

## **ADMINISTRATIVE PANEL DECISION**

Dansko, LLC v. Peter Byrne  
Case No. D2023-2218

### **1. The Parties**

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

Respondent is Peter Byrne, United States of America.

### **2. The Domain Name and Registrar**

The disputed domain name <danskoshoesoutlets.com> is registered with Key-Systems GmbH (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 22, 2023. On May 23, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 24, 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 (REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to Complainant on May 30, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on May 31, 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 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. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on June 22, 2023.

The Center appointed Timothy D. Casey as the sole panelist in this matter on July 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

Complainant has been a retailer of footwear since 1990. Complainant is the owner of numerous trademark registrations that include “Dansko” as the trademark or part of the trademark (the “DANSKO Marks”), including the following:

Mark	Jurisdiction	Class(es)	Registration No.	Registration Date
DANSKO	United States of America	25	3854991	September 28, 2010
DANSKO	United States of America	3, 18, 25, 35	4229847	October 23, 2012
DANSKO	United States of America	25	3265194	July 17, 2007
DANSKO	United States of America	25	2712957	May 6, 2003
DANSKO and Design	United States of America	3, 18, 25, 35	4229969	October 23, 2012
DANSKO and Design	United States of America	25	3265196	July 17, 2007

The disputed domain name was registered January 14, 2022.

Complainant provided evidence showing that the disputed domain name is being used in connection with a website that uses Complainant’s DANSKO Marks in connection with the sale of footwear.

#### 5. Parties’ Contentions

##### A. Complainant

Complainant contends that the disputed domain name is confusingly similar to the DANSKO Marks because it contains the DANSKO Marks in their entirety, only adding the descriptive terms “shoes” and “outlets.” Complainant cited a prior UDRP case that found the addition of such descriptive terms did not eliminate confusing similarity. Complainant contends that the Top-Level Domain (“.com”) of the disputed domain name is not an element of distinctiveness.

Complainant contends that Respondent has no rights or legitimate interests in the disputed domain name, is not affiliated with Complainant, and there is no evidence to suggest Respondent has registered the disputed domain name to advance legitimate interests for the *bona fide* offering of legitimate goods or services. Complainant cited prior UDRP cases that found that adverse inferences may be drawn as to Respondent’s rights or legitimate interest by the fact that Respondent anonymously registered the disputed domain name. Complainant further contends that the address provided by Respondent to the Registrar does not correspond to an actual location, is unverifiable, and appears to be false, which indicates an attempt to conceal Respondent’s true identity.

Complainant contends that Respondent is not commonly known as “Dansko” or any of the descriptive terms in the disputed domain name, and there is no evidence that Respondent’s use has been authorize, licensed, or endorsed by Complainant. Complainant contends that Respondent’s use of the disputed domain name is neither a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use, which is further highlighted by the fact that the disputed domain name resolves to a website including infringing content, featuring the DANSKO Marks and purporting to offer identical footwear.

Complainant contends that Respondent registered the disputed domain name for the purpose of disrupting Complainant’s business by creating a likelihood of confusion with the DANSKO Marks as to the source, sponsorship, affiliation, or endorsement of Respondent’s website by using the DANSKO Marks, images that

appear to be from Complainant's website, and by offering footwear for sale. Complainant also contends Respondent registered the disputed domain name after the registrations for the DANSKO Marks and clearly with the DANSKO Marks in mind.

## **B. Respondent**

Respondent did not reply to Complainant's contentions.

## **6. Discussion and Findings**

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

Complainant's use of the DANSKO Marks for more than 30 years and registrations for the same are more than sufficient to establish that Complainant has trademark rights in the DANSKO Marks prior to registration of the disputed domain name.

Complainant contends that the disputed domain name is confusingly similar to the DANSKO Marks.

Given that Complainant's DANSKO Marks are recognizable in the disputed domain name the Panel agrees and finds that the disputed domain name is confusingly similar to the DANSKO Marks.

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

The Panel finds that Respondent has no rights or legitimate interests in the disputed domain name. Respondent does not appear to be commonly known by the disputed domain name. Complainant has not licensed or otherwise permitted Respondent to use the DANSKO Marks.

Respondent's use of the disputed domain name in association with a website impersonating Complainant's website and appearing to sell footwear made by Complainant or counterfeiting Complainant's products is not a *bona fide* offering of goods or service that would give rise to rights or a legitimate interest in the disputed domain name.

Furthermore, the nature of the disputed domain name, comprising the DANSKO Marks and adding two descriptive terms carries a risk of implied affiliation with Complainant as it effectively impersonates or suggests sponsorship or endorsement by Complainant, and accordingly cannot constitute a fair use in these circumstances. See section 2.5.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). The addition of the descriptive terms in the disputed domain name only serves to further increase the level of falsely suggested sponsorship or endorsement by Complainant.

Respondent has not rebutted Complainant's *prima facie* case and has provided no arguments or evidence showing potential rights or legitimate interests in the disputed domain name. For these reasons, the Panel finds that Respondent has no rights or legitimate interests in the disputed domain name.

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

Given i) the timing of Complainant's first use of the DANSKO Marks in 1990 and the numerous prior registrations of the DANSKO Marks, predating registration of the disputed domain name by many years, Complainant being located in the United States of America where Respondent reportedly resides, and Complainant's use of the DANSKO Marks in association with footwear, ii) the inherently misleading nature of the disputed domain name as a combination of the DANSKO Marks with descriptive terms, in combination with a deceptive website engaged in potentially competitive activity, and iii) Respondent's use of the disputed domain name, indicates that Respondent had clear knowledge of the DANSKO Marks and Complainant's business prior to registration.

The Panel finds that Respondent's registration of the disputed domain name was in bad faith.

In addition, the Panel finds Respondent's usage of the disputed domain name to attract consumers to a website associated with the disputed domain name by falsely associating the website with Complainant constitutes use in bad faith consistent with paragraph 4(b)(iv) of the Policy.

The Panel concludes that the disputed domain name was registered and has been used in bad faith.

## **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, <danskoshoesoutlets.com>, be transferred to Complainant.

*/Timothy D. Casey/*

**Timothy D. Casey**

Sole Panelist

Date: July 27, 2023