

ADMINISTRATIVE PANEL DECISION

Dansko, LLC v. Client Care, Web Commerce Communications Limited Case No. D2023-0259

1. The Parties

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

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

2. The Domain Names and Registrar

The disputed domain names <danskoca.com>, <danskocanadaoutlets.com>, <danskocanadasale.com>, <danskochaussure.com>, <danskodeutschlandshop.com>, <danskoooutletaustralia.com>, <danskoshoecanada.com>, and <danskoshoesoutletuk.com> are 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 January 20, 2023. On January 20, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On January 28, 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 30, 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 amendment to the Complaint on January 31, 2023.

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 31, 2023. In accordance with the Rules, paragraph 5, the due date for Response was February 20, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 21, 2023.

The Center appointed Marilena Comanescu as the sole panelist in this matter on February 27, 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

Founded in 1990, the Complainant provides comfort footwear to customers around the world, including to medical professionals.

The Complainant holds trademark registrations for DANSKO, such as the following:

- the United States Trademark registration no. 2712953 for the word with device DANSKO, filed on January 9, 2002 and registered on May 6, 2003, and covering goods in Nice class 25; and
- the United States Trademark registration no. 4229847 for the word DANSKO, filed on March 16, 2012 and registered on October 23, 2012, and covering goods and services in Nice classes 3, 18, 25 and 35.

The Complainant holds and promotes its business on the website under the domain name <dansko.com>.

The disputed domain names were registered as follows:

- <danskoca.com> was registered on September 7, 2022;
- <danskoshoesoutletuk.com> was registered on September 8, 2022;
- <danskocanadasale.com>, was registered on September 15, 2022;
- <danskocanadaoutlets.com>, <danskochaussure.com>, <danskodeutschlandshop.com>, <danskootletaustrialia.com>, and <danskoshoeocanada.com> were registered on September 30, 2022.

At the time of filing the Complaint, according to evidence provided as Annexes 8-15 to the Complaint, (i) the disputed domain names <danskocanadaoutlets.com>, <danskocanadasale.com>, <danskochaussure.com>, <danskodeutschlandshop.com> and <danskootletaustrialia.com> resolved to a website confusingly similar to Complainant's website which prominently featured the Complainant's DANSKO mark and purports to offer identical footwear goods; and (ii) the disputed domain names <danskoca.com>, <danskoshoesoutletuk.com> and <danskoshoeocanada.com> resolved to error pages.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain names are virtually identical to its trademark, the Respondent has no rights or legitimate interests in the disputed domain names, and the Respondent registered and is using the disputed domain names in bad faith. The Complainant requests the transfer of the disputed domain names to it.

B. Respondent

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

6. Discussion and Findings

In view of the absence of a Response, the discussion and findings will be based upon the contentions in the Complaint and any reasonable position that can be attributable to the Respondent. Under paragraph 4(a) of

the Policy, a complainant can only succeed in an administrative proceeding under the Policy if the following circumstances are met:

- (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests in the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

The Panel will further analyze the potential concurrence of the above circumstances.

A. Identical or Confusingly Similar

The Panel finds that the Complainant holds rights in the DANSKO trademark.

All the disputed domain names incorporate the Complainant's trademark DANSKO with additional terms such as: "ca" in the disputed domain name <danskoca.com>; "canada" and "outlets" in the disputed domain name <danskocanadaoutlets.com>; "canada" and "sale" in the disputed domain name <danskocanadasale.com>; "chaussure" in the disputed domain name <danskochaussure.com>; "deutschland" and "shop" in the disputed domain name <danskodeutschlandshop.com>; "outlet" and "australia" in the disputed domain name <danskooutletaustralia.com>; "shoe" and "canada" in the disputed domain name <danskoshoeacanada.com>; "shoe", "outlet" and "uk" in the disputed domain name <danskoshoesoutletuk.com>.

However, such additions do not prevent a finding of confusing similarity as the Complainant's trademark is clearly recognizable within the disputed domain names. Numerous UDRP panels have considered that the addition of other terms (whether geographical, descriptive, pejorative, meaningless or otherwise) to trademarks in a domain name does not avoid a finding of confusing similarity. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Further, it is well established in decisions under the UDRP that the generic Top-Level Domain ("gTLD") (e.g., ".com", ".site", ".net") may typically be disregarded for the purposes of consideration of confusing similarity between a trademark and a domain name. See section 1.11.1 of the [WIPO Overview 3.0](#).

Given the above, the Panel finds that the disputed domain names are confusingly similar to the trademark DANSKO, pursuant to the Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

The Complainant asserts that the Respondent does not hold any trademark rights, license, or authorization whatsoever to use the mark DANSKO, that the Respondent is not commonly known by the disputed domain names and that the Respondent has not used the disputed domain names in connection with a legitimate noncommercial or fair use or a *bona fide* offering of goods or services.

In line with the case law, "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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element". See section 2.1 of the [WIPO Overview 3.0](#).

The Complainant has put forward a *prima facie* case that the Respondent does not have any rights or legitimate interests in the disputed domain names. The Respondent has not replied to the Complainant's contentions and has not come forward with relevant evidence to rebut the Complainant's *prima facie* case. There is nothing in the record suggesting that the Respondent has ever been commonly known by the disputed domain names or that the Respondent made a *bona fide* offering of goods or services or a legitimate noncommercial use under the disputed domain names.

