

## **ADMINISTRATIVE PANEL DECISION**

Dansko, LLC v. Web Commerce Communications Limited  
Case No. D2023-2064

### **1. The Parties**

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

The Respondent is Web Commerce Communications Limited, Malaysia.

### **2. The Domain Names and Registrars**

The disputed domain names <danskocanadaonline.com>, <danskocanade.com>, <danskoclogcanada.com> are registered with Alibaba.com Singapore E-Commerce Private Limited.

The disputed domain names are hereinafter together referred to as the “Domain Names”.

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 9, 2023. On May 10, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On May 11, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the 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 May 11, 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 May 11, 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 May 12, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 1, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 2, 2023.

The Center appointed Gregor Vos as the sole panelist in this matter on June 7, 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, such as comfort footwear and footwear for medical professionals. The Complainant was established in 1990 and supplies its products to countries worldwide.

The Complainant is the owner of *inter alia* the following trademarks (the "Trademarks"):

- United States Trademark reg. No. 2712957 for DANSKO, registered on May 6, 2003;
- United States Trademark reg. No. 2712953 for  , registered on May 6, 2003.

Further, it is undisputed that the Complainant is the holder of the domain name <dansko.com>.

The Domain Name <danskocanadaonline.com> was registered on April 19, 2023, the Domain Name <danskocanade.com> was registered on April 20, 2023, and the Domain Name <danskoclogcanada.com> was registered on April 21, 2023.

At the time that the Complainant filed the Complaint, the Domain Names <danskocanadaonline.com> and <danskoclogcanada.com> were and are still inactive. The Domain Name <danskocanade.com> resolves to an active website on which products are offered for sale under the Trademarks and on which the Trademarks are prominently depicted.

#### 5. Parties' Contentions

##### A. Complainant

With the Complaint, the Complainant seeks that the Domain Names are transferred to the Complainant. The Complaint is based on the following factual and legal grounds: the Domain Names are confusingly similar to the Trademarks of the Complainant, the Respondent has no rights or legitimate interests in the Domain Names, and the Domain Names have been registered and are being used in bad faith.

Firstly, according to the Complainant, the Domain Names are confusingly similar to its Trademarks. The Domain Names fully incorporate the Complainant's Trademarks with the mere addition of the geographical and descriptive terms "canada", "canade", "online" and "clog", and the generic Top-Level Domain ("gTLD") ".com".

Secondly, according to the Complainant, the Respondent has no rights or legitimate interests in the Domain Names. The Respondent is not using the Domain Names for a *bona fide* offering of goods or services or making any legitimate noncommercial or fair use. Also, the Respondent is not affiliated with the Complainant, has not received any authorization or license from the Complainant and there is no evidence that the Respondent is commonly known by the Domain Names. In addition, the Complainant submits that the Respondent uses the Domain Names to deliberately cause consumer confusion with the Complainant and its goods.

Finally, according to the Complainant, the Respondent has registered and is using the Domain Names in bad faith. The Respondent clearly had the Complainant in mind when registering the Domain Names and had full knowledge of the Complainant's rights in the Trademarks. In addition, the Respondent has registered the Domain Name <danskocanade.com> to promote identical goods in competition with or to imitate the

Complainant. The Respondent also concealed its true identity by registering the Domain Names through a privacy service, supporting the inference that the Respondent has knowingly engaged in bad faith registration and use of the Domain Names. Additionally, <danskocanadaonline.com> and <danskoclogcanada.com> are currently inactive, which demonstrates bad faith as the Respondent failed to make active use of them. Also, the Respondent registered the Domain Names to trade off of the Complainant's goodwill in its Trademarks and to confuse consumers into believing that the Respondent's Domain Names are affiliated or associated with the Complainant. Lastly, the Complainant suggests that it is likely that the Respondent plans to use the Domain Names to fraudulently obtain personally identifiable information from individuals that are believing that the Domain Names are actually affiliated with the Complainant. According to the Complainant, this demonstrates opportunistic bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

In view of the lack of a response filed by the Respondent as required under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs (5)(f), 14(a), and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding on the basis of the Complainant's undisputed factual presentations.

For the Complainant to succeed, it must prove, within the meaning of paragraph 4(a) of the Policy and on the balance of the probabilities that:

- (i) the Domain Names are identical or confusingly similar to a Trademark or a service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the Domain Names; and
- (iii) the Domain Names have been registered and are being used in bad faith.

Only if all three elements have been fulfilled, the Panel is able to grant the remedies requested by the Complainant. The Panel will deal with each of the requirements in turn.

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

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the Domain Names are (i) identical or confusingly similar to a trademark or service mark, (ii) in which the Complainant has rights.

With respect to having rights pursuant to paragraph 4(a)(i) of the Policy, it is noted that the Complainant is registered as the owner of the Trademarks. Consequently, the Panel finds that the Complainant has proven that it has rights in the Trademarks.

