

ADMINISTRATIVE PANEL DECISION

Dansko, LLC v. Melanie Oster and Client Care, Web Commerce Communications Limited
Case No. D2023-1911

1. The Parties

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

The Respondent is Melanie Oster, Germany and Client Care, Web Commerce Communications Limited, Malaysia.

2. The Domain Names and Registrar

The disputed domain name <danskonederland.co> is registered with NameCheap, Inc. (the "Registrar").

The disputed domain names <dansko-nederland.com>, <danskopolska.com>, and <danskoshoeireland.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 April 27, 2023. On April 28, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On April 28, 2023, and on May 9, 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 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 amended Complaint on May 11, 2023.

The Center verified that the Complaint together with the amended 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 June 1, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 21, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on July 6, 2023.

The Center appointed Federica Togo as the sole panelist in this matter on July 25, 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. Preliminary issue : Consolidation

As noted above, the Complaint relates to more than one domain name, which are registered by different Registrants, according to the information provided by the Registrars upon the Request for Registrar Verification sent by the Center, *i.e.* the disputed domain name <danskonederland.co> was allegedly registered by Melanie Oster and the disputed domain names <dansko-nederland.com>, <danskopolska.com>, and <danskoshoeireland.com> were allegedly registered by Client Care, Web Commerce Communications Limited.

In its Amended Complaint the Complainant requests the Panel to consolidate the cases.

Paragraph 10(e) of the UDRP Rules grants a panel the power to consolidate multiple domain name disputes.

In the Panel's view the Complainant submitted sufficient evidence to justify the consolidation in terms of common control of the domain names or corresponding websites and fairness and equitableness of the consolidation to all parties.

As set forth in section 4.11.2 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"): "Panels have considered a range of factors, typically present in some combination, as useful to determining whether such consolidation is appropriate, such as similarities in or relevant aspects of (i) the registrants' identity(ies) including pseudonyms, (ii) the registrants' contact information including email address(es), postal address(es), or phone number(s), including any pattern of irregularities, (iii) relevant IP addresses, name servers, or webhost(s), (iv) the content or layout of websites corresponding to the disputed domain names, (v) the nature of the marks at issue (*e.g.*, where a registrant targets a specific sector), (vi) any naming patterns in the disputed domain names (*e.g.*, <mark-country> or <mark-goods>), (vii) the relevant language/scripts of the disputed domain names particularly where they are the same as the mark(s) at issue, (viii) any changes by the respondent relating to any of the above items following communications regarding the disputed domain name(s), (ix) any evidence of respondent affiliation with respect to the ability to control the disputed domain name(s), (x) any (prior) pattern of similar respondent behavior, or (xi) other arguments made by the complainant and/or disclosures by the respondent(s)."

The Panel considers the consolidation as appropriate, taking into consideration the following factors: 1) in particular, the disputed domain names share the same IP Address; 2) the disputed domain name <dansko-nederland.com> redirects to the disputed domain name <danskonederland.co>, which is the only disputed domain name owned by a different Registrant; 3) the disputed domain names resolves to websites containing nearly identical, infringing content 4) the disputed domain names follow the same naming pattern by incorporating DANSKO followed by geographic and/or descriptive terms. All these elements give evidence of a common control of the domain names at issue.

On the balance of probabilities and taking into account the above circumstances of the present case, the Panel finds that the disputed domain names are under common control. The Panel is also satisfied that consolidation of these disputes is fair and equitable to all parties, and that they should be consolidated in the interest of procedural efficiency (*s. Pandora A/S v. Larry Sack, Alice Ferri, marino blasi, Sirkin Mösening, Meghan Pier, Monica Lugo, Tom Fargen, CAC Case No. 103259*).

5. Factual Background

The Complainant is the registered owner of several trademarks consisting of or containing DANSKO, e.g. United States of America trademark registration no. 2712957, registered on May 6, 2003, for goods in class 25.

