

ADMINISTRATIVE PANEL DECISION

Dansko, LLC v. sizuka juliana, halo
Case No. D2023-0462

1. The Parties

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

The Respondent is sizuka juliana, halo, Thailand.

2. The Domain Name and Registrar

The disputed domain name <danskoshoes.name> is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 1, 2023. On February 1, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 2, 2023, 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 (Unknown Registrant) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 2, 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 7, 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 22, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 14, 2023. The Respondent sent an informal email to the Center on February 2, 3, 15, and 22, 2023. After the Complainant’s request, the proceeding was suspended on March 2, 2023. The proceeding was reinstated on March 28, 2023.

The Center appointed Ganna Prokhorova as the sole panelist in this matter on April 18, 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 US based footwear established in 1990 that designs, manufactures, and sells various types of shoes under its DANSKO mark.

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

- DANSKO (word), Reg. No. 2,712,957, registered on May 6, 2003, in class 25,
- DANSKO (word), Reg. No. 3,265,194, registered on July 17, 2007 in class 25,
- DANSKO (word), Reg. No. 4,229,847, registered on October 23, 2012, in classes 3, 18, 25, and 35.

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

The disputed domain name was registered on December 6, 2022, and at the moment of filing the Complaint resolved to a blog describing gambling related content.

5. Parties' Contentions

A. Complainant

The Complainant asserts that each of the elements enumerated in paragraph 4(a) of the Policy and the corresponding provisions in the Rules have been satisfied. In particular, the Complainant asserts that:

(1) the disputed domain name is confusingly similar to the Complainant's trademark DANSKO and that the addition of the descriptive term "shoes" does not prevent the association between the disputed domain name and the Complainant's trademark.

(2) the Respondent has no rights or legitimate interests in respect of the disputed domain name, 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. The Respondent is not affiliated with the Complainant, and there is no evidence to suggest that the Respondent has registered the disputed domain name to advance legitimate interests for the *bona fide* offering of legitimate goods or services. The Respondent is not commonly known as "Dansko" or any of the terms in the disputed domain name.

(3) the disputed domain name was registered and is being used in bad faith. The disputed domain name resolves to a website with gambling related content. The Respondent has attempted to take commercial advantage of the Complainant's trademarks and commercial reputation and to trade off the Complainant's goodwill. It is evident that the Respondent had full knowledge of the Complainant's rights in its mark by the confusing similarity of the disputed domain name, which use its DANSKO mark in its entirety. The Respondent registered the disputed domain name long after the Complainant began advertising and using its DANSKO marks. Given that the Respondent also chose to attach the generic descriptors at the end of the Complainant's registered DANSKO mark in the disputed domain name, it is likely that the Respondent plans to use the disputed domain name in attempts to fraudulently obtain personally identifiable information from individuals believing that the disputed domain name is actually related to the Complainant.

B. Respondent

The Respondent did not formally reply to the Complainant's contentions but rather sent a few emails, two of them suggested that the Respondent is ready to transfer the disputed domain name (emails on February 15 and 22, 2023).

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all the elements listed in paragraph 4(a) of the Policy have been satisfied, as following:

- (i) the disputed domain name is 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 respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Complainant bears the burden of proving that all these requirements are fulfilled, even if the Respondent has not replied to the Complaint.

Moreover, the Panel has taken note of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") and, where appropriate, will decide consistent with the consensus views captured therein.

A. Identical or Confusingly Similar

According to paragraph 4(a)(i) of the Policy, it should be established that the disputed domain name is identical or confusingly similar to a mark in which the Complainant has rights.

The Complainant has demonstrated ownership of its DANSKO trademark. Therefore, the Panel is satisfied that the Complainant has registered trademark rights in the DANSKO mark. See [WIPO Overview 3.0](#), section 1.2.1.

With the Complainant's rights in the DANSKO trademark established, the remaining question under the first element of the Policy is whether the disputed domain name is identical or confusingly similar to the Complainant's mark.

