

## **ADMINISTRATIVE PANEL DECISION**

### **Dansko, LLC v. Web Commerce Communications Limited, Client Care Case No. D2023-2334**

#### **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, Client Care, Malaysia.

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

The disputed domain names <danskoclogsaustralia.com>, <danskooutletespana.com>, <danskoschuhehandler.com>, <danskozoccoll.com>, <slovenskodanskoonline.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 May 30, 2023. On May 31, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On June 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 that was previously put in the Complaint. The Center sent an email communication to the Complainant on June 9, 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 June 13, 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 19, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 9, 2023. The Respondent failed to submit any response to the complaint. Accordingly, the Center notified the Respondent’s default on July 14, 2023.

The Center appointed Ada L. Redondo Aguilera as the sole panelist in this matter on July 28, 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 footwear company that sales boots, sandals, flats, sneakers and clogs, all designed for long time wear and comfort. The Complainant's official website is "dansko.com".

The Complainant has registered their DANSKO trademark in the United States Patent and Trademark office, to mention some of them the following registrations:

Mark	Registration number	Registration date	Class (Nice Classification)
DANSKO	3854991	September 28, 2010	(International Class: 25) Socks
DANSKO	4229847	October 23, 2012	(International Class: 03) leather and suede cleaning and protecting preparations; shoe creams; shoe cleaner; sponges impregnated with shoe polish; shoe care cleaning kits comprised of shoe cleaners and shoe brushes.  (International Class: 18) all-purpose carrying bags; handbags  (International Class: 25) clothing, namely, [ hats and ] shirts  (International Class: 35) retail footwear [ and apparel ] store services; on-line retail store services featuring footwear and apparel
DANSKO	3265194	July 17, 2007	(International Class: 25) footwear; component parts of footwear, namely, tips and heel pieces; and leather shoes and imitation leather shoes
DANSKO	2712957	May 6, 2003	(International Class: 25) footwear, namely, casual outdoor shoes and work shoes for use in the health care, food service, equestrian, and general service industries
DANSKO and design	4229969	October 23 2012	(International Class: 03) leather and suede cleaning and protecting preparations; shoe creams; shoe cleaner; sponges impregnated with shoe polish; shoe care cleaning kits comprised of shoe cleaners and shoe brushes (International Class: 18) all-purpose carrying bags; handbags (International Class: 25) clothing, namely, [ hats and ] shirts (International Class: 35) retail footwear [ and apparel ] store services; on-line retail store services featuring footwear and apparel

DANSKO and design	3265196	July 17, 2007	(International Class: 25) footwear; component parts of footwear, namely, tips and heel pieces; and leather shoes and imitation leather shoes
DANSKO and design	2712953	May 6, 2003	(International Class: 25) footwear, namely, casual outdoor shoes and work shoes for use in the health care, food service, equestrian, and general service industries
DANSKO NARURAL ARCH	5638606	December 25, 2018	International Class 25: footwear, insoles for footwear
DANSKO NATURAL ARCH PLUS	6540779	October 26, 2021	(International Class: 25) Footwear; Insoles for footwear
DANSKO XP	4172633	July 10, 2012	(International Class: 25) Footwear

The disputed domain names were registered in the following dates:

1. <danskozoccoll.com> registered on august 30, 2022;
2. <danskooutletespana.com> registered on October 8, 2022;
3. <danskoschuhehandler.com> registered on February 8, 2022;
4. <slovenskodanskoonline.com> registered on February 8, 2022;
5. <danskoclogsaustralia.com> registered on October 22, 2021.

The disputed domain names resolve to websites prominently featuring the Complainant's DANSKO trademarks purporting to offer the Complainant's footwear goods at discounted prices.

## 5. Parties' Contentions

### A. Complainant

The Complainant argues that the disputed domain names are confusingly similar to its DANSKO trademark due to the fact that each of the disputed domain names includes the complete trademark. Additionally, the Complainant argues that the Respondent has no rights or legitimate interests with respect to the disputed domain names and finally, that the Respondent registered and is using the disputed domain names in bad faith. The Complainant requests the transfer of the disputed domain names.

