <dansko-ireland.com> (the “fourth disputed domain name”), <danskonz.com> (the “fifth disputed domain name”), <danskoretailer.com> (the “sixth disputed domain name”), <danskoukstockists.com> (the “seventh disputed domain name”) and <danskousa.com> (the “eighth disputed domain name”) are registered with Key-Systems GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 17, 2023. On January 18, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On January 19, 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 23, 2023, providing the registrant and contact information for the multiple underlying registrants disclosed by the Registrar and inviting the Complainant to either amend the Complaint adding the Registrar-disclosed registrants as the formal Respondents and provide relevant arguments or evidence demonstrating that all the named Respondents are, in fact, the same entity and/or that all domain names are under common control and/or to indicate which of the disputed domain names will no longer be included in the current Complaint. The Complainant filed an amended Complaint on January 27, 2023, including submissions on the issue of consolidation.

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 Respondents of the Complaint and the proceedings commenced on January 31, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 20, 2023. The Respondents did not submit any response. Accordingly, the Center notified the Respondents’ default on February 21, 2023.

The Center appointed Antony Gold as the sole panelist in this matter on March 6, 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 is a designer and supplier of a wide variety of footwear designed for long wear and comfort. It was established in 1990 and now supplies its products to many countries worldwide. The Complainant’s principal brand is DANSKO and it has registered trade marks in multiple countries to protect this trading style. These include, by way of example only, United States trade mark, registration number 4229847, registered on October 23, 2012, in classes 3, 18, 25, and 35.

Each of the disputed domain names was registered on either January 14, 2022, or January 17, 2022. The first, second, fourth, fifth, and seventh disputed domain names do not resolve to active websites. The third, sixth, and eighth disputed domain names resolve to websites branded with the Complainant’s DANSKO mark, presented in the same stylized form which the Complainant uses on its website. Each website features a substantially identical layout and stylization to that of the Complainant and purports to sell the Complainant’s footwear. The content of the Respondents’ websites is such that they are evidently intended to mislead Internet users into believing that they are those of the Complainant.

5. Procedural issue - Complaint filed against multiple Respondents

The Complainant seeks consolidation of its Complaints against the Respondents because it believes that all the disputed domain names have been registered by, and/or are controlled by, the same person or entity. It points out that all the disputed domain names were registered on either January 14, 2022, or January 17, 2022, that is within three days of each other. Each of the disputed domain names shares the same Registrar and privacy service. All the disputed domain names appear to have been registered using fictitious, incomplete or stolen names and addresses. Moreover, each Respondent’s email address is a combination of four letters and four numbers and has the same email extension, namely “@21.cn.com”.

The principles applied by UDRP panels considering requests for consolidation are set out at section 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). This explains that: “Where a complaint is filed against multiple respondents, panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. Procedural efficiency would also underpin panel consideration of such a consolidation scenario.” See also *Speedo Holdings B. V. v. Programmer, Miss Kathy Beckerson, John Smitt, Matthew Simmons*, WIPO Case No. [D2010-0281](#).

The circumstances to which the Complainant has drawn attention indicate that the Respondents are either the same person or are acting in concert in order to fulfil a common design. In either eventuality, the disputed domain names are plainly under common control. Furthermore, the Panel notes that none of the Respondents has challenged the Complainant’s assertions as to why consolidation is appropriate.

In these circumstances, it is procedurally efficient, as well as fair and equitable to all Parties, for the Complainant's case in respect of all eight of the disputed domain names to be dealt with in a single Complaint. The Panel therefore grants the Complainant's request for consolidation and the named Respondents are accordingly referred to below collectively as "the Respondent".

6. Parties' Contentions

A. Complainant

The Complainant says that the disputed domain names are confusingly similar to trade marks or service marks in which it has rights. Each of the disputed domain names includes the Complainant's DANSKO mark in full and adds descriptive or geographic terms to each of them. The addition of these terms does not eliminate the confusing similarity with the Complainant's mark.

The Complainant says also that the Respondent has no rights or legitimate interests in respect of any of the disputed domain names. The Respondent is not commonly known by any of the disputed domain names, nor has the Complainant authorized, licensed or endorsed the Respondent's use of its DANSKO mark in any of the disputed domain names.

The use of the third, sixth, and eighth disputed domain names to resolve to websites confusingly similar to the Complainant's website, in that they prominently feature the Complainant's DANSKO mark and purport to offer identical footwear goods, do not comprise *bona fide* offerings of goods and services. The Respondent is not commonly known by any of the disputed domain names. Nor does the Respondent's failure to make active use of the other disputed domain names constitute a legitimate noncommercial or fair use of them.

Lastly, the Complainant says that the disputed domain names were registered and are being used in bad faith. It is evident that the Respondent had full knowledge of the Complainant's rights in its mark, not only by the confusingly similarity of the disputed domain names, which use its DANSKO mark in its entirety, but by the fact that the Respondent has imitated the Complainant on the websites to which the third, sixth, and eighth disputed domain names resolve. The fact that the Respondent sought to conceal its identity by its use of a privacy service when registering the disputed domain names provides further support for the inference that each of them was registered and is being used in bad faith. The Respondent's failure to make active use of five of the disputed domain names does not prevent a finding of bad faith in respect of them.

B. Respondent

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

7. Discussion and Findings

Dealing, first, with the Respondent's failure to file a response to the Complaint, paragraph 14(b) of the Rules provides that if a party, in the absence of exceptional circumstances, does not comply with a provision of, or requirement under, these Rules, the Panel shall be entitled to draw such inferences from this omission as it considers appropriate.