The first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a "reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name". See [WIPO Overview 3.0](#), section 1.7. This test typically involves a side-by-side comparison of the disputed domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

The Complainants submit that the disputed domain name is confusingly similar to the Complainant's mark DANSKO. The disputed domain name includes the entire element of the Complainant's mark DANSKO. As per Section 1.7 of the [WIPO Overview 3.0](#), the disputed domain name <danskoshoes.name> should normally be regarded as confusingly similar. Merely adding the term "shoes" does not prevent a finding of confusing similarity between the disputed domain name and the mark under the Policy, paragraph 4(a)(i). See [WIPO Overview 3.0](#), section 1.8. Bearing that in mind, the Panel accordingly holds the disputed domain name is confusingly similar to the Complainant's trademark DANSKO.

The generic Top-Level Domain ".name" should generally be ignored when assessing confusing similarity as established by prior UDRP decisions.

Consequently, the Panel finds that the disputed domain name is confusingly similar to the trademark of the Complainant and that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

While the burden of proof remains with the Complainant, the Panel recognizes that this would often result in the impossible task of “proving a negative”, in particular as the evidence needed to show the Respondent’s rights or legitimate interests is often primarily within the knowledge of the Respondent. Therefore, the Panel agrees with prior UDRP panels that the Complainant is required to make out a *prima facie* case before the burden of production shifts to the Respondent to show that it has rights or legitimate interests in the disputed domain name to meet the requirements of paragraph 4(a)(ii) of the Policy.

The Panel accepts the Complainant’s submissions that the Respondent does not appear to have been known by the disputed domain name, has not made demonstrable preparations to use the disputed domain name, and the Respondent is not making a legitimate noncommercial use of the disputed domain name. Rather, the disputed domain name resolves to a website with gambling related content. Such use cannot establish rights or legitimate interests.

The Panel has found out that the Respondent is not a licensee of the Complainant and is not affiliated with the Complainant in any way. The Complainant has not granted any authorization for the Respondent to make use of its trademarks in a disputed domain name or otherwise.

Moreover, according to the case file, there is no evidence that the Respondent has or intends to use the disputed domain name in connection with a *bona fide* offering of goods or services.

The Panel finds that the Complainant has made out a *prima facie* case, a case calling for an answer from the Respondent. The Respondent has not responded and the Panel is unable to conceive of any basis upon which the Respondent could sensibly be said to have any rights or legitimate interests in respect of the disputed domain name (*Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#)).

The fact that the Respondent has indicated to the Center that it is ready to transfer the disputed domain name would seem to confirm that it has no rights nor legitimate interests in the disputed domain name and that the requirements of paragraph 4(a)(ii) of the Policy have been fulfilled.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must prove on the balance of probabilities both that the disputed domain name was registered in bad faith and that it is being used in bad faith.

The Panel finds that the Complainant has demonstrated the Respondent’s bad faith registration and use of the disputed domain name.

The Respondent registered the disputed domain name on December 6, 2022, almost 20 years after the Complainant registered its first DANSKO mark.

As regards use, the Panel finds that the following circumstances taken together warrant a finding of bad faith use of the disputed domain name:

- the probability that the Respondent was aware or should have been aware of the Complainant’s rights in the DANSKO trademark;
- the lack of a Response to the Complaint; and
- the use of the website to which the disputed domain name resolves for gambling related content.

The fact that there is a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent’s choice of the disputed domain name is also a significant factor to consider when determining if the disputed domain name was registered in bad faith (as stated in section 3.2.1 of [WIPO Overview 3.0](#)).

The Respondent has provided no evidence of actual or contemplated good faith use of the disputed domain name and the Panel does not find any such use plausible.

In light of the above, the Panel finds that the Respondent has registered and used the disputed domain name in bad faith and that the Complainant has established its case 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 name <danskoshoes.name> be transferred to the Complainant.

/Ganna Prokhorova/

Ganna Prokhorova

Sole Panelist

Date: May 2, 2023