### B. Respondent

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

## 6. Discussion and Findings

### A. Identical or Confusingly Similar

The Panel finds that the Complainant has established that it has registered trademark rights in the DANSKO trademark. In WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1, is stated that "Where the Complainant holds a nationally or regionally

registered trademark or service mark, this *prima facie* satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case.”

In order to establish the confusing similarity test, panels typically do a side-by-side comparison between the trademark and the domain name to establish if the complainant’s trademark is recognizable within each of the disputed domain names.

In the present case, the disputed domain names are:

- 1) <[danskozoccoll.com](http://danskozoccoll.com)>
- 2) <[dankooutletespana.com](http://dankooutletespana.com)>
- 3) <[danskoschuhehandler.com](http://danskoschuhehandler.com)>
- 4) <[slovenskodanskoonline.com](http://slovenskodanskoonline.com)>
- 5) <[danskoclogsaustralia.com](http://danskoclogsaustralia.com)>

The first disputed domain name <[danskozoccoll.com](http://danskozoccoll.com)> includes the trademark DANSKO with the additional term “zoccoll” and the generic Top-Level Domain (“gTLD”) “.com”;

The second disputed domain name <[dankooutletespana.com](http://dankooutletespana.com)> includes the DANSKO trademark with the additional term “outlet” and the geographical term “espana”, and the gTLD “.com”;

The third disputed domain name <[danskoschuhehandler.com](http://danskoschuhehandler.com)> includes the DANSKO trademark with the term “schuhehandler” and the gTLD “.com”;

The fourth disputed domain name <[slovenskodanskoonline.com](http://slovenskodanskoonline.com)> includes the DANSKO trademark with the additional terms “slovensko” and “online” and the gTLD “.com”;

And finally, the fifth disputed domain name <[danskoclogsaustralia.com](http://danskoclogsaustralia.com)> includes the DANSKO trademark with the terms “clogs” and the geographical term “australia” and the gTLD “.com”.

All the disputed domain names with the additional terms do not prevent a finding of confusing similarity under the first element. Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (see section 1.8 of [WIPO Overview 3.0](#)).

Additionally, it is well established that the gTLD (in this case “.com”) is generally disregarded when considering whether a disputed domain name is confusingly similar to the trademark in which the complainant has rights due to the fact that it’s considered as a standard registration requirement (see section 1.11.1 of the [WIPO Overview 3.0](#)).

For all the foregoing reasons, the Panel finds that the disputed domain names: <[danskozoccoll.com](http://danskozoccoll.com)> <[dankooutletespana.com](http://dankooutletespana.com)>; <[danskoschuhehandler.com](http://danskoschuhehandler.com)>; <[slovenskodanskoonline.com](http://slovenskodanskoonline.com)>; and <[danskoclogsaustralia.com](http://danskoclogsaustralia.com)> are confusingly similar to trademarks in which the Complainant has rights and that the requirements of paragraph 4(a)(i) of the Policy therefore are fulfilled.

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

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights to or legitimate interests in a disputed domain name by demonstrating any of the following:

- (i) Before any notice to you of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) The Respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) The Respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers, or to tarnish the trademark or service mark at issue.

Although the Policy addresses ways in which a respondent may demonstrate rights or legitimate interests in a disputed domain name, it is well established that, as it is put in section 2.1 of the [WIPO Overview 3.0](#), a complainant is required to make out a *prima facie* case that the Respondent lacks rights or legitimate interests. Once such *prima facie* case is made, the burden of production shifts to the Respondent to come forward with relevant allegations or evidence demonstrating rights or legitimate interests in the disputed domain names. If the Respondent does come forward with evidence of relevant rights or legitimate interests, the panel weighs all the evidence, with the burden of proof always remaining on the complainant.

In the present case, the Respondent is in default and did not present any argument or evidence that could help to revert the Complainant's contentions.