With regard to the assessment of confusing similarity of the Domain Names with the Trademarks, it is generally accepted that this test involves a reasoned but relatively straightforward comparison between the Complainant's Trademarks and the Domain Names (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). In cases where a domain name incorporates the entirety of a trademark, the domain name will normally be considered confusingly similar to that mark (see section 1.7 of the [WIPO Overview 3.0](#)).

In the present case, the Trademarks to which the Complainant has rights are incorporated in their entirety in the Domain Names. The addition of the geographical terms "canada" and the misspelled version "canade",

and the terms “online” and “clog” respectively, and the gTLD “.com” do not prevent a finding of confusing similarity with the Trademarks (see sections 1.8 and 1.11.1 of the [WIPO Overview 3.0](#)).

Consequently the Panel finds that the requirement under paragraph 4(a)(i) of the Policy has been satisfied.

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

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the Domain Names. The *onus* of proving this requirement, like each element, falls on the Complainant. Given the difficulty in proving a negative, however, it is usually sufficient for a complainant to make out a *prima facie* case that a respondent lacks rights or legitimate interests. If a complainant does establish a *prima facie* case, the burden of production shifts to the respondent (see, e.g. [WIPO Overview 3.0](#), section 2.1; *Sanofi v. Cimpres Schweiz GmbH*, WIPO Case No. [D2017-0522](#)).

Paragraph 4(c) of the Policy lists three non-limitative examples of instances in which the Respondent may establish rights or legitimate interests in the Domain Names.

The Complainant has substantiated that none of these circumstances apply in this case. By defaulting, the Respondent has failed to address the *prima facie* case established by the Complainant. Furthermore, based on the record before it, the Panel does not see an indication that any of the circumstances of paragraph 4(c) of the Policy is present.

Moreover, the impersonating nature of the content found at the Domain Name <danskocanade.com>, combined with the construction of the other Domain Names confirms the Respondent’s intention of impersonation or suggesting sponsorship or endorsement by the Complainant (see [WIPO Overview 3.0](#), section 2.5.1).

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Names. Paragraph 4(a)(ii) is thereby fulfilled.

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

Under paragraph 4(a)(iii) of the Policy, the Complainant must show that the Domain Names have been registered and are being used in bad faith. Paragraph 4(b) of the Policy lists four non-limitative circumstances which may be considered as evidence of registration and use in bad faith of a domain name.

In the present case, the Trademarks are registered by the Complainant and have been used for many years. The Complainant’s rights to the Trademarks predate the registration date of the Domain Names. In light of the reputation of the Trademarks and the fact that the Trademarks are prominently depicted on the website connected to the Domain Name <danskocanade.com>, the Panel agrees with the Complainant that it is not conceivable that the Respondent chose the Domain Names without knowledge of the Complainant’s activities and its Trademarks under which the Complainant is doing business. The reputation of the Trademarks of the Complainant has been confirmed by earlier UDRP panels (see e.g. *Dansko, LCC v. Wenhong Chen*, WIPO Case No. [D2012-0583](#); *Dansko, LCC v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2023-0413](#)).

In light of the lack of any rights or legitimate interest in the Domain Names by the Respondent, and in the absence of any conceivable good faith use of the Domain Names, the Panel finds from the present circumstances that the Respondent has intentionally sought to take unfair advantage of or otherwise abuse the Trademarks.

With regard to the use of the Domain Names in bad faith, the Panel finds that the use of the Trademarks in the Domain Names signals an intention on the part of the Respondent to confuse Internet users into thinking that the Domain Names are connected to the Complainant. This is reinforced by the fact that the Domain Name <danskocanade.com> resolves to a website displaying the Trademarks and purportedly offering for

sale the Complainant's products. However, the Respondent does not provide any information on its (nonexistent) relationship with the Complainant, which creates the false impression of an affiliation with the Complainant (see [WIPO Overview 3.0](#), section 3.2.1).

With regard to the Domain Names <danskocanadaonline.com> and <danskoclogcanada.com> it is generally accepted by UDRP panels that the non-use of a domain name does not prevent a finding of bad faith (section 3.3 of the [WIPO Overview 3.0](#)). In light of the reputation of the Trademarks, the lack of any rights or legitimate interest in the Domain Names by the Respondent, the Respondent's failure to file any response, and in the absence of any conceivable good-faith use of the Domain Names, the Panel finds from the present circumstances that the Respondent has intentionally sought to take unfair advantage of or otherwise abuse the Trademarks. This is reinforced by the reputation of the Complainant's Trademarks, as referenced above.

Accordingly, the Panel finds that the Domain Names have been registered and are being used in bad faith and that the third element of paragraph 4(a)(iii) of the Policy is fulfilled.

## **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 Domain Names <danskocanade.com>, <danskocanadaonline.com> and <danskoclogcanada.com> be transferred to the Complainant.

*/Gregor Vos/*

**Gregor Vos**

Sole Panelist

Date: June 22, 2023