The disputed domain name <danskopolska.com> was registered on October 24, 2022, the disputed domain name <danskoshoeireland.com> was registered on August 19, 2022, the disputed domain name <dansko-nederland.com> was registered on February 8, 2022, the disputed domain name <danskonederland.co> was registered on March 2, 2023. The disputed domain names resolve to websites displaying the Complainant's logo, and offering for sale products under the Complainant's trademarks.

6. Parties' Contentions

A. Complainant

It results from the Complainant's allegations that since 1990, it has provided comfort footwear to customers around the world. Beginning with clog sales, the Complainant now offers other footwear including boots, sandals, flats, and sneakers, all designed for long-wear and comfort.

In addition, it uses the domain name <dansko.com> for advertising and selling its products.

The Complainant further contends that the disputed domain names are confusingly similar to the Complainant's trademark DANSKO, as they incorporate the entirety of the Complainant's trademark DANSKO. The addition of the geographic and or descriptive terms are considered not sufficient to eliminate the confusing similarity with the Complainant's trademark DANSKO.

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain names. According to the Complainant, the Respondent is not commonly known as "dansko," or any of the terms in the disputed domain names. Moreover, there is no evidence connecting the Respondent with the disputed domain names and the Complainant has not authorized, licensed, or endorsed the Respondent's use of its DANSKO marks in the disputed domain names. The Respondent's use of the disputed domain names is neither a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use. In fact, they resolve to websites with infringing content, prominently featuring the Complainant's DANSKO marks and purporting to offer identical footwear goods. The Respondent has made every effort to confuse consumers into believing the disputed domain names are related to the Complainant by offering footwear and footwear products via websites that are confusingly similar to the Complainant's *bona fide* website.

Finally, the Complainant contends that the disputed domain names were registered and are being used in bad faith. According to the Complainant, the Respondent clearly had the Complainant in mind when registering the disputed domain names since the Respondent registered them in 2022 and 2023, long after the Complainant first began using and registered the DANSKO mark. This is evidenced not only by the confusingly similar disputed domain names which use the DANSKO mark entirely, but also by the fact that the disputed domain names resolve to websites which prominently display the Complainant's DANSKO mark. The Respondent also concealed its true identity by registering the disputed domain names through a privacy service and supports the inference that the Respondent has knowingly engaged in the registration and use of the disputed domain names in bad faith. Moreover, it is apparent that the Respondent registered the disputed domain names to trade off of the Complainant's goodwill in its DANSKO marks and to confuse consumers into believing that the disputed domain names are affiliated or associated with the Complainant when that is not the case.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to “decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”. Paragraph 4(a) of the Policy requires a complainant to prove each of the following three elements in order to obtain an order that the disputed domain name be transferred or cancelled:

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

The Panel will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must establish rights in a trademark or service mark and secondly establish that the disputed domain names are identical or confusingly similar to a trademark in which the Complainant has rights.

It results from the evidence provided, that the Complainant is the owner of various trademark registrations for DANSKO as indicated in the Factual Background of this Decision.

Prior UDRP panels have found that a disputed domain name is confusingly similar to a complainant's trademark where the disputed domain name incorporates the complainant's trademark in its entirety (see [WIPO Overview 3.0](#) at section 1.7).

This Panel shares this view and notes that the Complainant's registered trademark DANSKO is fully included in the disputed domain names, followed by the terms “polska”, “shoe” “ireland”, and “nederland” (and hyphen) respectively. Furthermore, it is the view of this Panel that the addition of these terms in the disputed domain names cannot prevent a finding of confusing similarity between the disputed domain names and the Complainant's trademark DANSKO since the Complainant's trademark is clearly recognizable in the disputed domain names (see [WIPO Overview 3.0](#) at section 1.8).

Finally, the generic Top-Level Domain (“gTLD”) “.com” and the country code Top-Level Domain (“ccTLD”) “.co” of the disputed domain names may be disregarded under the first element confusing similarity test as it is viewed as a standard registration requirement (see [WIPO Overview 3.0](#) at section 1.11.1).