According to the evidence provided in the Complaint, the Respondent has used the disputed domain names <danskocanadaoutlets.com>, <danskocanadasale.com>, <dansko chaussure.com>, <danskodeutschlandshop.com>, and <danskooutletaustralia.com>, in connection with a website copying the look and feel of the Complainant's website, providing products identical to those of the Complainant, reproducing the Complainant's trademark and product images. In this regard, UDRP panels have categorically held that the use of a domain name for illegal activity (such as swindle, fraud, identity theft, phishing and impersonation/passing off) can never confer rights or legitimate interests in a respondent. See section 2.13 of the [WIPO Overview 3.0](#).

Also, the disputed domain names <danskoca.com>, <danskoshoecanada.com>, and <danskoshoesoutletuk.com> are kept inactive and this does not amount to a *bona fide* or legitimate use. Moreover, the composition of the disputed domain names cannot constitute fair use as they carry a risk of implied affiliation to the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

For all these reasons, the Panel finds that the second element of the Policy is established, and the Respondent has no rights or legitimate interests in respect of the disputed domain names, pursuant to the Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The Complainant holds trademark rights since at least 2003 and promotes its business under the domain name <dansko.com> since 1996.

The disputed domain names were registered in September 2022 and incorporate the Complainant's trademark with additional geographical descriptors (*i.e.* UK, Canada, Deutschland) and/or words related to the Complainant's industry (*i.e.* shoe, chaussure, sale, outlet, shop).

From the above, the Panel finds that the Respondent was aware of the Complainant, its business, and trademark at the registration of the disputed domain names.

At the time of filing the Complaint, the Respondent was using the disputed domain names <danskocanadaoutlets.com>, <danskocanadasale.com>, <dansko chaussure.com>, <danskodeutschlandshop.com>, and <danskooutletaustralia.com> in connection with a website copying the look and feel of the Complainant's website and providing products identical to those of the Complainant.

Paragraph 4(b)(iv) of the Policy provides that the use of a domain name to intentionally attempt "to attract, for commercial gain, Internet users to [the respondent's] website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] website or location or of a product or service on [the respondent's] website or location" is evidence of registration and use in bad faith.

Given that the disputed domain names <danskocanadaoutlets.com>, <danskocanadasale.com>, <dansko chaussure.com>, <danskodeutschlandshop.com>, and <danskooutletaustralia.com> incorporate the Complainant's trademark with dictionary or geographical terms and the websites operated under the disputed domain names display the Complainant's trademark and product images, purportedly offer DANSKO branded goods, indeed in this Panel's view, the Respondent has intended to attract Internet users accessing the websites corresponding to the disputed domain names who may be confused and believe that the websites are held, controlled by, or somehow affiliated with or related to the Complainant, for the Respondent's commercial gain. This activity may also disrupt the Complainant's business and tarnish its trademark.

Also, three of the disputed domain names, namely <danskoca.com>, <danskoshoecanada.com>, and <danskoshoesoutletuk.com>, were not connected to active websites. From the inception of the UDRP, panels have found that the non-use of a domain name (including a blank or "coming soon" or other similar inactive page) would not prevent a finding of bad faith under the doctrine of passive holding. The Panel must examine all the circumstances of the case to determine whether the Respondent is acting in bad faith.

Examples of what may be relevant circumstances found to be indicative of bad faith include the degree of distinctiveness or reputation of the complainant's mark and the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good faith use. See section 3.3 of the [WIPO Overview 3.0](#).

As previously mentioned, the disputed domain names incorporate the Complainant's distinctive trademark with additional non distinctive terms and are confusingly similar to the Complainant's domain name, and the Respondent failed to participate in this proceeding and to put forward any argument in its favor.

Paragraph 4(b)(ii) of the Policy provides another circumstance of bad faith registration and use when the respondent registered the disputed domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct. The Panel finds that registering for at least eight disputed domain names reflecting the Complainant's trademarks, within a short timeframe, can be considered a pattern of abusive conduct and registration of the disputed domain names in bad faith. See section 3.1.2 of the [WIPO Overview 3.0](#).

Furthermore, according to Panel's independent searches, the Respondent appears to be a serial cybersquatter, being involved in numerous UDRP disputes. See for example *Buffalo Boots GmbH v. Domain Administrator*, See [PrivacyGuardian.org / Jessica Wechsler, Lindgren Katja, Andersson Hellstrom, Domain Admin, Whoisprotection.cc / Lisa Bohm, Maria Beich, Stephanie Maur, Bjork Melikssa, Calle Svensson, Diana Eisenberg, Martina Friedman, Web Commerce Communications Limited, Client Care](#), WIPO Case No. [D2021-3021](#); *C. & J. Clark International Ltd v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-0813](#); or *Reebok International Limited v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-4898](#) and cases cited therein.

The Respondent has not participated in the present proceeding and provided inaccurate contact information in the Whois. Such facts, together with all the other elements in this case, supports, in the eyes of this Panel, a finding of bad faith behavior.

For all the above reasons, the Panel finds that the Respondent registered and is using the disputed domain names in bad faith, pursuant to the Policy, paragraph 4(a)(iii).

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 names <danskoca.com>, <danskocanadaoutlets.com>, <danskocanadasale.com>, <danskochaussure.com>, <danskodeutschlandshop.com>, <danskoooutletaustralia.com>, <danskoshoecanada.com>, and <danskoshoesoutletuk.com> be transferred to the Complainant.

/Marilena Comanescu/

Marilena Comanescu

Sole Panelist

Date: March 7, 2023