

ADMINISTRATIVE PANEL DECISION

Dansko, LLC v. Client Care, Web Commerce Communications Limited Case No. D2023-0425

1. The Parties

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

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

2. The Domain Names and Registrar

The disputed domain names <danskoclogs-ireland.com>, <dansko-factoryoutlet.com>, <dansko-outlets.com>, and <danskoshoes-uk.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 30, 2023. On January 31, 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 1, 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 6, 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 10, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 2, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 6, 2023.

The Center appointed Peter Burgstaller as the sole panelist in this matter on March 21, 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 an US based producer of comfort footwear, founded in 1990, and providing its footwear to customers around the world, especially through its webshop available under <dansko.com> (Annex 4 – 6 to the Complaint).

The Complainant owns several registered trademarks containing the mark DANSKO, *inter alia* the US registered trademarks:

- DANSKO (word), Reg. No. 2,712,957, registered May 6, 2003, in class 25,
- DANSKO (fig.), Reg. No. 3,265,196, registered on July 17, 2007, in class 25,
- DANSKO (word), Reg. No. 3,265,194, registered July 17, 2007 in class 25,
- DANSKO (word), Reg. No. 4,229,847, registered October 23, 2012, in classes 3, 18, 25, 35, and
- DANSKO NATURAL ARCH (word), Reg. No. 5,638,606, registered on December 25, 2018 in the class 25 (Annex 7 to the Complaint).

The disputed domain names were registered on December 3, 2022 with regard to <danskoclogs-ireland.com> and <danskoshoes-uk.com> as well as on December 5, 2022 regarding <dansko-outlets.com> and <dansko-factoryoutlet.com> (Annex 1 to the Complaint).

On January 30, 2023, the disputed domain names <dansko-factoryoutlet.com> and <dansko-outlets.com> resolved to a website containing the figurative “dansko” registered trademark and offering the Complainant's shoes and footwear for sale (Annex 8 to the Complaint).

The disputed domain names <danskoshoes-uk.com> and <danskoclogs-ireland.com> were not actively used on January 30, 2023 (Annex 9 to the Complaint).

Currently (April 1, 2023), the disputed domain name <danskoshoes-uk.com> redirects to <danskoshoe-uk.com> which resolves to a website offering the Complainant's footwear for sale under the figurative “*dansko*” registered trademark; also, the disputed domain name <dansko-factoryoutlet.com> currently resolves to this website.

The disputed domain names <dansko-outlets.com> and <danskoclogs-ireland.com> are currently not in use.

5. Parties' Contentions

A. Complainant

Since 1990, the Complainant has provided comfort footwear to customers around the world. The Complainant has gained significant common law trademark rights in its DANSKO marks, through the use, advertisement, and promotion of such marks in connection with its footwear goods. The Complainant has also protected its DANSKO marks by filing for and obtaining various trademark registrations in the US Patent and Trademark Office.

The disputed domain names are virtually identical to the Complainant's DANSKO marks and domain name apart from descriptive elements which do nothing to distinguish the disputed domain names from the Complainant's DANSKO marks. Therefore, the disputed domain names are confusingly similar to the DANSKO marks in which the Complainant has established rights.

The Respondent has no rights or legitimate interests in respect of the disputed domain names. The Respondent is not affiliated with the Complainant, and there is no evidence to suggest that the Respondent has registered the disputed domain names to advance legitimate interests for the *bona fide* offering of legitimate goods or services. The Respondent has anonymously registered the disputed domain names in an effort to evade the consequences of registering the disputed domain names for which he/she has no rights or legitimate interests. Further, the Respondent is not commonly known as "Dansko," or any of the terms in the disputed domain names. Moreover, there presently is no evidence of any connection between the Respondent and the disputed domain names. The Complainant has not authorized, licensed, or endorsed the Respondent's use of its DANSKO marks in the disputed domain names.

The Respondent registered and used the disputed domain names in bad faith: Its adoption and use of the disputed domain names is in bad faith and is in willful infringement of the Complainant's prior rights. The Respondent has attempted to take commercial advantage of the Complainant's trademarks and commercial reputation and to trade off the Complainant's goodwill. The Respondent clearly had the Complainant in mind when registering the disputed domain names, because the Respondent had constructive notice of the DANSKO marks as the Complainant owns trademark registrations and the disputed domain names contain the identical DANSKO marks. This is supported by the fact, that the Respondent imitates the Complainant on the <dansko-outlets.com> and <dansko-factoryoutlet.com> websites which prominently display the Complainant's DANSKO marks. The Respondent's use and registration of the disputed domain names further constitute bad faith inasmuch as the disputed <dansko-outlets.com> and <dansko-factoryoutlet.com> domains are designed for commercial gain and to promote counterfeit goods, thereby raising a likelihood of consumer confusion. Through the disputed domain names <dansko-outlets.com> and <dansko-factoryoutlet.com>, the Respondent solicits business from Internet users while deceptively appearing as the Complainant. Such conduct is indicative of bad faith registration and use.

B. Respondent

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

6. Discussion and Findings

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; and
- (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.

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. This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

The Complainant submitted evidence, which clearly establishes rights in the mark DANSKO.

In the present case, the disputed domain names <danskoclogs-ireland.com>, <dansko-factoryoutlet.com>, <dansko-outlets.com>, and <danskoshoes-uk.com> are confusingly similar to the Complainant's trademark DANSKO because they only add descriptive and/or geographical terms to the mark DANSKO which cannot

prevent a finding of confusing similarity under the first element of the Policy, since the mark DANSKO is still clearly recognizable within the disputed domain names.