In the light of the above, the Panel finds that the disputed domain names are confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to

be proved, shall demonstrate the Respondent's rights or legitimate interests to the disputed domain names. In the Panel's view, based on the undisputed allegations stated above, the Complainant has made a *prima facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain names.

According to the Complaint, which has remained unchallenged, the Complainant has no relationship in any way with the Respondent and did not authorize the Respondent's use of the trademark DANSKO, e.g., by registering the disputed domain names comprising the said trademark entirely.

Furthermore, the Panel notes that there is no evidence showing that the Respondent might be commonly known by the disputed domain names in the sense of paragraph 4(c)(ii) of the Policy.

Furthermore, the nature of the disputed domain names carries a risk of implied affiliation, since all the disputed domain names contains the Complainant's trademark DANSKO followed by the terms "polska" (corresponding to Poland in English), "nederland" (being a misspelling of the term Netherlands), "ireland" and geographic terms are seen as tending to suggest sponsorship or endorsement by the trademark owner (see [WIPO Overview 3.0](#), section 2.5.1). In addition, the risk of implied affiliation is even reinforced in the disputed domain name <danskoshoeireland.com> since the disputed domain name contains the Complainant's trademark DANSKO followed by the term "shoe", which is related to the Complainant's business activity, see [WIPO Overview 3.0](#), section 2.5.1.

This is also confirmed by the content of the websites to which the disputed domain names resolve, displaying without authorization the Complainant's logo and offering for sale clothing under the Complainant's trademark.

It is acknowledged that once the Panel finds a *prima facie* case is made by a complainant, the burden of production under the second element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name (see [WIPO Overview 3.0](#) at section 2.1). Since the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names and the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds, in the circumstances of this case, that the Respondent has no rights or legitimate interests in the disputed domain names.

The Panel finds that the Complainant has therefore satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith. One of these circumstances is that the Respondent by using the disputed domain name, has intentionally attempted to attract, for commercial gain, Internet users to its 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 its website or location or of a product or service on its website or location (paragraph 4(b)(iv) of the Policy). It is the view of this Panel that these circumstances are met in the case at hand.

It results from the Complainant's documented allegations that the disputed domain names resolve to websites displaying the Complainant's logo, and offering for sale shoes under the Complainant's trademarks.

For the Panel, it is therefore evident that the Respondent positively knew the Complainant's mark. Consequently, and in the absence of any evidence to the contrary, the Panel is convinced that the Respondent also knew that the disputed domain names included the Complainant's trademark when it registered the disputed domain names. This is underlined by the fact that all the disputed domain names are clearly constituted by the Complainant's trademark followed by the geographical terms and also by the term

“shoe” - which is related to the Complainant’s business activity - for the disputed domain name <danskoshoeireland.com>. Registration of a disputed domain name which contains a third party’s mark, in awareness of said mark and in the absence of rights or legitimate interests amounts to registration in bad faith. In the circumstances of this case, the Panel finds that the registration of the disputed domain names was in bad faith.

Finally, the further circumstances surrounding the disputed domain names’ registration and use confirm the findings that the Respondent has registered and is using the disputed domain names in bad faith (see [WIPO Overview 3.0](#) at section 3.2.1):

- (i) the nature of the disputed domain names (all domain names incorporating the Complainant’s mark plus the addition of geographic terms and the term “shoe” in the disputed domain name <danskoshoeireland.com>);
- (ii) the content of the websites to which the disputed domain names direct, displaying the Complainant’s logo, and offering for sale shoes under the Complainant’s trademark;
- (iii) a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent’s choice of the disputed domain names;
- (iv) the respondents concealing their identity.

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, <danskonederland.co>, <dansko-nederland.com>, <danskopolska.com>, and <danskoshoeireland.com> be transferred to the Complainant.

/Federica Togo/

Federica Togo

Sole Panelist

Date: July 26, 2023