Therefore, the Panel takes into account the arguments and evidence that the Complainant presented in the present case, taking notice that the Respondent is not referred to or commonly known by the disputed domain name or any related trademark, also that the Complainant has not authorized the Respondent to use the trademark in any way including use in a domain name and that the Respondent's disputed domain names is neither used in connection with a *bona fide* offering of goods or/and services nor constitutes a legitimate noncommercial or fair use.

The Panel finds that 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, the Disputed Domains resolve to websites with content that prominently features the Complainant's DANSKO trademarks and copyrighted images purporting to offer identical footwear goods in lower prices. According to the evidence presented in the present case demonstrating that 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 website, we find relevant to establish regarding this topic, that other panels have held that such actions evidence respondent's lack of rights or legitimate interests in the disputed domain names, see *SuperMedia LLC v. Gina Parrado*, WIPO Case No. [D2011-1295](#) (pointing to the respondent's efforts to confuse consumers through operating a confusingly similar website and stating that "such actions are strong evidence that [the respondent] has no rights or legitimate interests in the disputed domain name."). Overall, there is no evidence that the Respondent is: (i) using the disputed domain names for a *bona fide* offering of goods or services; (ii) known by the "Dansko" designation or anything similar; or (iii) making any legitimate noncommercial or fair use. Rather, the Respondent uses the disputed domain names to deliberately cause consumer confusion with the Complainant's DANSKO trademarks and goods.

In conclusion, the Panel finds that the Complainant has made out a *prima facie* case. The Respondent has not responded, and based on the record, the Panel is unable to conceive any basis upon which the Respondent could have any rights or legitimate interests in respect of the disputed domain names.

This Panel also finds that the Respondent is not known under the disputed domain names or the Complainant's trademark and does not make any *bona fide* use, neither commercial nor noncommercial use, we find compelling to emphasize the fact that all the disputed domain names resolves towards an active webpage that offers similar products of the Complainant and therefore creates an active confusion regarding the origin of the products. The Internet users who visit the website displayed in any of the disputed domain

names could believe or be induced to confusion, believing that the products shown on the website are the Complainant's products.

In the present case, the Complainant made a *prima facie* case that the Respondent lacks rights or legitimate interests to which the Respondent failed to respond.

For the foregoing reasons the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain names and the requirements of paragraph 4(a)(ii) of the Policy therefore are fulfilled.

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

In order to prevail under the Policy, the Complainant must show that the disputed domain names have been registered and are being used in bad faith.

The Complainant's DANSKO trademarks have been continuously and extensively used for many years and have as a result acquired a considerable reputation and goodwill worldwide. Accordingly, the Panel is satisfied and certain that the Respondent must have been aware of the trademarks DANSKO when it registered the disputed domain names, noting also that the disputed domain names include the complete trademark DANSKO.

Taking into account all of the above, it is clear that the choice of the disputed domain names and the conduct of the Respondent are indicative of registration and use of the disputed domain names in bad faith.

About the use of the disputed domain names:

The Panel analyzed the Respondent's actions finding that the use of the disputed domain names intentionally attempts to attract, for commercial gain, Internet users to the websites by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or of the products on that website. Therefore, the Panel finds that the Respondent registered the confusingly similar disputed domain names and used them as websites to promote identical goods in competition with or to imitate the Complainant.

For all the foregoing reasons, the Panel finds that all the disputed domain names have been registered and are being used in bad faith.

In summary, this Panel finds that the Respondent, by choosing to register and use the disputed domain names, which are confusingly similar to the Complainant's well-known trademark, in the absence of convincing evidence and rebuttal to the contrary from the Respondent, are indicative of registration and use of the disputed domain names in bad faith.

For all the foregoing reasons, the Panel sustains that the Complaint fulfils the third condition of paragraph 4(a) 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, <danskoclogsaustralia.com> <danskooutletespana.com> <danskoschuhehandler.com> <danskozoccoll.com> <slovenskodanskoonline.com>, be transferred to the Complainant.

*/Ada L. Redondo Aguilera/*

**Ada L. Redondo Aguilera**

Sole Panelist

Date: August 11, 2023