

## **ADMINISTRATIVE PANEL DECISION**

### **Dansko, LLC v. Client Care, Web Commerce Communications Limited Case No. D2023-0413**

#### **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 <dansko-cz.com> and <dansko-sk.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 29, 2023. On January 30, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On February 1, 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 (Unknown Registrant) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 13, 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 February 14, 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 February 15, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 7, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 21, 2023.

The Center appointed Emre Kerim Yardimci as the sole panelist in this matter on March 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**

The Complainant is a United States based footwear established in 1990 that designs, manufactures, and sells various types of shoes under its DANSKO mark. The Complainant's family of DANSKO marks has gained significant consumer recognition in connection with the Complainant's goods through substantial use, advertising and promotion and it is particularly well-known for its clogs.

The Complainant is the holder of various DANSKO trademarks including United States. Reg. No. 2,712,953 for a stylized version of the mark DANSKO (registered May 6, 2003) for use in connection with footwear.

The Complainant holds and promotes its business on the website under the domain name <dansko.com> registered on August 23, 1996.

The disputed domain names were both registered on November 12, 2022, and they are not directed to an active website.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant asserts that the disputed domain names are confusingly similar to the Complainant's trademark DANSKO and that the addition of the geographical terms "CZ" and "SK" does not prevent the association between the disputed domain names and the Complainant's trademark.

The Complainant considers that the Respondent has no rights or legitimate interests in respect of the disputed domain names, mainly because the Complainant has neither licensed nor otherwise authorized the Respondent to use its marks or to apply for or use any domain name incorporating the trademark DANSKO.

Lastly, the Complainant says that the disputed domain names were registered and are used in bad faith. It is evident that the Respondent had full knowledge of the Complainant's rights in its mark by the confusingly similarity of the disputed domain names, which use its DANSKO mark in its entirety.

The Respondent's failure to make active use 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.

#### **6. Discussion and Findings**

Paragraph 4(a) of the Policy sets forth the following three elements which the Complainant must prove, during the administrative proceedings, to merit a finding that the disputed domain names be transferred to the Complainant:

- (a) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (b) the Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- (c) the disputed domain names have been registered and are being used in bad faith.

Pursuant to paragraph 15(a) of the Rules, the Panel shall decide a Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

### **A. Identical or Confusingly Similar**

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights. A trademark registration provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner.

As indicated above, the Complainant holds several trademark registrations for the DANSKO trademark.

The disputed domain names integrate the Complainant's DANSKO trademark in its entirety. The disputed domain names differ from the registered DANSKO trademark by the additional geographical abbreviations "sk" and "cz".

Several UDRP panels have ruled that the mere addition of a term does not prevent a finding of confusing similarity between a disputed domain name and a complainant's trademark. Therefore, it is the Panel's view that the use of such words together with the Complainant's trademark does not prevent a finding of confusing similarity between the disputed domain names and the Complainant's trademark (see, e.g., *Société des Produits Nestlé S.A. v. MrToys.com LLC*, WIPO Case No. [D2012-1356](#); *Allianz SE v. Roy Lee / Traffic-Domain.com*, WIPO Case No. [D2012-1459](#); *Swarovski Aktiengesellschaft v. mei xudong*, WIPO Case No. [D2013-0150](#); and *Swarovski Aktiengesellschaft v. www.swarovski-outlet.org*, WIPO Case No. [D2013-0335](#)).

As regards the generic Top-Level Domain ("gTLD") ".com", it is typically disregarded under the confusing similarity test under the Policy.

Consequently, the Panel finds that the Complainant has shown that the disputed domain names are confusingly similar to a trademark in which the Complainant has rights.

### **B. Rights or Legitimate Interests**

The onus is upon the Complainant to make out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain names, and it is then for the Respondent to rebut this case.

The Panel accepts the Complainant's submissions that the Respondent does not appear to have been known by the disputed domain names, has not made demonstrable preparations to use the disputed domain names, and the Respondent is not making a legitimate noncommercial use of the disputed domain names.

The Respondent has not filed a Response. It has no consent from the Complainant to register any domain name incorporating the Complainant's trademark, it has not used the disputed domain names for a *bona fide* offering of goods or services, and the Respondent is not commonly known by the disputed domain names.

The Respondent is not using the disputed domain names and as indicated in several UDRP decisions, the passive holding of the disputed domain names does not give rise to any rights or legitimate interests.

In the Panel's view, the Complainant has made out their *prima facie* case under this element of the Policy and the Respondent, who is in default, has failed to rebut this case.

In addition, the Panel finds that the disputed domain names, incorporating the Complainant's trademark in its entirety with the addition of terms "-cz" (Czech Republic), and "-sk" (Slovakia), carry a risk of implied affiliation with the Complainant.

In the circumstances of this case, and in view of the Panel's discussion below, the Panel finds that the second element of the Policy has been established.

### **C. Registered and Used in Bad Faith**

The Panel accepts the Complainant's assertions that the trademark DANSKO is a well-known trademark.

The incorporation of a well-known trademark into a domain name by a registrant having no plausible explanation for doing so may be, in and of itself, an indication of bad faith (*Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. [D2000-0163](#); *General Electric Company v. CPIC NET and Hussain Syed*, WIPO Case No. [D2001-0087](#); *Microsoft Corporation v. Montrose Corporation*, WIPO Case No. [D2000-1568](#)).

The Respondent has registered the disputed domain names but has not put it to any material use.

Thus, the Respondent is holding the disputed domain names passively. It has long been generally held in UDRP decisions that the passive holding of a domain name that incorporates a well-known trademark, without any actual or contemplated good faith use for an Internet purpose, does not necessarily circumvent a finding that the domain name is in use within the requirements of paragraph 4(a)(iii) of the Policy (*Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

The Panel finds that the non-use of the disputed domain names does not prevent a finding of bad faith under the doctrine of passive holding. Given the Respondent's lack of participation in this proceeding, the lack of any credible good-faith use to which the confusingly similar disputed domain names could be put, and the composition of the disputed domain names, the totality of circumstances supports an inference of bad faith. Therefore, in the view of cumulative circumstances, the Panel finds that the requirement of registration and use in bad faith is satisfied, according 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 <dansko-cz.com> and <dansko-sk.com> be transferred to the Complainant.

*/Emre Kerim Yardimci/*

**Emre Kerim Yardimci**

Panelist

Date: April 16, 2023