Paragraph 4(a) of the Policy provides that the Complainant proves each of the following three elements in order to succeed in its Complaint:

- (i) the disputed domain names are 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 names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

A. Identical or Confusingly Similar

The Complainant has produced evidence of its registered marks for DANSKO, including the mark full details of which have been set out above. It has thereby established its rights in this mark.

When considering whether the disputed domain names are identical or confusingly similar to the Complainant's mark the generic Top-Level Domain ".com" is disregarded as a technical requirement of registration. Each of the disputed domain names accordingly comprises the Complainant's DANSKO trade mark, in full and without alteration, followed by a geographic or descriptive term or terms, namely "canada", "espana", "factoryoutlet", "ireland", "nz" (being an acronym for New Zealand), "retailer", "ukstockists" ("uk" being an acronym for the United Kingdom) and "usa" (being an acronym for the United States of America) respectively. The addition of these terms does not prevent any of the disputed domain names from being found confusingly similar to the Complainant's mark. As explained at section 1.8 of the [WIPO Overview 3.0](#); "Where the relevant trade mark 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 Complainant's DANSKO mark is clearly recognizable within each of the disputed domain names and the Panel therefore finds that they are confusingly similar to a trade mark in which the Complainant has rights.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides, in summary, that a respondent may demonstrate that it may have rights or legitimate interests in a domain name by demonstrating either that, before any notice to it of the dispute, it has been using or has made demonstrable preparations to use, the domain name in connection with a *bona fide* offering of goods or services, or that it has been commonly known by the domain name or that it has been making a legitimate noncommercial or fair use of the domain name.

The use of the third, sixth, and eighth disputed domain names, in order to resolve to websites which masquerade as those of the Complainant does not amount to use in connection with a *bona fide* offering of goods and services; see *Zions Bancorporation, N.A. v. George Gillespie*, WIPO Case No. [D2022-3197](#), and also section 2.13.1 of the [WIPO Overview 3.0](#) which explains that "Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent".

There is no evidence to indicate that the Respondent has been commonly known by any of the disputed domain names and the second circumstance set out at paragraph 4(c) of the Policy is therefore inapplicable. Nor is the Respondent making a legitimate noncommercial or fair use of either the three disputed domain names which resolve to the websites described above or the five inactive disputed domain names, all of which feature a composition that carries a risk of implied affiliation to the Complainant, contrary to the fact, and thus such composition cannot constitute fair use.

Once a complainant has made out a *prima facie* case that a respondent lacks rights or legitimate interests in the disputed domain name, the burden of production shifts to the respondent to show that it does have such rights or legitimate interests. In the absence of any response from the Respondent to the Complaint, it has failed to satisfy that burden. The Panel accordingly finds that the Respondent has no rights or legitimate interests with respect to the disputed domain names.

C. Registered and Used in Bad Faith

The fact that, following registration of the disputed domain names, the Respondent has used the first, sixth, and eight disputed domain names in order to resolve to websites that purport to be those of the Complainant, establishes that the Respondent was aware of the Complainant's DANSKO mark as at the date of their registration and that they were registered in order to target the Complainant and take advantage of its repute

in its marks. Additionally, see section 3.1.4 of the [WIPO Overview 3.0](#) which explains: “[p]anelists have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trade mark by an unaffiliated entity (particularly domain names comprising typos or incorporating the mark plus a descriptive term) can by itself create a presumption of bad faith”. The Panel therefore finds the registration of the disputed domain names to have been in bad faith.

Turning to bad faith use, paragraph 4(b) of the Policy sets out, without limitation, circumstances which, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The circumstance set out in paragraph 4(b)(iv) of the Policy, in summary, is if a respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of its website. The use the Respondent is making of the first, sixth, and eight disputed domain names, as described above, is plainly intended to confuse Internet users into believing that its websites are those of the Complainant and therefore comprises bad faith use within the meaning of paragraph 4(b)(iv) of the Policy; see, for example *Clarins v. Privacy Service Provided by Withheld for Privacy ehf / Do Thanh Luan, Lilla Group*, WIPO Case No. [D2022-1178](#) and *Sneakersstuff AB v. Sneaker Games LLC / DONG LI*, WIPO Case No. [D2021-3237](#).

The fact that the first, second, fourth, fifth, and seventh disputed domain names are presently inactive does not prevent a finding of bad faith under the doctrine of passive holding; see section 3.3 of the [WIPO Overview 3.0](#) and, for example, *Ladbrokes Betting & Gaming Limited v. mehdi bouksila*, WIPO Case No. [D2021-3381](#). The factors that are typically considered when applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealment of its identity or its use of false contact details and (iv) the implausibility of any good faith use to which the domain name may be put. Applying the factors set out above to the current circumstances: (i) the Panel considers that the Complainant’s DANSKO mark is distinctive in the context of the Policy; (ii) the Respondent has not replied to the Complaint nor is there any other evidence of any actual or contemplated good faith use of the first, second, fourth, fifth, and seventh disputed domain names; (iii) the Respondent has sought to conceal its identity by use of a privacy service; and (iv) there is no plausible good faith use to which any of the disputed domain names could be put by the Respondent, particularly when considering the impersonating nature of the disputed domain names that do resolve to active websites. Accordingly, the circumstances support a finding of bad faith of these disputed domain names under the doctrine of passive holding.

For the above reasons, the Panel accordingly finds that the Complainant has established paragraph 4(a)(iii) of the Policy.

8. 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 names <dansko-canada.com>, <dansko-espana.com>, <danskofactoryoutlet.com>, <dansko-ireland.com>, <danskonz.com>, <danskoretailer.com>, <danskoukstockists.com>, and <danskousa.com> be transferred to the Complainant.

/Antony Gold/

Antony Gold

Sole Panelist

Date: March 20, 2023