Finally, it has also long been held that generic Top-Level-Domains are generally disregarded when evaluating the confusing similarity of a disputed domain name.

Therefore, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

While the overall burden of proof in UDRP proceedings is on the complainant, UDRP panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible 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. 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](#)).

In this regard, the nature of the disputed domain names, containing the Complainant’s trademark DANSKO in a confusing similar form and the Complainant’s contentions that the Respondent has no rights or legitimate interests in the disputed domain names, that the Respondent has no connection or affiliation with the Complainant, and the Respondent has not received any license or consent, express or implied, to use the Complainant’s trademarks in a domain name or in any other manner, as well as the Respondent not having rebutted these allegations, lead the Panel to the conclusion that the Complainant has made out an undisputed *prima facie* case so that the conditions set out in paragraph 4(a)(ii) of the Policy have been met by the Complainant.

In addition, the Panel finds that the disputed domain names <danskoclogs-ireland.com>, <dansko-factoryoutlet.com>, <dansko-outlets.com>, and <danskoshoes-uk.com> carry a risk of implied affiliation with the Complainant. See section 2.5.1 of the [WIPO Overview 3.0](#).

This finding is also supported by the fact that the Respondent’s use of the disputed domain names <dansko-factoryoutlet.com> and <dansko-outlets.com>, as shown in the screenshots submitted as Annex 8 to the Complaint, does not meet the requirements for a reseller or distributor to be making a *bona fide* offering of goods or services. See section 2.8 of the [WIPO Overview 3.0](#).

C. Registered and Used in Bad Faith

As stated in many decisions rendered under the Policy (e.g. *Robert Ellenbogen v. Mike Pearson*, WIPO Case No. [D2000-0001](#)) both conditions, registration and use in bad faith, must be demonstrated; consequently, the Complainant must show that:

- the disputed domain names were registered by the Respondent in bad faith, and
- the disputed domain names are being used by the Respondent in bad faith.

The Complainant’s company name is DANSKO (LLC) and it is the owner of the registered trademark DANSKO, long before the registration of the disputed domain names. Moreover, the Complainant has a strong Internet presence under its domain name <dansko.com>.

It is inconceivable for this Panel that the Respondent registered and used the disputed domain names without knowledge of the Complainant’s rights, which leads to the necessary inference of bad faith. This finding is supported by the fact that the disputed domain names incorporate the Complainant’s distinctive registered trademark and its company name DANSKO entirely, together with suffixes which clearly refers to the Complainant’s business and products (especially “shoes” and “clogs”). All of which in fact indicate that

the Respondent must have been aware of the Complainant's business and trademark when registering the disputed domain names.

Therefore, the Panel is convinced that the disputed domain names were registered in bad faith by the Respondent.

The Complainant put forward evidence that the disputed domain names <dansko-factoryoutlet.com> and <dansko-outlets.com> resolved on January 30, 2023 to a website containing the figurative and distinctive "dansko" registered trademark and offering the Complainant's shoes and footwear for sale. In doing so, the Respondent intentionally attempted to attract Internet users to its websites for commercial gain, by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation or endorsement of its website according to paragraph 4(b)(iv) of the Policy – this constitutes bad faith use of the disputed domain names.

Although there is no evidence put forward by the Complainant that the disputed domain names <danskoshoes-uk.com> and <danskoclogs-ireland.com> are being actively used, previous UDRP panels have found that bad faith use under paragraph 4(a)(iii) does not necessarily require a positive act on the part of the respondent – inaction is within the concept of paragraph 4(a)(iii) (see especially *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); *Ladbroke Group Plc v. Sonoma International LDC*, WIPO Case No. [D2002-0131](#)).

This Panel also concludes that the present passive holding of the disputed domain names constitutes bad faith use (see section 3.3 of the [WIPO Overview 3.0](#)), putting emphasis on the following:

- the Complainant's trademark DANSKO is distinctive and in use globally with a strong Internet presence;
- the Respondent has failed to present any evidence of any good faith use with regard to the disputed domain name;
- the Respondent registered the disputed domain names <danskoshoes-uk.com> and <danskoclogs-ireland.com> together with the actively used disputed domain names <dansko-outlets.com> and <dansko-factoryoutlet.com>;
- the disputed domain names moreover contain suffixes which refer to the business and products of the Complainant ("shoes" and "clogs"), and
- there is no future conceivable plausible reason for good faith use with regard to these disputed domain names.

Notwithstanding, following the Panel's own investigation (see section 4.8 of the [WIPO Overview 3.0](#)), when deciding this case, the disputed domain name <danskoshoes-uk.com> was used insofar as it redirected to <danskoshoe-uk.com> which resolved to a website offering the Complainant's products under the Complainant's distinctive, figurative trademark; hence, the disputed domain name <danskoshoes-uk.com> was used in bad faith, too.

Taking all these facts and evidence into consideration this Panel finds that the disputed domain names have been registered and used in bad faith under paragraph 4(a)(iii) 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 names <danskoclogs-ireland.com>, <dansko-factoryoutlet.com>, <dansko-outlets.com> and <danskoshoes-uk.com> be transferred to the Complainant.

/Peter Burgstaller/

Peter Burgstaller

Sole Panelist

Date: April 4, 2023